

O-098-08

**TRADE MARKS ACT 1994
TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF REGISTRATION No 834512
BY TOLLCO AB TO REGISTER THE TRADE MARK TEFEX
IN CLASSES 8 AND 21**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 71190
BY E.I. PONT DE NEMOURS AND COMPANY**

**TRADE MARKS ACT 1994
TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF Registration No. 834512
and a request by Tollco AB to protect the Trade Mark
TEFEX in Classes 8 and 21**

and

**IN THE MATTER OF Opposition thereto under No. 71190
by E.I. Pont de Nemours and Company**

BACKGROUND

1) On 8 September 2004, Tollco AB made a request for protection of an international trade mark (UK) (“the designation”) in Classes 8 and 21 in relation to the following specifications of goods:

Class 08: Hand tools and implements (hand-operated); cutlery; side arms; razors.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

2) The registration date of the base International registration is also 8 September 2004 and claims a priority date from Sweden of 30 August 2004. The trade mark for which protection is sought is TEFEX.

3) On 17 March 2005, E.I. de Pont de Nemours and Company filed notice of opposition to the designation. The grounds of opposition are in summary:

a) The trade mark designated is visually and phonetically similar to a number of the opponent’s trade marks. The respective goods are identical or similar and there is a likelihood that consumers in the UK will be confused as to the origin of products sold under this trade mark. The designation should be refused in accordance with Section 5(2) (b) of the Trade Marks Act 1994 (the Act).

b) The opponent’s trade mark TEFLON has been in use in the UK since 1966 and the opponent has undertaken considerable investment with a high degree of advertising spend resulting in a high level of turnover derived from sales under the earlier trade mark. As a result the trade mark is well known. Designation of the applicant’ trade mark would take unfair advantage of the reputation of the opponent’s earlier trade mark and should be refused in accordance with Section 5(3) of the Act.

c) The opponent has earlier rights in the word TEFLON and in a sign consisting of the word TEFLON and two words (indistinguishable in the copy provided by the opponent on page 13 of the TM7 form) appearing in a device comprising a diamond shape in two colours/shades with the border between the colours/shades being a wavy line. This “earlier right has been used in relation to a chemically inert substance whose physical properties have applications...as a “non-stick” coating for a wide range of industrial and household uses”. This earlier right has been in use since 1964. Since 1966 it has been used in the UK in relation to coatings for cookware, cooking and kitchen utensils and household goods and, since 1972, in relation to hand tools and implements, razors and cutlery. The opponent has gained a reputation and a very significant goodwill the acceptance of the applicant’s designation will result in damage to this reputation and goodwill. The designation should therefore be refused in accordance with Section 5(4) (a) of the Act.

d) The opponent’s earlier trade marks have filing dates going back to 1956, 1966 and 1996 respectively and are earlier trade marks as defined by Section 6(1) of the Act. The opponent has generated billions of US\$ from worldwide sales of products under the TEFLON trade mark. Promotion of the brand has involved multiple media coverage and has a considerable reputation in the UK for household products, kitchenware, cutlery, razors and hand and tool implements. Designation would therefore be contrary to Section 56 of the Act.

4) The details of the three earlier trade marks, insofar as they have been relied upon by the opponent in these proceedings, are UK registration 751471 TEFLON for the following list of goods:

Class 21: Sheet material in solid form composed of laminations of glass fibre fabrics bonded together with synthetic resin plastics, the glass fibre material predominating

UK registration 893315 TEFLON for:

Class 21: Cooking utensils and kitchen utensils all included in Class 21

and Community Trade Mark (CTM) registration 432120 TEFLON that includes the following goods:

Class 08: Hand tools and implements (hand operated); cutlery; side arms; razors.

Class 21: Household or kitchen utensils and containers (not of precious metals or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other Classes.

5) The applicant subsequently filed a counterstatement denying the respective trade marks are similar and draws upon the differences in the second syllables. It contends that –EX and –LON are totally different and that the letter X “is an unusual letter that is striking and attracts the attention of the consumer, making any risk of confusion even less likely”. It also notes the coexistence on the UK trade marks register of various forms of the trade mark TEFAL and contends it has an equal level of similarity to the opponent’s trade mark as its own. It denies there is a likelihood of confusion or association in relation to products sold under the respective trade marks. It denies that the designation would take unfair advantage of, or be detrimental to, any distinctive character or repute the opponent’s trade mark possesses. It contends that the grounds under Sections 5(2) (b), 5(3), 5(4) (a) and Section 56 should be rejected.

