

O-173-04

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2290335  
BY KIWI EUROPEAN HOLDINGS BV  
TO REGISTER A TRADE MARK IN CLASSES 3 AND 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 91431  
BY RECKITT BENCKISER (UK) LIMITED**

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**IN THE MATTER OF Application No. 2290335  
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**IN THE MATTER OF Opposition thereto under  
No. 91431 by Reckitt Benckiser (UK) Limited**

### **BACKGROUND**

1. On 17 January 2002 Kiwi European Holdings BV applied to register the trade mark DUOFRESH in Classes 3 and 5 of the register for the following specification of goods:

**Class 03:**

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, degreasing and abrasive preparations, all not being for use in oral hygiene; soaps; none of the aforesaid goods being for personal use.

**Class 05:**

Air freshening preparations, air deodorising preparations and deodorants not for personal use; preparations to neutralise bad odours.

2. The application was accepted by the Registrar and published in the Trade Marks Journal.

3. On 22 January 2003 Reckitt Benckiser (UK) Ltd filed Notice of Opposition against the application. In summary the grounds of opposition were:

- (i) Under Section 3(1)(b), or alternatively Section 3(1)(c) or Section 3(1)(d) of the Act because the applicant's mark consists of an expression DUOFRESH which is descriptive of a relevant characteristic of the relevant goods, or is an expression which may serve in trade to designate a relevant characteristic of the applicant's goods;
- (ii) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade mark owned by the opponent and is to be registered for the same and similar goods and there exists a likelihood of confusion in the part of the public –

<b>REGISTRATION No.</b>	<b>MARK</b>	<b>DATE REGISTRATION EFFECTIVE</b>	<b>SPECIFICATION OF GOODS</b>
1217406	BLEACHMATIC DUO	25 April 1984 (REVOKED)	Cleaning preparations; detergents containing bleach, and bleaching preparations, all for cleaning purposes; all for use in lavatories; all for sale in United Kingdom and for export to the Republic of Ireland.

4. The applicant filed a Counterstatement denying the grounds of opposition. Both sides filed evidence and asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing and the opponent forwarded written submissions for the Hearing Officer's attention.

### **Opponent's Evidence**

5. This consists of a witness statement by Benjamin Alexander Ramage dated 22 August 2003. Mr Ramage is a partner in Alexander Ramage Associates, the opponent's professional advisors in these proceedings.

6. Mr Ramage refers to the following Exhibits attached to his statement.

- (i) Exhibit BAR 1 – a copy of a print out giving details of Trade Mark Number 1217406 prepared from the Trade Marks Registry Trade Marks Enquiry Service.
- (ii) Exhibit BAR 2 – photocopies taken from pages 765, 1026 and 1027 of the New Shorter Oxford English Dictionary (1993 Edition) which include the following references –
  - (a) DUO – comb.form. “Prefixed to other L. roots to form composite numerals (duodemical), and irreg. used w. other words as equivalent to B1 – or D1 (duopoly, duotone);”
  - (b) FRESH – “not stale, musty or faded” and “pure, untainted, cool, refreshing, invigorating”.
- (iii) Exhibit BAR 3 – print outs of the first five screens of hits against the word FRESH restricted to the United Kingdom and results in English, using the ALTA VISTA search engine.
- (iv) Exhibit BAR 4 – contains print outs of the first five screens of hits against the word FRESH linked with any of the words “cleaning, freshening”, or “deodorising”, restricted to results in English in the United Kingdom, using the ALTA VISTA search engine.

## **Applicant's Evidence**

7. This consists of a witness statement by Jane More O'Ferrall dated 19 December 2003. Ms O'Ferrall is a partner in Haseltine Lake, the applicant's professional advisors in these proceedings.

8. Ms O'Ferrall refers to the following Exhibits which are attached to her statement –

- (i) Exhibit JMOF 1 – which is a print taken from the UK Trade Marks Registry database, of all trade marks commencing with DUO in force in the UK (including Community Trade Marks).
- (ii) Exhibit JMOF 2 – which is the printed result of a search run on the GOOGLE search engine against DUOFRESH. This search was not restricted as to geographical coverage.

9. In relation to Exhibit JMOF 1, Ms O'Ferrall points out that many trade marks consisting of DUO and a following word or element, have been accepted for registration. She draws attention to the mark DUOFRESH, No 1529131 in Class 3 which is registered for “Moisturising gels and creams, all for use in the bath and shower; bath salts, bath oils; all included in Class 3”.

10. Turning to Exhibit JMOF 2, the English language hits refer to a DuoFresh toilet cleaner from the Mintel International Group.

