

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

**IN THE MATTER OF APPLICATION NO. 1557879  
BY ADOLFO DOMINGUEZ SA  
TO REGISTER A MARK IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 43286  
BY ZINO DAVIDOFF SA**

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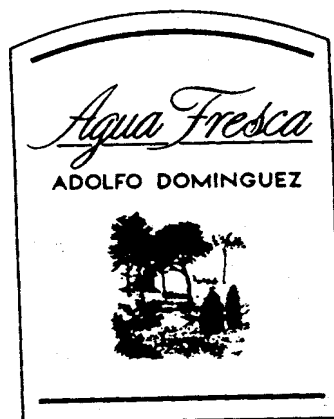
**AND**

10 **IN THE MATTER OF OPPOSITION THERETO UNDER NO. 43286  
BY ZINO DAVIDOFF SA**

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**DECISION**

20 On 4 January 1994 Adolfo Dominguez SA applied to register the mark shown below in Class  
3 in respect of "Perfumery and cosmetics; all included in Class 3; but not including toilet  
water." The application is numbered 1557879.



35 On 19 October 1995 Zino Davidoff SA filed notice of opposition to this application saying  
that they are the owners of the following trade mark:

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<u>No.</u>	<u>Mark</u>	<u>Class</u>	<u>Specifications</u>
1455766		03	Toilet preparations; preparations for the care of the skin, scalp and the body; suntanning preparations; preparations for reinforcing and strengthening nails; preparations for use in the bath; gel and foam preparations for use in the shower and the bath; preparations for toning the

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body; all being non-medicated; perfumes; aftershaves, milks, oils, creams, gels, powders and lotions; shaving foams and creams; pre-shaving foams and creams; cosmetics; eau de cologne; toilet water; soaps; essential oils, shampoos; preparations for hair; anti-perspirants; deodorants for personal use; dentifrices; depilatories; cleansing masks for the face; reconditioning phials; eye stylers, eye make-up remover; nail polish, nail base coat, nail varnish remover, cuticle lotions, nail revitalising lotions, bronzing creams, cosmetic products for the make-up, namely powders, blushers, eye shadows, eye crayons, mascara, lipsticks; moisturising concentrates; all in Class 3.

Objection is said to arise as follows:

- 20 (i) under Section 11 by reason of the use made of their mark by the opponents
- (ii) under Section 12(1) because the applicants' mark is confusingly and  
deceptively similar to the opponents' mark shown above
- (iii) under Section 17(1) in that the applicants are not the bona fide proprietors of  
the mark
- 25 (iv) under Section 17(1) in that the applicants have no intention of using the mark  
as advertised on the goods covered by the specification
- (v) that the Registrar should exercise his discretion and refuse registration

30 The applicants filed a counterstatement denying the above grounds and also saying that the words COOL and WATER are disclaimed in the opponents' mark.

35 Both sides ask for an award of costs in their favour and both sides filed evidence. The case was originally set down for a hearing on 4 April 2000. In the event the parties indicated that they were content for a decision to be taken on the basis of the papers filed (including the written submissions received). Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

By the time the 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 of that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly all references in the later parts of this decision are references to the provisions of the old law.

5 **Opponents' Evidence**

10 The opponents filed a statutory declaration, dated 4 October 1996, by Mr Georges Schelker who is a member of the Board of Directors of Zino Davidoff SA. Further statutory declarations are provided by Mr Peter Godden, Finance Director of Lancaster Group Ltd who have been granted a licence by Zino Davidoff SA to produce a wide range of toiletries and by Mr Peter Sydney Anstey Cooper, a fellow of the Institute of Linguistics who provided an English translation of the Licence Agreement from the original German language.

15 **Mr Schelker's evidence**

20 Mr Schelker says that the trade mark COOL WATER was first used in connection with an aftershave and related products in 1988, that worldwide and wholesale sales are in the region of £80 million and it has become a best selling brand. The mark was first used in the United Kingdom in 1991 in relation to a male fragrance and body products. The detail of that use is provided in Mr Godden's declaration on behalf of the licensees, Lancaster Group Ltd. They produce a wide range of toiletry products including aftershaves, perfumery, shower gel, deodorants, body lotions, using the mark. An example of the packaging showing the mark as registered is shown at Exhibit GS1. Mr Schelker says that because of the use made of their mark they have acquired a substantial reputation and believe that use of the applicants' mark will lead to a real chance of confusion in the market place since "AGUA FRESCA" is the Spanish equivalent of "COOL WATER", as indicated in the Trade Marks Journal advertisement shown as Exhibit GS2. The translation is confirmed as being accurate by the aforementioned Mr Peter Cooper at Exhibit GS3 and an extract from CASSELL'S SPANISH-ENGLISH DICTIONARY is referred to by him which also confirms this translation.