6) The opponent is put to proof of use in relation to all the goods relevant to the proceedings.

7) Both sides filed evidence in these proceedings. Neither side requested to be heard but the applicant has filed written submissions in lieu of a hearing. Both sides ask for an award of costs. After careful consideration of the papers, I give this decision.

Opponent’s Evidence

8) This takes the form of a witness statement by Anne Chabane and is dated 23 March 2006. Ms Chabane is the Corporate Trade Mark Specialist of Du Pont de Nemours International S.A., the European subsidiary of the opponent (collectively referred to as “Du Pont”). Ms Chabane provides information regarding the size of Du Pont, citing operations in more than 70 countries, a wide ranging product base, worldwide revenues of US\$26.6 billion, 60,000 staff worldwide and 75 laboratories located in 12 countries.

9) Ms Chabane explains that the trade mark TEFLON was originally registered in 1945 and has been used commercially since 1946 on a range of fluoropolymers, one application of which is as a superior non-stick coating on, among other things, cookware. She goes on to state that TEFLON is one of the world’s best known trade marks with an 80% recognition level in Europe. TEFLON “could be considered as the “grand-father” of ingredient branding,... [referring] to a component rather than an end-use product” and it is an invented word recognised as denoting DuPont’s trade mark.

10) Ms Chabane refers to commissioned research recording consumer recognition rates for the TEFLON brand as being at least 80%, both in the UK and other countries, with a particular association for the consumer to cookware and utensils. Worldwide reputation of the TEFLON brand is demonstrated by providing information regarding DuPont’s global activities and trade marks.

11) Use of the TEFLON brand in the UK began in 1964/5 in relation to the sheet materials of laminations of glass fibre, 1966 in relation to cooking/kitchen utensils and 1972 for metal coatings for hand tools and implements. TEFLON products have been sold throughout the UK. Various annual sales amounts are provided, including global and

European sales, but for the purposes of this decision, I will record only those amounts that relating to a period of five years prior to the applicant’s designation:

Year	Global	UK	Europe
2000	US\$ 850 million	Not disclosed	US\$ 187 million
2001	US\$ 680 million	US\$ 13 million	Not disclosed
2002	US\$ 630 million	US\$ 11 million	Not disclosed
2003	Not disclosed	US\$ 14 million	Not disclosed
2004	Not disclosed	US\$ 16 million	Not disclosed

I note that these amounts relate to flouropolymer, fluorofinishe and fluoroprotectant products bearing the TEFLON trade mark, including fabric protector and lubricants, paints and polishes, but not specifically to housewares and cooking liner products.

12) With respect to housewares and cooking liner products, no specific amounts are disclosed for the UK, but the following amounts are disclosed for the relevant five year period with respect to European sales:

Year	Housewares	Cooking Liners
2000	US\$ 19 million	-
2001	US\$ 20 million	-
2002	US\$ 21 million	-
2003	US\$ 22 million	US\$ 1 million
2004	US\$ 22 million	US\$ 1 million

13) Advertising expenditure in the UK is provided from 1989. No figures are provided for the years 1999 and 2000 but for the four year period prior to the applicant’s designation expenditure amounted to US\$ 1 million a year.

14) Ms Chabane declares that DuPont is aware that the applicant has used the TEFLON trade mark together with the TEFEX sign and contends that this is an attempt by the applicant to trade off DuPont’s significant reputation in the TEFLON trade marks.

15) Sixteen exhibits are provided with this witness statement. I do not intend to list them all here, but will refer to them as appropriate later in this decision.

Applicant’s Evidence

16) This is a witness statement by Anders Toll dated 3 October 2007. Mr Toll is chairman of Tollco AB.