## **Opponent's Submissions**

11. The opponent's submissions are contained in a letter dated 26 March 2004 from Mr B A Ramage of Alexander Ramage Associates.

12. In relation to the Section 3 objections, Mr Ramage states that the opponent's case may be summarised by saying that because DUO is a combining form, that it is equivalent of BI- or DI- meaning “two” and FRESH is a descriptive word with an obvious meaning. Consequently, the expression DUOFRESH is one that may serve to designate a relevant characteristic of the goods and, as such, is devoid of distinctive character or, alternatively, is customary in the current language and is apt for use as a descriptive expression.

13. On the Section 3(1)(c) ground, Mr Ramage refers to DOUBLEMINT (ECJ Case C-191-01p) and he states that this confirms that it is not necessary, at the time of application for registration, that the sign actually be in use in a descriptive manner. He adds that the issue in question is whether the expression is capable of being used by other economic operators to designate a characteristic of their goods and services. Turning to the DUOFRESH mark, Mr Ramage states that if a consumer is unsure whether a “duofresh” cleaner (or air freshener) contains two different methods of freshening or twice the ability to freshen as some other specified standard or as some other unspecified standard, he/she is nonetheless practically certain to apprehend that a characteristic of the product (whether its freshness or ability to freshen) is being designated as in some way doubled as duplicated, even if not literally or precisely so.

14. Turning to Section 3(1)(b) ground, Mr Ramage states that DUOFRESH may serve in trade to designate a relevant characteristic of the goods and consequently, it is devoid of distinctive character as it does not enable the relevant public to distinguish goods of a different commercial origin.

15. Going to Section 3(1)(d), Mr Ramage states that because DUOFRESH may serve in trade to designate a relevant characteristic of the goods, it is a term others may wish to use and so is brought within the ambit of Section 3(1)(d). He adds that Exhibit JMOF 2 to Ms O’Ferrall’s witness statement on behalf of the applicant, shows that the expression “duofresh” is actually in use by other traders.

16. Next, Mr Ramage addresses the Section 5 ground of opposition. He explains that the applicant’s mark DUO was filed on 17 January 2002, published on 20 October 2002 and opposed on 30 January 2003. The opponent’s mark BLEACHMATIC DUO was filed on 25 April 1984 and revoked on application of the present applicant with effect from 14 August 2003. He goes on to draw attention to Section 46(6) of the Act which reads:

“46(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor should be deemed to have ceased to that extent as from

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

17. Mr Ramage concludes that the rights subsisting in the opponent’s mark ceased as of 14 August 2003 and in consequence, the opponent’s mark was an “earlier trade mark” within the meaning of Section 6 of the Act at all material times for the purposes of this opposition.

18. Mr Ramage goes on to make a number of submissions in relation to the similarity of marks and goods. In relation to the Class 5 goods of the application, Mr Ramage states that air freshening preparations, air deodorising preparations and deodorants (not for personal use), or preparations to neutralise bad odours, are likely to originate with those who trade in, or manufacture cleaning preparations generally and more particularly, cleaning preparations for use in lavatories. He adds that air freshening preparations may not be found on directly adjacent supermarket shelves to bleaching preparations, but they are likely to be bought by the same consumer, namely those with an interest in maintaining a certain standard of cleanliness and freshness about the home and, more particularly, in the lavatory; and, accordingly, the risk that the purchaser might believe the goods in question come from the same undertaking or from economically linked undertakings constitutes a likelihood of confusion as mentioned above.

19. Turning to the applicant’s evidence, Mr Ramage states that it is not the Registrar’s practice to take the state of the Register into account and that nothing is known of the circumstances surrounding the acceptance of the marks referred to.

20. This completes my summary of the evidence filed in this case and the opponent's submissions. I now turn to the decision.

## **DECISION**

Section 3(1)

21. The relevant parts of Section 3(1) of the Act read as follows:

“3.-(1) The following shall not be registered -

- (a) .....
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

22. In the present case I must consider whether, on a prima facie basis, the mark in suit meets the requirements of Section 3(1)(b), (c) and (d) of the Act. The proprietor has not submitted nor provided evidence that its mark has acquired a distinctive character as a result of the use made of it.

23. In order to determine whether or not the mark in suit in its totality meets the requirements of Section 3(1) it seems to me that a full and proper approach involves a consideration of the elements comprised in the mark and then, after taking into account the goods and the particular customer for the relevant goods, undertaking a global appreciation as to whether in totality the mark meets the requirements set down in the Act.

