

O-223-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2526769
BY DELTA PRONATURA DR KRAUSS & DR BECKMANN KG
TO REGISTER THE TRADE MARK**



IN CLASSES 1, 3 & 5

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 100352
BY PUNCH INDUSTRIES**

BACKGROUND

1) On 22 September 2009 delta pronatura Dr. Krauss & Dr. Deckmann KG filed an application to register the following trade mark:



2) In respect of the following goods:

In Class 1: Chemicals used in industry, including washing and cleaning agent additives, cleaning agents for commercial and industrial use.

In Class 3: Bleaching preparations and other substances for laundry use; cleaning agents (in this class), in particular stain removing preparations, power cleaners, multi-purpose cleaners; preparations for removing lime, soap, rust, dirt, paint and other deposits or residues; washing-up preparations.

In Class 5: Disinfectants; cleaning agents (in this class).

3) Following examination, the trade mark was accepted and published for opposition purposes on 1 January 2010 in Trade Marks Journal No.6817

4) On 1 April 2010 a notice of opposition was filed by Punch Industries (hereinafter the opponent). The opponent is the registered proprietor of the following trade mark:

Trade Mark	Number	Application date & date of registration	Class	Specification
COLOR COLLECTOR	2537192	26.01.2010 / 28.05.2010 Priority claim of 4 August 2009 (Ireland).	3	Impregnated treated synthetic cellulose non-woven apertured sheets used in washing; laundry fabric conditioners, softeners, dirt and dye attracters; bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations.
COLOUR COLLECTOR A series of two			21	Articles for cleaning purposes; cloths for cleaning.

5) The opposition covers all the goods applied for and the opponent states that the marks and goods of the two parties are similar and so the application in suit offends against Section 5(2)(b).

6) On 5 August 2010 the applicant filed a counterstatement which consists of a denial of the ground on which the opposition is based

7) Only the opponent filed evidence in these proceedings. The matter came to be heard on 17 June 2011. At the hearing, the opponent was represented by Mr Malynicz of Counsel instructed by Messrs FR Kelly; the applicant was represented by Mr Marsh of Messrs Wilson Gunn.

OPPONENT'S EVIDENCE

8) The opponent filed a witness statement, dated 7 October 2010, by Gerry Lawlor a director of the opponent company, which he states is an unlimited Irish company. He states:

“The opponent is the world market leader in relation to a product used in a laundry wash cycle. This product which started as a sheet but is now also in a bag or sachet form which allows a user to mix different colour items of laundry because dyes which may bleed during the laundry wash cycle are absorbed by the sheet/bag/sachet and do not run between individual items of laundry.”

9) He states that the opponent has a European patent upon the product. The product was launched in the UK in 2001 under the mark COLOUR CATCHER. Since 2007 the turnover in the UK has exceeded £1million per annum. The opponent's mark was devised as “portraying an indirect and allusive reference to the product characteristic”. Competitors have registered marks such as COLOUR GRABBER and COLOUR LOCK. In addition the opponent supplies its product under marks which it has registered such as COLOUR CAPTURE and COLOUR COLLECTOR to specific customers. The mark COLOUR CAPTURE for instance is used by the Aldi chain of stores in Ireland.

10) Mr Lawlor states that the applicant has frustrated the opponent's marketing plans by seeking to register and commencing to use the mark in suit. He states that the applicant has a track record of such behaviour in other countries, having registered the mark in suit in Singapore and Australia and then preventing the opponent from registering its mark in these jurisdictions.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

12) 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.”

13) 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.”

14) In these proceedings the opponent is relying upon an earlier mark which has an application date of 26 January 2010 and a priority date of 4 August 2009. It is clearly an earlier trade mark and is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

15) 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; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(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 Kaisha v Metro-Goldwyn-Mayer Inc.*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

16) 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 applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

17) The opponent has made only a brief mention of use of the mark in the UK but has not provided any context such as the overall size of the UK market, market share or independent evidence that the mark relied upon has become known to the public or to the trade. Therefore,

the opponent cannot enjoy enhanced protection because of reputation. However, I do accept that the opponent's mark has some inherent distinctiveness, albeit a relatively low level, for the goods for which it is registered.


18) I shall first consider the goods of the two parties which are shown below for ease of reference.

Applicant's Goods	Opponent's Goods
In Class 1: Chemicals used in industry, including washing and cleaning agent additives, cleaning agents for commercial and industrial use.	
In Class 3: Bleaching preparations and other substances for laundry use; cleaning agents (in this class), in particular stain removing preparations, power cleaners, multi-purpose cleaners; preparations for removing lime, soap, rust, dirt, paint and other deposits or residues; washing-up preparations.	In Class 3: Impregnated treated synthetic cellulose non-woven apertured sheets used in washing; laundry fabric conditioners, softeners, dirt and dye attracters; bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations.
In Class 5: Disinfectants; cleaning agents (in this class).	In Class 21: Articles for cleaning purposes; cloths for cleaning.

