

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 2052536
BY ARCOR S.A.I.C.
TO REGISTER THE TRADE MARK
MENTHO PLUS ARCOR

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION **m** 45989 BY
VAN MELLE NEDERLAND B.V.

TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application m 2052536 by Arcor S.A.I.C.

and

5 IN THE MATTER of opposition
thereto under opposition m 45989 by
Van Melle Nederland B.V.

DECISION

10 Arcor S.A.I.C. applied on 19 Jan 1996 to register the trade mark MENTHO PLUS ARCOR in
class 30. Following examination, the application was advertised for opposition purposes for
the following goods:

“Confectionery, candy, chewing gum, lollipops, pastry, drops, chocolates, nougats,
bonbons, sweets, peanuts mixed or covered in chocolate; preparations for making
desserts and ice-cream; ice-cream..”

15 The application is opposed by Van Melle Nederland B.V.. Their grounds of opposition are:

Ž Section 5(2), in that the opponents have registered marks for similar goods such
that there exists a likelihood of confusion on the part of the public by association
with these earlier marks.

20 Ž Section 3(2) - Insofar the mark applied for is of such a nature as to deceive the
public.

The opponents have registered the following marks:

	MARK	m.	CLASS	GOODS
25	MENTOS VAN MELLE MINTS and device	882739	30	Non-medicated confectionery, all being mint flavoured.
	MENTOS (word)	976964	30	Bread, biscuits (other than biscuits for animals), cakes, pastry and non-medicated confectionery.

30 In response, the applicant filed a counterstatement admitting the existence of the opponent's
prior registration, but denying each of the grounds pleaded.

Both parties ask for an award of costs in their favour.

Neither party has requested a hearing; accepting instead that the Registrar should make his decision on the basis of the submitted, written evidence. Acting on the Registrar's behalf and after a careful study of all the papers, I now give this decision.

5 The Evidence

The opponents' evidence takes the form of a Statutory Declaration dated 25 June 1997 by Petronella De Groot-van Amelsvoort, who is the 'Trade mark Registration Manager' of Van Melle Nederland B.V., the opponents in these proceedings.

10 Ms De Groot-van Amelsvoort explains that her company is the registered proprietor in the UK of trade marks MENTOS VAN MELLE MINTS and device registered on 5 August 1965, and MENTOS (word) registered on 18 June 1971. She states that her Company has sold MENTOS sweets (mints and fruit flavours) continuously in the UK since 1955.

She gives the following sales figures for MENTOS confectionery:

Year	Approximate Quantities Sold (Tons)	Approximate Sales Value (£ Sterling)
15 1993	224	457,274
1994	233	419,252
1995	102	207,898
1996	91	190,404
1997	100	247,452

20 Ms De Groot-van Amelsvoort refers to two samples of confectionery product produced by Van Melle Nederland B.V. and provided in evidence. These consist of a tube of 14 mints labelled 'mentos' followed by the word 'mint'. Though the latter is in the same font, bounded in red and at an angle to the former, it is smaller in size and the word 'mentos' stands out as the most eye-catching aspect of the packaging. 'mentos' is in 1cm high lower case, dark blue and extends along 3/4's of the length of the tube, appearing 3 times around its external surface.
25 Both words are against a light blue and white background.

The other example provided has an identical design, but is described as containing 'chewy fruit flavoured sweets', with the word 'frukt' (in green, and bounded by white) replacing 'mint'. If anything, 'mentos' is more eye catching against the orange, red and yellow background the
30 packaging takes in this example.

Also provided in evidence are six invoices produced by Melle Export B.V., indicating sales of 'mentos' fruit and 'mentos' mints from 19 January 1995 to 20 February 1997 to the same

customer in the UK. The value of sales these invoices indicate for mentos confectionery is approximately £110, 000.

5 The applicant's evidence consists of a statutory declaration by Mahomed Hussein Daud, of the Trade Mark Owners Association, who are acting on behalf of Arcor S.A.I.C.. Mr Daud lists registrations that Arcor S.A.I.C. have for MENTHO PLUS, MENTHO PLUS ARCOR, MENTO PLUS or MENTO PLUS ARCOR in Algeria, Argentina, Australia, Benelux, Brazil, China, Dominican Republic, Ecuador, Germany, Israel, Jordan, Lebanon, Mexico, Panama, Paraguay, Peru, Portugal, Puerto Rico, Spain, Taiwan and Uruguay. Notarised and legalised
10 copies of certificates (with the exception of Brazil, where a simple photocopy has been provided) are included in evidence. The registrations extend back almost 10 years, but many are recent, with over half post-dating the UK application.

15 Mr Daud also refers to advice from his instructing principals, Arcor S.A.I.C., that van Melle Nederland B.V. have registrations for MENTOS and MENTOS plus device in Argentina, Brazil, Chile, Colombia, Ecuador, Paraguay, Peru and Uruguay. These appear to co-exist with those of the applicants, that is, MENTHO PLUS, MENTHO PLUS ARCOR, MENTO PLUS or MENTO PLUS ARCOR. Mr Daud's principals confirm that this is reflected in the marketplace, though no evidence is supplied to support this.

