

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

**IN THE MATTER OF AN APPLICATION, NO. 1524531
BY GRANITE COSMETICS LIMITED TO REGISTER
A MARK IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 42876 BY CUSSONS (INTERNATIONAL) LIMITED
AND CUSSONS (UK) LIMITED (JOINT OPPONENTS)**

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

10 **IN THE MATTER OF AN APPLICATION, NO. 1524531
BY GRANITE COSMETICS LIMITED TO REGISTER
A MARK IN CLASS 3**

AND

15 **IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 42876 BY CUSSONS (INTERNATIONAL) LIMITED
AND CUSSONS (UK) LIMITED (JOINT OPPONENTS)**

20 **DECISION**

On 21 January 1993, Granite Cosmetics Limited of Kensington, London applied under Section 17(1) of the Trade Marks Act 1938 (the old Act) to register the mark GRANITE with device in Class 3 in respect of "mens toiletries; all included in Class 3". The application is numbered B1524531.

On 26 July 1995, Cussons (International) Ltd and Cussons (UK) Ltd, both of Manchester, (Joint Opponents) filed notice of opposition to this application. The grounds of opposition are, in summary:

30

(i) under Section 12(1) by reason of the opponents registration of the mark GRAPHITE, which is registered in respect of the same or similar goods,

35

(ii) under Section 11, by reason of the opponents use of the trade mark GRAPHITE,

40

(iii) under Section 17, by reason that the applicant is not the true proprietor of the trade mark GRANITE. Further that the applicant does not use, or propose to use, the mark forming the subject of the application.

45

The opponents also claim that since the applicants can have no valid proprietary rights in the mark, the mark cannot be distinctive of the applicants goods. They ask the Registrar to refuse the application and award costs in their favour.

50

The applicants filed a Counterstatement denying these grounds; they ask the Registrar to dismiss the opposition and award costs in their favour.

Only the opponents filed evidence in support of their opposition.

50

By the time this matter came to be heard, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having

5 begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law, unless otherwise indicated.

10 The opponents filed a Statutory Declaration by Alaric Paul McDermott dated 18 June 1996 and a supporting Statutory Declaration by Nichola Amsel dated 10 June 1996. I turn first to consider Mr McDermott's evidence.

15 Mr McDermott states that he is the Company Secretary of Cussons (International) Ltd, and that he has worked for the company for six years and in the toiletries industry for fifteen years. Mr McDermott states that Cussons (International) Ltd is a subsidiary of Paterson Zochonis PLC and has a sister company Cussons (UK) Ltd of which he is also Company Secretary. Cussons (International) Ltd has responsibility for sales of the GRAPHITE range of toiletry products overseas, whereas Cussons (UK) Ltd is responsible for all marketing and sales in the
20 United Kingdom.

Mr McDermott goes on to state that the trade mark GRAPHITE was first adopted by Cussons (UK) Ltd in the United Kingdom in April 1991 for a range of mens toiletries and that it has been in constant use ever since for toiletries. He states that the trade mark GRAPHITE
25 is the subject of United Kingdom registration No. 1435436 and he exhibits samples of invoices which show sales of mens toiletries under the GRAPHITE trade mark. Also provided are samples of the packaging used in respect of the goods sold under the trade mark.

Mr McDermott states that he is advised by Ms Caroline Bonella who is employed by Trade
30 Mark Owners Association Ltd, their trade mark agents, that the benefit of Application No. 1524531 has been assigned from the original applicant, Jason Saba, to Granite Cosmetics Ltd.

Mr McDermott goes on to state that he instructed investigations into use of the trade mark GRANITE, whether by Mr Saba or Granite Cosmetics Ltd. The report of the investigator is
35 the subject of separate evidence by Ms Nichola Amsel. Mr McDermott further states that in his view there is potential for confusion between the respective trade marks given the similarity of the words and having a similarity of meaning in terms of strength, durability and the like.