24. I firstly consider the Section 3(1)(c) ground. Section 3(1)(c) provides for refusal of registration on the ground that the mark in question is simply descriptive. I take into account the guidance provided in the Judgement of the European Court of Justice in Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc, Rado Uhren* 8 April 2003. In particular, I find paragraphs 63 and 73 to 75 of the Judgement, set out below, to be of considerable assistance:

“63. As regards the first limb of the second question it must be observed that, according to Article 3(1)(c) of the Directive, descriptive trade marks, that is to say, those which consist exclusively of signs or indications which may serve, in trade, to designate the characteristics of the goods or services for which registration is sought, are not to be registered.

73. According to the Court’s case-law, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

75. The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all the relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand .....

25. Recent decisions and opinions of the European Court of Justice make it clear that there remains a public interest in keeping free certain words or combinations of words which others may wish to use.

26. For example the European Court of Justice in Case C191-01 (Office for Harmonisation in the Internal Market (Trade Marks and Designs) (*OHIM*) v *Wm Wrigley Jr* [2003] WL 101985) said:

“31. By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) of Regulation No 40/94 pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all.

That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.”

“32. In order for OHIM to refuse to register a trade mark under Article 7(1)(c) of Regulation No 40/94, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of

goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.”

27. The mark applied for consists of the word DUOFRESH. As the opponents correctly points out, it comprises two elements – the combining form DUO and the obvious dictionary word FRESH.

28. It is submitted by the opponent that the word DUOFRESH, in its totality, could refer to two different means of freshening or to twice the ability to freshen and thus would serve in trade to designate such characteristics. While I accept the opponent’s contention that the word FRESH merely indicates characteristics or qualities of the relevant goods eg cleaning products or air freshening products with a fresh odour and/or freshening effect. I am not convinced that the combining form DUO equates to a perception that the goods possess two means of freshening or twice (double) the ability to freshen. The combining form DUO is, in my view, not a natural or logical alternative to the words “twice” or “double” and it seems to me somewhat artificial and contrived to refer to a product as having a “two fresh”, “two freshening” or a “bi fresh/freshening”, “di fresh/freshening” characteristic or function.

29. I take the view that the average customer for the relevant goods (the general public) is unlikely to perceive the word DUOFRESH as having any real meaning or indication in relation to the goods at issue. The word DUOFRESH comprises a characteristic shared by many good trade marks, that of a clever and indirect allusion to a characteristic of the product.

30. To conclude, the opponent’s interpretation of the mark cannot be sustained. In my view the word DUOFRESH cannot be seen as indicating a normal way of representing the relevant goods or their essential characteristics in common parlance either now in the present, or at some time in the future. It does not comprise a term which should be kept freely available for all.

31. I find that the mark meets the requirements of Section 3(1)(c) of the Act and that ground of opposition fails.

32. I now go on to the Section 3(1)(b) ground which provides for refusal of registration on the ground that the mark in question lacks distinctiveness. In the application of Section 3(1)(b) I am assisted by the principles set out in the following decisions – *Cycling Is* [2002] RPC 37, *Libertel Group BV v Benelux Markenbureau*, Case C-104/01 and *Linde AG (and others) v Deutsches Patent-und Markenamt*, Joined Cases C-53/01 to C-55/01; which can be summarised as follows:

- (a) the exclusions from registrability contained in Section 3/Article 3 are there to ensure that trade marks whose use could successful be challenged before the Courts are not registered. The defence available to other traders by virtue of an objection under Sections 3(1)(b)

operates independently of objections under Section 3(1)(c) (*Cycling IS* paragraphs 43-45 and *Linde* paragraphs 67-68);

- (b) for a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (*Linde* paragraphs 40-41 and 47);
- (c) it is legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them come from the same undertaking or economically-linked undertakings (*Cycling IS* paragraph 53);
- (d) a trade mark's distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public's perception of that mark (*Libertel* paragraphs 72-77 and *Cycling IS* paragraph 64-61);
- (e) the relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (*Libertel* paragraph 46 referring to Case C-342/97 *Lloyd Schuhfabrik Meyer*).

33. In light of the above guidance I do not believe that the opponent has any stronger case under Section 3(1)(b) than under Section 3(1)(c). For the reasons previously stated in this decision (paragraphs 28 to 30 refer) I believe that the mark in totality is origin specific and will be seen by the relevant class of persons as indicating a product from a particular undertaking.

34. The ground of opposition under Section 3(1)(b) also fails.

35. Next, the Section 3(1)(d) ground. The leading guidance from the European Court of Justice on Article 3(1)(d) (equivalent to Section 3(1)(d) of the UK Act) is contained in *Merz & Krell GmbH & Co*, [2002] ETMR 21:

“41. It follows that Article 3(1)(d) of the Directive must be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indication in question describe the properties or characteristics of those goods or services.”

