

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2158570
BY JANCHEM DIRECT LIMITED TO REGISTER A SERIES OF
MARKS IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 49751
BY DEB LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2158570
by Janchem Direct Limited to register a series of
Marks in Class 3**

and

**IN THE MATTER OF Opposition thereto under No 49751
by Deb Limited**

DECISION

1. On 18 February 1998 Janchem Direct Limited applied to register the following series of eight marks:

DAB-HAND
DAB-HAND
DABHAND
Dab-hand
Dab-Hand
Dab hand
Dab Hand
Dabhand

for a specification of goods in Class 3 which reads "cleaning preparations; preparations for cleansing the skin; toilet preparations; soap; cleansers; creams; barrier creams; conditioners; skin conditioners; emollients". The application is numbered 2158570.

2. On 11 May 1999 Deb Limited filed notice of opposition to this application. They say they are the proprietors of the following marks:

No.	Mark	Classes	Specification
673329	Deb	03	Cleaning, scouring and polishing preparations, soaps, and non-saponaceous washing preparations for laundry and domestic purposes.
518167	DEB	03	Cleaning, polishing and scouring preparations; detergents and soaps; preparations and substances for cleaning the skin; detergents, cleaning preparations and skin cleansers, all being impregnated into wipes; cloths

impregnated with a skin cleanser; abrasive preparations; non-medicated toilet preparations; degreasing preparations; bleaching preparations; cleaners for surfaces, metals or glass; preparations and substances for cleaning or polishing motor vehicles, vehicle parts, engines or engine parts; cleaning preparations for removing lacquers and polymer coatings from vehicles; shampoos; disinfectant soaps, disinfectant detergent preparations and disinfectant cleaning preparations; antibacterial and antiseptic skin or hand cleansers; preparations for protecting, maintaining, conditioning or caring for the skin; creams, gels and lotions for the skin.

- 05 Disinfectant preparations; bactericidal preparations for application to the skin or for sanitising surfaces; alcoholic gel for skin hygiene purposes; skin cleansers for use in medical areas; skin sanitisers for medical hygiene purposes; medicated skin cream.
- 21 Dispensers for products in liquid, paste or gel form; soap dispensers; hand cleanser dispensers; skin cream dispensers; hand pump apparatus for dispensing cleaning and skin care products; parts and fittings for the aforesaid goods; wiping cloths; cloths impregnated with a detergent preparation or a cleaning preparation.

The first of these is a UK registration. The other was a CTM application at the time of filing the notice of opposition but has since progressed to registration. The opponents say that they have made extensive use of the mark DEB. Arising from this objection is said to arise under Section 5(2)(b) and 5(4)(a).

The opponents also say that the applicants' marks are laudatory and apt for use in, for example, slogans or straplines. The expression "dab-hand" is part of the ordinary English language which other traders might wish to use. On that basis the application is also said to be open to objection under Section 3(1)(b)(c) and (d).

3. The applicants filed a counterstatement denying the above grounds.

4. Both sides ask for an award of costs in their favour.
5. Both sides filed evidence. The matter came to be heard on 27 March 2001 when the applicants were represented by Mr A Fiddes of DLA Trade Marks and the opponents by Mr D Alexander of Counsel instructed by Harrison Goddard Foote.

Opponents' Evidence

6. The opponents filed eight statutory declarations as follows:

Jeffrey Bell	-	dated 17 September 1999
Elizabeth Ann Bowley	-	dated 17 February 1999
Andrew Williamson	-	dated 17 September 1999
Jonathan Hugh Couchman	-	dated 15 September 1999
Graham George Fletcher	-	dated 16 September 1999
Peter James Sleigh	-	dated 21 September 1999
Leslie Calver	-	dated 20 September 1999
Stephen Hepburn	-	dated 11 October 1999

7. Mr Bell is the Managing Director of Deb Ltd. He says:

"The company now called Deb Limited was incorporated in 1941 and has since that date continuously manufactured and sold cleaning preparations in relation to which it has used the trade mark DEB. DEB has therefore been in continuous use as a trade mark since 1941. Perhaps the company's most famous product is its hand cleanser sold under the brand name SWARFEGA, although the company, which is now primarily a skin care company, now sells a wide range of skin care and cleaning products and other goods. All the company's goods are sold under its house mark DEB. A bundle of product literature illustrating use of the trade mark DEB is to be found in Exhibit JB1.