40 I next turn to the Statutory Declaration by Nichola Amsel, who states that she is a partner in the firm Amsel and Co of Albert Square in Manchester. She and her firm have been retained by Cussons (International) Ltd in connection with the matter of these opposition proceedings. Ms Amsel states that, in May 1995, she was instructed to ascertain whether the trade mark GRANITE was currently in use in the United Kingdom on a range of toiletries. She was
45 advised that an individual, Jason Saba, had applied to register this trade mark within the United Kingdom in respect of such goods. She was further advised that a company called Granite Cosmetics Ltd was apparently selling toiletries under the trade mark GRANITE outside the United Kingdom, and was asked to see whether or not there was a connection between the two. She was also advised that there was an entity known only as GNS which
50 may have been a trading style or an abbreviated form of a limited company.

5 At the time of her enquiries, June 1995, Ms Amsel states that no accounts had been filed for Granite Cosmetics Ltd, and that little information was available through Companies House. She did however ascertain that there had been a company, GGNS Ltd, which had been dissolved but of which Jason Saba had been a Director. The company was dissolved on 6 July 1993 and does not appear to have traded prior to that date.

10 During her research, Ms Amsel also states that she consulted various price lists and directories in respect of the toiletries industry. To conclude, her investigations failed to find any manufacturing facility used by Granite Cosmetics Ltd within the United Kingdom or to find any evidence of sales within the United Kingdom under the trade mark GRANITE.

15 Finally Ms Amsel states that in separate but related proceedings between the parties involving Revocation action No. 8503, against Registration No. 1166439 GRANIT, she was instructed to make further enquiries, the results of which are sworn in a Statutory Declaration dated 28 March 1996, a copy of which is exhibited to her Statutory Declaration for these proceedings. Insofar as these proceedings are concerned the only relevant information to be gleaned from that exhibit is that Ms Amsel states that a Bankruptcy Order was issued against Mr Jason Saba in 1992 and that such information was discovered during a computer credit search against Mr Saba's former address. Ms Amsel is not clear however whether or not the Bankruptcy Order has been discharged. A copy of the Order appeared in the London Gazette dated 22 July 1992 and a copy of the relevant page is exhibited. Ms Amsel also exhibits copies of the first abbreviated accounts of Granite Cosmetics Ltd for the period 31 March 1995 (filed in October 1995). She states that no other Directorships are listed under the entry for Ghassan Saba, and that the ultimate parent company of Granite Cosmetics Ltd is stated to be Xpekt S.A. of the Republic of Panama.

30 The matter came to be heard on 16 January 1998. The opponents were represented by Mr John Lewis instructed by their trade mark agents, Trade Mark Owners Association, and the applicants were represented by Mr Robert Onslow of Counsel, instructed by their trade mark agents, W P Thompson & Co.

35 Before making submissions on the substantive issues in these opposition proceedings, Mr Lewis raised a preliminary point concerning the advertisement of the applicants' trade mark. He stated that the trade mark advertised in the Trade Mark Journal Nos. 6072,6081 and 6106 under number B1524531 was not the trade mark applied for and drew to my attention the CREOLA trade mark case [1997] RPC 507 in which Mr Justice Laddie held that the representation of the trade mark published must be a very close representation of the trade mark applied for.

40 In Mr Lewis' view because the representation of the mark advertised did not include the word GRANITE in the applicants' trade mark it had not been properly advertised and as a consequence he questioned whether these opposition proceedings should be considered null and void. Ms Freeman of W P Thompson & Company through Mr Onslow commented that they had complained to the Trade Mark Registry concerning the quality of the representation of the trade mark published and it was published again three times. Despite this the

5 representation which appeared in the Trade Marks Journal was never clear and despite these various attempts the quality of the image was such that the word GRANITE did not appear in any of the representations advertised.

