

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

IN THE MATTER OF TRADE MARK APPLICATION **m** 1437070
BY REMINGTON PRODUCTS INC
TO REGISTER THE MARK

TRAVEL PLUS 

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION **m** 41070
BY THE GILLETTE COMPANY

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

IN THE MATTER of trade mark
application **m** 1437070
by Remington Products Inc
5 to register a mark in class 8

and

IN THE MATTER of opposition
thereto under opposition **m** 41070
by The Gillette Company

10 DECISION

Remington Products Inc applied on 6 August 1990 under section 17(1) of the Trade Marks Act 1938 to register the mark shown below in Class 8 in respect of the following specification of goods:

TRAVEL PLUS 

15 “Electric shavers, all suitable for use by travellers; parts and fittings for the aforesaid goods; all included in Class 8.”

The application was given the number 1437070, and was published for opposition purposes on 29 June 1994. On 29 September 1994 The Gillette Company formally opposed the application.

I summarise the grounds of opposition as follows:-

20 **M** Section 12(1) — The opponent claims that the mark in suit so nearly resembles a number of trade marks already on the Register (listed below) in respect of the same goods or the same description of goods as to be likely to deceive or cause confusion contrary to Section 12(1) of the Act.

25 **M** Section 11 — By reason of the goodwill and reputation arising from the use of the opponent’s PLUS marks, use by the applicant of the mark in suit would lead to deception and confusion.

30 **M** Section 11 — Use of the mark applied for upon or in relation to electric shavers which were not adapted for use in aeroplanes would be deceptive and could pose a danger to human health and the registration thereof would be contrary to the provisions of section 11.

M Section 10 —The opponent contends that the mark applied for is not distinctive of the applicant’s goods and is not adapted or capable of distinguishing the goods of the applicant within the meaning of section 10.

5 M Section 17(1) — The applicant cannot validly claim to be the proprietor of the mark and did not have at the date on which the application was filed a present and definite intention of using the mark in the United Kingdom.

Finally, the opponent asks that the general discretion of the Registrar be exercised adversely to the applicant.

The relevant details of the existing registrations relied upon by the opponent are as follows:

10

Marks	m	Journal	Page
PLUS	1,216,788	5577 / 5728	1887 / 1732
CONTOUR PLUS	1,345,003	5809	655
BLUE II PLUS	1,505,682*	6015	1311

15 (* Mr Morcom accepted that the registration date of this mark is later than the filing date of the application in hand.)

In response, the applicant filed a counter-statement admitting the existence of the opponent’s registrations, but denying each of the grounds pleaded.

Both parties seek an award of costs in their favour.

20 Both parties also filed evidence, following which the matter came to be heard on 31 March 1999. At the hearing, the applicant was represented by Miss Fiona Clark of Counsel, instructed by Edward Evans & Co. The opponent was represented by Mr Christopher Morcom of Her Majesty’s Counsel, instructed by Gillette.

25 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. Nevertheless, these proceedings having begun under the provisions of the Trade Marks Act 1938, 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, and unless otherwise indicated, all references in the remainder of this decision are references to the provisions of the old law.

Opponent’s Evidence

30 The opponent filed statutory declarations by Andrew James Redpath and Steven John Jennings. At the time, Mr Redpath was the Assistant Secretary of the Gillette Company, and a Director of Gillette UK Limited — a wholly owned subsidiary company responsible for the manufacture and/or marketing of various products in the United Kingdom.

Mr Redpath confirms that Gillette first became involved with razors and shaving instruments in 1903 under the name of The Gillette Safety Razor Company. In this, the first year of sales, 51 razors and 168 blades were sold in the United States. In 1905 The Gillette Company established a UK subsidiary for the manufacture and sale of its products. The UK subsidiary functioned from a number of sites until in 1935 Gillette purchased land at Isleworth for a completely new factory. In 1937 the Lord Mayor of London opened the new factory (which is still in operation today), which is now Gillette's European Headquarters and forms the basis for its Eastern Hemisphere operations.

Since its inception, Gillette has diversified its business activities and interests with the acquisition of companies such as Oral-B Laboratories, Braun AG, Parker, Waterman and Papermate, Jafra and Liquid Paper. However, the blade and razor business is the core activity and the 1994 Company Accounts show that from total sales of \$6 billion, \$2.3 billion related to sales of blades and razors alone.

It is Mr Redpath's opinion that most people associate Gillette with shaving alone, and are largely unaware of its diverse interests.

