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

IN THE MATTER OF APPLICATION No 1560510
BY KASTLE HOLDINGS LTD
TO REGISTER A SERIES OF THREE TRADE MARKS IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 47092 BY FRASER MUIR HOLDINGS LTD

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BACKGROUND

On 28 January 1994, Mates Vending Ltd of Lichfield Road Industrial Estate, Tamworth, Staffordshire, B79 7XD applied under Trade Marks Act 1938 for registration of a series of three trade marks SMILEFRESH / SMILE FRESH / SMILE FRESH (stylised M) in respect of:

"Cleaning, polishing, scouring and abrasive preparations all being primarily for oral use; oral hygiene and dental preparations, substances and compositions; toothpaste; tooth gel; dentifrice; mouth wash; dental floss; breath freshener; all included in Class 3"

The marks were assigned, on 2 December 1996, from Mates Vending Ltd to Kastle Holdings Ltd, of 1 Lagrange, Lichfield Road Industrial Estate, Tamworth, Staffordshire, B79 7XD.

The marks are reproduced below for ease of reference:

SMILEFRESH

SMILE FRESH

SMILE FRESH

On 25 June 1997, Fraser Muir Holdings Ltd filed notice of opposition to the application. In summary the grounds of opposition are:

1) The opponents are the applicants for the trade mark number 2032327 SMILE in logo form for "soaps, perfumery, cosmetics" in Class 3.

2) The opponents have used the mark SMILE "for many years" in respect of the goods in application 2032327.

3) The applicants' marks so nearly resemble the mark of application 2032327 as to be likely to deceive or cause confusion and that the goods of application 1560510 are the

same goods or description of goods as those of application 2032327 and the goods upon which the opponents have used the mark of the application.

4) Registration of application 1560510 would be contrary to the provisions of Sections 11 and 12(1) of the trade Marks Act 1938 as amended.

5) The registrar should exercise his discretion under Section 17 and refuse the application.

The applicants filed a counterstatement denying all the grounds. The applicants also ask the Registrar to exercise his discretion in their favour and both sides seek an award of costs in their favour. Only the opponents filed evidence in these proceedings. By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the Trade Marks Act 1938 (as amended) unless otherwise indicated.

OPPONENTS' EVIDENCE

This takes the form of a statutory declaration, dated 25 February 1998 by Julian George Shuba, a director of Fraser Muir Holdings, the opponents. Mr Shuba has been a director of the company since 1977. Mr Shuba states that his company's application 2032327 has proceeded to registration only in respect of the logo version of the mark (it appears that the original application was for a series of two marks, the second mark being the word SMILE in block capitals), and that the opponents have used the mark of registration 2032327 up to the time of his statutory declaration. The mark registered is as follows:

Mr Shuba states that the opponents first used the mark in the UK "in 1982 or earlier" and that it has been used continuously since. He provides figures for the retail value of goods sold under the mark and also figures for advertising:

Year	Retail value £	Advertising
1991	95,000	5,000
1992	100,000	7,000
1993	115,000	10,000
1994	80,000	10,000
1995	85,000	5,000

Mr Shuba confirms that the product has been sold in towns throughout the UK. The products have been advertised in trade magazines and technical leaflets have been issued. A photocopy of

a sample of the packaging used (for what product it is unclear) is provided and shows the use of the SMILE logo. Similarly, copies of advertisements for cosmetics have been provided and again show use of the SMILE logo. Only one of these advertisements carries a date (1993), and it is not clear which magazines / newspapers these advertisements appeared in.

Finally Mr Shuba restates his belief that if the applicants' mark is registered then confusion would occur.

That completes my review of the evidence.