17) Mr Toll presents evidence to demonstrate that the respective trade marks have co-existed in Sweden for over ten years. Sales in the UK are disclosed with respect to “cookie sheets”, being sheets of non-stick material coated with polytetrafluoroethylene (PTFE) for use in baking. These sales have been by the applicant’s distributor at the Ideal

Home Exhibition, Earls Court. The applicant's products are also available in the UK from its website. Total UK sales are estimated to be in the region of £14,000 for the period from 2001 to 2007. I note that only about £2,200 of these sales took place prior to the date of designation.

18) Mr Toll refers to the applicant's trade mark applications in numerous other European countries and draws attention to a number of failed oppositions against the TEFEX trade mark that has been instigated by the opponent.

19) Mr Toll reiterates comments made in the applicant's counterstatement regarding the comparison of the trade marks and adds that the respective trade marks both consist of made up words and therefore there is no conceptual similarity.

20) Finally, Mr Toll levels a number of criticisms at Ms Chabane's witness statement. He identifies the reports presented in Exhibit AC2 as failing to illustrate the situation in the UK because it is unclear as to how many UK consumers were surveyed. He also contends that there is no evidence to support Ms Chabane's assertions that TEFLON was first used in 1964. Mr Toll refers to the apparent set of instances where TEFLON and TEFEX products were sold at the same events and points out that there is no evidence of confusion at these events. He also referred to the use by the applicant of the TEFLON trade mark and points out that this use took place in Germany and contends that it is not relevant to these proceedings.

21) A number of exhibits are provided with this witness statement. I do not intend to list them all here, but will refer to these and the issues listed above as appropriate, later in this decision.

22) That completes my review of the evidence insofar as they are relevant to the proceedings.

DECISION

Proof of use

23) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

24) The designation was published in the Trade Marks Journal on 17 December 2004. The three trade marks relied upon by the opponent were registered in the 1950s, 1960s and 7 April 1999 respectively. All these earlier trade marks were registered more than five years before the publication date of the applicant’s designation and the opponent is therefore required to demonstrate that these trade marks have been put to genuine use in the five year period ending with the date of publication of the designation.

25) The requirements for “genuine use” have been set out by the European Court of Justice (ECJ) in its judgment in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40. The ECJ held as follows:

“35. ... ‘Genuine use’ therefore means actual use of the mark....

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user...

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of its enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns...

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

26) Anne Chabane, in her witness statement of 23 March 2006 provided a plethora of exhibits to support the opposition, but I have some difficulty in extracting from these exhibits any firm evidence of UK sales. There is sufficient evidence to illustrate that DuPont has operations in the UK (Exhibit AC5) and that there are at least ten UK suppliers of DuPont’s “no-stick” products (Exhibit AC15). However, neither of these exhibits shows any use of the trade mark TEFLON and as such, they are of limited usefulness. Ms Chabane refers to Exhibit AC9 being specimen advertisements that have appeared in the UK for TEFLON products. Three of these adverts are in the German language, which to my mind, casts doubt that they have appeared in the UK. The remaining five are at least in the English language, but there is no indication of the dates when the adverts were used or where they appeared. I am unable to conclude that they were used in the UK during the relevant five year period. The remaining extracts in Exhibit AC9 are from a publication entitled “DuPont No-Stick News, The European Magazine of DuPont® Non-Stick Systems”. This clearly illustrates a wide range of TEFLON products. The title of the magazine can lead to an assumption that these products are sold into a European market, but references to specific use of TEFLON branded products in the UK is limited to a single entry stating that the Millennium Dome in London is “to be given a glass roof coated with Teflon®”. There is nothing more to indicate if, in fact, such a roof was ever fitted.

27) Ms Chabane declares sales in the UK under the TEFLON trade mark and also lists locations in many regions of the UK where TEFLON products are sold, however, very little of the evidence filed is specifically targeted at substantiating these claims.

28) Exhibit AC7 presents, among other things, nearly fifty pages from the websites “teflon.com” and “dupont.com” providing detailed product and other information. Once again, this illustrates little with respect to use of the TEFLON trade mark in the UK and in fact there are numerous references, such as prices in dollars and an account of launching a new product in Kentucky that indicate these websites are targeted at the US.