In 1984, Gillette applied for and was granted registration in the United Kingdom of the trade mark PLUS (m 1216788) in respect of shaving products. This was shortly followed by the launch of the CONTOUR PLUS shaving system in 1986. Mr Redpath exhibits copies of the packaging, and a report from the advertising agency handling the promotion of CONTOUR PLUS. In 1988, Gillette also registered the trade mark CONTOUR PLUS (m 1345003) in the United Kingdom.

Later on, Gillette added its G II PLUS and BLUE II PLUS ranges. Together with the earlier CONTOUR PLUS mark, Mr Redpath refers to these collectively as Gillette's PLUS marks. He says that the PLUS marks make a very significant contribution to Gillette's turnover in the UK. By way of example over 425 million units of PLUS branded goods, have been sold in the UK from 1985 to date. Mr Redpath provides the following details of the UK turnover by value and volume, together with details of the television advertising expenditure:-

	VALUE	VOLUME (units)	Advertising
1985			£1,658,700
1986	£2,501,000	16,159,000	£3,043,000
1987	£5,469,000	32,848,000	£2,898,000
1988	£7,785,000	44,636,000	£3,418,000
1989	£10,757,000	60,065,000	£4,235,200
1990	£11,806,000	57,885,000	
1991	£11,552,000	50,935,000	
1992	£11,227,000	47,291,000	
1993	£10,607,000	41,810,000	
1994	£12,529,000	50,284,000	£1,141,300
1995			£27,500


Whilst the brand name PLUS has been used in conjunction with some of Gillette's other brands, Mr Redpath states that PLUS is the brand name which the company has adopted in relation to shaving systems incorporating a lubricating strip. Moreover he says that in the United Kingdom Gillette has an exclusive right to use of the word PLUS in relation to shaving products; there are no other registered trade marks on the UK register which contain the word PLUS in relation to shaving products.

Mr Jennings is Gillette's Trade Marks Manager and a Registered Trade Mark Attorney. His statutory declaration exhibits a printout of all the trade marks, whether registered, lapsed, pending or abandoned contained in Class 8 and featuring the character string "PLUS". The exhibit runs to eleven pages, but Mr Jennings stresses that apart from the pending application which is the subject of this opposition, there are no other trade marks containing the character string "PLUS" in relation to razors and razor blades, whether electrically operated or not. In particular, Mr Jennings draws attention to application **m** 1308360 for the mark SCHICK CONFORT PLUS, which he says was abandoned as a result of Gillette's opposition to it.

On this basis Mr Jennings is also of the opinion that Gillette has a de facto monopoly in relation to the word "PLUS" for razors and razor blades.

Applicant's Evidence

In support of the application, Remington filed a statutory declaration by Allen Stephen Lipson. Mr Lipson's job title is: Vice President Administration, General Counsel and Secretary of Remington Products Company LLC, the successor to the business and assets of Remington Products Inc.


Mr Lipson states that Remington first started using the trade mark **TRAVEL PLUS**  in the United Kingdom in 1987 and has used the mark continuously in the United Kingdom since that date. The mark has been used and is being used in the United Kingdom in relation to a range of electrical appliances suitable for use by travelers, these including battery operated travel shavers, travel irons, travel hair dryers and travel clocks. These products are sold as a unified range extensively in the United Kingdom through major high street retail chains, including Boots, Argos, Curry's, Dixons, and Comet as well as through mail order houses and other major retailers and leading electrical retail outlets. Thus sales have occurred throughout the United Kingdom and on an extensive scale, with total sales of the range of products in the United Kingdom being in excess of £14 million up to and including 31st December 1996. In relation specifically to shavers, Remington's turnover in the United Kingdom for the period October 1990 to December 1996 was approximately £2,085,800.

Mr Lipson goes on to say that despite these sales, neither he nor anyone in his company nor its British subsidiary, Remington Consumer Products Limited, is aware of a single instance of confusion between the products of Gillette sold under the mark and the products of The Gillette Company or of Gillette UK Limited. (I simply note here that Mr Lipson's evidence regarding the knowledge of others in this matter is strictly hearsay.)

In relation to Gillette's registration **m** 1216788 (PLUS), Mr Lipson is keen to point out that it has been cancelled in respect of all goods except "razor blades incorporating lubricating means or incorporating lubricant inserts or for razors or containers for the aforesaid razor blades".

