

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2008229  
BY WISDOM TOOTHBRUSHES LIMITED  
TO REGISTER A MARK IN CLASS 21**

**AND**

**IN THE MATTER OF OPPOSITION NO. 44778 THERETO  
BY THE GILLETTE COMPANY AND ORAL-B LABORATORIES  
(A DIVISION OF GILLETTE CANADA INC.)**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2008229**

**by Wisdom Toothbrushes Limited**

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**IN THE MATTER OF Opposition No. 44778 thereto**

10 **by The Gillette Company and Oral-B Laboratories (a division of Gillette Canada Inc.)**

**BACKGROUND**

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On 18 January 1995 Addis Limited applied to register the trade mark WISDOM CONTOUR in Class 21 for the following goods:-

Toothbrushes and parts and fittings therefore; all included in Class 21.

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On 20 June 1996 joint opponents, The Gillette Company and Oral-B Laboratories (a division of Gillette Canada Inc.) filed notice of opposition to the application. The grounds of opposition are:-

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1. Under Section 5(2) because the applicants' trade mark is identical or similar to the opponents' registered CONTOUR trade marks and the second opponents' trade mark CONTURA which is the subject of an earlier application.

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2. Under Section 5(3) of the Act in that the opponents' trade marks have a substantial reputation in the United Kingdom and that use of the applicants trade mark would take unfair advantage of or be detrimental to the distinctive character or repute of the first opponents trade marks.

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3. Under Section 3(6) because the application was made in bad faith.

The trade marks the opponents rely upon are set out below:

<b>NO.</b>	<b>TRADE MARK</b>	<b>CLASS</b>	<b>GOODS</b>	
40	1164331	LADY CONTOUR	08	Razors and razor blades, all for use by women.
45	1203804	CONTOUR	08	Cutlery (other than surgical cutlery); hand tools; shaving instruments included in Class 8; razors and razor blades;

5				dispensers, cassettes and cartridges, all adapted for and containing razor blades; parts and fittings included in Class 8 for all the aforesaid goods; but not including non-electric soldering apparatus, soldering blowpipes and non-electric soldering irons. PART SURRENDER.
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15	1265576	CONTOUR	08	Razors and razor blades; containers adapted for razors or razor blades; cartridges containing razor blades; razor blade dispensers.
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25	1273807	CONTOUR SPORT	08	Razors and razor blades; containers adapted for razors or razor blades; cartridges containing razor blades; razor blade dispensers.
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35	1345003	CONTOUR PLUS	08	Shaving instruments; razors and razor blades; dispensers, containers and holders, all adapted for razors or razor blades; cartridges containing razor blades; all included in Class 8.
40	*1589316	CONTURA	21	Toothbrushes; electric toothbrushes; bristles for the aforesaid goods; toothpicks; all included in Class 21.

\* the trade mark of ORAL-B Laboratories

45 The applicants filed a counter-statement denying the grounds of opposition. In particular they deny that the opponents have any reputation in respect of the CONTOUR trade marks for products which are the same or similar to the goods covered by the specification of this

application. They also deny that the respective trade marks are the same or similar or that the application was made in bad faith.

Both sides seek an award of costs in their favour.

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Only the opponents filed evidence in these proceedings and the matter came to be heard before me on 24 July 1998 when the opponents were represented by Mr Christopher Morcom, of Queens Counsel, instructed by Gillette Management Limited and the applicant by Mr Guy Burkill, Counsel, instructed by Hughes Clark & Co.

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### **The Opponents' Evidence**

This consists of a Statutory Declaration dated 22 October 1996 by Mr Andrew James Redpath, an Assistant Secretary of the Gillette Company who is also a Vice President of Oral-B Laboratories. He is authorised to make this declaration on behalf of both of these companies (the joint opponents). He states that the information and facts contained in the Statutory Declaration come either from his own knowledge or the books and records of the companies, to which he has full access.

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Mr Redpath first of all states that the companies are the proprietors of the registered trade marks set out earlier in this decision. In 1978 distribution of products under the trade mark CONTOUR commenced in the United Kingdom (and throughout Europe). The first product sold under this trade mark was a twin blade razor in a cartridge form which had the unique feature (at the time) of a swivel head. Subsequently other personal hygiene and grooming products were sold under this trade mark including a twin blade cartridge with an integral lubricated strip sold under the trade mark CONTOUR PLUS.

