

O-300-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2373346  
BY A2P INTERNATIONAL LIMITED  
TO REGISTER THE TRADE MARK:**

**MEGADENT**

**IN CLASSES 3, 5 AND 21**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 93191  
BY  
LIDL STIFTUNG & CO KG**

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### **BACKGROUND**

1) On 18 September 2004 A2P International Limited, which I will refer to as A2P, applied to register the trade mark MEGADENT (the trade mark). The application was published for opposition purposes in the "Trade Marks Journal" on 12 November 2004 with the following specification:

*toothpastes; medical toothpastes; toothpaste for smokers; cleaning preparations for the teeth; cosmetic preparations for cleansing the teeth; disclosing liquid for personal use in indicating tartar on the teeth; disclosing tablets for personal use in indicating tartar on the teeth; rinses to prevent tartar forming on the teeth; deodorants for the body; deodorants for the feet; roll-on deodorants; soaps; all included in Class 3;*

*mouthwashes; dental rinses; dental abrasives; dental adhesives, chemical products for dental purposes; cleaners [preparations] for sterilising dental instruments; all included in Class 5;*

*toothbrushes; electric toothbrushes; holders for toothbrushes; devices for cleaning the teeth; all included in Class 21.*

The above goods are in classes 3, 5 and 21 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 14 February 2005 Lidl Stiftung & Co KG, which I will refer to as Lidl, filed a notice of opposition to the application. Lidl is the owner of international registration no 658803 of the trade mark NEVADENT. Its date of designation in the United Kingdom is 17 March 2003 and it is protected. It is protected for the following goods:

*dentifrices;*

*toothbrushes.*

The above goods are in classes 3 and 21 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the

Registration of Marks of 15 June 1957, as revised and amended. Lidl claims that the respective trade marks are similar. It claims that the respective goods are similar or identical. Consequently, there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Lidl claims that its trade mark has a reputation in respect of toothbrushes. It claims that the respective trade marks are similar. Lidl claims that use of the trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of its trade mark by suggesting a link between the respective trade marks in the mind of an average consumer. Consequently, registration of the trade mark would be contrary to section 5(3) of the Act.

4) A2P filed a counterstatement. It denies that the trade marks are similar and so denies the grounds of opposition under section 5(2)(b) of the Act. It denies the grounds of opposition under section 5(3). A2P also claims that the section 5(3) ground of opposition lacks sufficient particularisation. It requests, that when an assessment of costs is made, that the lack of particularisation is taken into account.

5) Both sides filed evidence.

6) A hearing was held on 27 September 2006. Lidl was represented by Ms Simpson of Urquhart-Dykes & Lord LLP. A2P was represented by Ms Lazenby of Claire Lazenby.

## **EVIDENCE**

### **Evidence of Lidl**

7) This consists of a witness statement by Peter Fischer, who is the Managing Director of Lidl Stiftung & Co Beteiligungs-GmbH, which is a “general partner” of Lidl.

8) Lidl owns and operates a chain of grocery stores which have been trading in the United Kingdom since 1994. At the date of Mr Fischer’s statement it had more than 330 stores in the United Kingdom. The date of Mr Fischer’s statement is written by hand and it is not possible to know exactly in which month it was signed. It could have been August or September; however, it was the 29th of the month and in 2005. NEVADENT was first used on Lidl’s “toothbrush twin pack” in June 2000, its “Perfection Toothbrush” in March 2003 and for dental floss in February 2002. Exhibited at PF1 is a sales summary list of goods sold under the NEVADENT trade mark. It is neither stated nor indicated that these sales relate to the United Kingdom. All of the information is written in German with the exception of annotations by hand, which name the specific product. The details for dental floss, as per exhibit PF1, show no sales in 2002 other than August, which is contradictory to the statement that first use was in February 2002. The goods sold under the NEVADENT trade mark have been available for purchase at Lidl’s stores throughout the United Kingdom at various times. Exhibited at PF2 are a variety of sales invoices and delivery notes. The majority of the invoices are from Trisa of Switzerland, a number of these emanate from after the date of application. Invoices dated 22 October 2003, 28

January 2004 and 20 July 2004 show deliveries, respectively, of 10,884, 10,884 and 14,454 products (some of these products appear to contain more than one toothbrush). A delivery note dated 19 March 2003 has strikings out and amendments by hand and it is not possible to be certain what it is indicating. There are three delivery notes from Westone Products Limited; two are dated prior to the date of application. They are all for one pallet of NEVADENT dental floss, containing 5760 products.

