

O-173-07

**TRADE MARKS ACT 1994 AND THE TRADE MARKS (INTERNATIONAL  
REGISTRATIONS) ORDER 1996 (AS AMENDED)  
IN THE MATTER OF APPLICATION NO M786606  
BY LIDL STIFTUNG & CO KG  
TO PROTECT A TRADE MARK  
IN CLASS 21**

## **TRADE MARKS ACT 1994**

**AND**

### **THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996 IN THE MATTER OF INTERNATIONAL REGISTRATION No M786606 AND THE REQUEST BY LIDL STIFTUNG & CO KG TO PROTECT A TRADE MARK IN CLASS 21**

#### **Background**

1. On 26th September 2002 Lidl Stiftung & Co KG of Heiner-Fleischmann –Strasse 2, D74172, Neckarsulm, Germany, designated the UK under the provisions of the Madrid Protocol in respect of the following:

Goods: Class 21

Toothbrushes

The mark applied for is shown below:-

#### **UNODENT**

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 (as amended) and a notice of Provisional Total Refusal under Article 9(3) of that order was issued. The ground of refusal was stated as being under Section 5(2)(b) of the Trade Marks Act 1994.

3. The following earlier conflicting rights were identified as citations against the Holder's mark in class 3 both being registered UK marks in the name of Billericay Dental Supply Co Ltd:-

i) 2007215A - UNODENT

Goods: Class 21

Toothbrushes; toothpicks; bottles; bowls; containers; trays; boxes.

ii) 2007215B - UNODENT

Goods: Class 3

Dental polishes; dentifrices; preparations for cleaning dentures; cleaning preparations; swabs; cotton rolls; cosmetic creams; all for medical, paramedical or dental applications.

4. Following the six months allowed for reply given in the examination report; the Holders were given numerous extensions of time, with the final date for reply being 21st October 2006.

5. No reply was received to the last extension of time letter, therefore on the 21st December 2006, the designation was refused under Section 37(4) of the Trade Marks Act 1994.

6. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

7. It was noted at this stage that an objection should have also been raised under Section 5(1) of the Act with regard to citation 2007215A. Both the cited mark and the present designation are in class 21 they are identical marks with identical goods involved.

8. We wrote to the Agent for the holder on 26 January 2007, stating that we intended to cover these issues in the statement of grounds, unless they had comments to make to the contrary. No reply has been received so these matters are also included.

## **DECISION**

### **Comparison of marks (Section 5(1))**

#### **The Law**

9. **Section 5(1)** of the Act reads as follows:

“5-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

10. An earlier trade mark is defined in Section 6(1) which states:

“6-(1) In this Act an “earlier trade mark” means-

(a) a registered trade mark, international trade mark (UK), Community trade or International trade mark (EC), which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11. As outlined in Kerley’s law of Trade Marks and Trade Names Fourteenth Edition, paragraphs 9-017 – 9-021:

9-017 - “This subsection implements the mandatory provisions of Art 4(1)(a) of the TM Directive. For an objection to arise a number of requirements must be satisfied.

#### *Earlier trade mark*

9-018 - First, there must be an earlier trade mark. This is defined in s.6 of the Act and is considered in paras 9-122 to 9-133. As is the equivalent provision in the CTM Regulation, Art.8(2).

*The trade marks must be identical*

9-019 - Secondly, the earlier trade mark must be identical to the mark applied for. A sign is identical with a trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer (*L T J Diffusion v Sadas* (“Arthur et Felicie”) [2003] F.S.R. 34 at p.608; *Reed Executive v Reed Business Information* [2004] R.P.C. 40 at p767, CA; *Compass Publishing v Compass Logistics* [2004] EWHC 520; [2004] R.P.C. 41.

The comparison must be between the whole mark applied for and the earlier registered mark.

*The goods or services must be identical*

9-020 – Thirdly, the goods or services the subject of the application must be the same as those the subject of the earlier trade mark. This requires a consideration of the scope of the respective specifications. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.

9-021 – If the marks are identical, and any of the goods or services are identical then the prohibition applies”.

12. In 2007215A we have an identical mark to the Holders designation “UNODENT” in block capitals and containing no stylisation or added matter. The designation is for “toothbrushes” in class 21. The earlier right is also in class 21 and includes “toothbrushes”. We therefore have identical goods. For these reasons I find that the prohibition under Section 5(1) must therefore apply.