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Mr Redpath goes on to state that for many years the shaving system sold under the CONTOUR trade mark was the company's flagship shaving system, representing the most technically advanced shaving system of its time. It would appear that this position has now been supplanted by the company's SENSOR shaving system. However, Mr Redpath considers that his company possesses a very substantial goodwill and reputation in its CONTOUR family of trade marks for personal hygiene products and he exhibits at AJR1 sales figures for CONTOUR products from 1990 to 1995 in Europe and the UK. As far as the United Kingdom is concerned the figures are 12.3 million in 1993, 15.8 million in 1994 and 14.2 million in 1995.

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Because of the advent of the SENSOR and SENSOR XL shaving systems the company's CONTOUR products have lost their position as leading edge technology products and thus sales have been falling since 1990. However, Mr Redpath states that his company does not underestimate the substantial value of its reputation and goodwill under the trade marks. He is advised and believes that in 1995 a national usage study was conducted by BJM, an independent market research consultancy, to establish the number of users of his company's CONTOUR shaving systems. The results for the UK were that there was a residual user base of 1.3 million men and 432,000 women for his company's CONTOUR products. This, he says, is not surprising given the high volume of sales for a prolonged period.

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Mr Redpath goes on to state that on 3 August 1996 his company arranged for NOP Consumer Market Research to undertake a quick objective test to establish whether the public were still aware of Gillette CONTOUR products. He produces at exhibit AJR2 the summary sheets from the interviews conducted. He states that out of the sample of 77 respondents, 56 had not  
5 heard of the goods sold under the trade mark CONTOUR but that 6 out of the 77 people identified CONTOUR with Gillette (and a further person identified CONTOUR with aftershave/deodorant). The clear message that Mr Redpath deduces from the survey is that no one associated the trade mark CONTOUR with Wisdom (the applicants) or with toothbrushes but that a significant number of respondents directly associated the CONTOUR trade mark  
10 with Gillette or with shaving. Thus Mr Redpath believes that the applicants for registration will benefit from the goodwill and reputation which Gillette have in their CONTOUR trade marks and, further, that use of the trade mark applied for is likely to cause confusion and deception with regard to the high public recognition of Gillette's CONTOUR trade mark thus contravening Sections 5(2) and Sections 5(3) of the Trade Marks Act 1994.

15 Mr Redpath further states, that Oral-B Laboratories is the proprietor of the trade mark CONTURA in the United Kingdom (and in a number of other countries), and he exhibits at AJR3 a list of all the applications which have been made for the registration of the CONTURA trade mark. The application for registration in the United Kingdom was filed with the Trade  
20 Marks Registry on 28 October 1994.

Following the filing of the application for registration Mr Redpath reports that Mr Stephen Jennings, a colleague, noticed in a routine search of the United Kingdom Trade Mark Register that application number 2008229 in respect of the trade mark WISDOM CONTOUR had been  
25 filed. Subsequently, Stephen Jennings wrote on 11 April 1995 to the trade mark agents of record for this application asking that the application be abandoned. A copy of this letter is exhibited at AJR4, the response from Hughes Clark, in a letter dated 3 August 1995 and exhibited at AJR5. This states that, in the view of Addis Limited, the respective trade marks are not the same or similar; that they already had a substantial goodwill in this trade mark and  
30 had no intention of abandoning the application.

Mr Redpath is of the opinion that the reason for the delay in replying to Mr Jennings' letter was to conceal the launch of the WISDOM CONTOUR products in the United Kingdom. He goes on to say that in addition to the confusion between his company's CONTOUR trade  
35 mark and the applicants trade mark there would also be confusion between it and his company's CONTURA trade mark. In that connection he produces at AJR6 the grounds of opposition filed by Addis Limited against his company's application for the trade mark CONTURA. He notes from the statement of grounds made by Addis Limited that they believe (and their trade mark advisors believe), that WISDOM CONTOUR and CONTURA  
40 are confusingly similar.

Mr Redpath goes on to provide as exhibits AJR7a and AJR7b samples of the WISDOM CONTOUR toothbrush packaging and Wisdom's ordinary packaging. In his view, it is clear that the applicants for registration have no intention of using the trade mark WISDOM  
45 CONTOUR rather it is their intention to use only CONTOUR, which predominates on the packaging. He notes that on the CONTOUR packaging the Wisdom logo is almost invisible and is written in a smaller font than such descriptive terms as "standard head". This is in stark

contrast to the other packaging where the word Wisdom dominates the pack. He therefore believes that the applicants for registration were already aware of the opponents substantial goodwill and reputation in its CONTOUR trade marks and their earlier application for registration in respect of the word CONTURA and that the word Wisdom was added to the applicants' trade mark on the application simply to assist in overcoming the difficulties of his company's earlier trade mark registration.