Deb sells its products into the retail and non-retail markets and is strongest in the non-retail "away from home" market, where the company sells, for example, cleaning preparations and skin care products to organisational and industrial customers, for example factories, hospitals, car repair shops and other workshops, and fitness centres. Deb is a market leader in the "away from home" market in the UK and also exports significant quantities of products under the trade mark DEB. Deb is proud of its reputation for quality and works hard to maintain it. The company's business success is founded upon this industry-wide reputation."

He exhibits (JB1) a selection of trade literature and says the range of goods covers:

protective hand creams (barrier creams), lotion soaps, hand cleaning creams and gels anti-bacterial creams and soaps, body shampoos, hand cleaning wipes, reconditioning hand creams, skin sanitisers, surface cleaners, degreasers, disinfectant cleaner and disinfectant, detergent, vehicle cleaners, dispensers for the above products.

8. Turnover at ex factory prices for the period 1990 onwards are given as follows:

<u>UK Sales of DEB Products</u>		<u>UK Sales of DEB Skin Cleaning Products</u>		<u>UK Sales of DEB Skin Creams</u>	
1990	£14,287k	1990	£8,109k	1990	£237k
1991	£14,559k	1991	£8,154k	1991	£337k
1992	£14,812k	1992	£7,462k	1992	£294k
1993	£14,225k	1993	£8,077k	1993	£293k
1994	£14,846k	1994	£9,020k	1994	£366k
1995	£16,046k	1995	£10,041k	1995	£460k
1996	£17,307k	1996	£10,937k	1996	£580k
1997	£18,377k	1997	£12,191k	1997	£630k
1998	£17,996k	1998	£12,358k	1998	£697k

The company sells its products throughout the UK both directly in the case of larger customers and, through a network of over 1000 distributors.

9. The goods are promoted primarily through the work of the company's sales representatives and the distributors' sales representatives. Publicity is also received through editorial features in the trade press such as Cleaning and Maintenance, Industrial Equipment News and Food Trade Review (examples are shown at Exhibit JB2).

10. In relation to the matter of confusion he comments as follows:

"11. The trade mark DAB-HAND causes me serious concern because of the risk of DAB-HAND products being taken to be DEB ones. DAB is evidently very similar to DEB, especially phonetically, and HAND would be seen as part of a product description and/or dispose people to misconstrue DAB as DEB in view of the fact that DEB and hand care are almost synonymous.

12. The most important sales route for the "away from home" or occupational market is through distributors, which are independent companies who buy DEB goods from us and then deliver them to the end users after orders have been placed. "Away from home" skin care products are therefore not normally seen side-by-side on the shelf or indeed seen before purchase. Phonetic confusion, for example over the telephone, therefore presents particular risks.

13. In short, there would be ample opportunity for confusion. Thus end users talking to distributors of DAB-HAND cleansers or creams, whether through sales representatives on the road or telesales reps, would order DAB-HAND goods thinking they were ordering DEB goods. Indeed, the mark DAB-HAND seems to invite this mistake. In the case of end users who employ young purchasing clerks who are completely ignorant of the products they are ordering, requests from shopfloor staff for DEB handcare products could easily be transmitted into orders for DAB-HAND products through misreading or mis-hearing the trade mark DEB. Also, people in the trade denigrating DAB-HAND products in speech or writing would be misconstrued as denigrating DEB products."

11. Ms Bowley is the Technical Manager for Deb. Her declaration deals with the care taken in formulating products; the expertise and resources the company has to provide hygiene audits of

customers; their co-operation with third party organisations in promoting skin care at work and providing effective quality products; and the various associated leaflets and videos that are produced. The purpose of her declaration is therefore to suggest that any problems with the quality of the DAB-HAND products would rebound on the opponents.