36. It is clear from the final sentence of the above paragraph that a mark is subject to refusal or invalidation under this head if it is customary in the language of the trade irrespective of whether it describes the properties or characteristics of the goods. The onus is upon the opponent to make out this case.

37. It seems to me that a claim that a word or words have become customary in the trade is likely to require evidence from the trade or a representative part thereof as an underpinning minimum. It will be difficult though not perhaps impossible for a case to be made based purely on evidence from the party making the claim even if that party is itself engaged in the relevant trade.

38. The opponent has filed no evidence going to Section 3(1)(d). However, it does seek to rely upon Exhibit JMO F2 attached to Ms O’Ferrall’s witness statement of 19 December 2003 which was filed on behalf of the applicant. This exhibit relates to a printed result of a global search run on 12 December 2003 on the GOOGLE search engine against DUOFRESH and contains “hits” which refer to a DuoFresh toilet cleaner from the Mintel International Group. However, it seems to me that the “hits” concerned are a long way from showing that the word DUOFRESH has become customary in the trade. Use appears to be by one party and there is no indication of how the word is used, in what context it is used, where it is used and when such use commenced.

39. In all the circumstances there is no course open other than to find that the Section 3(1)(d) ground fails.

Section 5(2)(b)

40. Section 5(2) of the Act reads as follows:

“5.(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.”

41. The opponents trade mark number 1217406 was in effect at the relevant date for these proceedings (17 January 2002) by virtue of Section 46(6) of the Act and constituted an earlier right. An earlier right is defined in Section 6, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

- (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 mark,”

42. 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;
- (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*, paragraph 23;
- (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*, paragraph 17;
- (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*, paragraph 24;
- (g) 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;
- (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.

43. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration 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 above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity of the goods, the category of goods in question and how they are marketed. As I have no evidence to demonstrate use of the respective marks in the UK in relation to the relevant goods I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods covered within the respective specifications.

44. Turning to a comparison of the respective goods I have to consider whether the goods covered by the application are the same or similar to the goods covered by the opponent's registrations. Both the applicant's Class 3 goods include cleaning and bleaching preparations both at large and specific ie polishing, scouring, degreasing and abrasive preparations. The opponent's Class 3 goods are lavatory cleaners. Given the wide nature of the applicant's specification in Class 3 I have no doubt that the applicant's specification includes identical and similar goods to that of the opponent.

45. The application also includes air freshening preparations, air deodorising preparations and deodorants (not for personal use) in Class 5. These are clearly not the same as the opponent's goods in Class 3 and in determining whether the goods covered by the application are similar to the goods covered by the opponents trade marks, I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

“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 services;
- (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 particular 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.”

46. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods and/or services.

47. The uses of air fresheners and deodorisers are clearly different from lavatory cleaners as such in that the former removes or mitigates bad smells whilst the latter cleans and removes stains, germs etc. Turning to the users of the respective goods, these would include the public at large who are looking to cleanse and freshen their homes. These intentions could overlap in the lavatory/bathroom areas. On the physical nature or properties of the goods, lavatory cleaners usually contain bleaches or similar substances in liquid form, whereas air fresheners are usually sold in solid or aerosol/spray form. I have no evidence before me on the respective trade channels but it seems to me that the relevant goods are specialized in their intended use and are sold in different areas of a store or supermarket. The goods are not in competition and are not, in general, alternative purchases which will fulfill the same function. While cleansing may have a deodorising effect, this is a short lived side-effect which is not the primary objective of the exercise. Taking the position as a whole, I do not believe the applicant’s Class 5 goods possess any substantive similarity with the opponent’s goods in Class 3. The respective goods have obviously different uses which is reflected in how they are sold and purchased.

48. I now go on to a comparison of the marks in suit with the opponent’s earlier registration. In the evidence the applicant has drawn attention to the state of the UK trade marks register in relation to marks prefixed with the letters DUO. I am not assisted by such evidence and I am guided on this point by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite 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 inquiry 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 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 eg *MADAM* Trade Mark and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

49. My decision involves a comparison of the applicant’s and opponent’s particular marks and must be made on its own merits.

50. I now go on to compare the mark in suit with the applicant’s earlier mark.

51. The mark in suit consists of the word DUOFRESH which, as considered earlier in this decision (see paragraphs 27 to 29) possesses distinctive character. It comprises the combining form DUO and the obvious dictionary word FRESH. The DUO

element may allude to a bi-functional product while the remaining element, the word FRESH may directly describe characteristics or qualities of the relevant goods. The opponent's earlier mark consists of the two words BLEACHMATIC DUO, the word BLEACHMATIC being invented.

