

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1456524
BY TAXOR COSMETIC AG
(FORMERLY TAXOR GESCHENKARTIKEL PRODUKTIONS-UND
HANDELS GMBH)**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 42323
BY PACO RABANNE PARFUMS**

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

5 **IN THE MATTER OF APPLICATION NO. 1456524
BY TAXOR COSMETIC AG
(FORMERLY TAXOR GESCHENKARTIKEL PRODUKTIONS-UND
HANDELS GMBH)**

10 **AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 42323
BY PACO RABANNE PARFUMS**

15 **BACKGROUND**

20 On 25 February 1991 Taxor Cosmetic AG (formerly Taxor Geschenkartikel Produktions-und Handels GmbH) of Berlin Germany applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark **CALINDA** in respect of a specification which, after amendments, reads:-

25 Soap, perfumery, eau de cologne; cosmetic creams, balms, tinctures; cosmetic preparations for bathing; shampoos; hair lotion; ethereal essential oils; cosmetic preparations for use in sun-tanning; preparations for application to the skin to facilitate shaving; all included in Class 3.

On 18 April 1995 Paco Rabanne Parfums filed notice of opposition against the application.

30 In summary the grounds of opposition are:-

- 35 (1) Under Section 12 of the 1938 Act and Section 5 of the 1994 Act because the trade mark in suit is confusingly similar to trade mark registration no. 937830 in respect of the trade mark **CALANDRE**.
- (2) Under Section 11 of the 1938 Act and Section 5 of the 1994 Act because confusion would arise owing to the use by the opponents of the trade mark **CALANDRE**.

The applicants filed a counterstatement denying the grounds of opposition.

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

Both parties filed evidence but neither party has sought to be heard and, therefore, after a careful study of the papers I give this decision.

45 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994.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.

5 **OPPONENTS' EVIDENCE.**

10 This consists of a declaration executed by Jaques Jorand on 7 May 1996. M Jorand is the General Director of the opponents. He has a good knowledge of the English language. M Jorand has been associated with the opponents for twenty years and his declaration is made from his own personal knowledge or from information obtained from the records of the opponents, to which he has full access.

15 M Jorand states that the opponents are the registered proprietors of the registered trade mark no. 937830 for the trade mark **CALANDRE** in Class 3 in respect of perfumes, non-medicated toilet preparations, cosmetic preparations, dentifrices, depilatory preparations, toilet articles included in Class 3, sachets for use in waving the hair, shampoos, soaps and essential oils. M Jorand declares that the trade mark is used in the United Kingdom in respect of the goods for which it is registered. He exhibits as JJ2 a selection of cartons and photographs of goods bearing the trade mark **CALANDRE**.

20 M Jorand declares that the opponents have used the trade mark **CALANDRE** since at least 1975 and that total sales for the years 1975 to 1995 inclusive have been in the region of £6,149,620, being an average of £292,800 per annum at retail values. M Jorand states that, taking into account the nature of the goods, this represents a large number of sales.

25 M Jorand exhibits copies of a selection of recent price lists and invoices. However, these all relate to periods after the relevant date, i.e. the date of the filing of the application, and therefore can have no bearing upon my decision.

30 M Jorand declares that the expenditure on publicity relating to goods sold under the trade mark **CALANDRE** is as follows:

YEAR	£
1982	29,000
1983	30,000
1984	35,000
1985	35,000
1986	37,000
1987	40,000
1988	72,000
1989	81,000

1990	40,000
1991	30,000
1992	35,000
1993	30,000
5 1994	30,000
1995	60,000

10 M Jorand goes on to state that goods bearing the trade mark **CALANDRE** have been sold throughout the United Kingdom and inter alia in the following towns: Belfast, Birmingham, Bournemouth, Brighton, Bristol, Cambridge, Canterbury, Cardiff, Darlington, Edinburgh, Glasgow, Guildford, High Wycombe, Leeds, Leicester, Liverpool, London, Manchester, Newcastle, Nottingham, Oxford, Plymouth, Reading, Sheffield, Southampton, Swindon and
15 Windsor.

M Jorand concludes his declaration by making comments as to the likelihood of confusion between the trade mark **CALANDRE** and the trade mark **CALINDA**.

20 **APPLICANTS' EVIDENCE**

This consists of a declaration executed by Wolfgang Reichow on 26 June 1997. Herr Reichow is Chairman of the Board of the applicants. He has knowledge of the English Language. His
25 declaration is made from his own personal knowledge or from information obtained from the records of the applicants, to which he has access.

Herr Reichow exhibits example of how the applicants use the trade mark **CALINDA**. He states that the applicants are the proprietors of the trade mark **CALINDA** in respect of goods in Class
30 3 in various other jurisdictions. He goes on to give details of the registrations.

Herr Reichow refers to an opposition action in relation to the trade mark **CALINDA** between the same parties in the instant case in Sweden. He exhibits as WR3 documents which he states show
35 that the Swedish Trade Mark Court found no likelihood of confusion.

Herr Reichow concludes his evidence by making comments as to the lack of likelihood of confusion between the trade mark **CALANDRE** and the trade mark **CALINDA**.

40 **OPPONENTS' EVIDENCE IN REPLY**

This consists of a further declaration by Jaques Jorand, executed on 5 January 1998.

M Jorand states that the advertisements exhibited by Herr Reichow as WR1 are in German and that the applicants have filed no evidence of use of the trade mark in suit in the United Kingdom. M Jorand declares that the certificates of registration exhibited by Herr Reichow as WR2 do not have a bearing on a trade mark conflict in the United Kingdom.

5

M Jorand states that the documents exhibited by Herr Reichow as WR3 do not show what the decision in Sweden in relation to the conflict between **CALINDA** and **CALANDRE** was.

