

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos 2170516B AND 2170548B BY
RECKITT & COLMAN PRODUCTS LIMITED & RECKITT & COLMAN
(OVERSEAS) LIMITED TO REGISTER MARKS
IN CLASS 5**

AND

**IN THE MATTER OF OPPOSITIONS THERETO UNDER
Nos 49541 & 49534 BY RE. LE. VI. S.P.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application Nos 2170516B
and 2170548B by Reckitt & Colman Products Limited
& Reckitt & Colman (Overseas) Limited to register
marks in Class 5**

and

**IN THE MATTER OF Oppositions thereto under
Nos 49541 & 49534 by RE. LE. VI. S.P.A.**

BACKGROUND

1. On 25 June 1998 Reckitt & Colman Products Limited and Reckitt & Coleman (Overseas) Limited applied to register the mark **FRESH LINEN** in Classes 3 and 5. Following examination the applications were divided, accepted and published for the following specifications of goods in Class 5:

2170516B

“Pharmaceutical and sanitary preparations; deodorants (not for personal use); air freshening preparations, air purifying preparations; disinfectants, germicides; preparations for killing weeds and vermin; antiseptic preparations, anti-bacterial preparations; but not including any preparations for freshening linen; none being for export except to the Republic of Ireland”

2170548B

“Pharmaceutical and sanitary preparations; deodorants (not for personal use); air freshening preparations, air purifying preparations; disinfectants, germicides; preparations for killing weeds and vermin; antiseptic preparations, anti-bacterial preparations; but not including any preparations for freshening linen; all being for export except to the Republic of Ireland”.

2. I also note that the applications now stand in the name of Reckitt Benckiser (UK) Limited although nothing turns on this point.

3. On 2 March 1999 RE. LE. VI. S.P.A of 46040 Rodigo (MN), Italy, filed notices of opposition. The grounds of opposition were extensive but, in the event, only the following were pursued by Mr Onslow at the Hearing:

- (a) under section 3(1) of the Act, because the trade mark applied for is devoid of any distinctive character and/or consists exclusively of signs or indications

which may serve in the trade to designate the kind, quality or other characteristics of the goods and/or that it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade

- (b) under section 5(2) of the Act in that the trade mark for which registration is sought is similar to the opponents' earlier community trade mark shown in the Annex to this decision and is to be registered for goods identical or similar to the goods for which the earlier trade mark is protected

4. The applicants filed counterstatements in which the grounds of opposition are denied.

5. Only the opponents filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 6 April 2001. The applicants were represented by Mr Hugo Cuddigan of Counsel instructed by Alexander Ramage Associates, the opponents were represented by Mr Robert Onslow of Counsel instructed by Potts Kerr & Co.

6. Although these two oppositions were not formally consolidated, as the trade marks are identical and the basis of the oppositions, the evidence filed and Counsel's submissions were similar in both cases, it is convenient to issue a joint decision.

OPPONENTS' EVIDENCE

7. This consists of two affidavits both by Giancarlo Zanetti. I do not need to summarise these because they had no part to play in my considering the issues here, or in the decision itself.

DECISION

8. The first ground of opposition is based on section 3(1). Although not particularised in the notices of opposition, as originally pleaded the objections clearly go to sub-paragraphs (b), (c) and (d) of section 3(1). However at the Hearing Mr Onslow did not pursue the objection under sub-paragraph (d) and I think he was right not to do so. Sub-paragraphs (b) and (c) of section 3(1) 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)

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”.

9. In considering the matter under this head, I have regard to the comments of Jacob J in *British Sugar PLC and James Robertson and Sons Ltd* [1996] RPC 281, page 306, line 1 (the TREAT decision), in which he said:

“Next, is “Treat” within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned (“North Pole” for bananas) can clearly do. But a common laudatory word such as “Treat” is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character.”

10 Also Aldous LJ in *Philips Remington* [1995] RPC 809:

“The scheme of the Directive and the Act appears to require that signs which are not capable of distinguishing are excluded from registration at the initial stage. Those which are capable of distinguishing will be excluded unless they have or have acquired some distinctive character. An example is the trade mark WELDMESH to which I have referred. It is capable of distinguishing, but without use would retain its primary meaning of, welded mesh. It would therefore be devoid of any character that was distinctive. However, use could provide a secondary meaning, namely that the welded mesh to which the trade mark was applied came from a particular trader. Upon that being established it would become registrable as it would pass the dual test laid down by section (Article) 3(1)(a) and (b).

The requirement under section (Article) 3(1)(b) is that the mark must have a distinctive character to be registrable. Thus it must have a character which enables it to be distinctive of one trader’s goods in the sense that it has a meaning denoting the origin of the goods.”