Mr Lipson denies that his company's travel shavers are goods of the same description as razors, razor blades or containers for razor blades. He adds that Remington's travel shavers are sold through electrical retailers such as Dixons and Curry's. To the best of his knowledge, neither Dixons nor Curry's sell razors or razor blades. Moreover, according to Mr Lipson, even in shops such as Boots, where Remington's travel shavers will be on sale simultaneously with Gillette's razors and razor blades, the respective products are located in entirely different parts of the shops.

Remington has registered the mark in suit in the United States (m 1471214) in Class 8 in respect of "Electric shavers, attachments and parts thereof." Not only does Mr Lipson consider this to be significant, but he also claims that Gillette's corresponding US trade mark registrations were not cited against Remington's US Trade Mark m 1471214 and, furthermore, that Gillette made no attempt to oppose the registration of that trade mark in the United States of America, their home market.

Reviewing the opponent's evidence, Mr Lipson comments that the opponent has never used the trade mark PLUS. He says that the evidence shows use of the marks CONTOUR PLUS and G II PLUS and some use, after the material date, of the mark BLUE II PLUS. In his view there is no possibility of confusion between Remington's mark **TRAVEL PLUS**  and either of the trade marks CONTOUR PLUS or G II PLUS. He claims that his view is supported by the inability of the opponents to provide any evidence of confusion in the market place.

Opponent's Evidence in Reply

In reply to the applicant's evidence, Gillette filed a statutory declaration by Timothy Nicholas MacCaw. It appears that Mr MacCaw took over from Mr Redpath as Assistant Secretary of The Gillette Company at some point after the opponent's first round of evidence was completed.

In part, Mr MacCaw's evidence addresses the matter of similarity of wet blade razors and electric shavers. To this end, he exhibits a copy of the Remington 1997-1998 catalogue, which features a range of razors called powered wet blades, where an electrically operated razor takes a standard 'wet' razor blade. Mr MacCaw says that product developments such as this blur the distinction between wet and dry shaving.

Unfortunately there is a problem with Mr MacCaw's evidence. It became clear at the hearing on 31 March that the statutory declaration had been prepared for Mr Redpath to execute, but that as a result of internal reorganisations, Mr MacCaw signed the declaration. Whilst the front page of the declaration has been amended to show Mr MacCaw's name instead of Mr Redpath's, there are several references within the body of the declaration that clearly indicate that no other changes were made. For example in paragraph 8, Mr MacCaw refers to "... my paragraph 14 of my Declaration of 21st November 1995". In actual fact, the reference is to Mr Redpath's first declaration. I indicated to Mr Morcom at the hearing that I was unhappy to put much weight on Mr MacCaw's evidence in the circumstances since I could not be certain how much of it was his evidence and how much was Mr Redpath's.

Consequently when Mr MacCaw says “I know from experience that these blades also fit a number of wet razors including Gillette razors”, I have to bear in mind that this statement was probably prepared for Mr Redpath, and may be hearsay coming from Mr MacCaw.

5 After the formal evidence rounds had been concluded, the opponent sought and was granted leave to file further evidence in the form of a second statutory declaration by Steven John Jennings. This additional evidence concerns an action taken by Gillette against another UK company, Sterling Four Limited, that was using the trade mark PLUS in relation to razors with a lubricating strip. The action was resolved when Sterling Four gave an undertaking, dated 19 October 1998, to cease all dealing in razors and razor blades by reference to the word “PLUS”. Mr Jennings says that the action taken against Sterling Four proves that the registration upon which this opposition is based is being enforced against third parties.

15 Against this background, I now turn to consider the respective grounds of opposition. Mr Morcom indicated at the commencement of the hearing that the opponent did not intend to pursue the second of the two grounds based on section 11 — ie. that use of the mark in relation to shavers that are not adapted for use in aeroplanes would be deceptive and could pose a danger to human health.

Section 10

This section of the Act is as follows:

20 **10** (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to the limitations, in relation to use within the extent of the registration.

25 (2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

30 (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

35 Mr Morcom’s case under section 10 was that the applicant’s mark consists of two ordinary words TRAVEL and PLUS, with what he described as a non-distinctive device of an aircraft. He submitted that the words themselves were also prima facie non-distinctive for the goods in question. Although the applicant’s evidence shows that the mark has been used on fourteen million pounds worth of product in the TRAVEL PLUS range between 1987 and 1996, Mr Morcom reminded me that there was no breakdown of this figure to enable the Registrar to determine what proportion of sales had taken place prior to the material date, 6 August 1990. Furthermore, it was accepted by Miss Clark on behalf of the applicant that there was no

evidence that the mark had been used on electric shavers prior to the material date. Thus all the prior use was in relation to other electrical appliances, eg hair dryers, travel clocks etc..