12. Mr Williamson is the son of the founder of the company. He sets out the history of the brand DEB from 1940 onwards. I note that he says the name is derived from 'debutante' because the company was a newcomer to the market at that time.
13. Mr Couchman is the opponents' professional representative in this matter. He exhibits a selection of material from the company's archives to which he had access. He draws particular attention to a July 1972 editorial article headed "They're Deb hands at cleaning up" though this strikes me as little more than a piece of journalese.
14. The remaining declarations come from people in the trade. I will deal with their evidence in more detail later in the decision. Suffice to say for present purposes that they attest to the fact that DEB is a well known brand in the cleaning and hygiene industry and comment on the issue of confusion.

Applicants' evidence

15. The applicants filed two statutory declarations by Kevin Pinder and Alan Michael Fiddes.
16. Mr Pinder is the applicants' Sales Director. He explains how the applicants came to adopt the mark and the pre-filing search that was undertaken. As there has been no challenge to the applicants' bona fides I see no need to record this material. He also exhibits examples of labelling of the product and gives early sales figures. Some of this material is after the relevant date and to the extent that it is intended to demonstrate that there has been no customer confusion it is of little value as 1998 sales appear to be at a low level.
17. Mr Fiddes is the applicants' professional representative in this matter. His declaration is a lengthy one and for the most part consists of a detailed critique of the opponents' evidence in chief. The main points to emerge are that
 - he criticises the basis on which the opponents' declarants approach the question of comparison of marks. In essence his point is that the marks must be compared as wholes
 - Messrs Calver, Sleigh and Hepburn are distributors who may have same affiliation with the opponents. Accordingly little weight should be given to their views. It is also suggested that their declarations are in a similar format suggesting they were answering a standard set of questions
 - he suggests that certain of the declarations are merely non-expert opinion which should be considered inadmissible whilst others are partial in so far as they are the views of employees of the opponent company

- it is suggested that DEB is frequently used as a company name and that individual products carry other brands such as SWARFEGA and JIZER
- the distributors who have given evidence have not said how customers order goods, that is to say whether DEB is normally used in association with a sub-brand for identification purposes. Nor do they explain whether ordering is by fax, phone, completion of an order pad etc.
- the turnover figures given by Mr Bell do not make it clear whether the sales figures for DEB skin cleaning products and skin creams are in fact sub-sets of the DEB products sales
- examples are provided (Exhibits AMF 2 and 3) of material gleaned from the opponents' web site and an advertisement in Car Accessory Trader which suggest that prominence is given to the sub-brands and, therefore customer recognition is of those brands.

18, The above is no more than an outline of some of the main points to emerge from Mr Fiddes' declaration. I will deal with specific points to the extent necessary in my decision below.

Opponents' evidence in reply

19. I will simply record that Mr Bell and Mr Couchman filed further statutory declarations picking up on and dealing with specific points made by the applicants' declarants. In general these further comments do not advance the argument greatly or raise relevant issues but I bear them in mind.
20. With the above evidence in mind I turn to the grounds of opposition.
21. I do not think I am doing the opponents any disservice if I say that the Section 3 grounds were not pursued with any great vigour at the hearing. Equally Mr Alexander did not give them up. I will deal with them briefly.

Section 3(1) reads:

- 3.-(1) The following shall not be registered -
- (a) signs which do not satisfy the requirements of section 1(1),
 - (b) trade marks which are devoid of any distinctive character,
 - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

22. Objection is taken under paragraphs (b), (c) and (d) in terms which largely mirror the wording of the Act. If I were to find that the mark was open to objection under one or more of these heads it is unlikely, on the basis of the minimal use that had taken place by the filing date, that the applicants would be in a position to benefit from the proviso to the sub-section. The matter, therefore, turns on the character of DAB HAND as an unused mark. In *British Sugar PLC v James Robertson & Sons Ltd* (the TREAT case), 1996 RPC 281 Mr Justice Jacob said:

"Next is "Treat" within Section 3(1)(b). What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word inherently from the old Act but the idea is much the same) devoid of any distinctive character."