29) Exhibit AC7 also includes a copy of the “DuPont 1999 Data Book”. This includes a consolidated statement of cash flows that includes, on page 12, selected additional data detailing, amongst other things, DuPont’s net sales by geographic region for the years 1997-1999. In 1999, UK net sales is recorded as US\$ 960 million. No further breakdown is given and no indication as to what proportion of these sales relates to TEFLON products. In what appears to be a copy of the “DuPont 2004 Annual Review” there is a three page article about the Selfridges department stores in London and Birmingham and identifies a link between the store and DuPont, but it makes no mention of TEFLON branded products. A further article in the same publication discusses the use of a number of DuPont’s branded clothing products being used by London’s metropolitan Police, but once again this provides no assistance regarding the use of the TEFLON trade mark in the UK.

30) Exhibit AC8 provides a number of examples of labels incorporating the trade mark TEFLON, but no indication is given either to the date when such labels were used or to the geographic territory in which they were used.

31) Exhibit AC10 provides a list of local newspaper titles together with circulation size where, Ms Chablane claims, TEFLON goods were advertised. The table fails to identify TEFLON products, but merely refers to DuPont as being the client. Further the document is dated 4 August 2005 which is outside the relevant five year period. The accompanying copies of advertisements, advertising features and website extracts often relate to a time outside the relevant five year period, fail to identify a date, fail to identify the TEFLON brand or fail to show use of the trade mark TEFLON on relevant goods. Those that are worthy of specific mention are:

- Several extracts from fluorocarbon.co.uk relating to industrial bakeware bearing a TEFLON trade mark and with a copyright notice date of 2003
- Extract from cooksparaphernalia.co.uk which includes the statement “[n]on-stick coatings are made by a number of manufacturers. Probably the best known is Dupont, who make Teflon® coatings.” Whilst this extract is dated after the relevant five year period, it is revealing in respect to the TEFLON brand being known in the UK.

32) Ms Chabane refers to Exhibit AC11 and states that this includes brochures distributed to UK consumers dating from February 1999, November 1999 and June 2001 respectively. I note that the first of these falls outside the relevant five year period. The second of these, entitled “Teflon Industrial News” appears to be targeted at an industry audience and carries three articles about coatings that bear the TEFLON brand. One discussing a test that demonstrates the abrasion resistance of TEFLON coatings, a second discusses the development of a catalyst product using TEFLON technology, and a third referring to a competition for innovative developments using TEFLON coatings. None of these articles illustrate use in the UK. The third brochure is undated and gives no indication of the geographic scope of its use. This is another industry focused publication entitled “Adding

value with DuPont Teflon non-stick surfaces” providing information on the various non-stick cookware and bakeware products provided under the TEFLON brand.

33) Exhibit AC13 consists of a recording of a television advert for the DIY company B&Q that contains a reference to a “paint with TEFLON for toughness”. This has no relevance with respect to the goods at issue.

34) Exhibit AC14 is a copy of a DuPont leaflet produced for a trade fair in Birmingham held between 6 - 10 February 2000. This leaflet makes claims to the TEFLON brand having 90% consumer awareness in the cookware sector and details new TEFLON cookware and bakeware products for the year 2000. It also lists thirteen traders appearing at the show that are showing products with DuPont non-stick surfaces.

35) Finally and significantly, Exhibit AC2 provides two extracts of customer surveys that record awareness of the TEFLON brand in the UK as being 86% and 80% respectively. The applicant has drawn my attention to the fact that the mathematics in relation to the first of these is unclear and the size of the UK sample questioned is therefore not obvious. The second survey, marked as “NOP Consumer” appears to be an international survey with an undisclosed number of participants. It reports that of the 80% who were aware of the brand in the UK, three quarters of these “knew that Teflon was contained in cookware”. I accept the applicant’s comments regarding the first survey and there are also issues concerning the second survey, in particular, regarding the size of the sample questioned in the UK. Nevertheless, taking these two surveys together, there is a strong inference that the TEFLON brand is widely sold in the UK.

36) Following completion of my reading of the evidence, I am left feeling that there may be significant use of the TEFLON trade mark in the UK, but the evidence is not well marshalled to demonstrate that this is so during the relevant five year period. For example, despite the opponent’s claims in its notice of opposition, there is no evidence of use in the UK with respect to razors and cutlery. Nevertheless, for the purposes of Section 6A of the Act, I am satisfied that the opponent has sufficiently demonstrated genuine use for the following Class 21 goods:

Sheet material in solid form composed of laminations of glass fibre fabrics bonded together with synthetic resin plastics, the glass fibre material predominating; cooking utensils and kitchen utensils.