5 In response, Miss Clark submitted that the applicant's mark is inherently capable of distinguishing, and in support of her position she pointed to the fact that the opponent's PLUS mark had been accepted in Part A of the register. In other words, if the mark PLUS is accepted as being distinctive for razor blades etc, then how can the applicant's mark (which includes the 'distinctive' element PLUS) be found to be incapable of distinguishing in respect of electric shavers. In the event, and despite some very interesting submissions from both Counsel, I have decided the question by looking at the applicant's mark alone, and without
10 being influenced in either direction by the circumstances of the opponent's earlier registration.

TRAVEL PLUS 

The applicant's mark (see left) is a combination of three elements, each of which on its own might be considered lacking in distinctiveness in relation to electric travel shavers. But considering the mark as a whole, as I believe I must, then I have little hesitation in deciding that the mark is capable of distinguishing the applicant's goods from the goods of others. The opposition under section 10 fails accordingly.
15

Section 12(1)

This section of the Act reads as follows:

20 "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
25 goods of that description."


The reference in this section to a near resemblance is clarified by section 68(2B) of the Act which says that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

30 Mr Morcom accepted that the opponent was unable to rely upon its BLUE II PLUS mark in relation to either section 11 or section 12 as it is a later mark. For the purposes of section 12(1), the opponent's case rests on its PLUS and CONTOUR PLUS registrations.

The standard test for opposition under section 12 has been laid down in the *OVAX* case¹ by Mr Justice Evershed. Applied to the facts of the present case, the test may be expressed as follows:

35 Assuming use of the opponent's marks PLUS and CONTOUR PLUS in a normal and fair manner for any of the goods covered by these registrations, is the tribunal satisfied

¹Smith Hayden & Co Ltd's Application [1946] 63 RPC 97

that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant uses the mark **TRAVEL PLUS**  normally and fairly in respect of any goods covered by the proposed registration?

5 So far as I am aware, the test advanced by Mr Justice Parker in the *PIANOTIST* case² remains the appropriate test for similarity of marks in proceedings under the 1938 Act and I propose to apply it in this case. The relevant passage reads:-

10 “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 man 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.”

20 Miss Clark did not accept that the goods in respect of which the opponent’s marks are registered are the same as, or of the same description as, the goods contained in her application. Indeed, she made what I can only describe as a valiant attempt to distinguish between razors and electric shavers on the basis of the criteria originally laid down in *PANDA*³, and subsequently elaborated by Mr Justice Jacob in *TREAT*.⁴ To my mind, the high point of her argument was that most people who shave tend to favour either wet shaving with an open blade razor, or dry shaving with an electric shaver, and that apart from occasional deviations, will not usually vary significantly. To this extent, the argument runs, the respective goods do not compete with each other. In a sense, it is true that the two methods of shaving are not absolutely interchangeable for one requires water and the other requires electricity (mains or battery).

30 Having said that, Mr Morcom was able to point to a particular product in the applicant’s catalogue (exhibited to Mr MacCaw’s statutory declaration) called a ‘powered wet blade’ which is advertised as providing “the closeness and control of a blade with the speed and safety of a dry shave”. It seems to me that powered wet blades are a hybrid form of shaving instrument, blurring the boundary between the two established means for shaving. Nevertheless there is no suggestion in the evidence that they were in existence at the material date, and consequently it is doubtful whether I should be influenced by this development in deciding whether the respective goods are similar or not.

²In the Matter of an Application by the Pianotist Company Ld for the Registration of a Mark [1906] 23 RPC at page 777

³Jellinek [1946] 63 RPC 59

⁴British Sugar PLC v James Robertson & Sons Ltd [1996] RPC 281

Having carefully considered all the submissions on the point, I have concluded that similar goods are involved. At a fundamental level, wet blade razors and electric shavers perform the same basic function even though they achieve the end result in different ways. Moreover, the users are the same, even though individual users may have personal preferences for one type of instrument or the other. As for trade channels, although the overlap is by no means complete, the evidence shows that both products can share the same trade channels.