Finally, Mr Redpath states that his company is suffering damage because it cannot really exploit its CONTOUR trade mark in the United Kingdom because of the launch of the WISDOM CONTOUR product. He exhibits at AJR8 a copy of a letter from John Bower, Vice President of Oral-B operations in Europe to his UK Manager explaining why the introduction of CONTURA to the United Kingdom has been delayed. That concludes my review of the evidence.

## DECISION

First of all, I deal with the ground of opposition based upon Section 3(6) of the Act which states:

**3(6)** A trade mark shall not be registered if or to the extent that the application is made in bad faith.

The provision does not attempt to indicate what is meant by "bad faith", thereby leaving it to the registrar or the courts to decide in a particular case what amounts to bad faith. Examples of circumstances where bad faith *might* be found were given in the Notes on the Trade Marks Act 1994, published by the Patent Office and based upon the notes on clauses prepared for use by Parliament. These included the following:

(ii) where the applicant was aware that someone else intends to use and/or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

In this case the applicants' attention was drawn by the opponents to their trade marks, but the fact that the applicants continued to prosecute their application does not amount, in my view, to bad faith on their part. Nor does the fact that the packaging they have used so far show that the CONTOUR element dominates the WISDOM element indicate that the applicants do not intend to use the trade mark applied for. In my view therefore no evidence has been submitted which supports the allegation that this application for registration was made in bad faith and the opposition based upon Section 3(6) is dismissed.

I turn to deal with the opposition based upon Section 5(2) of the Act which states:-

**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

5 (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,

10 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

I consider first of all the opponents earlier registrations the details of which are set out earlier in this decision. There was no dispute between the parties that these earlier registrations should be considered as earlier rights on the basis of Section 6. Each of these registrations is for or contains the word CONTOUR as the distinctive element. All of these registrations are in Class 8 and are for razors, razor blades and associated goods (though registration No. 1203804 goes somewhat wider, I have assumed that it is in relation to razors, razor blades and associated goods covered by that specification that the opponents rely on). The applicants' trade mark consists of the words WISDOM and CONTOUR and protection is sought for toothbrushes and parts and fittings therefore, which fall into a Class 21.

The first matter to be decided is whether or not the goods covered by the earlier registrations of the opponent are the same or similar to those covered by the application in suit. Clearly they are not the same and therefore I need to consider whether they could be considered to be similar. In that regard I use the test laid down by Mr Justice Jacob in TREAT [1996] RPC 281, where he said:

“I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to *goods of the same description*. I do not say this because I believe there is any intention to take over that conception directly. There plainly is not. But the purpose of the conception in the old Act was to prevent marks from conflicting not only for their respective actual goods but for a penumbra also. And the purpose of *similar goods* in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think 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 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.

This is rather an elaboration on the old judicial test for *goods of the same description*. It seeks to take account of present day marketing methods. I do not see any reason in principle why, in some cases, goods should not be similar to services (a service of repair might well be similar to the goods repaired, for instance). I do not pretend that this list can provide other than general guidance. The fact is that the Directive and hence our Act have introduced an area of uncertainty into the scope of registration which in many cases can only be resolved by litigation.

Taking each of the factors set out by Jacob J in turn, I consider first of all the respective uses of the respective goods. Razors, razor blades and associated goods are used by both men and women for the removal of facial and body hair whereas toothbrushes are intended for the purpose of cleaning, or removing plaque from, teeth. The respective goods are not used for the same or similar purposes. Therefore, in my view, the uses of the respective goods are different. However, the respective users of the respective goods are the same. Most of the adult population of the United Kingdom, whatever their gender, clean their teeth and remove facial or body hair by means of shaving. The physical nature of the goods is, however, different, in my view. Shavers contain a handle at the end of which is a sharp blade for the purpose of removing facial or body hair, whereas a toothbrush consists of a handle together with a head containing bristles (usually of plastic) which may be of a soft, medium or hard texture. Thus, the head of the toothbrush consisting of bristles is of a completely different nature to that of a razor which consists of a sharp blade. The respective trade channels through which the goods reach the market and whether, in the case of a supermarket, they are likely to be found on the same or different shelves are the final factors. In my view the general channels of trade are likely to be the same. There was no evidence before me that the respective goods are usually manufactured, by the same companies, however I have no doubt, whatever their source, that each are distributed through the same wholesalers and retailers and therefore the two will come into contact in that context. I reach this view because I do not think that either razors or toothbrushes are specialised goods which would have their own particular channels of trade. However, I am not convinced that toothbrushes and razors do sit together in the same sections of supermarkets, for example. It seems to me that the opponents use of the general term 'personal hygiene products' to cover both toothbrushes and razors is far too wide a general description. As Mr Burkill said at the Hearing "You do not think of razor blades when you brush your teeth. If you do, you are not going to brush hard enough. They are quite different products. One of them has got the sharpest possible blade and the other is something you stick in your mouth and waive up and down". I note in fact that Mr Redpath also groups his companies goods together under the term 'grooming products' which I consider to be a more apt term for razors and razor blades. Simply because the trade