Section 5(2)(b)

37) The opposition is founded upon Section 5(2)(b) of the Act. This reads:

“(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

38) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law 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 B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(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.*,

The average consumer

39) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. The opponent's evidence appears to identify three distinct consumer groups. The first of these is the general public who would purchase the *cooking utensils* and *kitchen utensils* in a general retail environment and the second is the business consumers who purchase these products for use in commercial kitchen environments. In terms of the degree of attention paid in the purchasing act, I do not believe that these two groups of consumers vary to any great degree.

40) It is clear that there is also a third category of consumer. The relevant consumer of the applicant's *unworked and semi-worked glass* and the opponent's *laminated sheet materials* products is manufacturers of products made from such goods. Here, the purchasing act will be well considered and the degree of attention paid by such consumers will be at a higher level than that practiced by the general purchasing public. The costs of such products are likely to be higher, possibly considerably higher, than those products sold to the general public. This provides further support to my view that a generally higher degree of care is involved in the purchasing process for such products.

41) I therefore conclude that the relevant average consumer with respect to *cooking utensils* and *kitchen utensils* is in most cases an ordinary member of the public or a commercial purchaser paying a reasonable degree of attention, but with respect to *unworked and semi-worked glass* and *laminated sheet materials* the consumer will be a more specialised business consumer with a high degree of knowledge and paying a high degree of attention.

Comparison of goods

42) I intend to approach the comparison of goods question based upon this more narrow scope upon which the opponent has demonstrated genuine use, namely in Class 21 and for convenience, I reproduce both the applicant's list of goods below and the opponents revised list of goods:

Opponent	Applicant
	Class 08: <i>Hand tools and implements (hand-operated); cutlery; side arms; razors.</i>
Class 21: <i>Sheet material in solid form composed of laminations of glass fibre fabrics bonded together with synthetic resin plastics, the glass fibre material predominating; cooking utensils and kitchen utensils</i>	Class 21: <i>Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.</i>

43) In assessing the similarity of goods it is necessary to apply the approach advocated by case law. In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281, Mr Justice Jacob, as he then was, commented:

“...I think the following factors must be relevant in considering whether there is or is not similarity:

- (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.”

44) The term *kitchen utensils* is common to both the applicant’s specification and the revised list of goods of the opponent and it follows that in terms of applying the criteria identified above, these goods are identical. This offers the opponent its strongest case. If it cannot win here it will not succeed for the other goods.

Comparison of marks

45) I will now go on to consider the differences between the trade marks themselves and the impact of any differences upon the global assessment of similarity. The trade marks to be compared are:

Trade mark of E.I. de Pont de Nemours and Company	Trade mark of Tollco AB
TEFLON	TEFEX

46) The earlier trade mark is a made-up word consisting of the two syllables TEF and LON. In its written submissions, the applicant contends that the TEF prefix appears to be commonplace on the UK Register and concludes from this that trade marks with a TEF prefix have no proprietorial significance. The applicant supports this contention with a copy of a search undertaken for UK and Community trade marks (Exhibit AT7 of Mr Toll’s witness statement). At Exhibit AT8, Mr Toll also provides evidence of a number of TEFAL trade marks with respect to the same goods and contends that these trade marks have not required the consent of the opponent and neither do they appear to have been raised as citations during the examination stage of these trade marks.

47) I note the Mr Toll’s contentions but the existence of other TEF trade marks on the UK Register can not be a deciding factor. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

48) The applicant also contends that the respective suffixes LON and EX differentiate the trade marks visually and phonetically and that the EX component of the applicant’s trade mark “is especially distinctive given the sound and visual dominance of the letter “X””.

49) The average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the trade marks must, therefore, be assessed by reference to the overall impressions created, bearing in mind their distinctive and dominant components. Consequently, I must not engage in an artificial dissection of the trade marks, although I need to take account of any distinctive and dominant components. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but 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.