11. In his skeleton argument Mr Onslow for the opponents put his case like this:

“These (marks) are descriptive of air fresheners etc which have a generally starchy/newly washed/ironed smell. The applicant’s point boils down to this: that there is no one smell which can be identified as definitively that of fresh linen, so that the mark is merely evocative. This is a bad point. If it were right, the mark FRESH would be registrable for air fresheners without use because there is no one smell which can be described as being “fresh”. The fact is that the words FRESH LINEN used on air fresheners etc are intended to evoke a particular class of smell - perhaps different smells to different people, but smells which everyone would generally accept as being distinctly that of fresh linen”.

12. Later in his skeleton argument Mr Onslow goes on to say:

“Once one gives thought to it, it is apparent that there is a sliding scale of descriptiveness in the field of names relating to smells. These are:

- (i) marks which merely co-operate with the smell to evoke a particular image. Examples of this are common in the perfume industry. (It so happens there are registrations for WHITE LINEN and TWEED for perfumes). These names do not describe the smells, nor are they intended directly to evoke the smell which the customer can expect to find when the bottle is opened. Instead they evoke an image, which is complemented by the smell. The name and the smell co-operate to evoke the image. A hypothetical example in the air freshener field might be SUNSHINE, which would not be descriptive, but evocative.
- (ii) a half-way house where the name evokes a concept, but carries with it an ill-defined class of smells of great generality eg. COUNTRYSIDE for air fresheners which could convey anything from freshly mown grass through to freshly spread manure.
- (iii) marks which, although the class of smell evoked is general, is well defined. The mark FRESH is an example of this.
- (iv) marks which evoke a very specific smell. An absurd example of this for air fresheners is NEW MOWN GRASS.

As a rule of thumb, marks in (i) and (ii) would probably be registrable without use. Marks in (iii) would need use. And marks in (iv) may be inherently devoid of distinctive character.

Once one tries to place FRESH LINEN onto the scale, it is submitted that it falls between (iii) and (iv) ie. well on the descriptive side at least needing use”.

13. In his skeleton argument Mr Cuddigan commented as follows:

“It is accepted that the mark FRESH LINEN would be devoid of distinctive character for cotton sheets. However, the mark is applied for in respect of a variety of pharmaceutical and chemical products. There is no aspect of such products that can be described by the phrase FRESH LINEN. While the word FRESH implies a certain desirable connotation with respect to deodorants and disinfectants it is submitted that LINEN cannot. FRESH LINEN does not describe an odour, nor can it. It is a characteristic of clean linen articles that they be odourless. In this manner the mark is quite different from, say, FRESH ROSES, which would be wholly descriptive of a fragrance product. Indeed, linen could be said to be a vector for a fragrance, but not the source of it. It is therefore quite the opposite of descriptive for this mark”.

14. Having referred to the comments of Jacob J in TREAT (reproduced at paragraph 9

above), Mr Cuddigan concludes:

“Here linen is meaningless for pharmaceutical and sanitary preparations. It cannot be bought in pharmacies and has nothing to do with health. The mark consequently enjoys distinctive character”.

15. At the Hearing both Counsel developed the arguments foreshadowed in their skeleton arguments reproduced above. Having considered these submissions and having borne in mind not only the comments of Jacob J in *TREAT* and Aldous J in *Philips v Remington* but also the current state of the law in the context of how distinctive character should be measured, I disagree with the Trade Marks Examiner who accepted the application for registration because, in my view, the words *FRESH LINEN* are, in relation to some of the goods specified in the applications, open to objection under paragraphs (b) and (c) of section 3(1) of the Act.

16. The fact that different people may have somewhat differing expectations of what the smell of *FRESH LINEN* may be does not in my view assist the applicants. As Mr Onslow put it:

“..... of course he wants to put a laundered-type smell in the bottle. That, in turn in my submission shows this, that if the mark is granted, effectively the monopoly is for the idea of the laundered smell in the bottle. Because a person manufacturing air fresheners who wants to use that same concept, the freshly laundered smell in the bottle is more or less constrained to use those words; or those words are of the sort that a legitimate trader could legitimately expect to be able to use to describe the smell”.

17. I agree with Mr Onslow that the words *FRESH LINEN* fall into category (iii) of his list above ie. marks which, although the class of smell evoked is general, is well defined. When encountering the words *FRESH LINEN* used in relation to some of the goods the subject of the applications the public will in my view see these words as describing a characteristic of the goods concerned ie. goods which recreate or simulate the smell of *FRESH LINEN* and not as a badge of origin. The term is not therefore a trade mark by nature but could possibly become so by nurture - see the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in AD 2000 [1997] RPC 168.