9) Approximate annual sales figures are given for NEVADENT products, which show the same figures as those in PF1. The figures given are as follows (the part year figures are calculated on the basis of the figures given in PF1):

Year	Toothbrush twin pack	Perfection tooth brush	Dental floss
2000	272,340		
2001	364,140		
2002	458,940		28,800
2003	401,370	238,500	190,080
2004 (to end of August)	346290	235,620	132,480

The turnover in euros for the goods is as follows:

Year	Toothbrush twin pack	Perfection tooth brush	Dental floss
2000	433,021		
2001	578,983		
2002	467,203		28,512
2003	397,356	379,215	266,515
2004 (to end of August)	342,827	374,635	131,155

Again it is not stated if these figures relate solely to the United Kingdom. The approximate amounts spent on promotion of goods sold under the NEVADENT trade mark are as follows:

2000 - 2001	€5,000
2001 - 2002	€10,000
2002 - 2003	€10,000
2003 - 2004	€10,000

It is not stated if this relates solely to promotion in the United Kingdom. Examples of advertisements are exhibited at PF4; the advertisements are contained in newsletters distributed by Lidl throughout its stores in the United Kingdom. Lidl also distributes approximately 10,000 newsletters per week directly to households. Exhibit PF4 has more than one copy of the same advertisement. There are in fact three advertisements. The years of the advertisements are not given but by matching the day with the date, this can

be ascertained. A promotion advertising products available from Thursday 6 May 2002 shows “nevadent” dental floss and toothbrushes. A promotion advertising products available from Thursday 29 May 2003 shows “Nevadent” toothbrushes. The third advertisement, from Monday 24 May 2004, does not show any NEVADENT products. The two newsletters in which NEVADENT products appear included a large variety of other products sharing the page(s) with the NEVADENT products. One of the newsletters also shows Dentalux mouth wash and toothpaste.

### **Evidence of A2P**

10) This consists of a witness statement by Diana Pennock Connolly. Ms Connolly has thirty years experience in business, technical and patent research. Until April 2005 she was responsible for this research at Bristows. She left Bristows to be the head of Findtech; this is a firm that she is developing to provide information to the intellectual property profession. She was asked by Ms Lazenby to undertake some research into the United Kingdom market for oral hygiene.

11) Exhibited at DC1 are extracts from a report by Mintel entitled ‘Oral Hygiene –UK-March 2004’. The reports states:

“The oral hygiene market comprises toothpaste, denture products, mouthwash/breath fresheners and ancillary items, such as dental floss and disclosing tablets. While toothpaste dominates the market, it has also hampered the growth of the industry, having long since reached saturation point ...”

The report states that the market for oral hygiene stands at £442 million, £31 million is invested in advertising oral hygiene products and most of the products are sold through supermarkets. At DC2 a copy of an article from the magazine ‘Marketing’ is exhibited, it is headed ‘Oral Care – Dental Diversification’. The article is dated 22 September 2004. It states that in the previous year United Kingdom consumers spent £440 million on oral hygiene. The article states that GlaxoSmithKline and Colgate Palmolive account for more than 75% of toothpaste sales. The article includes figures for ancillary products, defined as floss, dental gum etc, which show that between 1999 and 2003 the size of this market rose from £13 million to £25 million.

12) Exhibited at DC3 are extracts from a Mintel report entitled ‘Toothbrushes – UK-April 2004’. Mintel valued the market to be worth £201 million in 2004, with the volume decreasing by 8% from the previous year. The report states that powered toothbrushes account for almost half of the market. It states that most manual toothbrushes are sold at supermarkets whilst most electric toothbrushes are bought through catalogue outlets. It lists the “key players” as Colgate Palmolive, GlaxoSmithKline, Johnson & Johnson, Wisdom, Philips and Gillette; Gillette and Philips dominate the power operated toothbrush market.

13) Exhibited at DC4 are extracts from a paper published by GlaxoSmithKline entitled ‘Toothbrush Market Overview’. Two graphs and a chart are exhibited. The graphs show

the market value for manual toothbrushes in the United Kingdom in 2003 to be £105 million with GlaxoSmithKline having 13% of that market. The chart shows GlaxoSmithKline's main competitors in the manual toothbrush market: Colgate, Gillette, P&G, Unilever and Jordan.

