

**IN THE MATTER OF  
INTERNATIONAL REGISTRATION NO. 657167  
AND THE REQUEST BY ANDREAS GIESEN  
TO PROTECT A TRADE MARK IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO. 70003 BY ORAL-B LABORATORIES  
A DIVISION OF GILLETTE CANADA INC.**

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15

On 23 May 1996, Andreas Giesen of Koln, Germany, on the basis of a registration in that country, requested protection in the United Kingdom of the trade mark "ORADENT" under the provisions of the Madrid Protocol. The international registration is numbered 657167 and protection was sought in Class 3 for a specification of goods which reads as follows:

"Non-medical toothpaste, mouth-wash, products for oral hygiene".

The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration, specifying the goods for which protection was to be conferred, were published in accordance with Article 10.

On 11 June 1997, Oral B Laboratories, a division of Gillette Canada Inc., filed notice of opposition to the conferring of protection on this international registration. The grounds of opposition are, in summary:-

- i) that the trade mark the subject of the request is not capable of distinguishing the applicants' goods and therefore contravenes Section 3(1)(b) of the Trade Marks Act 1994;
- ii) that the mark consists of the word "ORA", which is an abbreviation of the word oral and the word 'DENT', which is an abbreviation of the word dental, both of which are terms which are commonly used to designate the kind, quality and intended purpose of the goods covered by the request, it therefore contravenes Section 3(1)(c) of the Trade Marks Act 1994;
- iii) that the trade mark contravenes Section 3(1)(d) of the Act because it consists exclusively of indications which have become customary in the current language or in the bona fide practices of the trade for products which relate to oral and dental hygiene;
- iv) that the trade mark contravenes the provisions of Section 5(2) of the Act in that it so resembles the opponents' trade marks that there exists a likelihood of confusion on the part of the public. A list of the opponents trade marks is at Annex 1;

5 v) that the trade mark contravenes Section 5(3) of the Act, in that it is identical  
with or similar to the opponents' trade marks which have a substantial  
reputation in the United Kingdom and that use therefore of the trade mark the  
subject of the request will take unfair advantage of, or be detrimental to, the  
distinctive character or repute of the opponents' ORAL-B trade marks.

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The opponents ask the Registrar to refuse the request to protect the international registration  
and award costs in their favour.

15 In accordance with Article 10(4) of the Trade Marks (International Registration) Order 1996,  
the form TM7 and notice of opposition was sent to the International Bureau and to the  
international registration holders on 20 June 1997. No counter-statement or address for  
service in the United Kingdom was filed and therefore no evidence in support of the  
application has been adduced by the applicant.

20 The opponents have not filed any evidence in support of their opposition to the request for  
protection but have requested that a decision be taken from the Notice of Opposition on file  
on the basis of which, and after careful study, I give the following decision.

25 First of all, in the absence of any evidence, from the opponents in support of their opposition  
to this request for protection based upon the provisions of Section 3 of the Act, I have no  
information available to me which was not available to the Trade Marks Examiner. I see no  
reason therefore to reconsider the Trade Mark Examiner's decision that this request for  
protection satisfies the requirements for registration, as required by Article 3 of the Order and  
Section 3 of the Act. However, in case I am wrong in summarily dismissing the opposition  
30 based upon the provisions of Section 3 I go on to consider the matter in some detail.

Section 3 of the Act so far as it is relevant states:

35 3. - (1) The following shall not be registered -

- (a) -----
- (b) trade marks which are devoid of any distinctive character,
- 40 (c) trade marks which consist exclusively of signs of 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,
- 45 (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:

50 Provided that, a trade mark shall not be refused registration by virtue of paragraph (b),

5 (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.

10 The opponents submit that the trade mark applied for is not capable of distinguishing the applicants' goods and as such contravenes Section 3(1)(b) of the Act. However, I consider that the trade mark the subject of the request for protection demonstrates some distinctive character. It does not, for example, appear in any dictionary used by the Trade Marks Registry in order, prima facie to determine these matters and thus in my view the trade mark ORADENT consists of an invented word and as such can hardly be said therefore to be without any distinctive character.

15 The opponents go on to contend that the mark applied for contravenes Section 3(1)(c) of the Act as it consists of the abbreviations 'ORA' and 'DENT' terms they say are commonly used to designate the kind, quality and intended purpose of the goods applied for. Whilst it is obvious that the term 'DENT' consists of the first four letters of the word dental I have no evidence before me that it is a recognised abbreviation for the word dental. The same considerations apply to the term ORA. In any event, in my view, the conjoining of the term ORA and DENT gives the resulting word an identity which is distinct from the words from which it is claimed they derive. I conclude therefore that the word 'ORADENT' is an invented word. See WHISQUEUR trade mark case (1949) 66 RPC page 105.

25 The opponents go on to state that the trade mark applied for contravenes Section 3(1)(d) of the Act. I must therefore consider whether this trade mark consists of a sign which honest traders use or are likely to want or need to use. However, I have no evidence before me to show that honest traders actually use either of the elements of which the trade mark consists. Thus, bearing in mind my consideration that the trade mark is an invented word, I consider that it does not contravene Section 3(1)(d) of the Act.

35 Given my findings as set out above, I find that the opposition, insofar as it is based upon Sections 3(1)(b) (c) and (d) of the Trade Marks Act 1994, fails.

I turn now to consider the opposition under Sections 5(2) and 5(3) of the Act.

These Sections of the Act as far as they are relevant read as follows:

40 **5.(2)** A trade mark shall not be registered if because-

(a) .....

45 (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.

50

- 5 (3) A trade mark which-
- (a) is identical with or similar to an earlier trade mark and
  - (b) is to be registered for goods or services which are not similar to those  
10 for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair  
15 advantage of, or be detrimental to the distinctive character or the repute of the earlier trade mark.