13. This would appear to be fatal to this designation. However, for the sake of completeness I now go on to consider the objection under Section 5(2)(b) of the Act.

**Comparison of marks (Section 5(2)(b))**

**The Law**

14. **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.”

15. An earlier trade mark is defined in Section 6(1) which states:

“6-(1) In this Act an “earlier trade mark” means-

(a) a registered trade mark, international trade mark (UK), Community trade or International trade mark (EC), mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

16. I take into account the guidance provided by the European Court of Justice (ECJ) in the following cases: *Sabel BV v Puma AG* [1998] R.P.C. 199. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmnH v Klijsen Handel .bV.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

17. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally taking into account all relevant factors. *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*. The average consumer 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 kept in his/her mind. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel*,

(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*,

(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*,

(e) A global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks and vice versa. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Incm*,

(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*,

(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*,

(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*,

18. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

### ***Prima facie* comparison**

#### **Comparison of the marks**

19. The earlier rights 2007215A and 2007215B (in the same ownership – Billericay Dental Supply Co. Ltd) - consist of a single invented word “UNODENT” with no additional stylization or get up. The Holders mark is a single invented word “UNODENT” again with no additional stylisation or get up. Therefore, they are, in fact, identical marks.

#### **Comparison of the goods**

20. The cited marks cover the following goods between them:

*Class 3 - Dental polishes; dentifrices; preparations for cleaning dentures; cleaning preparations; swabs; cotton rolls; cosmetic creams; all for medical, paramedical or dental applications and Class 21 - Toothbrushes, toothpicks; bottles; bowls; containers; trays; boxes.*

21. I have already found that identical goods are involved in respect of “Toothbrushes”, in class 21 see paragraph 12 above.

22. Bearing in mind the relevant factors as laid out under *BRITISH SUGAR PLC v JAMES ROBERTSON & SONS LTD*. [1996] R.P.C. 281, Mr Justice Jacob and later confirmed in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Incm*. All factors relating to the goods or services themselves must be taken into account. I will consider therefore the following factors :

In deciding whether the goods and/or services covered by the opponents’ earlier mark are the same as, or similar to the applicants’ goods, I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 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 service;
  - (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 practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or 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 the trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

Whilst I acknowledge that in the view of the *Canon* judgement the *Treat* case may no longer be wholly relied upon, as can be seen from the following paragraph from the *Canon* judgement, 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:

23. “In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, intended purpose and their method of use and whether they are in competition with each other or are complementary.”

Applying the *Treat* test I regard all goods in class 3 of 2007215B as similar to toothbrushes, with the exception of swabs and cotton rolls. This is because they share the same use, users (assumed to be general public), trade channels (again assumed to be sold direct to the general public) and location within a supermarket. All such products relate to oral hygiene in general; they complement or compete with each other. I would further add from my own knowledge that manufacturers of toothpaste may well provide a suite of complementary products around their core product, toothbrushes being the main one. Also from my own knowledge, what may have in the past been thought to be specialist dental products having certain properties and for application only by technicians, appear to be increasingly available on the supermarket shelves, e.g. cosmetic toothpaste.

As regards the goods in class 21, I find that toothpicks are similar goods for the reasons given above. I am less certain about bottles; bowls, containers, trays and boxes. Whilst it is conceivable that such items could, e.g. be purpose made for holding toothbrushes, I do not find that such goods are similar in accordance with the test set out in *Treat*.

24. I find that for the majority of the goods remaining in the specifications of the cited marks, they are similar to toothbrushes and satisfy these relevant factors.

### **Likelihood of confusion**

25. I must bear in mind that a mere possibility of confusion is not sufficient (see e.g. *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found that the goods for which the earlier trade marks are registered are either identical or closely similar to the goods applied

for. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably observant and circumspect. In relation to these goods I consider the average consumer to be the general public. The goods at issue are everyday dental and cleansing items that are purchased with an average degree of care and attention, but no more.

26. Having found that the marks are identical and the goods are similar I conclude that there is a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

### **Conclusion**

27. The designation is therefore refused protection in the UK under the terms of Articles 3, 9(3) and 11(5) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under Sections 5(1) and 5(2)(b) of the Act.

**Dated this 19th day of June 2007**

**Gail Ashworth  
For the Registrar  
The Comptroller General**