30 Mr Schelker refers to the Registry's Practice Guide at page 47 of Chapter 6 shown as Exhibit GS4 which states that Spanish is considered to be known to a reasonable and increasing number of UK residents. He says on that basis confusion will be likely between the words COOL WATER and AGUA FRESCA especially as COOL WATER is distinctive of their products, not being a descriptive phrase in conjunction with perfumery products. He also says this likelihood is increased at duty-free outlets as a large volume of their sales occur there and visitors will include Spanish-speaking tourists who will believe there is a common source origin between the applicants' and the opponents' products. He says that confusion is likely to be increased by the similarity of the scripts used in both marks, the dominance of the words in the applicants' mark and the fact that the remainder of their mark is in a different script which draws attention to the words in conflict. A copy of the opponents' Registration Certificate is provided as Exhibit GS5.

45 Mr Schelker says that as a result of their use of the mark COOL WATER internationally since 1988 and in the United Kingdom since 1991 they have acquired extensive common law rights. He also says that statutory rights have been obtained and therefore the opponents (I presume he means to say "applicants") are not the rightful proprietors of the words COOL WATER or

their Spanish equivalent. Therefore, due to the similarity between the two marks the application should be refused.

**Mr Godden's evidence**

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Mr Godden confirms the statements set out in Mr Schelker's evidence that they produce under license a range of products for the opponents and first used the mark in 1991. Exhibit PG1 shows a sample of the packaging. He provides the following estimated UK turnover figures.

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<u>YEAR</u>	<u>TURNOVER</u>
1993	2,467,000
1994	3,531,000
1995	3,501,000

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He says that figures for 1991-2 are not available but believes they will be in excess of £1 million.

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With regard to advertising he says that the products using their trademark have been advertised in publications such as GQ, Esquire, FHM, Q, Mojo, Empire, Premier, Sky, Cosmopolitan and Marie Claire, all having high circulations so that their trade mark has become well known to the general public. Examples are provided as Exhibit PG2, and Exhibit PG3 provides a media schedule illustrating by year since 1991 the costs involved in placing advertisements in the national press and on television. Further promotions and special offers in major stores are provided by the opponents and Exhibit PG4 provides copies of promotional literature illustrating this. Free samples are also provided to the general public as illustrated in Exhibit PG5. They also provide other promotions such as producing a personal stereo bearing their trade mark, an example is provided at Exhibit PG6.

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He says that there are over 700 stockists in the UK of the opponents' products, including the perfumery departments of major stores as well as perfume chains and individual chemists and pharmacists. He also says a significant proportion of UK turnover results from duty free sales, including all UK airports, and the range is featured in in-flight magazines.

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**Applicants' evidence**

The applicants filed a declaration by Juan Manuel Fernandez Novo, Financial Manager of Adolfo Dominguez S.A., a position he has held since 1992.

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He draws attention to the fact that their mark consists not just of the words AGUA FRESCA but also, he says, other more distinctive elements namely the words ADOLFO DOMINGUEZ and a small arboretum of ornamental trees. He says that these two elements are the most eye-catching and memorable components of their mark, not least because the words ADOLFO DOMINGUEZ are presented in thick block capitals in the centre of the mark. He also says that his company Adolfo Dominguez S.A. has a well-established reputation for clothing and cosmetics and would expect a customer on seeing their mark to associate it with them and no other in view of the strength of the words ADOLFO DOMINGUEZ appearing in it. Likewise,

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he refers to the strength of the word DAVIDOFF appearing in the opponents' mark. He says that consumers would not be confused.

5 He refers to the opponents' reference to the translation of AGUA FRESCA and that Spanish speaking people would be confused. He refers to the meaning of FRESCA as being not only "cool" but "fresh". Exhibit JMFN1 provides an extract from Collins Spanish-English Dictionary showing entries for FRESCA and FRESCO (being a noun for "fresh air"). He says that the word conveys cold, fresh, bracing etc and the device of trees, some of which are bending as if in a breeze reinforces "fresh" rather "cool", especially, if not Spanish-speaking.