10 Mr Onslow acknowledged that the trade mark had not been properly advertised and that re-advertisement may well be necessary. However, he urged me not to deem these proceedings abandoned. The opponent had launched the proceedings because they were fully aware of the applicants trade mark and of the correct representation (which includes the word GRANITE) on the TM3. Mr Onslow was also concerned about the possibility of a further opposition by the current opponents in the event of re-publication

15 In reaching my decision I noted that the CREOLA case was one in relation to the Trade Marks Act 1994 so whilst I had to take note of it, it was not binding upon me . In arriving at my decision on the matter, I went back to first principles. The purpose of advertising applications which the Registrar had accepted (or Advertising before Acceptance under the provisions of Section 18(1)) is to give anyone who is interested an opportunity to look at and consider the trade mark that is advertised and oppose the application if they take the view that it affects them in some way. It seemed to me that in this case the opponent had not been disadvantaged by the Trade Marks Registry's error. They had been able to oppose the trade mark because they believed that it is confusingly similar to their own. I therefore decided to allow these opposition proceedings to continue as far as these two parties are concerned. Whether the trade mark should be re-published to be dependant upon the final outcome of the opposition proceedings.

30 With all of the written evidence in mind, I now turn to consider the grounds of opposition which are based upon Sections 11, 12(1) and 17 of the Act. Sections 11 and 12(1) state:

- 35 **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.
- 40 **12(1).** Subject to the provisions of sub-section (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

45 The reference in Section 12 (1) to a near resemblance is further elucidated by Section 68(2)(b) of the Act which states that references to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

The established tests for grounds of opposition based upon Sections 11 and 12 are set down in the Smith-Hayden and Company Limited's application (Volume 1936 63 RPC 101) as adapted by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, the relevant tests may be expressed as follows:

- 5 (a) (Under Section 11). Having regard to the user of the trade mark GRAPHITE is the tribunal satisfied that the mark applied for, GRANITE, 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?
- 10 (b) (Under Section 12). Assuming user by the opponents of their trade mark, GRAPHITE, in a normal and fair manner for any of the goods covered by the registration of this mark, is the tribunal satisfied that there will be no reasonable likelihood of deception among a number of persons if the applicants used their
- 15 mark, GRANITE, normally and fairly in respect of any goods covered by their proposed registration.

I deal first of all with the grounds of opposition based upon Section 12(1). For the purposes of the above test I must, of course, consider the full range of goods covered by the applicants and the opponents specifications. The applicants specification covers specifically mens

20 toiletries in Class 3, and the specification of the opponents registered mark is as follows:

“Perfumes, essential oils; non-medicated toilet preparations; cosmetic preparations; dentifrices; depilatory preparations; anti-perspirants, deodorants for use on the person;

25 soaps; all included in Class 3”.

In my view identical goods are involved. The matter therefore resolves itself into a comparison of the marks themselves. In this respect, I refer to the well known test propounded by Parker J. in PIANOTIST Co’s application. The relevant passage reads as

30 follows:

“You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In

35 fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but

40 that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case”.

Both sides made submissions at the hearing in relation to the application of the PIANOTIST

45 test. Briefly, Mr Onslow took the view that the two trade marks are significantly different. Both are dictionary words; GRANITE means a hard crystalline rock, so conjuring up a manly and rugged image, whereas GRAPHITE means a soft, black form of carbon used in pencils, lubricants etc. so conjuring up an image of high technology and creativity. He referred me to the ZINC case, Sir Terence Orby Conran v Mean Fiddler Holdings [1997] FSR 856 and drew

50 attention to the fact that zinc and its chemical element “Zn” were found to be confusingly

5 similar by Walker, J, as the two marks conjure up the same idea despite the fact they are visually different, whereas in this case there are both visual and phonetic differences between the trade marks. Mr Onslow also claimed support for his view that the trade marks were not similar from the NEUTROGENA case [1996] RPC 473.