23. In their statement of grounds the opponents suggest that "the applicant's marks are laudatory and apt for use in a laudatory sense in, for example, slogans or straplines. The expression "Dab Hand" is part of the ordinary English language which other traders might wish to use and should be left free for such use". I agree that Dab Hand is, and would be seen as, a commonly used and understood expression. It is perhaps something of a colloquialism but is not objectionable simply because of that. It is used to indicate that someone is skilled at, or expert in, something (it could be virtually anything). So far as I am aware it is normally only used to describe a person or perhaps an animate object of some kind. As an expression it has no particular or obvious application in describing the attributes or characteristics of goods. In the context of the goods at issue here it might be said to be cleverly allusive given the reference to hand and the fact that the goods could include for instance hand creams. But it is some way in my view from being open to objection under Section 3(1). As Mr Fiddes pointed out at the hearing the applicants commissioned a pre-filing Search and Advisory Service report from the Registry which found no objection to the mark under Section 3. Self evidently also the mark encountered no objection at the formal examination stage which would have prevented the application proceeding to publication. Neither of these factors can be determinative of the matter in an opposition. They do, however, confirm my own view of the mark. The objections under Section 3(1)(b) (c) and (d) fail.

24. The main ground of opposition and the one to which submissions at the hearing were almost exclusively directed is that under Section 5(2)(b). I was referred to a large number of reported cases. The main ones I rely and which seem to me to bring together relevant guidance from the European Court of Justice are *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Mayer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

25. The applicants do not dispute the existence of the opponents' earlier trade marks. They also accept that identical goods are involved. The matter, therefore, turns critically on my view of the respective marks within the overall context of the composite nature of the test (Balmoral Trade Mark, 1999 RPC 297). I will comment in turn on my general approach to the issues before me, the circumstances in which it is said confusion will arise, the comparison of marks, the trade evidence and my overall assessment of the likelihood of confusion having regard to all the relevant factors.

26. The opponents' UK registration is for the mark Deb (that is upper and lower case). Their CTM registration is for the mark DEB presented in upper case. The reason for the adoption of the mark is described by Mr Williamson. The company was in the early 1940s a newcomer to the market or 'debutante'. It is unlikely that current customers will know how the name came to be adopted though they might well recognise the mark as being an abbreviation of debutante. The word has no particular signification in relation to goods and is in my view inherently distinctive for the particular goods at issue. There has also been use of the mark over a number of years and the opponents (mainly Mr Bell) provide evidence as to that use and the resulting reputation. The applicants do not concede that the claimed reputation has been sufficiently demonstrated in the evidence. Their criticism goes mainly to the lack of substantiation of part of Mr Bell's evidence; the nature of the trade evidence; and the nature of the use where it is said that individual products in the range are better known by their sub-brands (such as SWARFEGA) rather than DEB itself.
27. It is true that in some areas (paragraph 9 of Mr Bell's declaration, for instance, dealing with sale and distribution methods) the evidence could have fleshed out the trading circumstances in greater detail. But I do not accept the generality of the applicants' criticism. Briefly my reasons are:
- by any standard the volume of trade is significant
 - a network of over 1000 distributors suggests extensive market coverage
 - DEB is used as a housemark. Most recent use has the word set in the context of a device but the word is dominant. Even where sub-brands are present and prominent the DEB mark still features
 - there is evidence from a leading competitor (Mr Sleight of Arco) that DEB has "been the number one brand over the past 10 years...."
 - Mr Fletcher of the trade association (Cleaning and Hygiene Supplies Association) also acknowledges DEB's position in the market place
 - even if the distributors who have given evidence represent the opponents (a point that is not clear from the evidence on this case) it does not necessarily detract from their views and knowledge of the trade in general and DEB's position in it.
28. I, therefore, accept that the opponents are entitled to make the claim they do and that I should take into account the highly distinctive character of their mark in coming in due course to my own view on the likelihood of confusion (criteria (f) above).
29. I have already indicated that I approach the applicants' mark on the basis that it is a well known expression. I do not think anything turns particularly on the fact that a series of eight marks has been applied for. It might be said that presenting the combination as a single word or in hyphenated form makes some marginal difference to the overall appearance. But I am inclined to think that the point is not particularly material and neither side made anything of it in submissions at the hearing.
30. It is part of the opponents' case that the respective marks are to be used on, inter alia, hand cleaners, hand creams etc. That is to say that either the mark might 'read into' the goods or at least the word