14) Exhibited at DC5 are pages from the websites of the key players in the United Kingdom toothbrush market. These show that Aquafresh, Colgate and Crest are used for both toothpastes and toothbrushes. Aquafresh is also used in relation to dental lozenges and dental gum. The pages exhibited for Oral-B and Wisdom do not refer directly to toothpaste. However, the Oral-B banner has sections headed: whitening, floss and interdental, toothpaste and mouth rinse.

15) Exhibited at DC6 are the results of the searches that Ms Connolly made in the United Kingdom publications database of Lexis Nexis. Ms Connolly states that the database is particularly good for business and commercial reports from general sources such as 'Marketing Week' and the 'Financial Times'. The results show hits from a wide number of sources eg 'Mail on Sunday', 'Daily Record', 'Chemist & Druggist', 'The Times', 'The Guardian', 'The Daily Mail', 'Bristol Evening Post', 'Daily Star' and 'The Evening Standard'. Ms Connolly states that a search for articles published in the last five years in the United Kingdom found 383 hits for Aquafresh, 401 hits for Oral-B, 59 hits for Mentadent and 206 hits for Crest. There were no hits for NEVADENT.

16) Using information from company websites, exhibited at DC7, the figures of the number of stores that various supermarkets operate are given:

Aldi	300
Asda	289
Budgens	227
Kwik Save	494
Morrisons/Safeway	+400
Netto	136
Sainsbury	727
Sommerfield	814
One Stop	527
Tesco	1252
Waitrose	165

The same sources of information are used for the Boots and Superdrug chains of chemists/pharmacies. The former has 1400 branches and the latter 700. Ms Connolly states that most of the figures relate to 2005 but there was nothing in her searching, apart from the annual report of Sainsbury which indicates that the number of stores in its chain in 2004 was 144 less than in 2005, led her to believe that the figures for 2004 and 2003 were significantly different from those for 2005.

17) Exhibited at DC8 is a page from the website of the British Dental Health Foundation, downloaded on 5 January 2006. This shows an Infadent branded toothbrush being for

sale. Exhibited at DC9 are pages downloaded from the website of ReachPharmacy.com on 5 January 2006. This shows a Mentadent toothbrush being offered for sale. Exhibited at DC10 to DC14 are various pages downloaded from the Internet on 5 January 2006. These show the following products being offered for sale:

Mentadent P toothpaste;  
Dentemp os filling material;  
Dentemp dental wax;  
Fixodent dental adhesive;  
Steradent;  
Dentural;  
Dentucreme;  
DentiMint mouthwash;  
Dentiplus mouthwash  
Dentyl mint and clove mouthwashes.

## **DECISION**

### **Preliminary indication**

18) In her skeleton Ms Lazenby referred to the preliminary indication made in relation to the opposition. At the outset of the hearing I stated that the preliminary indication had no effect upon me and that I had a self-denying ordinance which stopped me looking at preliminary indications. Ms Lazenby noted that I had written the preliminary indication. This surprised me, as it is the practice of the registrar that the hearing officer and the writer of the preliminary indication are not one and the same. (It did not surprise me that I had no recollection of writing the preliminary indication.) Although the practice has been broken, I do not consider that I should recuse myself from writing the decision. I was not aware of the preliminary indication and, other than seeing my name upon the covering letter, have still not read it. In making my decision I have to consider the evidence before me and the submissions made to me; so the decision making process is very different from that at the preliminary indication stage. In taking into account the evidence and the submissions, I could easily find differently from what I had decided in the preliminary indication. The decision will also give an analysis of the reasoning that give rises to the final finding, so either side can decide if I have fallen into error. Taking all these matters into account I consider that to arrange for another hearing, with the subsequent cost and delay, would be disproportionate. If either side considers that I should have recused myself, it can make that a subject of appeal; when the substantive issues can also be considered, allowing for economy of process. This is not to be taken to indicate that I am not most unhappy that the situation has arisen, which I most certainly am.

### **Limitation of attack**

19) At the hearing Ms Simpson withdrew the attack against *deodorants for the body; deodorants for the feet; roll-on deodorants; soaps*. So these goods no longer have to be considered.