18. Whilst the submissions at the hearing (not surprisingly) concentrated on the use of the words in the context of air fresheners, the nature of the goods remaining in the specifications (with the exception of pharmaceutical preparations and preparations for killing weeds and vermin) are in my view sufficiently broad that I can not exclude the possibility that they may also have the smell of *FRESH LINEN* as a subsidiary feature. As examples, the broad term sanitary preparations would include articles of sanitary clothing which may well have the smell of *FRESH LINEN* as a desirable subsidiary characteristic, disinfectants would include disinfectants for household use which may replicate the smell of *FRESH LINEN*. Suffice to say that with the exception of pharmaceutical preparations and preparations for killing weeds and vermin I am not prepared to assume that the other goods in the specifications are free from objection under section 3(1). If the applicants limit their applications to the non-objectionable goods indicated, the objections under section 3(1) will fall away. Should they chose not to so limit, the oppositions under section 3(1) will succeed in their entirety.

19. The next ground of opposition is based on section 5(2) of the Act.

20. This reads as follows:

“5. - (1)

(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 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.”

21. An earlier right is defined in section 6 of the Act, the relevant part of which states:

“6.- (1) In this Act an ‘earlier trade mark’ means -

- (a) a registered trade mark, international trade mark (UNITED KINGDOM) 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 marks,
- (b)
- (c)”

22. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *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. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

23. 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* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, 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* page 224;

- (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* page 224;
- (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* page 7, 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* page 8, 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* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) 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* page 9 paragraph 29.

24. In his skeleton argument Mr Cuddigan conceded that the goods in the applicants' specifications were similar to those for which the opponents' trade mark was registered. That being the case, I have only the marks to consider. As the respective marks are clearly not identical the matter falls to be considered under section 5(2)(b) of the Act.

25. For convenience the respective marks are reproduced below:

Applicants' mark:

FRESH LINEN

Opponents' mark:



26. In his skeleton argument Mr Onslow put his case like this:

“As to 5(2), there is no doubt that FRESH LINEN and LINEA FRESH are generally similar. Are they confusingly similar, assuming no use of either in the United Kingdom? The risk of confusion is of the type to be found in the supermarket. The

marks share 9 out of 10 letters, albeit the words are reversed. The “a” of LINEA is not so different in form from a lowercase “n” in LINEN if used in lower case. The products are mass market products, of wide consumption. Customers are less inclined to pay attention to the whole trade mark, but are more inclined to memorise only some particulars.....The opponents’ case is that there is a risk that the visual distinction will not be made, so that the different concept never arises as a possibility”.

27. In his skeleton argument Mr Cuddigan commented on the conflict under section 5(2) in the following terms:

“It is not accepted that there is any likelihood of confusion between FRESH LINEN and the opponents’ LINEA FRESH flower device.

- (i) The stylised nature of the device serves to distinguish the two marks, both in the typeface of the words and in the inclusion of the sunflower image.
- (ii) The word LINEA has no English meaning. This is especially distinguishing when the mark applied for is a phrase which, although not descriptive of the products covered, does have a meaning.
- (iii) As a matter of pronunciation the first syllable of LINEN is stressed while the second and third syllables of LINEA are stressed.
- (iv) The word FRESH appears as the first word in the mark applied for and as the last word in the opponents’ mark.”

28. At the hearing Mr Onslow urged me when making my assessment to give greater weight to the word elements appearing in the respective trade marks as it is well settled that words in marks “speak” louder than devices. In addition because the word FRESH appearing in the trade marks was descriptive, the public were, in his view, more likely to look to the LINEA and LINEN elements of the respective trade marks as the distinguishing feature. Mr Cuddigan for his part drew my attention to the various differences between the respective trade marks and to the circumspect nature of the average consumer.

29. Although evidence has been filed by the opponents in these proceedings, they are not as a result of this evidence claiming any enhanced reputation in their LINEA FRESH (and device) trade mark such that it is a point I need to bear in mind when reaching my decision.

30. When comparing the respective trade marks it is self evident that both contain the word FRESH, albeit in differing positions. In this respect I agree with Mr Onslow that in the context of the various goods at issue, the word FRESH is likely to be taken by the public as describing a characteristic of the goods concerned. However I do not accept that this means that greater weight will be placed on the LINEA and LINEN elements of each. It is well settled that the average consumer perceives trade marks as a whole and does not proceed to analyse their various details. This is the approach I shall adopt here. Earlier in this decision I have found under section 3(1) that the words FRESH LINEN are apt to describe characteristics of a range of goods within the specifications applied for - they have a smell which recreate or simulate the smell of FRESH LINEN. As such and in relation to those goods the trade marks send a clear conceptual message to the potential purchaser. The

opponents' trade mark consisting as it does of the unfamiliar (potentially invented word LINEA) together with the word FRESH is unlikely, in my view, to create any such conceptual image in the potential purchasers mind and on this basis at least the marks are readily distinguishable.