An earlier trade mark is defined in Section 6 of the Act, the relevant provisions of which states:

20 “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  
25 that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

The opponents in their Notice of Opposition have provided some details of earlier registered trade marks i.e. the trade marks and a reference to the Trade Marks Journal in which  
30 presumably the trade marks were published, see Annex 1. However, the tribunal has been given no details of the goods covered by these registrations. It should not be assumed that the Registrar has knowledge of the register in relation to particular registrations. In that connection the extract from the following notice which appeared in the Trade Marks Journal No. 6162 is relevant:

35 **Evidence in *Inter Partes* Matters - Registrar’s Knowledge of the Registrar**

At a recent hearing involving opposition, the applicant attempted to introduce new evidence concerning the state of the register; the introduction being on the basis that  
40 the Registrar should take into account such information and that it must be known to him because it is his register. The opponents objected.

The Hearing Officer refused to admit the new evidence because he took the view that if a party wishes to place evidence before the Registrar in *inter partes* matters this  
45 must be by way of statutory declaration as required by the Trade Marks Rules and copied to the other party so that they are in a position to respond. The Hearing Officer stated “On my appraisal no party can make assumptions about the Registrar’s knowledge and certainly not as regards his knowledge of the register in relation to particular applications or registrations”.

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5 In the absence of comprehensive information from the opponents I am unable to determine whether their registrations cover the same or similar goods as those covered by the application. However, on the assumption that the opponents' registration no. 1148558 for the trade mark ORAL-B does cover the same or similar goods to those of the application. I go on to consider the similarity of this trade mark and the applicants' trade mark. In order to assist me in the comparison of the marks I use the guidance propounded by PARKER J in Pianotist Co's application (1906) 23RPC 774 at page 777 line 26 et seq.

15 "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 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 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".

25 In addition I take into account the decision of the ECJ in Sabel BV v Puma AG [1998] RPC 6 page 224 which states:

30 "That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - "... there exists a likelihood of confusion on the part of the public ..." - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details."

The trade marks in question are shown below:

| 40 | <u>Applicants Trade Mark</u> | <u>Opponents Trade Mark</u> |
|----|------------------------------|-----------------------------|
|    | ORADENT                      | ORAL-B                      |

45 As I have held earlier in this decision the applicants' trade mark consists of an invented word, the combination of the two elements ORA and DENT. The opponents trade mark consists of the word ORAL together with the letter B. In my view there are significant visual differences in the appearance of these trade marks, despite the fact that each commence with the same three letters (the letters O, R and A). This stems from the degree of invention in the applicants' trade mark whilst the opponents trade mark consists of a dictionary word (which could be descriptive for the goods covered by their registration), together with the letter B.

5 For similar reasons, I consider that the two marks are likely to be pronounced differently.  
However, I must also consider the possibility of imperfect recollection, see *ARISTOC LTD v*  
*RYSTA LTD* [1945] 62 RPC (Page 72 line 46 to page 73). In that respect I think that the  
visual and aural differences already mentioned are such as to ensure that confusion as a result  
of imperfect recollection on the part of the public is unlikely. The opposition under Section  
10 5(2)(b) therefore fails.

Turning to the grounds of opposition based upon Section 5(3). The opponents have put in no  
evidence before me to show what, if any, reputation in the United Kingdom accrue to their  
earlier trade marks, let alone any evidence to indicate that the applicants' later trade mark  
15 would take advantage of or be detrimental to either the distinctive character or reputation of  
these earlier trade marks. I have no basis therefore for determining the matter and I must hold  
therefore that the opposition under Section 5(3) also fails.

The opponents have failed on all their grounds of their opposition and in the circumstances it  
would be usual to award costs against them. However, as the applicants have not played any  
20 part in these proceedings and therefore have not incurred any costs, so far as I am aware, I  
make no order for costs in this case.

In the event of no appeal against this decision within the prescribed period the international  
25 registration no. 657167 stands protected in the United Kingdom.

30 **Dated this 2<sup>nd</sup> day of July 1998**

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

**Annex 1**

| <u>Class</u> | <u>Mark</u>                       | <u>Number</u> | <u>Journal/Page</u> |
|--------------|-----------------------------------|---------------|---------------------|
| 3            | ORAL B                            | B1148558      | 5434,2522           |
| 5            | ORAL-B Logo                       | 1274322       | 5892,5537           |
| 5            | ORAL-B Logo                       | 1463352       | 6024,2822           |
| 5            | ORAL-B Logo &<br>word MINUTE FOAM | 1471559       |                     |
| 10           | ORAL-B                            | 1081450       | 5262,1119           |
| 10           | ORAL-B                            | 1081449       | 5264,1225           |
| 10           | ORAL-B Logo                       | 1081451       | 5264,1226           |
| 10           | ORAL-B Logo                       | 1081452       | 5264,1226           |
| 10           | ORAL-B Logo                       | 1463351       | 6004,7799           |
| 10           | ORAL-B Logo<br>ULTRAFLOSS         | 1573592       | 6147,2849           |
| 21           | ORAL-B                            | 1080418       | 5271,1599           |
| 21           | ORAL-B                            | 1080419       | 5394,208            |
| 21           | ORAL-B                            | 1080420       | 5284,2138           |
| 21           | ORAL-B Logo                       | 1080422       | 5271,1600           |
| 21           | ORAL-B Logo                       | 1242907       | 5784,4129           |
| 21           | ORAL-B Logo                       | 1080421       | 5271,1600           |
| 21           | ORAL-B Logo                       | 1242906       | 5785,4280           |
| 21           | ORAL-B RIGHT<br>ANGLE             | 1172446       | 5510,1010           |
| 21           | ORALB                             | 978701        | 4908,1891           |