### **Evidence of use**

20) Ms Simpson accepted that the use of Lidl's trade mark upon dental floss was not relevant to the case as the registration upon which it relies does not cover these goods. Ms Lazenby initially made objections to the material exhibited at PF1 and some of the material exhibited at PF2 as it was in German. Rule 72(1) of the Trade Marks Rules 2000 (as amended) states:

“72. - (1) Where any document or part thereof which is in a language other than English is filed or sent to the registrar in pursuance of the Act or these Rules, the registrar may require that there be furnished a translation into English of the document or that part, verified to the satisfaction of the registrar as corresponding to the original text.”

Translation is, therefore, not mandatory. It will depend upon the circumstances. In this case from the internal information in the exhibits eg serial numbers and some limited handwritten translations, and the evidence of Mr Fischer, it is possible to work out the meaning of any key elements that are in German. When I commented upon this to Ms Lazenby she did not press the issue. There is one document, relating to advertising, at the end of exhibit PF2 which is completely in German, that cannot be understood without a knowledge of German and so I have not taken this document into account. Most of the information in PF1 occurs, in another form, in Mr Fischer's statement. The case certainly does not turn upon the material exhibited at PF1 and PF2. Consequently, I have taken the evidence exhibited at PF1 and PF2 into account, with the exception of the last page of PF2.

21) Ms Lazenby submitted that it is not stated that the figures, which I have summarised at paragraph 9, relate to the United Kingdom and that they are in euros. It was her submission that, consequently, it could not be accepted that the figures relate to the United Kingdom. It is not unusual for undertakings to give figures for sales in the United Kingdom in currencies other than sterling; US dollars and euros are commonly used. I see nothing significant in the currency used, especially for a company based in the eurozone. However, I am concerned that Mr Fischer does not make it clear that the figures relate to the United Kingdom. It seems to me that this is a matter of importance, it could be that the figures relate to sales in more than one jurisdiction. It is not uncommon to be presented with trans-national turnover figures in evidence before the registrar. Ms Simpson considered that in the context of the statement it was clear that the figures relate to the United Kingdom. If at one time Mr Fischer specifically refers to the United Kingdom and at another does not, I do not consider that any such assumption can be made. It is quite probable that there is just a lack of precision in the drafting of the



statement. In my experience where trans-national figures are being used this is specifically stated. Owing to the outcome of my findings, nothing will turn upon whether the figures relate to the United Kingdom or trans-national use. Consequently, as it is most likely that the figures relate to the United Kingdom, I will treat them as such. However, in the event of an appeal, I suggest that it would be in the interests of Lidl to file an additional statement from Mr Fischer clarifying this point; subject to the appellate body allowing such additional evidence in.

22) Ms Simpson relied upon the evidence of Lidl in order to establish a reputation for the purposes of section 5(3) of the Act and also to give enhanced protection in the context of section 5(2)(b) of the Act. The parameters in relation to these matters have been set out by the European Court of Justice (ECJ). In *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572 (*Chevy*) ECJ set out the requirements for reputation under section 5(3) of the Act:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

In *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585 the ECJ set out the sort of things that should be considered when considering the distinctiveness of a trade mark arising from its use.

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

23) 2003 was the best full year, prior to the date of application, for sales. The total sales of toothbrushes amounted to €76,571. The Oanda® foreign exchange website gives the average sterling/euro exchange rate for the year 2003 as 0.69240. So the value of sales for 2003 was £537,697. The value of the market place for manual toothbrushes, according to the evidence summarised in paragraph 13, was £105 million; so NEVADENT had 0.51% of the market, in monetary terms. Exhibited at DC3 are extracts

from a Mintel report entitled 'Toothbrushes – UK- April 2004'. Mintel valued the market to be worth £201 million in 2004, with the volume decreasing by 8% from the previous year; which gives a figure for 2003 of approximately £217 million. So NEVADENT's share of the whole toothbrush market in 2003 was 0.25%. The market for toothbrushes is divided into two: powered and the manual brushes. The most relevant segment is that for manual brushes, however, I consider that the market as a whole should not be ignored. Brands such as Oral-B cover both types, and in my experience it is not unusual for people to have both types; using the manual brush for when they are away from home or the powered brush needs recharging.

24) Mr Fischer gives figures for promotion of the goods. The promotion consists of showing the goods in a newsletter which has a number of different products in it. It is difficult to understand, owing to the nature of the promotion, how the expenditure on advertising could be calculated. Whatever the case, the maximum expenditure in any one year was €10,000, this is not a great deal. There appears to be duplication of the material exhibited at PF4; as far as I can see there is only evidence of use on NEVADENT in relation to toothbrushes on two occasions; 6 May 2002 and 29 May 2003. The search by Ms Connolly of the print media data base shows no reference to NEVADENT in a five year period.