10 He challenges the fact that "Spanish is known by a large number of UK residents" and refers to information produced by his company's trade mark attorney at Exhibit JMFN2.

15 He also challenges Mr Godden's declaration in that there is no other formal documentation to support the fact his company has a license to produce the opponents' goods and invites the Registrar to consider refusing that evidence. He also says that there is no evidence provided to show why as a result of the opponents' reputation there is a "risk of confusion".

20 He refers to the marks being considered in their totality and that the relevant words in suit, namely COOL, WATER, AGUA and FRESCA are in common use in the trade. Exhibit JMFN3 shows a series of searches by their trade marks attorney showing trade marks registered in the UK including these words and also EAU and ACQUA and refers to disclaimers of the elements COOL and WATER in the opponents' mark. He also refers to them in some detail in his statement and again notes the fact that in many instances the individual words are disclaimed. He says that owing to the popularity of these words they chose to add the other elements as they felt AGUA and FRESCA were regarded as "more descriptive than front line trade mark matter". The particular version of the mark was, he says, chosen "because of the idea of freshness which trees and water evoke." Exhibit JMN4 shows extracts from "Chemist & Druggist Directory 1997" which, he says, lists brands and trade names in use. He says this also shows common use of the words at issue. The Exhibit also shows similar information in "Chemists & Druggists Price List" 1995 and 1997.

35 He asks the registrar to find that any "extensive use", "substantial reputation and goodwill" referred to by the opponents in relation to their mark has only been in relation to the combined mark DAVIDOFF COOL WATER and no independent trade mark rights accrue to the COOL WATER element and that the opponent has been unable to show any real case of deception or confusion.

#### 40 **Opponents' evidence in reply**

45 The opponents filed evidence in reply in the form of a further declaration by Mr Schelker, dated 28 May 1998. He says that he does not believe that the words ADOLFO DOMINGUEZ and the arboretum of trees are the most "eye-catching" components of the applicants' mark and says that AGUA FRESCA is shown in a stylised script which is eye catching and similar to the one used in their own mark. He also says that the words ADOLFO DOMINGUEZ and the tree device are considerably smaller in size in the applicants' mark. He considers, therefore, imperfect recollection would lead the public to remember the mark by the

words AGUA FRESCA. He further says that greenery such as leaves, trees and flowers are commonly used by perfumery and cosmetics companies therefore the arboretum device is not distinctive for the goods and that word marks are more clearly remembered than device elements.

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He says that the applicants make reference to a “well-established reputation for clothing and cosmetics” but that no evidence is provided to support this, especially with regard to the UK. He also refers to their absence from the lists provided in eg the “Chemist and Druggist Directory 1997” extract (Exhibit JMFN4). He also says that the public will often buy such goods by the secondary brand and that COOL WATER alone is given prominence at the bottom of advertisements as shown at Exhibit PG2 of Mr Godden’s Declaration.

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He also challenges the translation of AGUA FRESCA as meaning “fresh” water and points out that the applicants agreed to the translation of “cool water”. He also maintains that Spanish is spoken by a greater number of people in the UK than the applicant’s evidence suggests and is a well-known European language.

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In response to the applicants’ query regarding the license granted to Lancaster Group Limited, a copy of the agreement is provided at Exhibit GS6 (in German). He also challenges the applicants’ assertion that the words at issue and foreign equivalents are commonly used. He also says that he is not claiming use of the individual words but in the combination COOL WATER. He says that they believe the opponents have a substantial reputation in the words COOL WATER in view of their use not only in the UK but in many other countries, as listed in Exhibit GS7 and that the applicants are not the bona fide proprietors of the identical words in Spanish. He also points out that as the applicants’ mark has not been in use in the UK they have been unable to refer to any actual instances of confusion.

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That completes my review of the evidence.

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The matter falls to be decided primarily under Sections 11 and 12 of the Act. These Sections read as follows:-

“ 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.

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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:-

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a. the same goods

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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.”

5 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states 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.

10 The established tests for objections under these provisions are set down in Smith Hayden and company Ltd's application (Volume 1946 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

15 **(Under Section 11)** Having regard to the user of the opponents' mark ((a) below), is the tribunal satisfied that the mark applied for ((b) below) 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?

20 **(Under Section 12)** Assuming user by the opponents of their mark (a) in a normal and fair manner for any of the goods covered by the registration of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark (b) normally and fairly in respect of any goods covered by their proposed registration?"