20 Mr Daud also refers to examples of packaging material and advertising for the sale of MENTHO PLUS in Latin American countries. This product is presented in rectangular tube, 9 cm in length, in a range of flavours, including cherry, honey, mint, lemon and lime. The background colouring reflects the flavour, but 'mentho plus' is in white, italicised, in lowercase, and clearly the main distinguishing feature.

25 Also provided in evidence is packaging from a number of products purchased in the UK. These include HALLS MENTHO-LYPTUS ORIGINAL, HALLS MENTHO-LYPTUS BLACKCURRANT, MENTOS MINT, MINTIES, NUTTALL'S MINTOES and MURRAY MINTS. The shape, size and colouring of these products differ significantly (the Nuttall's Mintoes come in a bag). Mr Daud states that a number of products contain the prefix 'MENT' or 'MENTHO'. He concludes that the MENTOS product co-exists with these products, and thus would be able to co-exist with his clients product.

30 The results of a search of the Marquesa Database for the prefixes MENTHO, MENTO or MINT is also provided in the applicant evidence:

	MARK	NO
	MENTHO-LYPTUS	527479
	HALLS MENTHO-LYPTUS & Device	875432
35	HALLS MENTHOMINT	958143
	NUTTALL'S MINTOES	561858
	NUTTALL'S MINTOES	903724
	NUTTALL'S MINI-MINTOES	903726

	MURRAYMINTS	634408
	MURRAYMINTS & Device	717276
	MURRAYMINTS	718862
	MURRAY FRESHMINTS	1211549
5	MURRAY BUTTER MINTS & Device	1231549
	MINITES	2015686

Mr Daud notes that these co-exist with trade marks MENTOS VAN MELLE MINTS (m 882739) and device and MENTOS (word) (m 976964). Details of the above registrations are produced as evidence.

10 Finally, Mr Daud says that the term MENTHO, which is the combining form for menthol (Webster's Third New International and Dictionary), should be regarded as common and descriptive.

That concludes my review of the evidence, and I turn to consider the respective grounds upon which this opposition has been brought. These are stated above, and repeated here:

15 Ž Section 5(2), in that the opponents have registered marks for similar goods such that there exists a likelihood of confusion on the part of the public by association with these earlier marks.

 Ž Section 3(2) - Insofar the mark applied for is of such a nature as to deceive the public.

20 Taking the second ground cited first, Section 3(2) in the 1994 Act is as follows:

 ‘(2) A sign shall not be registered as a trade mark if it consists exclusively of !
 (a) the shape which results from the nature of the goods themselves,
 (b) the shape of goods which is necessary to obtain a technical result,
 or
25 (c) the shape which gives substantial value to the goods.’

It is a puzzle as to why this section is cited. It is intended to prohibit the use of shapes intrinsic to the goods for which a trade mark is sought, or which serve a utilitarian purpose, or which contribute significantly to the value of those goods. As the signs under question are word marks, section 3(2) is irrelevant. It may have been the intention of the opponent to cite
30 section 3(3)(b) of the Act:

 ‘(3) A sign shall not be registered as a trade mark if it is !
 (a)
 (b) of such a nature as to deceive the public..’,

35 part of which is quoted in their Statement of Grounds. Assuming this, objection on this ground seems to me very weak. The absolute grounds objection of 3(3)(b) means there must

be some inherent characteristic of the mark that would deceive. Examples given relate to the nature, quality or geographical origin of the goods. There is nothing in the proposed trade marks that suggest deception on the basis of these examples - or for anything else for that matter - and I thus dismiss the objection relating to this ground without further consideration.

5 Returning to the first ground, section 5(2) of the Act reads:

‘(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,

10 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.’

As stated previously, the applicants wish to register their trade mark for the following goods in class 30:

15 “Confectionery, candy, chewing gum, lollipops, pastry, drops, chocolates, nougats, bonbons, sweets, peanuts mixed or covered in chocolate; preparations for making desserts and ice-cream; ice-cream..”

The opponent’s mark MENTOS VAN MELLE MINTS & device is also registered in class 30, in respect of ‘Non-medicated confectionery, all being mint flavoured’. MENTOS, again registered in class 30, has a wider specification, but also includes non-medicated confectionery. Bearing in mind the overlap with the goods specified in the application, I conclude that the goods in question can be considered identical. I will return to the issue of similarity of the marks under section 5(2) after considering the significance of the evidence submitted, and summarised above.

25 The opponent’s evidence does three things: notes the presence of earlier trade marks MENTOS VAN MELLE MINTS & device and MENTOS on the Register, shows that there are some sales of products incorporating the MENTOS trade mark in the UK (thus establishing a reputation for the trade mark ‘MENTOS’) and, finally, provides examples of the products sold.