25) The NEVADENT goods are only sold in Lidl shops. The information supplied by Ms Connolly shows that the number of shops run by Lidl is quite low in comparison with its competitors; and Ms Connolly does not even make a reference to Co-op shops. As the goods are only sold in Lidl shops and advertised in Lidl newsletters, the potential number of people being aware of the brand is self-limiting. The newsletters will go to non-Lidl shoppers but if they don't shop at Lidl there is a disincentive to look at the newsletter. The newsletters are also not promoting just one item but many. Mr Fischer states that 10,000 newsletters are delivered each week directly to households. He does not state where they are distributed. Is it to the same 10,000 households? In a population of 60 million people, 10,000 newsletters is not a great deal. There is no indication of how many of these newsletters have ever carried promotions for NEVADENT products. It could be just the two that have been put into evidence. The newsletters cover a lot of goods but they will not cover all of the goods sold by Lidl. It appears that they concentrate upon special offers and new products or to promote a particular branch of goods eg for dental health. So appearance in the newsletter of a particular product is likely to be sporadic.

26) Ms Lazenby criticised the evidence of Mr Fischer in that he states that Lidl's stores can be found throughout the country but, rather than putting in evidence of their locations, he just makes reference to a website. It is Ms Lazenby's submission that the evidence does not substantiate the claim. The invoices and delivery notes exhibited at PF2 show addresses in Lutterworth, Livingston, Runcorn, Belvedere, Bridgend (the Bridgend and Belvedere material emanates from after the material date). It is not possible to extrapolate from this that there are stores throughout the United Kingdom; there may be large areas of the United Kingdom where Lidl does not, or did not at the date of application, have stores. From the evidence I just cannot tell the position.

27) The number of persons using toothbrushes is enormous. The average consumer for the goods is the public at large. No doubt Lidl has used the trade mark NEVADENT for toothbrushes. The market share enjoyed by the brand is small. The promotion of the brand is very limited, its availability is limited; only to Lidl shoppers. Ms Connolly's search of the print media data base for a period of five years does not show one reference to NEVADENT. Lidl's business model doesn't simply explain this away, as it is common practice for publications to do comparisons of products and to have advertorials showing a variety of products. **I do not consider that Lidl has established, in relation to toothbrushes, that at the date of application the trade mark NEVADENT was known to a significant part of the public.** So Lidl fails the *Chevy* test. The evidence Lidl has supplied signally fails to include the sort of evidence that the ECJ in *Windsurfing Chiemsee* suggested should be furnished. **I do consider that Lidl has established that the use made of the trade mark can lead it to benefit from any enhanced protection in relation to section 5(2)(b) of the Act.**

28) Consequent upon these findings, the evidence of Lidl will have no effect upon the outcome of this case. The test will be on the basis of normal and fair use of its trade mark in relation to the goods for which it is registered.

#### **Likelihood of confusion – section 5(2)(b) of the Act**

29) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

Lidl's trade mark is an earlier trade mark within the meaning of the Act.

30) In determining the question under section 5(2)(b), I take into account the guidance provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P*.

## Comparison of goods

31) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the ECJ held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected), their method of use and whether they are in competition with each other or are complementary. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

In relation to the terms used in specifications Jacob J stated:

“When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade.”

Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

I take on board the class in which the goods or services are placed is relevant in determining the nature of goods and services (see *Altecnic Ltd's Trade Mark Application* [2002] RPC 34). Although it dealt with a non-use issue, I consider that the words of Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

32) The goods of the earlier registration are: *dentifrices* and *toothbrushes*. The goods of the application which are under attack are:

***toothpastes; medical toothpastes; toothpaste for smokers; cleaning preparations for the teeth; cosmetic preparations for cleansing the teeth; disclosing liquid for personal use in indicating tartar on the teeth; disclosing tablets for personal use in indicating tartar on the teeth; rinses to prevent tartar forming on the teeth; all included in Class 3;***

*mouthwashes; dental rinses; dental abrasives; dental adhesives, chemical products for dental purposes; cleaners [preparations] for sterilising dental instruments; all included in Class 5;*

***toothbrushes; electric toothbrushes; holders for toothbrushes; devices for cleaning the teeth; all included in Class 21.***