25 The marks are as follows:

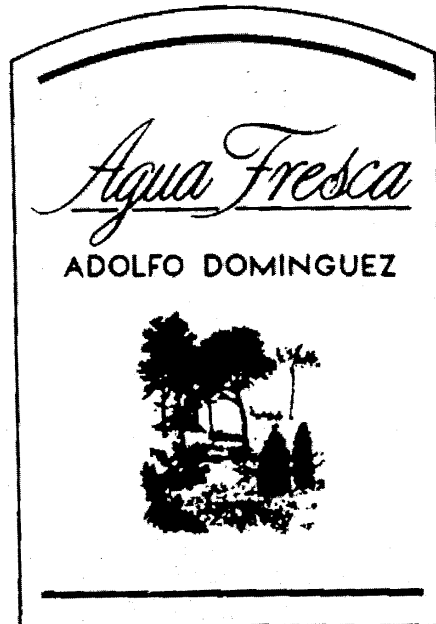
(a)

(b)

30 Opponents' mark

Applicants' mark

*Davidoff*  
*Cool Water*





I will deal firstly with Section 12. It is not disputed that the applicants' goods (perfumery and cosmetics) are the same and/or of the same description as those of the opponents. The matter, therefore, turns on the comparison of the marks themselves for which purpose I bear in mind the standard test set down in Pianotist Co's application 1906 RPC 774. More particularly in this case given the very obvious differences between the marks, it turns on the opponents' contention that the words AGUA FRESCA translate as COOL WATER and would, therefore, give rise to confusion with the opponents' mark.

Before considering the evidence and submissions in relation to the translated meaning of AGUA FRESCA I will comment briefly on two supplementary points that have arisen. The first is that the script form in which AGUA FRESCA is written is reminiscent of that used in the opponents' mark and increases the risk of confusion. I give little weight to this factor. Both parties employ a copperplate script which is commonly found on products and in advertisements and is not in itself particularly memorable or distinctive. Secondly, the applicants say in their counterstatement that rights to the words COOL and WATER have been disclaimed. In fact number 1455766 has been registered on the basis of a disclaimer "to the exclusive use, separately of the words 'Cool' and 'Water'. (my emphasis). That is to say the opponents do not have rights in the individual words but do claim rights in the combination within the overall context of the mark. Although, therefore, the applicants have filed evidence intended to show that words such as COOL, WATER, AGUA, AQUA, EAU etc are common in the trade this is not in itself an answer to the opponents' case.

Turning to the words AGUA FRESCA the opponents have filed a declaration from a qualified translator saying that the words are the recognised Spanish phrase for COOL WATER. An extract from Cassell's Spanish-English Dictionary has been provided in support of this claim. The opponents also say that the Trade Marks Registry Work Manual, an extract from Chapter 6 of which is exhibited at GS4 states that Spanish is likely to be known to a reasonable and increasing number of UK residents. Thus it is suggested that confusion will arise amongst that part of the public who speak or understand the Spanish language. The applicants for their part counter that Collins Spanish English Dictionary has AGUA FRESCA translated as cold water. They further suggest that people generally will consider the word FRESCA as meaning 'fresh', that being the nearest English word and the totality as (potentially at least) 'fresh water'.

It is apparent from the above that the evidence does not establish a single undisputed meaning for the words AGUA FRESCA. The most that can be said is that the words are capable of being translated as 'cool water'. I tend to agree with the applicants that those with a passing familiarity with Spanish, or other Romance languages, might also discern in FRESCA a connection with the English word 'fresh'. It might also bring to mind the commonly understood term al fresco. The fact of the matter is, of course, that there is no direct evidence before me from the public as to quite what they would make of the words.

So far as the Registry Work Manual extract is concerned I regard it as being of dubious relevance. The passage referred to deals with the treatment of foreign words on distinctiveness grounds under the Trade Marks Act 1994 and not conflict between marks under the 1938 Act. Of rather greater relevance is the guidance given under the 1938 Act in relation to comparison of words. The following is from Chapter 10 at 10-54

5 “ENGLISH AND FOREIGN EQUIVALENTS: The Golden Fan case [13 RPC 295] gives judicial support to the view that foreign words and their English equivalents may be confusingly similar. Current practice is not to apply this too rigidly and the following examples illustrate current practice and show that the foreign equivalent must be reasonably close either visually and/or phonetically to be in conflict.