I go on therefore to consider whether the trade marks are similar. It is necessary to compare the trade marks as a whole when the question of the similarity of marks is in issue. In so comparing, I note that it is well established that the first syllable of a word is important for the purpose of distinction (see *TRIPCASTROID* [1925] RPC 264). In this case the first word of the applicant's mark is completely different. The applicant's mark begins with the word TRAVEL, whereas the opponent's mark m 1345003 begins with the word CONTOUR which looks and sounds very different. I have no doubt that the opponent's position under section 12(1) is strongest in respect of registration m 1216788 (PLUS), as this mark is entirely subsumed in the applicant's mark. It also not uncommon to use the prefix TRAVEL to denote a smaller or lighter version of something — eg. chess and travel chess. On the other hand, I cannot ignore my own instinct which tells me that the word PLUS is not likely to be a particularly distinctive trade mark when used on its own. The position (in terms of the distinctiveness of the mark PLUS) is not changed significantly if I assume that normal and fair use includes use with other trade mark material. Taking the best view I can of the matter, I am satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if these two marks are used normally and fairly for the respective goods; the opposition under section 12 fails accordingly.

Section 11

This section is in the following terms:

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.

The established test for objection under section 11 has been laid down in the *OVAX* case by Mr Justice Evershed and subsequently adapted by Lord Upjohn in *BALI*⁵. Applied to the facts of the present case, the test may be expressed as follows:

Having regard to the user of the opponent's marks, is the tribunal satisfied that the mark applied for, 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?

Under section 11 it is important to consider the nature and extent of the opponent's user of its marks. The evidence shows, and Mr Morcom did not seek to deny, that the opponent has

⁵BALI Trade Mark [1969] RPC 472

only used the mark PLUS in combination with other trade mark matter; the later mark, CONTOUR PLUS, being one of several examples. Furthermore, the evidence indicates that the opponent uses the mark PLUS to signify a particular form of razor blade having a lubricating strip. Nevertheless, Mr Morcom maintained that the PLUS element has always
5 been given particular emphasis, and has come to be recognised as the opponent's trade mark.

Mr Morcom also stressed that it was the applicant's responsibility under section 11 to prove that use of their mark would not cause confusion. In his submission they had not done so; the applicant had not even filed evidence showing how they use or propose to use the mark.

10 However, in the circumstances of this opposition, and in particular given my finding in relation to the likelihood of deception/confusion under section 12, I do not believe that the opposition under section 11 can succeed. Under section 12, the opponent was entitled to the benefit of notional use which would have encompassed use of the mark PLUS on its own as an indication of origin. Under section 11, I must not overlook the fact that the mark has never
15 been relied upon as the sole indication of origin, but rather it has been used to signify a particular feature (a lubricating strip) applied to any of a number of Gillette razors, eg Gillette Contour, Gillette G II, Gillette Blue II. Having regard to the nature of the opponent's user, and notwithstanding the scale of use in financial terms, I am satisfied that the mark applied for, 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
20 number of persons. Consequently the opposition based on section 11 fails.

Section 17(1)

This section reads:

25 "17(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous 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."

The issue in relation to section 17(1) is whether, at the time of filing the application, the applicant had a bona fide claim to be the proprietor of the mark and a genuine intention to use the mark. At the beginning of the hearing Mr Morcom accepted that this was not a particularly strong ground of opposition, and in the event neither Mr Morcom nor Miss Clark
30 addressed me at any length on the subject. Moreover, I have read all the evidence filed in these proceedings and I can find no support for an objection based on section 17(1). The opposition under this section fails accordingly.

Registrar's Discretion

35 There remains the matter of the Registrar's general discretion under section 17(2). During the course of the hearing, Miss Clark suggested that I might decide to exercise the Registrar's discretion by allowing the applicant to amend the specification to exclude the 'hybrid' category of shaving instruments described as 'powered wet blades'. The purpose of such an amendment would be to clarify the scope of the right being sought, having regard to product development in the field since the application was originally filed. More specifically,
40 Miss Clark suggested that "foil-headed electric shavers and rotary electric shavers" would now

be a more accurate description of the goods of interest to her client. It is clearly in the public interest to minimise any uncertainty regarding the scope of a registered trade mark, and I have therefore decided that the Registrar should only accept this application subject to the specification being amended to:—

5 “Foil-headed electric shavers and rotary electric shavers, all suitable for use by
travellers; parts and fittings for the aforesaid goods; all included in Class 8.”

10 Consequently the application will be allowed to proceed towards registration if, within one month of the end of the appeal period for this decision, the applicant files Form TM21 restricting the specification as indicated. If the applicant does not amend the specification as set out above, the application will be refused.

The applicant, having been successful in these proceedings, is entitled to a contribution towards the costs of defending the application. I therefore order the opponent to pay to the applicant the sum of **£635**.

Dated this 26th day of May 1999

15 **Mr S J Probert**
Principal Hearing Officer
For the Registrar, the Comptroller-General