50) The trade marks must therefore be considered in their entirety and in this case, I do not believe that the trade marks can be dissected into specific distinctive and dominant components. From the visual perspective, the respective marks share the same first three letters and I note that the opponent's trade mark contains a second element of the three letters LON, whilst the applicant's trade mark contains a second element of the two letters EX. These second elements vary in that one is of three letters, the other is of two letters and none of the three letters appearing in the opponent's mark appears in the applicant's trade mark. For these reasons, I find that the respective trade marks have a low level of similarity.

51) Similar considerations apply from the aural perspective. Both trade marks consist of two syllables, with the first of these being identical. The applicant has drawn my attention to the phonetic impact of the letter "X" in its trade mark. The difference in the pronunciation of the second syllable results in the opponent's trade mark having the sound TEF-LON and the applicant's trade mark having the sound TEF-X.

52) I recognise that there are some aural similarities between the trade marks, but I am mindful of the comments of the European Court of Justice in *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal market (OHIM) Case C-234/06P*:

"32. Even though it is conceivable that aural similarity alone could create a likelihood of confusion, 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..."

53) As they are both made up words, I consider that there is no conceptual similarity or dissimilarity. Taking account of the similarities and differences in the visual and aural impressions, I find that there is a low level of visual similarity and a lowish level of aural similarity and, overall, I find there is a low level of similarity between the respective trade marks.

Use and distinctive character of the earlier trade mark

54) I also have to consider whether the opponent's trade mark has a particularly distinctive character either arising from the inherent characteristics of the trade mark or because of the use made of it. The opponent's trade mark TEFLON comprises a made up word and as such it has an inherently high level of distinctive character for the revised list of goods.

55) 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 Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen 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 distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

56) The opponent’s evidence, whilst not being well marshalled has demonstrated that its TEFLON trade mark has a world wide reputation for certain non-stick products. Its evidence has illustrated that this world-wide reputation extends to the UK, at least in respect of *sheet material in solid form composed of laminations of glass fibre fabrics bonded together with synthetic resin plastics, the glass fibre material predominating; cooking utensils and kitchen utensils*. I can therefore conclude that it benefits from a strong enhanced reputation for such products and that its already high distinctive character is further enhanced by this reputation.

Likelihood of confusion

57) I have found that the respective trade marks share some aural similarity but have a low visual similarity and that the earlier trade marks possess a high degree of distinctive character, further enhanced by their reputation. I have also found that at least some of the respective goods are identical and that the relevant consumers are the same. I must now make an assessment as to whether these factors combine to create a likelihood of confusion.

58) In taking a balanced view and adopting the global approach advocated by case law, I find that the impact of the visual and aural differences between the respective trade marks to be such as to not lead the relevant public to confuse the trade marks or to be led into believing that the respective goods originate from the same source. I find there is no likelihood of confusion and the opposition under Section 5(2) (b) fails.

Section 56

59) Owing to my finding under Section 5(2) (b) of the Act that there is no likelihood of confusion between the respective trade marks, this ground of opposition must also fail.

Section 5(4) (a)

60) I go on to consider the ground under Section 5(4)(a). That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

61) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

62) To the above I add the comments of Pumfrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472).

Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

63) The opponent relies upon an earlier right in the word TEFLON and in an earlier right consisting of the word TEFLON and two (undistinguishable) words appearing in a device comprising a diamond shape in two colours/shades with the border between the colours/shades being a wavy line. The first question is whether the opponents have any goodwill in TEFLON. In my assessment of the evidence in respect of the ground under Section 5(2)(b) I came to the view that the opponents are likely to have established a strong reputation in TEFLON in respect of their *sheet material in solid form composed of laminations of glass fibre fabrics bonded together with synthetic resin plastics, the glass fibre material predominating; cooking utensils and kitchen utensils*. I see no reason why the position should be any different in respect of goodwill.

64) Ms Chabane, in her witness statement of 23 March 2006, draws attention to the applicant using the TEFLON trade mark together with the TEFEX sign and an example of this is provided at Exhibit AC16 accompanying her witness statement. This exhibit consists of photocopies of packaging of a non-stick baking liner bearing the trade mark TEFEX. However, the copies are of insufficient quality to ascertain the nature of the use of the name TEFLON which appears in the text on the reverse side of the packaging. Despite being in a language other than English, it is possible to identify further text that attributes ownership of the TEFLON trade mark to “Du Pont” and ownership of the TEFEX trade mark to the applicant. This appears to highlight the different ownerships rather than the existence of any association in trade. Therefore, the exhibit fails to demonstrate that the applicant is benefiting from any association with the opponent’s products and indeed, there is no evidence provided to illustrate how the relevant consumer may perceive such use. It is not conclusive in demonstrating misrepresentation by the applicant.