10 Mr Lewis submitted that the SMITH-HAYDEN test should apply and argued that the two marks do indeed both look similar and conjure up similar images. In his view there is a substantial overlap between the images conjured up by the two trade marks; both have manly, outdoor and sporting connotations. In addition, he said that the goods sold under the trade marks were not bought after an enormous amount of consideration, very often they would be
15 picked up as impulse purchases and this being so, it is likely that the two marks would be the subject of imperfect recollection. In that connection my attention was drawn to the WAGAMAMA case 1995 FSR 713.

It is self evident that the two trade marks are indeed two separate dictionary words of the
20 English language. From a visual point of view it is also self evident that the only difference is in the middle of the two marks where the letter “N” in GRANITE is replaced with the letters “PH” (pronounced “F”) in the mark GRAPHITE. Thus the beginning and ending of the respective trade marks are the same. It seems to me also that there is, as Mr Lewis submitted at the hearing, an overlap between the images arising from the dictionary meanings. I also
25 take account of the decision of Luxmoore L. J. In the Court of Appeal, in the ARISTOC v RYSTA case, 60 RPC 87 where he said:

“The answer to the question whether the sound of one word resembles too nearly the
30 sound of another so as to bring the former within the limits of Section 12 of the Trade Marks Act 1938, must nearly always depend on first impression, for obviously a person who is familiar with both words will neither be deceived nor confused. It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by
35 syllable, pronounced with the clarity to be expected from a teacher of elocution. The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that persons wants”.

40 In my view, taking account of all of the factors mentioned, I believe that the two trade marks are confusingly similar and thus if the applicants were to use their trade mark GRANITE normally and fairly in respect of the goods stated on their application I consider that there is the likelihood of deception amongst a substantial number of would-be purchasers as regards
45 the origin of the respective goods.

I next turn to consider the grounds of opposition based upon Section 11. The opponents have filed evidence claiming continuous use of the trade mark GRAPHITE since April 1991 for a range of mens toiletries which is unchallenged. There is no evidence of actual confusion
50 available to the tribunal but in view of my finding in relation to the grounds of opposition based upon Section 12(1), I consider that any use by the applicants of their trade mark

5 GRANITE is, in the context of the Smith Hayden test, likely to cause deception and confusion amongst a substantial number of people. Therefore the opposition under Section 11 also succeeds.

10 The opponents further claim that the application should fail under Section 17, by reason that the applicant is not the true proprietor of the trade mark GRANITE, and further, that the applicant does not use, or propose to use, the trade mark forming the subject of the application. Section 17 says:

15 : “(1) any person claiming to be the proprietor of a trade mark used or proposed to be used by him who desires of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the Register.

20 (2) subject to the provisions of this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments modifications, conditions or limitations, if any, as he may think right”.

The applicant has not filed any evidence in these proceedings to rebut these allegations. However, I have no evidence before me from the opponents that Granite Cosmetics Limited did not adopt the mark GRANITE independently and in good faith. The question of confusion and deception is a different question to that of ownership (per Morrit J. in the AL-BASSAM trade mark case 1995 RPC 526). There is no evidence either that Granite Cosmetics Ltd do not propose to use the trade mark. I find therefore that the opponents fail in their ground of opposition under Section 17.

30 Finally there remains the matter of the Registrar’s discretion. As the opponents have been successful in respect of their opposition under both Sections 11 and 12, no exercise of that discretion is either necessary or appropriate.

35 As the opponents have been successful in these proceedings they are entitled to a contribution to their costs. I hereby order the applicants to pay the opponents the sum of £735 as a contribution to their costs.

40 In the event that my decision is overturned on appeal to the Court it will be necessary, in my view, for this application for registration subsequently to be re-advertised for the purpose of enabling any third party, but not either of the current opponents, to oppose the application on the basis of the correct representation of the trade mark applied for.

Dated this 27 day of February 1998

45

**M KNIGHT
For the Registrar
50 The Comptroller General**