

**TRADE MARKS ACT 1938 (as amended)
& TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NOS.
1330686/1294891 AND 1326391 IN THE NAME OF DALMAS S.p.A**

and

**IN THE MATTER OF OPPOSITION THERETO UNDER NOS.
34458, 34448 & 34447
BY CUSSONS (UK) LTD AND CUSSONS (INTERNATIONAL) LTD**

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BACKGROUND

20 Dalmas SpA of Bologna, Italy, applied to register the trade marks, in Class 3. After
examination the three trade marks were advertised as follows:

Date of application	No.	Trade mark	Specification of Goods
25 4 December 1986	B1294891	LA PERLA PARFUMS	Perfumes included in Class 3; but not including any such goods for use in manufacture and not including essential oils.
30 10 November 1987	B1326391		Perfumery included in Class 3, but not including any such goods for sale for use in manufacture.

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10 All three applications were opposed by joint opponents Cussons (UK) Ltd and Cussons (International) Ltd. Consolidation of the proceedings was agreed at an early stage.

The grounds of opposition are, in summary, as follows:

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(i) under Sections 9 and 10 because the trade marks are neither adapted to distinguish nor capable of distinguishing the goods of the applicant.

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(ii) under Section 11 by reason of the use and reputation of the opponents in their trade marks CUSSONS PEARL, use by the applicants of their trade marks would cause confusion and deception.

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(iii) under Section 12 because of the opponents earlier registrations of their CUSSONS PEARL trade marks as follows:

No.	Specification of goods
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1194994	Toilet soap, all for sale in the United Kingdom.
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1216669	Toilet soap, all for export from the United Kingdom. Toilet soap, all for sale in the United Kingdom.
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(iv) under Section 17 because the applicants can not claim to be the proprietor of the trade marks the subject of the applications.

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Both sides seek the exercise of the Registrar's discretion and an award of costs in their favour.

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Evidence was filed by both parties and the matter came to be heard on 28 January 1999 when the applicants were represented by Mr Colin Birrs of Counsel, instructed by K W Nash their trade mark attorneys, and the opponents were represented by Ms Caroline Bonella on behalf of their trade mark attorneys Trade Mark Owners Association.

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By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

OPPONENTS EVIDENCE

5 This consists of a Statutory Declaration dated 11 January 1995 by Alaric Paul McDermott, Company Secretary of the opponents.

10 Mr McDermott states that the opponents first adopted and used what he calls their "PEARL" trade mark in 1984 and exhibits packaging used at that time showing that word along with the CUSSONS trade mark. The trade mark CUSSONS PEARL is used on soaps, creme bath and shower gel. By 1986 when the first of the applicants' trade marks was filed UK sales under the trade mark were running at £3M per annum. Exhibits provided show how the trade mark was presented and used. Details of other trade marks which the opponents have acquired since the opposition was entered are also provided. However, as there was no request to amend the pleadings to take them into account I pay them no heed.

15 In Mr McDermott's view the applicants' trade marks will be known by the PERLA element, which in Spanish means pearl and he goes on to exhibit an entry from Cassell's Spanish/English, English/Spanish Dictionary from which he concludes that LA PERLA means anything precious or bright and, in the plural, fine teeth. He concludes that the applicants' trade marks should be refused under the provisions of Section 9, 10, 11 and 12 of the Act.

APPLICANTS EVIDENCE

25 This consists of a Statutory Declaration by Stephen Dominic James, the Managing Director of Hornvale Limited, the distributor in the United Kingdom of the applicants' products. He says that the applicants first commenced use of their trade marks in 1987 and he goes on to provide material showing how the trade marks are used and sales and advertising figures. But as these are all in respect of periods after the dates of application I take no account of them.

OPPONENTS EVIDENCE IN REPLY

30 This consists of a further Statutory Declaration by Mr McDermott dated 23 April 1996. He comments on the exhibits attached and to the details contained in the applicants evidence. But as I have disregarded those I need not record Mr McDermott's comments.

DECISION

35 First of all, though the opponent has pleaded Section 17 in alleging that the applicants can not claim to be proprietor of the trade marks no evidence has been submitted in that regard. I therefore dismiss the opposition insofar as it was based upon the applicants proprietorship of the trade marks.

I turn next to the grounds of opposition based upon Sections 9 and 10 of the Act. These state:

45 9. - (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

(2) For the purpose of this section "distinctive" means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

10(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

- (a) the trade mark is inherently capable of distinguishing as aforesaid;
- and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

5 (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

10 Application No. 1330686 is the only one to which the objection under Section 9 applies, the other two were accepted for registration in Part B of the Register. Application 1330686 is for the trade mark LAPERLA and therefore I consider that trade mark against Section 9 first of all.