The following words would be in conflict under Section 12:

10 ENKLE	(German)	=	ANKLE
PROMESSE	(French)	=	PROMISE
OUI	(French)	=	YES
RASTLOS	(German)	=	RESTLESS
FREGATE	(French)	=	FRIGATE

15 The following words would not be in conflict under Section 12:

20 DOM	(German)	=	CATHEDRAL
CHIEN	(French)	=	DOG
TIENDA	(Spanish)	=	SHOP
CONEJO	(Spanish)	=	RABBIT

25 There may be occasional instances where the meaning of the foreign equivalent is thought to be so well known that (despite lack of visual and/or phonetic similarity) it would be in conflict under Section 12. OUI or YES is an example of this.”

30 In their written submissions the applicants have also pointed by way of precedent to the co-existence of BOOTS and STIEFEL (said to be the German equivalent) and an opposition case where SIEMPRE and SEMPRE (‘always’ in Spanish and Italian) were allowed to be registered in the face of ALWAYS.

35 The above Work Manual extract is no more than general guidance as to the Registry’s approach and is not necessarily conclusive of the position in any particular case. However, so far as non-Spanish speakers or those with only a rudimentary knowledge of the language are concerned it is, I think, apparent that there is no visual or phonetic similarity and hence no conceivable likelihood of confusion.

40 However, what of the position of Spanish speakers or those with some knowledge of the language and the possibility (I put it no higher than that) that they might make the connection that the opponents would have me accept? The applicants have produced evidence in the form of census figures which suggest that the number of people in the UK who claim Spain as their birthplace is very small indeed (0.07% of the population). The opponents say that in numerical terms it is not an insubstantial number and in any case makes no allowance for those who have learnt Spanish. It is probably right that one should not take too narrow a view of the matter given also the freedom of movement and employment that exists within the

45 European Community.

It seems to me that the following are relevant considerations:

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S there is nothing in the nature of the products to suggest that they are directed towards those of Spanish origin or other Spanish speakers. The target market is more likely to be defined by factors such as price, exclusivity of sales outlets etc.

S the words themselves are capable of more than one translated meaning

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S there is no evidence that customers would necessarily pause to analyse the mark (or rather an element of it) or look for linguistic associations/alternative meanings. Moreover unless a Spanish speaker was equally familiar with the English language the possible translation to COOL WATER might never be apparent

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S even in the unlikely event that a small number of people did make the association it is not evidence of confusion (as opposed to recognition of a linguistic connection).

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S the words AGUA FRESCA are only part of a composite mark which contains other distinguishing features and is, as a totality, wholly different to the mark DAVIDOFF COOL WATER

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The Section 12 test set out above requires me to consider whether there is a likelihood of deception or confusion amongst a substantial number of persons. I find it highly improbable this will be the case. The opposition therefore fails under Section 12.

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This is not a case where Section 11 gives rise to significantly different considerations to those dealt with under Section 12. The range of goods in respect of which the opponents have claimed use appears to be narrower than those of registration no. 1455766 and in terms of what has been substantiated up to the material date in these proceedings mainly restricted to eau de toilette. To that extent the Section 12 ground gave the opponents a broader basis for attack. There is though one other aspect of the opponents' case on which I should comment. There is evidence in Exhibit PG2 to Mr Godden's declaration to suggest that COOL WATER has been used on its own in relation to eau de toilette. However the sample advertisements provided show the words in association with a picture of a bottle that carries the DAVIDOFF  
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COOL WATER mark in the form registered. Whilst this does establish a degree of independence for the words it is always in the overall context of it being a DAVIDOFF COOL WATER mark. I am not therefore persuaded that there is any aspect of the opponents' use which should lead me to a different conclusion to the one reached under Section 12 and, of course, my views on the words themselves remain as set out above. The Section 11 ground  
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also fails.

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Under Section 17(1) the opponents make two claims, that the applicants are not the bona fide proprietors of the mark applied for and that they have no intention of using it on the goods covered by the specification. The opponents' evidence goes to the Section 11 and 12 grounds. I cannot see that they have ever pursued the Section 17(1) grounds as a separate

matter and I can see no obvious reason for finding against the applicants on either of the issues raised. Nor have any other circumstances been brought to my attention which suggest I should refuse the application in the exercise of the Registrar's discretion.

5 As the opposition has been unsuccessful the applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £435. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

10 **Dated this 27 day of April 2000**

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**M REYNOLDS**  
20 **For the Registrar**  
**The Comptroller General**