

O-256-08

TRADE MARK ACT 1994

**IN THE MATTER OF APPLICATION NO 2394890
BY UNILEVER PLC TO REGISTER
THE TRADE MARK TEASE IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION NO 94626 BY
DISTRIBRANDS COSMETICS B.V.**

TRADE MARKS ACT 1994

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BACKGROUND

1. On 22 June 2005 Unilever Plc applied to register the mark TEASE for the following goods in Class 3 of the international classification system:

Class 03:

Soaps; perfumery, essential oils, cosmetics; colognes, eau de toilette, perfume body sprays; oils, creams and lotions for the skin; shaving foam, shaving gel, pre-shaving and after-shaving lotions; talcum powder; shower gel, bath foam; dentifrices; non-medicated mouthwashes; deodorants; anti-perspirants for personal use; non-medicated toilet preparations.

2. On 8 September 2006 Distribrands Cosmetics B.V. of the Netherlands filed notice of opposition to this application citing a single ground under Section 5(2)(b) of the Act in relation to which reliance is placed on the following protected international registration:

No	Mark	Class	Specification
834787	TEEZE!	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

No 834787 also covers goods in Class 14 but these do not play a part in this opposition.

3. The applicant filed a counterstatement denying the above ground. In particular it denies that the marks are confusingly similar and suggests there are significant visual and conceptual differences. It also claims that “perfume body sprays, oils, creams and lotions for the skin; shaving foam, pre-shaving and after-shaving lotions; talcum powder, deodorants, anti-perspirants for personal use” are dissimilar goods.

4. Both sides have filed evidence. Neither side has asked to be heard. Written submissions have been received on behalf of the applicant under cover of a letter dated 12 August 2008 from Murgitroyd & Company, its Trade Mark Attorneys.

Evidence

5. For the record the evidence filed in this case is as follows:

- | | |
|------------------------------|---|
| Opponent's evidence in chief | - declaration by Michel Vermonden, Marketing Manager of Distribrands Cosmetics B.V. |
| Applicant's evidence | - witness statement by Puravee Shah, Trade Mark Agent with Murgitroyd & Company |
| Opponent's evidence in reply | - statutory declaration by Michel Vermonden |

6. I do not propose to summarise this material - much of it consists of submission and a discussion of the opponent's as yet unrealised intention to market its products in the UK. There are supporting exhibits showing some advertising and website material that the opponent uses or plans to use. The applicant's evidence is also in the nature of submissions.

DECISION

Section 5(2)(b)

The law and leading authorities

7. The relevant part of the statute reads

“(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.”

8. The leading authorities and principles to be applied can be derived from the following well known cases - *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *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, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

The average consumer and its purchasing process

9. The goods in issue are a range of perfumes, cosmetics and personal care products. The applicant's written submissions suggest that they are the sort of things that are purchased with significant care and diligence across all age groups but particularly so in the case of teenage girls to whom the opponent aspires to target its products. The applicant also says that these goods are overwhelmingly purchased on the basis of visual inspection on the basis of a careful selection from the relevant shelf.

10. Firstly, as regards the target audience for the goods it is not appropriate to restrict consideration to teenage girls even if this is the opponent's immediate intention. There is no reason why this target audience should not expand or change over time. That much is clear

from the following passage from *Devinlec Developpement Innovation Leclerc SA v OHIM*, Case T-147/03:

“Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.

.....

It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

11. In this case there is nothing in the nature of the goods themselves that points to a particular age range or type of consumers. The respective ranges of goods also include some items that are purely intended to beautify and others that are more functional in nature or at least combine cosmetic effect with functionality. There is likely to be a considerable variation in the potential price range of the goods concerned and consequent variations in the level of care and attention paid by consumers.

12. I agree with the applicant that cosmetic and toiletry items can be the subject of off the shelf purchases. However, that is not universally the case. Many retail establishments have areas dedicated to the goods of particular cosmetic houses with assistants available to give advice. Oral enquiries are likely to play a greater role in these circumstances as they will too in the case of recommendations and purchases by third parties (husbands purchasing for wives, for instance, on the basis of spoken reference to the brand).

Comparison of goods

13. The applicant’s position has shifted somewhat since the claim made in the counterstatement (recorded above). In its written submission it concedes that with the exception of the opponent’s “bleaching preparations and other substances for laundry use” the respective goods are similar.

14. The opponent’s earlier trade mark has a broad specification which includes ‘cleaning, polishing, scouring and abrasive preparations’. In the absence of a limitation of any kind these terms cover goods for personal as well as laundry etc use. The opponent’s specification also covers ‘soaps, perfumery, essential oils, cosmetics and dentifrices’ which appear as discrete items in the applied for specification as well as falling within the broad term ‘non-medicated toilet preparations’. 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 (*Gérard Meric v OHIM*, Case T-133/05). The result is that all of the goods are either identical to those of the earlier mark or are closely similar being products for personal toiletry and beautification purposes.

Comparison of marks

15. The marks are TEASE and TEEEZ!. The applied for mark consists of a single syllable word. The earlier trade mark is also a single syllable word with an exclamation mark after it. The effect of the exclamation mark is to provide emphasis for what precedes it. The word itself is, therefore, the dominant and distinctive element of the earlier mark.