The use of word *dentifrices* is born of the International Classification of Goods and Services for the Purposes of the Registration of Marks; it is not a word in common English usage. Outside the arena of trade marks I have never heard it used in English; in French it is in common usage. My understanding of the word is that it means any tooth cleaning substance, whether that be a paste, powder or liquid. *Toothbrushes* of the earlier registration will include *electric toothbrushes*. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* the Court of First Instance (CFI) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

As *devices for cleaning the teeth* must include toothbrushes, the former goods must be considered to be identical to *toothbrushes*. **Consequently, all of the highlighted goods of the specification above must be considered to be identical to the goods of the earlier registration.**

33) *Disclosing liquid for personal use in indicating tartar on the teeth; disclosing tablets for personal use in indicating tartar on the teeth; rinses to prevent tartar forming on the teeth; mouthwashes; dental rinses* all have the same purpose as the good of the earlier registration, dental hygiene. All of the goods will be taken into the mouth, as will dentifrices. The goods will all be used in combination with the goods of the earlier registration in promoting dental hygiene. These goods will all be found in the same area of shops. A2P's evidence shows use of the same trade marks, Aquafresh and Oral-B, across a range of dental hygiene goods. **I consider that the goods referred to at the beginning of the paragraph are highly similar to the goods of the earlier registration.**

34) *Holders for toothbrushes* have no purpose without *toothbrushes*, so they are complementary to them. From my own experience, I know that it is common practice for electric toothbrushes to come with holders for the brushes that they use. Indeed this is a core element of the product, as one toothbrush body will be used with a number of brushes which have to be kept somewhere, somewhere that is preferably hygienic and convenient. As I have stated above the term *toothbrushes* includes electric toothbrushes. **I consider, therefore, that there is a good degree of similarity between holders for toothbrushes and toothbrushes.**

35) *Dental abrasives; dental adhesives, chemical products for dental purposes; cleaners [preparations] for sterilising dental instruments* appear primarily to be goods for the dental surgery or dental hospital; not goods for the man or woman in the street. *Dental adhesives*, in my view, are not the same as *denture adhesives*; the former goods are for fixing dental implants and the like. The first three sets of goods are for dental purposes and so share that in common with the goods of the earlier registration. The primary purpose of the last goods is to sterilise instruments, instruments that happen to be dental instruments. I do not consider that any of the goods can, in any realistic sense, be considered to have a dependent or symbiotic relationship with the goods of the earlier registration; nor would one substitute one set of goods for another. Consequently, I do not consider that the respective goods are either complementary or in competition. These are not the sort of goods that I have ever seen in the supermarket or pharmacy. In the absence of evidence to the contrary, I do not consider that they will share the same channels of trade as the goods of the earlier registration. The users of these goods will be members of the dental profession, not the public at large. *Dental abrasives* might be used by a hygienist or dentist when giving a scale and polish and so have a link to *dentifrices*. However, the *dentifrices* in class 3 would still certainly not be a substitute for these goods. **Taking all these factors into account I find that there is a very low degree of similarity between dental abrasives, dental adhesives and chemical products for dental purposes and the goods of the earlier registration. Owing to the fundamental**

**difference in the purpose of *cleaners [preparations] for sterilising dental instruments, they are at one remove from the mouth, I do not consider that these goods can be considered similar to the goods of the earlier registration.***

36) I have summarised my findings below:

**Identical goods:** *toothpastes, medical toothpastes, toothpaste for smokers, cleaning preparations for the teeth, cosmetic preparations for cleansing the teeth, toothbrushes, electric toothbrushes and devices for cleaning the teeth.*

**Highly similar goods:** *disclosing liquid for personal use in indicating tartar on the teeth, disclosing tablets for personal use in indicating tartar on the teeth, rinses to prevent tartar forming on the teeth, mouthwashes and dental rinses.*

**Good degree of similarity:** *holders for toothbrushes.*

**Very low degree of similarity:** *dental abrasives, dental adhesives and chemical products for dental purposes.*

**Not similar goods:** *cleaners [preparations] for sterilising dental instruments.*

### **Comparison of trade marks**

37) The trade marks to be compared are:

**Lidl's trade mark**

NEVADENT

**A2P's trade mark:**

MEGADENT

38) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

39) It is necessary to consider who the average consumer is and the nature of the purchasing process. These matters will affect how the trade marks are considered and the

likely effect of any similarities or dissimilarities. The goods that I have referred to in paragraph 35 are, in my view, for the dental health professional. They will be bought with care and caution and as the result of careful and informed decision. The remainder of the goods will be bought by the public at large. There was a divergence in view between Ms Simpson and Ms Lazenby as to the nature of the purchasing process in relation to toothbrushes. It is necessary to consider the purchasing process in relation to all of the goods of the application. It is unlikely that any of the goods will be bought in a mad, supermarket dash. The potential purchaser, if a new purchaser, will check the packaging with some care, to make sure the product is suitable; there will be issues relating to size, sensitivity, exact purpose eg whether a whitening product. In this process, he or she will be exposed to the trade marks for some time. If a returning purchaser, he or she will wish to make sure that the product that is being bought is the correct one for his or her purposes; the easiest way that this can be done is by looking at the trade mark.

40) Ms Simpson argued that the suffix of the two trade marks was –adent. In both trade marks I consider that the emphasis, in speech, will fall upon the letter a, there will be a falling away of the last syllable, dent. Mega is a commonly known word, the natural division of MEGADENT is “mega” and “dent”. Consequently, I disagree with Ms Simpson’s submission as to what represents the suffix of the two trade marks; it is in my view –dent.

41) It is necessary to decide what are the distinctive and dominant components of the trade marks. I am of the view that the trade marks naturally divide into two parts, “neva” and “dent” and “mega” and “dent”. A2P has filed evidence to show that “dent” is used for a variety of dental related trade marks. This does not surprise me, “dent” has a clear link to teeth, through its appearance in such words as dental and dentist. There is no necessity for a prefix or suffix to exist on its own in trade or in dictionaries to be perceived by the relevant public as being descriptive (see *Eurohypo AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-439/04*). Even without the evidence of A2P I would have taken the “dent” elements of the trade mark as non-distinctive in relation to the goods in question. A non-distinctive element will have an effect on the consideration of the similarity of the trade marks. In *José Alejandro SL v Office for Harmonization in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc Intervening*(Case T-129/01) [2004] ETMR 15 the CFI stated:

“The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark.”

This is a view that the CFI has also upheld in *Koubi v OHIM – Flabesa (CONFORFLEX) Case T-10/03*, paragraph 60 and *Grupo El Prado Cervera v OHIM – Debuschewitz (CHUFADIT) Case T-117/02*, paragraph 51. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the CFI stated:



“59. It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by each of those signs, such that all the other components are insignificant (*MATRATZEN*, paragraph 33).”

It is common place to state that the beginnings of word trade marks are more important in relation to giving rise to similarity than the endings. As the CFI stated in *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-336/03:

“75 It should be noted in this regard that the attention of the consumer is usually directed to the beginning of the word (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-0000, paragraph 83).”

As the CFI found in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)*, in considering whether trade marks are similar the perception of the relevant public has to be taken into account.

42) “Mega” is a commonly used word, meaning a large amount or something that is of excellent quality. The “mega” element of A2P’s trade mark has a strong conceptual hook for the memory, identification and consideration of the trade mark. When viewing the trade mark this element will have an impact; the visual impression is the result of perception which will include the meaning. In the case of a word the visual impact is not just a matter of the pattern of the letters, it cannot be divorced from meaning and memory. Taking into account the dominant and distinctive elements of the trade marks, I consider them to be visually dissimilar. Both trade marks are invented words; however, the position of the strong element “mega” at the beginning of the A2P’s trade mark will generate a conceptual association. Both trade marks share the non-distinctive “dent” element, which has an association with dental products. The strength of the “mega” element generates a degree of conceptual dissonance between the two trade marks. Ms Simpson argued that the letters “g” and “v” were similar phonetically. The “g” has a hard, guttural sound; it is most definite and striking. “V” has a soft labial sound. There is a close phonetic proximity between “v” and “f”; which is probably why in Welsh an “f” is pronounced like a “v” and in German a “v” is pronounced like an “f”. I can see no proximity between the sounds of a hard “g” and “v”; they are clearly and definitely different. The letters “m” and “n” are phonetically close and sometimes confused. The other elements of the trade marks are phonetically identical. I consider that owing to the marked difference between a hard “g” and “v” that there is a good deal of effective phonetic distance between the trade marks. The emphasis in speech will fall upon the first two syllables, and so the final syllable will have less impact in speech; so any phonetic similarity is lessened. However, I could not go so far as to deny that there is some, limited, degree of phonetic similarity between the trade marks.