15 Clearly LAPERLA is not acceptable under Section 9(1)(a) or 9(1)(b). Nor is it acceptable under Section 9(1)(e), as I do not consider that there was any discernable use prior to the date of application.

20 Ms Bonella, sought to persuade me that because of the dictionary definition of the Spanish word PERLA the trade mark was either descriptive or laudatory in relation to the goods covered by the applicants specifications and therefore failed to meet the requirements of Section 9(1)(c) and (d). In that respect I accept that the Trade Marks Registry does not accept as invented words the foreign equivalent of English words, where the language concerned, as in this case, is reasonably well known. And though it could be argued that LAPERLA is somehow different to the two words LA PERLA I must have regard to the aural use of the trade mark which to a reasonable number of Spanish speakers in the United Kingdom would convey a meaning to the listener of something precious or bright etc. Thus the trade mark does not meet the requirement of Section 9(1)(c).

30 Is the mark therefore one which is acceptable under 9(1)(d)? Ms Bonella referred to her client's registered trade marks as having a disclaimer of the word "Pearl" attached to them which suggested that the word was considered either descriptive or non-distinctive by the Trade Marks Registry. However, I am unable to give that fact much weight, not least because the goods covered by the opponent registrations and those of the applicants are not the same. Mr Birss suggested that the word pearl could be a descriptive term in relation to soap and thus the need for a disclaimer of the term in the trade mark CUSSONS PEARL. I must, however, reach my own view.

40 Taking account of the dictionary definition of the word PERLA and the goods of the specification of application no. 1330686, I do not regard the word LAPERLA as one which is apt for use in association with perfume and therefore not one which either describes the applicants goods or refers to any quality of them. The way in which the word PERLA is presented within the trade mark, even if it was considered to be lacking somewhat in distinctiveness, ensures that the word LAPERLA would be seen and acknowledged as a badge of origin. The opposition based upon Section 9 of the Act fails accordingly.

45 I turn to the objections to all the trade marks based upon Section 10. In considering these I turn to the comments of Mr Justice LLOYD Jacob in Torq Set (1959) RPC 344 at page 346.

“Part B of the Register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders.”

5 Having considered each of the trade marks in turn I reach the view that, taking my findings
above into account, each of them meets the criteria for registration in Part B. First of all, I
have no evidence that anyone would see these terms as anything other than as a trade mark
and no evidence has been presented to show that registration of these trade marks would
embarrass other traders. The term LA PERLA, or indeed the word PERLA, is not one, in my
10 view, which others might need nor is any trader likely to stumble into using it. In my view, the
term LA PERLA presented as one word, or two, or with a device, is not likely to convey to
the buying public anything other than a badge of trade origin. . In the circumstances the
opposition under Section 10 fails accordingly.

15 I go on to consider the grounds of opposition based upon Section 11 and Section 12(1) of the
Act. These read:

20 **11.** It shall not be lawful to register as a trade mark or part of a trade mark any
matter the use of which would, by reason of its being likely to deceive or cause
confusion or otherwise, be disentitled to protection in a court of justice, or would be
contrary to law or morality, or any scandalous design.

25 **12. (1)** Subject to the provisions of subsection (2) of this section, no trade mark shall
be registered in respect of any goods or description of goods that is identical with or
nearly resembles a mark belonging to a different proprietor and already on the register
in respect of:-

- (a) the same goods
- 30 (b) the same description of goods, or
- (c) services or a description of services which are associated with those
goods or goods of that description.

35 The reference in Section 12 to a near resemblance is clarified by Section 68 (2B) of the Act
which says that references in the Act to a near resemblance of marks are references to a
resemblance so near as to be likely to deceive or cause confusion.

40 The established tests for objections under these provisions are set down in SMITH HAYDEN
& Cos application (Volume 1946 63 RPC 101) later adapted in the case of Section 11 by Lord
Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand these tests
may be expressed as follows:

- 45 1. (under Section 11) Having regard to the user of the trade mark CUSSONS
PEARL is the tribunal satisfied that the trade marks applied for LAPERLA, LA
PERLA and LA PERLA & device, if used in a normal and fair manner in

connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of person?

