

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NUMBER 2211995  
BY TERENCE HATELEY AND WILLIAM BELL  
TO REGISTER A TRADE MARK IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 50791  
BY SUN PHARMACEUTICALS CORP**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application Number 2211995  
by Terence Hateley and William Bell  
to Register a Trade Mark in Class 3**

and

**IN THE MATTER OF Opposition thereto  
under Number 50791  
by Sun Pharmaceuticals Corp.**

### BACKGROUND

1. On 21 October 1999 Terence Hateley & William Bell applied to register the following trade mark in Class 3 for a specification of "Self-tanning products, self-tanning impregnated towellettes; suntanning preparations; toiletries, soaps, haircare, body lotions; nail preparations".



2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 7 March 2000 Wildbore & Gibbons on behalf of Sun Pharmaceuticals Corp. filed a Notice of Opposition against the application. In summary, the grounds of opposition were:

- (i) Under Section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to the following UK registered trade marks owned by the opponents and registered for the same and similar goods and there is therefore a likelihood of confusion on the part of the public:-

NUMBER	MARK	REGISTRATION EFFECTIVE	CLASS	SPECIFICATION
1323235	BANANA BOAT	6 OCTOBER 1987	3	Cosmetics; non-medicated toilet preparations; soaps; perfumes; preparations for teeth and hair; cosmetic and toilet articles; nail polish and nail polish removing preparations; sun tan preparations; all included in Class 3.
2100885		23 MAY 1996	3	Sun care protection, sun block preparations; sun screen preparations; skin lotions; non-medicated lip-balm; hair lighteners; hair conditioners; gels containing aloe vera, collagen, vitamin E and/or vitamin A, all used for skin care purposes; sun tan lotions and oils; moisturizing lotions and gels.

(iii) Under Section 5(4)(a) of the Act in that the trade mark applied for is liable to be prevented by the law of passing off.

3. The applicants, through their agents Swindell & Pearson, filed a counterstatement denying the grounds of opposition stating that the respective marks were different and not similar. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing.

### **Opponent's Evidence**

4. This consists of a witness statement by Chris McLeod dated 23 January 2001. Mr McLeod is a trade mark agent in the firm of Wildbore & Gibbons, the opponent's professional advisors in this matter.

5. Mr McLeod submits that the application in suit is similar to the opponent's registered marks 1323325 and 2100885, includes identical and similar goods within its specification and that there is a likelihood of confusion. He also re-iterates the Section 5(4)(a) ground and states that the opponent has built up a reputation in its trade marks.

6. Mr McLeod goes on to say that the opponent first used its marks in the UK in 1998 in relation to sun tan lotions and creams, sun block preparations and sun screen preparations and he adds that the marks have continued in use on these goods since that date. He provides the following approximate annual sales figures:-

1998	£772,000
1999	£810,000
2000	£934,000

**Applicants' Evidence**

7. This consists of a witness statement by Philip John Cooper dated 28 September 2001. Mr Cooper is a trade mark attorney in the firm of Swindell & Pearson, the trade mark agents representing the applicants.

8. Mr Cooper explains that the word "banana" has, or is part of words having, several definitions appearing in Websters Third New International Dictionary and a copy of the relevant page is attached as Exhibit "PJC 1" to his declaration. He states that since the word "banana" is a generic name denoting a natural product and the banana fruit is well known, it is reasonable to suppose that banana scent or fragrance, or extract of banana, might be used as an ingredient in certain products for personal use. Therefore, Mr Cooper, conducted a search on the internet on 8 November 2000 a copy of a print-out of the results to support this supposition is attached as Exhibit "PJC 2" to Mr Cooper's declaration.

9. Next, Mr Cooper states that it is his understanding, following a telephone conversation with Terence Hateley of the applicants, that the name BANANA BEACH was chosen as part of the trade mark in suit, because it is the name of a particular beach or resort. Mr Cooper conducted a further internet search on 8 November 2000 and a copy of the print-out results are at Exhibit "PJC" to his declaration. They show that there is a beach or resort having the name "Banana Beach" both at Ambergris Caye in Belize and at Skiathos in Greece.

10. This completes my summary of the evidence filed in this case. I now turn to the decision.

**DECISION**

11. Firstly, I go to the ground of opposition under Section 5(2)(b) of the Act 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."

12. An earlier right is defined in Section 6, the relevant parts of which state:-

"6.-(1) .....

- (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,"

13. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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.* paragraph 27;
- (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*, paragraph 23;
- (c) 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*, paragraph 23;
- (d) 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*, paragraph 17;
- (e) 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*, paragraph 24;
- (f) 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*, paragraph 26;
- (g) 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*, paragraph 41;

- (h) 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*, paragraph 29.

14. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection afforded to such a mark. In the present case, the opponents claim a reputation in their marks. However, while they have provided information in relation to turnover in their marks this, in itself, does not demonstrate reputation or goodwill sufficient to further enhance the intrinsic merits of the marks, which are in any case considerable.