**43) Consequent upon the above, I consider that the trade marks are not visually or conceptual similar, and it could be argued that there is a degree of conceptual dissonance. The trade marks are phonetically similar, but to a limited degree.**

### **Conclusion**

44) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case there is a variation between the degrees of similarity between the goods. Certain goods are identical, some highly similar, some have a good degree of similarity, some a very low degree of similarity and one set of goods are not similar (and so there cannot be a likelihood of confusion.) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade marks (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ETMR 585). NEVADENT includes the non-distinctive suffix –dent. “Neva” has no meaning, as far as I know. I have to consider the trade mark as a whole. As a whole I consider that the trade mark, in relation to the goods for which it is registered, has a good capacity for identifying the goods for which it is registered as coming from a particular undertaking. I have already concluded that Lidl cannot benefit from the claim it has made to a reputation in respect of toothbrushes. Even if it could, this would be of limited effect. Reputation can make a trade mark that does not enjoy a great deal of distinctiveness more distinctive and so cause a greater likelihood of confusion (*Sabel BV v Puma AG*). I have decided that the trade mark has a good degree of inherent distinctiveness. Reputation can also have an effect where there is only a limited degree of similarity between goods or services (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case certain of the goods are identical, others are highly similar and some have a good degree of similarity; so reputation could only effectively assist in relation to those goods where there is a low degree of similarity.

45) The goods of the application, with the exception of those for the dental professional, will normally be bought from the supermarket or pharmacy shelf. In *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-206/04 P the ECJ stated

“21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.

22 Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

The ECJ went on to state:

“35 That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (see, to that effect, Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20).”

The CFI in *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-3/04 stated:

“56 As OHIM has wisely observed, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 55).”

In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the CFI held

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product

covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

This is a case where the visual impact is of most importance. The potential customer will see the goods; he or she is unlikely to ask for them. In this context the conceptual and visual differences are of importance; the weight of the “mega” elements comes into play. I have also indicated that I consider that the phonetic similarity is not overwhelming, the meaning of “mega” and the hard “g” come into play. Aural similarity is not divorced from the ability to identify a word or element in a trade mark; the brain processes what it hears through experience and knowledge, perception is not the simple matter of the effect on the workings of the ear, the ear merely transmits to the brain for processing of the stimulus. As indicated I consider that there will be a reasonably careful purchasing decision involved. Some of the goods may be of low value but the customer wants to be sure that they are right for the job. Those goods which will probably not be on the supermarket or pharmacy shelf ie those for dental professional, will be bought with a great deal of care; which will balance against any increase in the importance of phonetic similarity. Owing to the differences between the trade mark, I do not consider that the concept of imperfect recollection will have any great effect. **Taking all of these factors into account, I find that there is not a likelihood of confusion and the grounds of objection under section 5(2)(b) of the Act are dismissed.**

### **Section 5(3) of the Act**

46) Section 5(3) of the Act reads:

“(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

**47) Lidl has to establish that, at the date of application, it had a *Chevy* reputation. I have decided that it has not done so and so this ground of opposition must fail.** In any event, this is a case where I consider that if the opponent was not successful under section 5(2)(b) of the Act, it would not be successful under section 5(3) of the Act either.

### **COSTS**

48) A2P having been successful is entitled to a contribution towards its costs. Ms Lazenby submitted that there had been a lack of particularisation in the grounds for section 5(3) of the Act. This is the case. Indeed, it was not until I specifically asked Ms Simpson to state what head(s) of damage Lidl claimed under section 5(3) of the Act that the exact head of damage was identified. Her skeleton argument did not identify the nature of the claim. A2P provided a good deal of evidence in relation to the section 5(3) ground, evidence going to the nature and size of the market and the knowledge of Lidl’s

trade mark in the market. In effect it had to make most of the running in relation to the evidence. The onus is upon to Lidl to prove its case, however, it could be a risky strategy for A2P to rely upon this and not to file evidence. Taking into account the thoroughness and relevance of the evidence of A2P, I consider that it should be compensated to the maximum of the scale for its own evidence, £1,500, and to the maximum of the scale for considering the evidence of Lidl, £750. **I order Lidl Stiftung & Co KG to pay A2P International Limited the sum of £3,250. 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 this decision is unsuccessful.**

**Dated this 19th day of October 2006**

**David Landau  
For the Registrar  
the Comptroller-General**