30 The applicants evidence shows that there are registrations in 21 countries for at least one of the marks MENTHO PLUS ARCOR, MENTO PLUS, MENTO PLUS ARCOR or MENTOPLUS. Eight South American countries have registrations for the opponents marks MENTOS or MENTOS & device and the statement is made that products using both the latter and former marks share these market places without confusion. However, this conclusion is weakened by a lack of evidence on sales of the respective products. I can, anyhow, give little weight to this evidence since I have no means of knowing the trading or trade mark environment in which the two companies operate in the countries concerned.

40 Turning to the situation in the UK, Mr Daud’s claim that a number of products contain the prefixes MENT or MENTHO rather overstates the case. Only 3 products of this type are identified in evidence as currently sharing the market place: one of these is the opponents and the other two are two flavours of the same brand from the same manufacturer. However, it is

clear that 'MENTHO' is used on products other than the applicants, as in MENTHO-LYPTUS.

I am not convinced of the relevance of the references to the use of 'MINT' as a prefix or otherwise. This is clearly a descriptive word, well recognised by consumers, who will accept that products so labelled have a certain taste and, in my view, are unlikely to confuse the prefixes MENT or MENTHO with the prefix MINT, even when the trade marks have very similar spelling, as in MINTOES and MENTOS. I therefore find the argument unconvincing that the co-existence on the marketplace of products using marks incorporating 'MINT', side by side with those using MENTOS, should present no objection to the addition of products bearing the applicant's mark. Other examples cited are so different from the marks under discussion as to be irrelevant to the issues surrounding confusion (MURRAYMINTS, for example) under section 5(2).

Returning to consideration of the grounds under this section, as the goods in respect of which the application is made are identical with the goods covered by the opponent's prior registrations, the matter to be decided is whether or not the marks MENTOS and MENTHO PLUS ARCOR are similar such that there is a likelihood of confusion. (In making the comparison, I have not considered the opponent's earlier mark MENTOS VAN MELLE MINTS (& device) since it is clear to me that the position in relation to this mark cannot be any more favourable to the opponent than the position in relation to their later MENTOS mark). In deciding the question of similarity I take account of the guidance set down by Parker J in *Pianotist* (1906) 23 RPC 777, which reads as follows:

"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 consider what is likely to happen if each of these 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 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 registration in that case."

And also that provided by the ECJ in *Puma v Sabel* C251/95:

'The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components'

Comparing the marks at issue as wholes, I do not think there is any likelihood of direct visual confusion between MENTOS and MENTHO PLUS ARCOR. The obvious difference is that one mark consists of one word, and the other of three. However, the advice given by the ECJ requires cognisance of the distinctive and dominant components in the marks and it may be argued that the word MENTHO is the 'distinguishing and essential' feature (SAVILLE PERFUMERY (1941) RPC 58, page 162) of the applicant's mark. As a consequence, its

similarity to MENTOS is significant. I do not believe that this argument carries much force in this case. In considering the overall impression created by the applicant's mark the presence of the word PLUS together with ARCOR shifts the emphasis of the mark, both visually and verbally. I therefore conclude that the marks are not similar and, even allowing for imperfect
5 recollection and the low cost of these types of good, I do not think there is any real risk of confusion between the two sets of marks.

Also of relevance to this subject is whether the prefixes MENTO or MENTHO can be regarded as descriptive, as claimed by Mr Daud. Are MENTO or MENTHO names which, in the words of Templeman J (McCAIN OVEN CHIPS (1981) RPC 5, pages 72 and 73) are
10 'apt and appropriate to describe a produce rather than a manufacturer..'? That is, do they '...not indicate the source of the goods, but the nature of the goods.'? If so, the public would recognise that the respective prefixes have a descriptive meaning and would therefore not find the marks MENTHO and MENTOS confusingly similar.

I incline toward the view that the prefix MENTHO may be regarded as descriptive in that it
15 may be seen by some to refer to the presence of menthol in certain consumer products. I am aware that this substance has been typically used in a range of products, including sweets, but also cigarettes, shaving creams and lotions. An example is provided by the use of MENTHO in MENTHO-LYPTUS where the prefix MENTHO is used in the same manner to MINT (for
20 example in 'MINTOES', and 'MINTIES') to indicate a characteristic of the product to be purchased.

Finally, I believe it would be undesirable to prevent the applicant from incorporating a descriptive element such as MENTHO within a mark because it may be argued it is similar to MENTOS. This appears analogous to the Registrar's decision in ANCHOLA V
25 ANCHOVETTE (1916) RPC 1, where the prefix ANCHO was a clear code for anchovies. Thus the grounds under section 5(2) also fail, and the opponents are unsuccessful in their opposition to this application.

The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay to the applicant the sum of **£435**.

30 **Dated this 17th day of July 1998**

Dr W J Trott
Principal Hearing Officer
For the Registrar, the Comptroller-General