16. The applicant's written submissions refer to the strong visual differences and variously refer to 'peripheral phonetic resemblance' and 'highly questionable' phonetic resemblance. It is suggested that the triple E combination and exclamation mark produce a completely different sound to that of the ordinary dictionary word TEASE. Finally, the applicant points to conceptual differences as a result of one mark being a dictionary word and the other a highly unusual invented word.

17. Mr Vermonden's evidence for the opponent claims that the marks are phonetically identical and, because the derivations are the same, conceptually identical or at least similar as well.

18. There can be no doubt that the words make quite different visual impacts. TEASE is, as has been pointed out, a well known dictionary word. TEEEZ! on the other hand is an invented word or perhaps more correctly an invented spelling. It is an unusual construction. I cannot think of any other word that has three letters E in succession in this way. Partly because of that it is unlikely to be taken as a casual misspelling of any other word. Nor does it have the appearance of a foreign language word.

19. Phonetically on the other hand, I find the words to be indistinguishable or so nearly so as to make no difference. The elongated vowel sound of TEEEZ! and the exclamation mark does not cause me to adjust that view of the matter. An exclamation mark is for emphatic effect, does not affect the pronunciation of the accompanying word and would not itself be articulated in speech. I reject the applicant's attempt to play down the phonetic similarity between the marks.

20. TEEEZ! not being a dictionary word, cannot be said to have a meaning of its own. However, once the view is taken that it is phonetically indistinguishable from the word 'tease' then it is inevitable that the latter word will be brought to mind. Thus, whilst the spelling may be invented, the concept behind the mark will, for a significant proportion of consumers, be the same as that of the earlier trade mark.

21. There are, therefore, strong visual differences, phonetic identity and a strong likelihood of conceptual identity.

Likelihood of confusion

22. The distinctive character of the earlier trade mark is a factor to be taken into account. The opponent has yet to commence use in this country so there can be no question of its position being improved through use. The inherent characteristics of the mark are nevertheless strong both on account of its unusual spelling/visual appearance and the underlying word to which it alludes. That underlying meaning is not descriptive of a characteristic of any of the goods.

23. It was held in the *Lloyd Schuhfabrik* case, that "mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) of the Directive". Article 5(1)(b) of the Directive is concerned with the rights conferred by a trade mark but is cast in substantially identical terms to Article 4(1)(b) which in turn corresponds to Section 5(2)(b) of the Act.

24. That is not to say that phonetic identity or similarity will carry the day. Assessment of aural similarity is but one of the relevant factors to be taken into account. The outcome in any particular case will turn on the importance (or otherwise) of aural considerations in relation to trade in the goods concerned and a global appreciation of all relevant circumstances.

25. Furthermore, visual and/or conceptual differences can serve to counteract phonetic identity. A case where that was the position was C-206/04P, *Mülhens GmbH & Co KG and OHIM* where the marks in issue were ZIRH and SIR accompanied by a heraldic figure. The Court of First Instance held that there was no visual or conceptual similarity but phonetic similarity in certain countries. The Court noted in paragraph 11 (referring to the CFI's judgment) that:

“49. According to the case-law of the Court, the phonetic similarities may be counteracted by the conceptual differences between the trade marks in question. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately ([Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel* (BASS) [2003] ECR II-4335], paragraph 54).”

The ECJ upheld the CFI's view that the degree of similarity between the signs at issue was not sufficient to find that the relevant public might believe that the goods concerned came from the same or economically linked undertakings.

26. The *Mülhens* case involved Class 3 goods similar to those in issue here. The Court of First Instance held that such goods are generally sold in such a way as to enable the relevant public to examine them visually. Much the same point is made in the applicant's written submissions by reference to Case T-342/05, *Henkel KGaA v OHIM*. Whilst finding phonetic similarity to be of lesser importance, the Court did not, however, exclude oral ordering from its considerations. Phonetic similarity was not enough in the *Mülhens* case to result in a likelihood of confusion in the face of visual and conceptual differences. In contrast to that case the competing marks here are phonetically indistinguishable and converge on the same idea notwithstanding the very clear visual differences. The quirky spelling of the earlier trade mark is sufficient to avoid any likelihood of direct confusion in the context of visual contact with the marks which I consider to be the primary means by which consumers will encounter the goods.

27. What troubles me about the applied for mark is that consumers will respond to the underlying meaning and be reminded of the opponent's mark. That leads to the question as to whether it is a mere bringing to mind or association in the deeper sense that consumers would be led to believe that identical and closely similar goods sold under those marks emanated from the same or related trade sources. The visual difference in the marks is not proof against that happening. Having given the matter careful consideration I have come to the conclusion that the common and distinctive underlying concept will result in an expectation on the part of consumers that the goods have a common trade origin.

28. In coming to that view I have not placed any reliance on Exhibit DC2 and 3 to Mr Vermonden's first declaration showing the TEEEZ! mark in artwork and on the applicant's website where it appears in conjunction with wording such as 'Be teased' thus reinforcing the underlying meaning. To do so would go beyond the mark for mark comparison that is required under Section 5(2)(b).

29. The outcome is that the opposition succeeds in relation to all the goods of the application.

COSTS

30. The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of **£1000**. 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 16th day of September 2008

**M Reynolds
For the Registrar
The Comptroller-General**