65) I found earlier that the respective trade marks only share a low level of similarity and that this finding, when taken as part of the global assessment advocated by case law resulted in a finding of no likelihood of confusion under Section 5(2) of the Act. The opponent’s case under Section 5(4) (a) is no stronger. This means that the necessary misrepresentation required by the tort of passing off would not occur. Therefore, the opposition under Section 5(4) (a) fails.

Section 5(3)

66) I turn to consider the ground for opposition under Section 5(3) of the Act which reads as follows:

“5.-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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 or international trade mark (EC) 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.”

67) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon v Fitnessworld* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler A.G. v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited v Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42.

68) The applicable legal principles arising from these cases are as follows.

a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ’s judgment in *General Motors Corp. v Yplon SA* (CHEVY) [1999] ETMR 122).

b) Under this provision the similarity between the marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier mark and the later mark or sign, *Adidas Salomon v Fitnessworld*, paragraphs 29-30.

c) The link must be such that it would cause real as opposed to theoretical effects: *Intel v Sihra* and *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWHC 1878 (Ch).

d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J. in *Premier Brands UK Limited v Typhoon Europe Limited* [2000] FSR 767).

e) The stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).

f) There is detriment to the distinctive character of the earlier mark where it is no longer capable of arousing immediate association with the goods or services for which it is registered. There is detriment to the repute of the earlier mark where the goods or services for which the later mark is used appeal to the public's senses in such a way that the earlier mark's power of attraction is diminished: *Spa Monopole v OHIM* [2005] ETMR 109 (CFI). These concepts have also been described as blurring or tarnishing the earlier mark (paragraph 88 of Pumfrey J.'s judgment in *Daimler Chrysler v Alavi* (MERC) [2001] RPC 813).

g) Unfair advantage is taken of the distinctive character or the repute of the earlier mark where there is clear exploitation and free-riding on the coat-tails of a famous mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

69) I also note the following comment from Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited v Coinworld Limited and Others* [2005] FSR 7:

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

70) I have already established that the TEFLON trade mark consists of a made-up word and enjoys a strong reputation in respect of *sheet material in solid form composed of laminations of glass fibre fabrics bonded together with synthetic resin plastics, the glass fibre material predominating; cooking utensils and kitchen utensils*. These findings led me to conclude that the opponent's trade mark has a high degree of inherent distinctive character and that this is enhanced further with respect to the aforementioned goods because of the use made of it. However, whilst acknowledging this strong distinctive character and also the similarities that exist between the respective trade marks, I am also aware of the significant differences. The applicant's trade mark is also a made-up word with its own high level of distinctive character and it is my view that the differences between the respective trade marks outweigh the similarities. It is possible that a consumer familiar with the opponent's trade marks, upon seeing the applicant's trade mark in relation to the same goods, may call to mind the trade marks they already know, but I do not consider the similarities to be such that they will establish a link between the

respective trade marks. Even if the similarities were such as to establish a link, no evidence has been put forward to show that there was a taking of unfair advantage of or detriment to, the distinctive character of the earlier trade mark. It follows that, where the goods are only similar, no link will be established.

71) I find that the similarity between the trade marks is insufficient to create the necessary link that would affect the relevant consumer's purchasing behaviour. Therefore, the opposition under Section 5(3) fails.

COSTS

72) The opposition having failed, the applicant is entitled to a contribution towards its costs. I take account of the fact that the decision has been reached without a hearing taking place, though with written submissions having been prepared by the applicant. I award costs on the following basis:

Consideration of TM7	£200
Statement of case in reply	£300
Preparing and filing evidence	£300
Considering evidence	£150
Filing written submissions	£200
TOTAL	£1150

73) I order E.I. Pont de Nemours and Company to pay Tollco AB the sum of £1150. 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 7th day of April 2008
Mark Bryant
For the Registrar,
the Comptroller-General