19) It was accepted at the hearing that the Class 3 goods of the two parties were identical, whilst the applicant's goods in Class 1 and 5 were very similar to the opponent's class 3 goods.

20) I must now determine the average consumer for the goods of the parties, which are, broadly chemical cleaning products. It is my view that the goods offered by the two parties are aimed at the general public. In my view, such items are not purchased without some consideration, not least as they have different functions in the house such as laundry or bathroom cleaners. Although I must take into account the concept of imperfect recollection.

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

Applicant's Trade Mark	Opponent's Trade Marks
 <p>The logo for Dr. Beckmann Original Colour & Dirt Collector. It features the brand name 'Dr. Beckmann' in white on a blue oval background, with 'Original' in smaller text above it. Below this, 'Colour & Dirt Collector' is written in blue, bold, sans-serif font.</p>	<p>COLOR COLLECTOR</p> <p>COLOUR COLLECTOR</p>

22) The opponent referred me to the following paragraphs of the *Medion* case which read:

“[30] However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

[31] In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.”

23) The opponent contends:

- The applicant’s mark still has an independent distinctive role within the opponent’s mark and that confusion is still likely because people will link the marks. The public may not be aware of who Dr Beckmann is, or even if they are, they may think that the two undertakings are linked economically, that Dr Beckmann has taken over the opponent, etc.
- Whilst the appropriated part is not identical, in the sense that the words “& DIRT” have been added, it makes little difference. The *Medion* point still arises because the appropriated part is highly similar to the opponent’s earlier mark.
- *Medion* at paragraph 37 does not require the earlier mark to be particularly distinctive – “normal distinctiveness” suffices. The words COLOUR COLLECTOR are, it is submitted, of average distinctive character in relation to these goods.
- The instant case is precisely the sort of appropriation that was deprecated by the ECJ in *Medion*. As Mr Lawlor explains at paragraph 9 of his statement, the applicant has a track record of seeking to mimic the brands of the opponent by adding the words “ORIGINAL DR BECKMANN” as a house mark: see also his exhibits GL7-9. It clearly believes, unless it is stopped, that it is entitled to appropriate any mark provided it adds “ORIGINAL DR BECKMANN”. With respect, that cannot be a sensible commercial or legal strategy.

24) The applicant referred me to Case T-6/01 *Matratzen Concord GmbH v OHIM* (which was taken into account by the Court in *Medion*) where the CFI stated:

“A complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.”

25) The applicant contended:

- The dominant and standalone distinctive element of the mark in suit is the “Dr Beckmann Original logo” element.
- The words “Colour” and “collector” do not form dominant or standalone distinctive elements in the mark in suit.
- The difference between the marks of the two parties is further highlighted by the fact that the words “Colour” and “Collector” are separated from each other by the elements “& dirt”.
- The inherent distinctiveness of the earlier mark is further reduced by the admission at paragraph 3 of the witness statement that the product under the earlier mark is referred to in the associated patent as “a dye scavenging substrate”, i.e. a colour collector.

26) To my mind, the mark in suit comprises of a dominant and distinctive house mark “Dr Beckmann Original & logo” and a very descriptive element “colour & dirt collector”. In reaching this conclusion I take into account that the goods in the specification applied for are, broadly, chemical cleaning products. Therefore, the average consumer when viewing the mark in suit will regard the words “colour & dirt collector” as simply a description of precisely what the product does. I do not accept the contention that these words have an independent distinctive role within the mark in suit. The opponent’s mark is also different to these words as it consists of simply “colour collector”. This mark I have already commented has a very low level of distinctiveness as it is suggestive of the products for which it is registered. The mark in suit has the words “& dirt” interposed between the two words in the opponent’s mark. This makes this element of the applicant’s mark even more descriptive of the product and takes it far enough away from the opponent’s mark that there will be no confusion even between these two elements. When the “house mark” element of the mark in suit is added to the equation the marks are completely different, visually, aurally and conceptually.

27) I must now 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. Even though the goods in Class 3 are identical the marks are so different that I believe that there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2) (b) therefore fails.

COSTS

28) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering and commenting on the other side’s evidence	£500
Preparing for and attending a hearing	£600

TOTAL	£1,300
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29) I order the opponent to pay the applicant the sum of £1,300. 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 23rd day of June 2011

**George W Salthouse
For the Registrar,
the Comptroller-General**