10

Finally M Jorand again comments on the likelihood of confusion between the respective trade marks.

DECISION

15

The grounds of opposition refer to both grounds under the 1938 and 1994 Acts. In accordance with the transitional provisions set out in Schedule 3 to the 1994 Act I must continue to apply the relevant provisions of the old law to these proceedings. Therefore the grounds based on the 1994 Act are dismissed.

20

The opposition is based on Sections 11 and 12 of the Act which read:

25

“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.

30

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:-

35

- (a) the same goods
- (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.”

40

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states 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.

45

The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd’s 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:-

(Under Section 11) Having regard to the user of the mark **CALANDRE**, is the tribunal

satisfied that the mark applied for CALINDA, 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 persons?

5 **(Under Section 12)** Assuming user by the opponents of their mark CALANDRE in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark CALINDA, normally and fairly in respect of any goods covered by their proposed registration.

10 I turn to the grounds of opposition under Section 12 first. There has been no argument advanced that the same goods or goods of the same description are not involved in relation to the respective specifications of registration no. 937830 and the application in suit. It is clear that the same goods or goods of the same description are involved. I, therefore, need to consider whether the trade mark CALANDRE is confusingly similar to the trade mark in suit. In doing so I take account of the guidance set down by Parker J in Pianotist Companies application (1906) 23 RPC 777 at line 15 26 et seq, which reads as follows:

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 these goods. In fact, you must consider all the surrounding circumstances; and you must further 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, 25 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 registration.”

30 Each party has argued the opposite position in relation to the likelihood of confusion, which is to be expected. The applicants have placed weight on the fact that they have registrations outside the United Kingdom and that they declare that the Swedish Trade Mark Court found no likelihood of confusion between the respective trade marks. The position outside the United Kingdom does 35 not influence me, I have no knowledge as to the nature of the markets and whether there are or have been any conflicts. In relation to the Swedish case I do not have a copy of the decision before me. I do not know what evidence was put before the Swedish Trade Mark Court, and what the full judgement was. Even if I did it would not be likely to affect my decision. In relation to issues of confusion each jurisdiction will be different, taking into account linguistic and cultural differences; also there are likely to be differences in the way the markets for the goods operate. 40 When considering the likelihood of confusion I must do so on the basis of the likelihood of confusion in the minds of the public in the United Kingdom.

45 I have also noted the comments in the evidence of the parties in relation to the danger of confusion. However, the decision as to whether there is a likelihood of confusion is a jury question. (Although in certain cases the opinions of expert witnesses will have a bearing upon the matter - see TATTINGER S.A. v. ALLBEV LTD (1993) FSR 641 at page 663.)

Both trade marks consist of three syllables, in each case the last syllable is likely to trail off in oral usage. The first two syllables of the respective trade marks only vary in relation to the second vowel. It is well established that the beginnings of words are more important when considering confusion than the ends - see the following extract from TRIPCASTROID 42 RPC 264 at page 279 lines 33 to 40:

“The termination of the new word is different. Though I agree that, if it were the only difference, having regard to the way in which the English language is often slurred at the termination of words, that might not alone be sufficient distinction. But the tendency of persons using the English language to slur the termination of words also has the effect necessarily that the beginning of words is accentuated in comparison, and in my judgement, the first syllable of a word is, as a rule, far the most important for the purpose of distinction.”

Taking into account normal usage of the trade marks, which must include oral use, I consider that there is a likelihood of confusion. I also consider that the two trade marks are so similar that there would be a danger of confusion in relation to written use. The risk of confusion is increased as both words are not English words and would be seen as invented words, so the public would have no meaning upon which to “hook” their perception. I cannot take into account whether the particular goods of the respective parties are of high cost or not. As I am simply comparing the specifications I must accept that the goods therein could be of very low cost, “bags of sweets” in the usual terminology. It cannot therefore be presumed that the purchase of the goods will be based on an educated and informed knowledge of the goods. However, even if it was, I find that the respective trade mark are so similar that there would still be a likelihood of confusion. (On a subjective level, but one that is indicative, whilst writing this decision I found that I had to return regularly to the papers in order to avoid confusing and juxtaposing the respective trade marks.)

I, therefore, find that registration of the trade mark in suit would be contrary to Section 12(1) of the Act.

I turn now to the grounds of objection under Section 11 of the Act.

Before Section 11 can be applied it must be established that the trade mark which is being relied upon is known to a substantial number of persons in the United Kingdom (NOVA (1968) RPC 357 at 360.) The opponents have shown use of the trade mark CALANDRE since 1975, this use has been constant and across the United Kingdom. The turnover figures and the publicity expenditure are not particularly large in the context of the potential market for the goods, however, combined with the length of use they establish that a substantial number of people would know the trade mark CALANDRE.

The issues relating to the likelihood of confusion have been dealt with above in relation to Section 12 and so there is no necessity to rehearse them here. The opponents have claimed that they have used the trade mark in respect of all the goods for which it is registered. This has not been supported with exhibits; specifically not with exhibits that can be identified as relating to a period prior to the relevant date. However, the applicants have not challenged the validity of the claim and so I accept it. Consequent upon this I consider that there is a likelihood of confusion and

deception with the trade mark of the opponents if the applicants use the trade mark in suit in relation to any of the goods in relation to which registration is sought.

5 I, therefore, find that the registration of the trade mark in suit would be contrary to Section 11 of the Act.

I turn now to the issue of the Registrar's discretion. As the findings under Sections 11 and 12 are mandatory it is not appropriate to exercise discretion in this case.

10 The opponents having succeeded in these proceedings I order the applicants to pay them the sum of £735 towards their costs.

Dated this 18 day of June 1999

15

20

**DW Landau
For the Registrar
The Comptroller General**