DECISION

The main grounds of opposition are Sections 11 and 12 of the 1938 Act. These read as follows:

> *"11. - It shall not be lawful to register as a service mark or part of a service 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."*
>
> *12. - (1) "Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of*
> *(a) the same goods,*
> *(b) the same description of goods, or*
> *(c) services or a description of services which are associated with those goods or goods of that description."*

The opponents' mark was applied for on 2 September 1995 and therefore has a later filing date than the applicants' mark, I do not consider that the opponents can succeed under Section 12(1) if they fail under Section 11. I shall therefore take the Section 11 ground first.

Under this heading I must consider the actual user of the opponents' mark. It is stated that the opponents had used their mark for approx. 12 years at the relevant date, 28 January 1994. The exhibits filed relate to use in 1993 and show the mark in the following way:

The word SMILE appears together with the words "cosmetics" and "make-up". The opponents state that their registered mark is the word SMILE, however in use it resembles SMILES.

The established test for this section is set down in Smith Hayden and Company Ltd's application (Volume 63 1946 RPC 101) later adapted by Lord Upjohn in the BALI trade mark case (1969 RPC 496). Adapted to the matter in hand the test may be expressed as follows:

> Having regard to the user of the opponents' mark SMILE (in logo form), is the tribunal satisfied that the series of three marks applied for, SMILEFRESH / SMILE FRESH / SMILE FRESH (stylised M), 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?

I consider firstly the marks themselves. For this purpose I take into account the guidance set down by Parker J in Pianotist Co's application (1906 23 RPC 774 at page 777):

> *"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."*

The opponents' mark consists of the single word SMILE, albeit in a logo form (see above). The applicants have a series of three marks each of which is effectively made up of the two words SMILE and FRESH. In the first mark these words are joined, in the second are shown as two words and in the third mark they are shown as two words with the M in SMILE being stylised. It is accepted that the beginnings of marks are usually more important than their endings. However, given that the applicants' marks consist essentially of two words whereas the opponents' mark consists of one (stylised) word. Both the opponents' and applicants' trade marks have only a small degree of distinctive character and are therefore entitled to a commensurate degree of protection.

So far as the sound of the marks is concerned although they obviously all begin the same, the applicants' marks have two additional syllables compared to the single word of the opponents' mark. There is a tendency for people to slur the ends of words, but even allowing for this and the notion of imperfect recollection I do not consider there is a real likelihood of confusion arising from oral use of the marks.

The opponents' mark has a number of dictionary definitions all of which are very similar and can be summarised as a facial expression characterized by an upturning of the corners of the mouth, creating an agreeable appearance showing amusement, friendliness etc. The applicants' mark also implies a pleasant happy appearance but the additional word (FRESH) adds to the concept the image of a clean, invigorated and healthy appearance.

I must also consider the goods themselves, the type of customer and the surrounding

circumstances. The opponents' evidence indicates that their mark has been used on goods designed to aid the appearance of the skin, either cleaning it, hiding imperfections and colouring or ensuring a pleasant odour. In contrast the applicants' goods are concerned with the removal of detritus and odours from the mouth. In my experience the products would not usually be sold in close proximity to each other.

Taking into account all of the factors and comparing the marks as wholes, I consider that the degree of similarity between the mark SMILE and the series of three trade marks SMILEFRESH / SMILE FRESH / SMILE FRESH (stylise M) is insufficient to give rise to a real likelihood of confusion under Section 11. The opposition under this Section fails.

I now consider the position under Section 12. The opponents' case is slightly stronger under Section 12 as their registration for "cosmetics" could be said to include cosmetic toothpaste. But as I indicated earlier in this decision the applicants' application was filed prior to the opponents' application. It is well established that the matter must be determined as at the date of application. At that date the opponents' mark was not on the register. Indeed it was not filed until 2 September 1995. The later filing date is therefore fatal to the opponents' case under Section 12. However, in case I am wrong about this, I would regard the later filing date of the opponents' application as a "special circumstance" under Section 12(2) and still find in the applicants favour.

As the opposition has failed, the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £235.

Dated this 9 Day of April 1999

George W Salthouse
For the Registrar
The Comptroller General