

O-041-11

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION OF INTERNATIONAL TRADE MARK No. 984887
STANDING IN THE NAME OF
IVOCLAR VIVADENT AG**

AND

**IN THE MATTER OF THE REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No. 16134
BY DENTALSERVE.NET PROFESSIONAL SERVICES LTD**

BACKGROUND

1) On 17 April 2008, with a priority claim of 29 October 2007. Ivoclar Vivadent AG (the registered proprietor) applied to protect its international trade mark IPS E.MAX THINEERS in the UK, in respect of the following goods:

Class 5: Materials for use in dentistry, namely materials for the manufacture of impressions, artificial teeth, veneers, crowns and bridges, inlays, prosthesis; protective coatings; isolation materials; materials for relining tooth cavities; tooth filling materials; colour stains for use in dentistry; ceramics for the manufacture of crowns, bridges, inlays, onlays and veneers; dental alloys; precious metal alloys and non-precious metal alloys for dental technology, precious metals and non-precious metals for dental technology; dental materials for repairing tooth defects; opaque materials for use in dentistry.

Class 10: Apparatus, tools and instruments for use in dentistry, namely shade guides to determine tooth shades; polishing instruments, ceramic mixing plates; artificial teeth, crowns and veneers.

2) The application was examined and accepted. The trade mark was published for opposition purposes. No opposition was filed, and protection granted on 28 June 2009.

3) On 16 July 2009 Dentalserve.net Professional Services Ltd (the applicant) applied for invalidity under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The grounds are, in summary:

- a) The applicant is the proprietor of UK trade mark No.2439048 THINEERS registered in respect of:

Class 3: Cleaning preparations for dentures and other dental products.

Class 5: Dental prosthesis adhesives; materials for dental use, all included in Class 5.

Class 10: Dental prosthesis implants; dental instruments and apparatus; dental products; artificial teeth; all included in Class 10.

- b) As the marks and goods are similar there is a likelihood of confusion amongst the public and so the mark in suit should be declared invalid under Section 47(2)(b) of the Trade Marks Act 1994.

3) On 21 September 2009 the registered proprietor filed a counterstatement denying the ground of invalidity. They state that:

“In dentistry “veneers” are thin layers of restorative material placed over a tooth surface, either to improve the aesthetics of a tooth, or to protect a damaged tooth surface. Within the relevant public i.e. by dentists and dental technicians, the slightly modified term “thineers” is widely known and will be understood as short form for very thin veneers. Even dentists and dental technicians who are not yet familiar with the term “Thineers” will understand this word since “thineers” is an obvious combination of “thin” and “veneers”.”

4) The registered proprietor contends that the applicant's mark is not distinctive and that the marks are not similar.

5) Both parties filed evidence and both ask for an award of costs. The matter came to be heard on 18 January 2011 when the registered proprietor was represented by Mr Fenner of Messrs Shoosmiths and the applicant by Mr Malynicz of Counsel instructed by Messrs Marshall Law.

APPLICANTS' EVIDENCE

6) The applicant filed a witness statement, dated 25 November 2009, by Mohan Lal Photay a director of the applicant, a position he has held for nine years. He states that one of his company's products is THINEERS which are ultra thin porcelain veneers which can often be fitted to existing teeth without surgery, injections, drilling or removing healthy teeth. The mark was invented by Mr Photay three years ago and subsequently registered. He states that no-one else uses the term THINEERS. He states that turnover in the mark THINEERS grew from £8,500 in 2006 to £250,000 in 2008. He states that his company has spent considerable sums advertising their products under the THINEERS trade mark.

REGISTERED PROPRIETORS' EVIDENCE

7) The registered proprietor filed a witness statement, dated 19 January 2010, by Sibylle Hummel a Product Manager of the registered proprietor, a position she has held for eight years. She states that to her the word THINEERS is simply an abbreviation of "thin veneers". At exhibit 1 she provides copies of printouts from dentists and hospitals showing that they use the term "Thineers". The first is from a dental hospital in India which describes ultra thin veneers and then states that they are unlike conventional veneers and then states "With THINEERS you can:" and it lists a number of advantages. The second website is from a dental health centre in Lincolnshire, which states: "We can provide veneers, made using specialist systems such as Empress, Procers, Lava, Authentic as well as very thin Thineers." It also features a photograph of the same model shown in the exhibit to the applicant's statement. The other website pages are from other parts of the globe, not the UK, but all describe veneers or very thin veneers such as "Thineers" or "lumineers". All of the printouts are dated December 2009 and mostly relate to India.