15. Although the opponent may have had a real and substantial presence in the market place for one to two years prior to the relevant date for these proceedings (21 October 1999), this does not demonstrate a reputation among the relevant public for the mark BANANA BOAT. While I accept that evidence filed in cases before the Registrar should be proportionate to the costs involved in what is essentially a lower cost option for dispute resolution, an opponent seeking extended protection for a trade mark because of its reputation and enhanced distinctive character is under an obligation to demonstrate the repute of their mark with the average customer for the relevant goods. In my opinion this requires, at least, the filing of specific and relevant documentation going to matters such as market share, the actual use of the mark on packaging and the goods, details of marketing and promotion and independent trade support or analysis. To conclude, I do not consider that the opponents have established a reputation for the purposes of these proceedings. I must therefore compare the mark applied for and the opponent's registrations assuming normal and fair use of these marks, bearing in mind that, in my view, the earlier trade marks intrinsically possesses a high distinctive character in relation to the goods.

16. The goods specified within the application in suit and the opponent's registrations both include (inter alia) preparations and lotions for suntanning and it is common ground that they cover the same and similar goods.

17. 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 considerations of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

18. The application in suit consists of the word BANANA above the word BEACH followed by an exclamation mark, which, in turn, appears above the word SUN which is above a roughly drawn device which I perceive as the sea-shore and a star fish, which, in turn, is above

the word WIPE. The words, all of which have obvious dictionary definitions are slightly stylised but, in my view, this has no significant impact on the totality of the mark. On the other hand, the opponent's registrations comprise firstly, the dictionary word BANANA followed by the dictionary word BOAT and secondly the words BANANA BOAT with the device of leaves. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind in my considerations.

19. In my comparisons of the marks, while I do not lose sight of the fact that the opponents have cited two registrations, I do not believe that registration number 2100885 (the words BANANA BOAT with the accompanying device of leaves) puts them in any stronger position for all practical intents and purposes and I shall limit my considerations to a comparison of the mark in suit and registration number 1323235 for the mark BANANA BOAT.

20. Turning firstly to a visual comparison of the marks, I find them quite different. While it seems to me that the words BANANA BEACH are the dominant components of the applicant's mark, they are different in totality from the words BANANA BOAT and I see no reason why the words BEACH and BOAT would be ignored, marginalised or imperfectly recollected by the prospective customer in visual use. In his statement, Mr Cooper submitted that the word BANANA could have a reference to the goods at issue and is, in effect, is non-distinctive element. While this may well be the case, I do not believe that this would be obvious to the customer for the goods when the respective marks are in use as, in their particular combinations, it seems to me that BANANA BEACH and BANANA BOAT would "hang-together" in the customers mind and possess their own different connotations which I will consider under conceptual similarity in due course.

21. On the consideration of aural use of the marks it is my view that the applicants mark would be described orally by customers as BANANA BEACH, especially as in normal oral use "words speak louder than devices". However, the respective words BANANA BEACH and BANANA BOAT are aurally distinct in totality as, once again, I do not believe that the elements comprising the words BEACH and BOAT would be ignored or that the marks would be imperfectly recollected by customers.

22. Conceptually, I believe that the respective marks are different. The opponent's mark brings to mind a boat carrying bananas whereas the applicant's mark conveys a beach named "Banana", possibly because it is fringed by banana trees or is banana shaped.

23. I would add that, while I have no evidence before me on the point, it seems to me that the relevant customer for sun tanning preparations would be relatively careful in their purchase as a primary function of such goods is to protect against the sun's rays. The customer might well wish to check (often through a close visual inspection) that the goods e.g. were of the correct factor, were waterproof or were suitable for use on sensitive skins.

24. On a global appreciation I have come to the conclusion that, while it is possible that some people encountering the applicants' mark may think it reminiscent of the opponent's marks it does not follow that a likelihood of confusion exists. Given the visual, aural and conceptual differences between the marks and after taking into account all the relevant factors (including

imperfect recollection, the category of goods and the customer for the goods), it seems to me that the possibility of confusion is sufficiently remote that it cannot be regarded as a likelihood. The opposition under Section 5(2)(b) fails.

25. Next, I consider the ground of opposition under Section 5(4)9a), which states:-

"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) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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."

26. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC in the WILD CHILD case [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (See Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (See Art 4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the applicant in accordance with the law of passing off".

"A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341 and Erven Warnink BV v J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff's 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 defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation."

27. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed .....", the relevant date is therefore the date of the application for the mark in suit.

28. Earlier in this decision I found that the opponent had not demonstrated reputation or goodwill in the UK at the relevant date on the basis of the evidence before me. Furthermore, I have also found that the application in suit and the opponent's registration were not confusable. Accordingly, the opposition under Section 5(4) of the Act must fail.

29. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £450. 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 26 day of March 2002**

**JOHN MacGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**