31. Visually and orally the respective trade marks are somewhat closer. The sunflower device though not insignificant is unlikely to be the one which fixes itself in the mind of the consumer and therefore is not likely to be the distinguishing feature between the respective trade marks. As Mr Onslow pointed out words in trade marks "speak" louder than devices. Both the applicants' and the opponents' marks consist of two words, each consisting of five letters. The word FRESH is of course common to both but takes the prefix position in the applicants' mark and the suffix position in the opponents. The words LINEA and LINEN are the same length and differ by only one letter at the end of each word. However I bear in mind that the word LINEN is a well known dictionary word whereas LINEA is not. The goods for which registration is sought are varied in their nature. Some may be relatively inexpensive household items which are likely to be bought without a great deal of care (air fresheners for example) whilst others, for example pharmaceutical preparations, are likely to be purchased with a good deal more care. Consequently it is difficult with any degree of certainty to be able to identify the traits of the "average consumer" of such a disparate range of goods.

32. Given the above the decision as to whether there is or is not a likelihood of confusion is a matter of first impression. At the Hearing I asked Mr Cuddigan if given imperfect recollection it was possible that a potential purchaser who had previously purchased LINEA FRESH may encounter FRESH LINEN (perhaps at an angle on a supermarket shelf) assume it was the same product and purchase it in error. Mr Cuddigan replied that while it was conceivable that such a mistake could occur, in his view it was not a likelihood. On balance, I agree with this conclusion. There is in my view a possibility (or a risk as Mr Onslow put it in his skeleton argument) of the respective trade marks being confused but there are, in my view, sufficient differences between the marks (the reversal of the positioning of the FRESH element, the various differences between the words LINEN and LINEA and the presence in the opponents' trade mark of a device element) for this mere possibility or risk not to amount to a likelihood of confusion as required by the Act. Thus, the opposition based on section 5(2)(b) is dismissed.

33. The oppositions to these applications succeed. However the applications may proceed on the basis of limited specifications of goods. If the applicants therefore file a Form TM21 within one month of the date of this decision limiting the specifications of goods to the following:

2170516B

"Pharmaceutical preparations; preparations for killing weeds and vermin; none being for export except to the Republic of Ireland".

2170548B

"Pharmaceutical preparations; preparations for killing weeds and vermin; all being for export except to the Republic of Ireland".

then the objections under Section 3(1) of the Act fall away and the applications may proceed to registration. If no Form TM21 is filed then the applications for registration will stand refused in their entirety.

34. As the oppositions to the two applications have been substantially successful the opponents are entitled to a contribution towards their costs. At the hearing Mr Cuddigan asked me to bear two factors in mind when making any award. Firstly the expense to which his instructing agent had been put as a result of the manner in which the opponents' evidence was supplied to him by the opponents' agents (haphazardly) and secondly that a number of the original grounds of opposition had not been pursued. Mr Onslow (albeit without the backgrounds relating to the serving of the opponent's evidence) felt that the oppositions were unremarkable. It was he commented quite commonplace for extensive grounds of opposition to be initially pleaded only to find that a number of these original grounds are subsequently abandoned. This in his view allowed all concerned to concentrate only on those issues which are likely to be material to the outcome of the proceedings.

35. While it is plainly desirable for the issues between parties to be narrowed down to focus on the real area of dispute, ideally this should be done as early in the proceedings as possible. To some extent the Trade Marks Registry's examination of Statements of Case and Counter-Statements outlined in Tribunal Practice Notice 4 of 2000 (October 2000) will assist in this regard. However, I note that these oppositions were launched in March 1999 before its issue and I do not wish to be overly critical of the manner in which the opponents originally pleaded their case. That said, it seems to me that the grounds pleaded under section 3(6) and 5(1) were never likely to succeed and ought not to have been included. Equally however I do not think that the inclusion of these grounds would have disadvantaged the applicants to any great extent. Finally I note Mr Onslow's comment that the evidence filed has not played much of a part in the proceedings; in actual fact it played none. Taking all these factors into account I think the applicants are entitled to be compensated not only for the somewhat haphazard way the opponents evidence was supplied to them but also because they were required to peruse evidence which in reality was irrelevant. Ordinarily I would have awarded the opponents the sum of £1400. However to reflect the inconvenience and wasted time encountered by the applicants' agents, I propose to reduce this amount to £1000. This sum to be paid by the applicants to the opponents within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 03 day of August 2001

M KNIGHT
For the Registrar
the Comptroller-General

Annex A: Order a copy