52. In the comparison of the marks the guiding authorities make clear that they must be compared as a whole although, as recognized in *Sabel BV v Puma AG* (mentioned earlier in this decision) in any comparison reference will inevitably be made to the distinctiveness and dominance of individual elements. It is, of course, possible to over analyse marks and in doing so shift away from the 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 when making the comparisons.

53. I now go on to a visual, aural and conceptual comparison of the respective marks. The marks differ in that the opponent's mark contains the word BLEACHMATIC and the applicants mark has the additional descriptive element FRESH added to the word DUO. Both marks share DUO, in the opponent's mark as it is a word in itself, while in the applicants mark it is an element within the word DUOFRESH.

54. In my view the difference in the respective marks would be obvious in visual and aural use. However, it seems to me that within the context of the opponent's earlier mark, the word BLEACHMATIC is likely to be perceived as a house mark of the opponent. There is no obvious link between the word BLEACHMATIC and the word DUO and the house mark interpretation is to my mind logical and obvious.

55. In light of the above, when comparing the marks I have taken into account the views expressed in *Bulova Accutron*[1969] RPC 102. While the case was decided under the 1938 Act, it seems to me that the following views, expressed at 109-140 by Stamp J, remain relevant today:

“As I have already said, if what had to be considered was a side by side comparison, the additional word would have had a vital significance, but where imperfect recollection is relevant what has to be considered is how far the additional word is significant to prevent imperfect recollection and the resultant confusion. Particularly having regard to the fact that BULOVA is the house name of the applicants and has significance other than as a trade mark, its addition before the word ACCUTRON does not in my judgement serve to prevent the deception or confusion which would in the view of the Court of Appeal have been caused but for that adoption. As the Assistant Registrar remarks in his decision:

“As Bulova and Accutron do not hold together as a phrase or present a wholly different meaning to the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products.” I would add that the combination of the two words is likely to be taken by other persons on first impression as an indication that the part of the trade mark which consists of BULOVA is a house name of the marketers of the watches, that the trade mark is ACCUTRON and that they will confuse them

with watches marketed under the trade mark ACCURIST simplicitor.”

56. Accordingly, it seems to me that the addition of the word BLEACHMATIC (which is likely to be perceived as a house mark) to the opponent’s mark does not significantly defuse the rule of confusion.

57. The remainder of the opponent’s mark is the word DUO, which is also contained as an element within the mark in suit. While I do not lose sight of the fact that the applicant’s mark also contains an additional element ie the word FRESH, this element is directly descriptive of a characteristic or quality of the relevant goods.

Accordingly, the dominant and distinctive component within the applicant’s mark is the combining form/word DUO, an element shared with the opponent’s earlier registration. As the remainder of the opponent’s mark (BLEACHMATIC) is likely to be perceived as a house mark, it is my view that, in their totalities, the respective marks share visual, aural and conceptual similarity and that the differences within the marks do not significantly defuse the risk of confusion.

58. In my considerations relating to the global appreciation of a likelihood of confusion I must consider the goods at issue and the average customer for the goods. It seems to me that the customer for the relevant cleaning and air freshening preparations etc would include the public at large who purchase such products for their households. The goods would be purchased with a degree of care e.g. as to the nature of their scent or fitness for purpose, but they would not constitute an expensive or sophisticated purchase.

59. On a global appreciation taking into account the relevant factors, I have come to the following conclusions:

- (i) the respective Class 3 specifications of the mark in suit and the opponent’s earlier registration cover identical and similar goods;
- (ii) the goods covered by the applicant’s Class 5 specification possess no substantive similarity to the opponent’s goods;
- (iii) the respective marks are similar;
- (iv) in all the circumstances the relevant consumer is likely to be confused in relation to the origin of the goods in Class 3, but not as to the origin of the goods contained within Class 5 of the applicant’s specification.

60. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in Canon:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18)”.

## **CONCLUSION**

61. The opposition is under Section 5(2)(b) is successful in relation to the Class 3 goods of the mark applied for. If within 28 days of the expiry of the appeal period the applicant files a Form TM 21 deleting Class 3, the application will be allowed to proceed in relation to Class 5. If the applicant fails to file a Form 21 deleting Class 3, the application will be refused.

## **COSTS**

62. The opponent is entitled to a contribution towards costs and I order the applicant to pay the opponent the sum of £1000 which takes into account the fact that no hearing took place on this case. This sum is to be paid within seven days of the expiry of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 14<sup>th</sup> day of June 2004**

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