APPLICANT'S EVIDENCE IN REPLY

8) The applicant filed a second witness statement by Mr Photay, dated 26 April 2010. He provides a number of comments upon the evidence provided by the registered proprietor. However, much of what he says is not of assistance to my decision. He does make the point that he has supplied a number of the proprietors whose websites are featured in the registered proprietor's evidence. In short they are referring to his product by its trademark name.

9) That concludes my review of the evidence filed in these proceedings insofar as I consider it necessary.

DECISION

10) The sole ground of opposition is under Section 5(2)(b) of the Trade Marks Act 1994 which reads as follows:

"5.-(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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

12) In these proceedings the applicant is relying upon an earlier mark which has a registration date of 8 June 2007 and is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

13) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (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 B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

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

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

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

14) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the registered proprietor's mark and the mark relied upon by the applicant on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

15) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered.

In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

16) I must now determine the average consumer for the goods of the parties, which are, broadly products for use by dentists. It is agreed that the goods offered by the two parties are aimed at the dental profession. Such items are not purchased without some consideration, and dentists are professionals who are likely to be careful in placing orders. Although I must take into account the concept of imperfect recollection.

17) I next turn to consider the goods of the two parties. It was agreed at the hearing that the goods of the two parties are identical or very similar.

18) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant’s Trade Mark	Registered Proprietor’s Trade Marks
THINEERS	IPS E.MAX THINEERS

19) Clearly, the registered proprietor’s mark contains more than one word or element and is, therefore, a composite mark. The *Medion* case acknowledges that the overall impression conveyed to the relevant public by a composite mark may, in certain circumstances, be dominated by one or more of its components.

20) The registered proprietor contended that in relation to dental veneers, the word THINEERS is descriptive. To my mind this is not correct. The term is allusive of the product as it refers to ultra thin veneers, but cannot be considered to be descriptive. The registered proprietor filed evidence which it contended showed that the applicant’s mark was used descriptively by the dental industry. Only one reference was from the UK and referred to a number of makes of veneers, including the applicant’s THINEERS. The other use was mainly from India and at the hearing the registered proprietor contended that the dental industry was global and so consideration should be taken of this evidence. I do not accept this contention, but even if I did most of the evidence from India would appear to refer to Thineers as a trade mark not as a descriptor. Lastly, the registered proprietor sought to rely upon the opinion of their witness Ms Hummel who it was stated has been in the industry for eight years. She was not put forward on the basis of her being an expert witness, nor is she a dentist. I do not believe that I should place great weight upon her opinion in this matter. I also note that despite her time in the industry she was unable to provide any examples of the mark being used descriptively in the UK or Europe.

21) I also note that the registered proprietor states in its skeleton argument that “IPS E.MAX is a stand alone trade mark used by Ivoclar in relation to materials that it supplies to dental laboratories and as such has a high degree of recognition with the relevant public”. I therefore regard this aspect of the mark as effectively a “house” mark, with the word “Thineers” being the subsidiary mark. As such the word “Thineers” is a distinct component within the composite mark whilst not being the dominant component. However, I must compare the marks as wholes.

22) There are clearly visual differences between the marks, in that the registered proprietor's mark contains the house mark "IPS E.MAX" in addition to the whole of the applicant's mark "THINEERS".

23) There are obvious aural differences as well as an element of identity. Although there may be a degree of ordering over the telephone or face to face with a salesman I would imagine that most orders would be written (including on-line).

24) Conceptually, I do not believe that either mark conjures up an image in the average consumer's mind.

25) The applicant has shown only very modest use of its mark and so cannot enjoy enhanced protection because of reputation. However, I do accept that the applicant's mark is inherently distinctive for the Class 3, 5 & 10 goods for which it is registered.

26) Considering the marks as wholes and acknowledging the differences I consider the marks to be similar as the registered proprietor's mark contain the applicant's mark in its entirety and the only difference is the addition of the registered proprietor's house mark.

27) I take all of the above into account when considering the marks globally. I also take into account 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. The similarities in the marks are such that when used on goods which are identical or similar, such as in the instant case. I believe that there is a likelihood of consumers being confused into believing that the goods provided by the registered proprietor are those of the applicant or provided by some undertaking linked to them, such as by way of a license. The invalidity action under Section 5(2) (b) therefore succeeds in relation to the whole of the specification which was registered. As such the registration is deemed never to have been made.

COSTS

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£400
Preparing for and attending a hearing	£1000
Expenses	£200
TOTAL	£1,800

28) As the applicant has been successful it is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant the sum of £1,800. This sum 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 08 day of February 2011

**G W Salthouse
For the Registrar
the Comptroller-General**