5 2. (under Section 12) assuming user by the opponents of their trade mark
CUSSONS PEARL in a normal and fair manner for any of the goods covered
by the registration of that trade mark, is the tribunal satisfied that there will be
no reasonable likelihood of deception amongst a substantial number of persons
10 if the applicants use their trade marks LAPERLA, LA PERLA, and LA PERLA
and device, normally and fairly in respect of any goods covered by the proposed
registration.

15 Taking the Section 12(1) ground first I consider the well established guidelines for the
comparison of trade marks laid down by Parker J in Pianotist Co's application (1906) 23 RPC
774 at page 777 line 26 et seq:

20 “You must take the two words. You must judge of them, both by their look and by
their sound. You must consider the goods to which they are to be applied. You must
consider the nature and kind of customer who would be likely to buy those goods. In
fact, you must consider all the surrounding circumstances; and you must further
25 consider what is likely to happen if each of those trade marks is used in a normal way as
a trade mark for the goods of the respective owners of the marks. If, considering all
those circumstances, you come to the conclusion that there will be a confusion - that is
to say, not necessarily that one man will be injured and the other will gain illicit benefit,
but that there will be a confusion in the mind of the public which will lead to confusion
in the goods - then you may refuse the registration, or rather you must refuse the
30 registration in that case.”

35 Visually and aurally the respective trade marks of the opponents are different. There are no
common elements and the "English" nature of the opponents' trade mark contrasts significantly
with the "Spanish" nature of the applicants trade marks. And as I have already held that the
applicants trade marks are not likely to convey a direct meaning to the purchasing public I do
not think that any customer would have any difficulty in distinguishing goods sold under the
opponents' trade mark from those sold under the applicants' trade marks. Therefore normal
40 and fair use of the respective trade marks of the opponents and the applicants is not likely to
cause deception amongst a substantial number of persons. In reaching this view I take the view
that the applicants and opponents goods as set out in the respective specifications are goods of
the same description. It is commonplace for perfume manufacturers to produce (usually for
sale in gift packs) soaps, shower gel deodorant and talcum powder, scented with a particular
45 fragrance or scent. Therefore the respective goods are likely to be produced and sold by the
same traders, go through the same channels and bought by the same customers. However, as I
do not regard the respective trade marks to be confusingly similar the grounds of opposition
based upon Section 12(1) are dismissed.

50 Insofar as Section 11 is concerned I see no reason for a different finding from that under
Section 12(1). It was submitted that because of the strength of the opponents' house mark
(CUSSONS) the comparison should be PEARL against LA PERLA. I disagree. All of the

evidence of use shown by the opponents shows use of the trade mark CUSSONS PEARL and although on some products and promotional material the word PEARL is predominant there is no doubt that the two words are used together. Therefore as I have already held that the trade marks are not confusingly I similar consider that the use by the applicants of their trade marks, LAPERLA, LA PERLA and LA PERLA and device, having regard to the user of the opponents trade mark CUSSONS PEARL, is not likely to cause deception and confusion amongst a substantial number of persons.

There remains the matter of the Registrars discretion. However, the effects of Sections 11 & 12 are mandatory and therefore no exercise of discretion is possible.

The opponent having failed on all of their grounds of opposition in respect of all three applications are ordered to pay to the applicants the sum of £12000.

Dated this 28 day of May 1999

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**M KNIGHT
Principal Hearing Officer
For the Registrar
the Comptroller General**

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TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION Nos 1330686/1294891
AND 1326391 IN THE NAME OF DALMAS S.p.A**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER Nos 34458,
34448 AND 34447 BY CUSSONS (UK) LTD
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**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application Nos 1330686/1294891
and 1326391 in the name of Dalmas S.p.A**

and

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**IN THE MATTER OF Opposition thereto under Nos 34458,
34448 and 34447 by Cussons (UK) Ltd and
Cussons (International) Ltd**

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SUPPLEMENTARY DECISION

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My written decision in these proceedings, dated 28 May 1999, contained a clerical error. It has been brought to my attention that the cost figure I awarded was incorrect. The necessary power to correct this is provided I believe by Order 20 Rule 11 of the Rules of the Supreme Court which states:

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"Clerical mistakes in judgments or orders, or errors arising therein from any accidental slip or omission, may at any time be corrected by the Court on motion or summons without an appeal."

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I therefore correct the final paragraph of my written decision in these proceedings to read as follows:

"The Opponent having failed on all of their grounds of opposition in respect of all three applications are ordered to pay to the applicants the sum of £1200."

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Dated this 7th day of June 1999

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M KNIGHT
For the Registrar
the Comptroller General