channels through which they come are the same and the users of the respective products are the same does not to my mind justify a claim that the goods themselves are similar. Indeed I am re-enforced in this by the comment of Jacob J in the TREAT case at page 297 lines 16-24, where he said:-

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“Turning to the present case, the two products to some extent have the same use, but broadly in practice have different uses. They are hardly in direct competition and consumers will find them in different places in supermarkets. Their physical nature is somewhat different, the Robertson product being hardly pourable and really needing spooning out of the jar whereas the British Sugar product is meant to be poured out of the small hole in the plastic top. Moreover it seems that for the purposes of market research the two products are regarded as falling within different sectors. Taking all these things together, I think the spread is not to be regarded as *similar* to the dessert sauces and syrups of the registration”.

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He found that in some respects the goods had the same characteristics but nevertheless were not similar goods. Similarly, taking all the relevant factors into account, in my view razors, razor blades and associated goods falling into Class 8 are not similar goods to toothbrushes falling into Class 21.

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As I have held that the respective goods of the opponent and the applicant are neither the same nor similar that effectively decides the matter under Section 5(2) in relation to the comparison of the opponents registered CONTOUR trade marks and the applicants trade mark. However, in the event that I am found wrong on that point I go on to consider whether the respective trade marks are the same or similar.

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In that connection I follow the approach adopted by the European Court of Justice (ECJ) in Sabel v Puma [1998] RPC page 199. The Court considered the meaning of Article 4(1)(b) of the Directive which is identical to Section 5(2) of the Act. At page 223, the ECJ stated:-

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In that respect, it is sufficient to note that, unlike Article 4(1)(b), those provisions apply exclusively to marks which have a reputation and on condition that use of the third party’s mark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

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As pointed out in paragraph 18 of this judgment, Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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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.

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10 The mark the subject of the application is WISDOM CONTOUR and the opponents earlier registrations consist of the word CONTOUR, solus and with other elements. In respect of the comparison of the trade marks themselves, I take the view that the respective trade marks are similar and I take fully into account the test set out by the European Court in doing so I note that the word CONTOUR is common to both trade marks and as a result of the global  
15 appreciation of the visual and oral comparisons of the trade marks this fact is likely to result in the public at large being confused as to the origin of the respective goods. In that connection I bear in mind BULOVA ACCUTRON [1969] RPC 102 which dealt with the comparison of the trade marks ACCURIST and BULOVA ACCUTRON, under the provisions of the Trade Marks Act 1938, but the points made then on the comparison of those trade marks are still apt  
20 in consideration of this case under the Trade Marks Act 1994. In that case the Court upheld the Assistant Registrar's decision where he concluded:-

25 "The present issue is not simply a comparison of two words; but the comparison of one word with a composite mark the second component of which has been held to be confusingly similar to ACCURIST. Can this component be said to be rendered innocuous now that it appears with and is preceded by BULOVA? I do not think that I can hold that it is and that there is any less risk of deception or confusion. I think that a person having, for example, an imperfect recollection of ACCURIST is just as likely to confuse it with ACCUTRON in the composite mark. As BULOVA and  
30 ACCUTRON do not hold together as a phrase or present a wholly different meaning from 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. A person meeting BULOVA ACCUTRON and confusing the latter word with ACCURIST is, I think,  
35 likely to consider that BULOVA is another mark which he had previously not observed or which had not been drawn to his attention before."

40 In my view the circumstances of this case are the same and anyone who was aware of the trade mark CONTOUR may be confused or deceived as to the origin of the goods if they were to come across the applicants' WISDOM CONTOUR trade mark.

Insofar as the comparison between the applicants WISDOM CONTOUR trade mark and the opponents' CONTURA trade mark which is also the subject of an earlier application which again was not disputed was an earlier right under the provisions of Section 6, I can do no  
45 better than refer to the parallel opposition proceedings between the two parties numbered 44495 where I have held that the word CONTURA is not similar to the word CONTOUR. At page 6 lines 26-36 I said:

Given my findings in relation to Section 9(1)(c) I have no hesitation in stating that the trade mark CONTURA has no direct reference to the character or quality of the goods to be sold under the trade mark and therefore also qualifies under Section 9(1)(d). Mr Burkill was concerned that registration of the word CONTURA would enable the applicants to prevent others from using the word contour in respect of the same or similar goods and thus, paraphrasing the words of the then Master of the Rolls Cozens-Hardy L J in the ORLWOOLA case, “allow wealthy traders to monopolise part of the great common of the English language unfairly to the exclusion of other people”. My finding is based upon the fact that there is no similarity between the two words. Had there been so then the trade mark would not have been acceptable for registration because the word contour does have a meaning insofar as toothbrushes are concerned - the head or handle being shaped to fit either the mouth or hand.

That was in the context of deciding the registrability of the trade mark CONTURA under the provisions of the Trade Marks Act 1938 but nevertheless it is, I think, relevant in this case.

Taking into account all of the points above I consider that the opposition based upon Section 5(2), of the Act fails.

I go on finally to consider the grounds of opposition based upon Section 5(3) of the Act, where the opponents’ claim that the use of the trade mark applied for is without due cause and would therefore take unfair advantage of or be detrimental to the distinctive character or repute of the opponents’ trade marks which are registered and therefore protected (as required by this particular provision of the statute).

The opponents have, through their evidence, sought to demonstrate first of all that they have a reputation in respect of the trade mark CONTOUR which is protected in the United Kingdom in respect of razors, razor blades and associated articles in Class 8. They have done this principally by means of a survey which showed, in their view, that a substantial proportion of the population directly associated the CONTOUR trade mark with the opponents or with shaving. I have to say that I do not consider that Mr Redpath’s deduction is one with which I can agree. Only six out of the seventy-seven respondents were able to associate the trade mark CONTOUR with Gillette and this in my view is not a significant number. Further, I consider that there were in any event some defects in respect of the survey itself. As Mr Burkill pointed out, the questions were to some extent leading and therefore the survey fails to support, in my view the opponents submissions that they had a reputation in the trade mark CONTOUR. Nevertheless, I consider that the sales figures given in Mr Redpath’s evidence in relation to the volume of products sold under the CONTOUR trade mark in respect of razors and razor blades does clearly indicate that the opponents had a reputation in respect of those goods. However, I am given no evidence to indicate that that reputation extends beyond those goods.

As indicated above I am not prepared to accept at face value that razors and razor blades can be categorised under the term ‘personal hygiene products’, or that the applicants goods can be similarly categorised, without some clear and unequivocal evidence that this is the case or alternatively that there is some association between the respective goods. Further, in order to satisfy the requirements of Section 5(3) it is necessary to establish not only that a protected

trade mark has a reputation but a would-be opponent needs to demonstrate that the use of the later trade mark is without due cause and would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier trade mark. Apart from Mr Redpath's statement that "It is likely that the applicants for registration will benefit from the goodwill and reputation which Gillette have in their CONTOUR trade mark" there is no indication of how the use of the later trade mark would take unfair advantage of the opponents' trade marks, given that they are used or proposed to be used in respect of different products. Similarly, there is no indication of how use of the applicants' WISDOM CONTOUR trade mark is likely to be to the detriment of the distinctive character or the reputation of the opponents CONTOUR trade marks. In that connection I note that the opponents admit that their reputation in respect of the word CONTOUR for razors and razor blades is diminishing as they increase promotion of their SENSOR trade mark for the same goods. The results of the survey confirm this fact.

In the circumstances I take the view that whilst the opponents do have a reputation, which may be becoming a residual reputation, in respect of the trade mark CONTOUR for razors, razor blades and associated goods, this reputation does not extend beyond this, or at least I have no evidence before me to that affect. Similarly, I have no evidence that the use by the applicants of their WISDOM CONTOUR trade mark will have any effect on the diminishing reputation of the opponents' trade marks or that there is likely, as a result of any use by the applicant, to be any damage caused to the opponents. In the circumstances I find that the grounds of opposition under Section 5(3) are not made out and therefore the opposition under this ground is dismissed.

The opposition having failed on all grounds I order that the opponents pay to the applicants the sum of £400 as a contribution towards their costs.

**Dated this 12 day of October 1998**

**M KNIGHT  
FOR THE REGISTRAR  
THE COMPTROLLER GENERAL**