hand might appear in close association. This has resulted in claim and counterclaim in the evidence as to how such circumstances might arise and the bearing it should have on my decision. There are a number of references to the non-distinctiveness of HAND and the potential for mis-hearing of marks - DAB-HAND as DEB-HAND (Mr Fletcher) and the similarity between DEB and DAB (Mr Sleigh and Mr Calver). I will come onto this evidence in rather more detail later in the decision. Suffice to say at this point the applicants say these are false comparisons and I must compare the marks as wholes and not as if an element had been added to one or subtracted from the other.

31. It was held in REACT Trade Mark, 2000 RPC 285 that, in the absence of evidence of use, notional and fair use of the respective marks is to be assumed. That is to say the comparison I must make is between each and every one of the eight marks in the applicants' series and the marks Deb or DEB. However, it is not unreasonable to assume that marks, which after all are for use in trade, might be used in conjunction with the name of the goods to which they are to be applied. The precise extent, circumstances and manner in which this might happen are matters on which it seems to me my view can be informed by the evidence from the parties on actual trading practices. In other words it does not follow that because it can happen it necessarily will happen.
32. Mr Alexander also reminded me that I must bear in mind that it would be open to the applicants to format their mark in such a way that, for instance, the words or elements might be presented in different script, font, colour etc. That is so but the essence of the mark would still need to be words DAB HAND. A form of presentation that compromised the distinctive identity of the mark by, for instance, overemphasising one element or reducing the significance of the other would be likely to take the applicants beyond the boundaries of normal and fair use of the mark applied for.
33. With these preliminary observations in mind I go on to compare the marks.
34. In his skeleton argument Mr Alexander says "'Dab" and "Deb" are the distinctive elements of the marks under comparison. "Hand" adds nothing distinctive. The first syllable of DAB HAND is very similar to DEB". I do not accept that approach to assessing the distinctive character of the applicants' mark. Whilst it is quite correct to say that, taken on its own, the word HAND carries descriptive significance in relation to the goods, any such meaning becomes a subsidiary consideration when it features as an element within a well known expression. The distinctive character lies in the totality of the mark. That conclusion has no less force in my view simply because the mark may also be seen as a play on words in the context of the goods. It is part of the appeal of the mark that there is an element of wordplay present. I very much doubt that the significance of the wordplay would be lost on customers.
35. On the basis of that approach to the marks I find that there is little visual similarity beyond the obvious point that an element of the applicant's mark has some similarity to the opponents' mark (though even on that basis they are short words with well known meanings). Aurally they are quite distinct though I will go on to comment below on the question of aural confusion arising from spoken orders. Conceptually too the objection never gets off the ground. On a straightforward comparison, therefore, there is very little similarity.
36. This brings me to the circumstances of trade, the evidence from trade experts and what it is said might happen under normal trading conditions. The opponents' evidence deals at several points with the potential for aural confusion arising from telephone sales. The comments in paragraphs 12 and 13 of

Mr Bell's declaration (set out in paragraph 10 above) are a case in point. Mr Hepburn, one of the distributors who has given evidence, also refers to telesales as follows:

"..... In the same way, people in telesales situations talking about, say, "DAB HAND cream" would I am sure take it that what was being talked about was familiar DEB hand cream.

6. At A & J we still take telesales orders in handwriting. What happens is that I or whoever else writes down the customer's order and then passes the written order on for processing. In such hand-written orders, DAB could easily be misconstrued for DEB or, indeed, DEB could be read as DAB - the difference between an "a" and an "e" is not much."

In fact Mr Hepburn's comments suggest that the misconstruction would result not just from telephoned orders but the handwritten transmission of those orders which is a somewhat different matter. However, I am prepared to accept that telephone orders are a feature of the commercial and industrial cleaning products' trade and that I should take such a circumstance into account in determining the likelihood of confusion. I bear in mind also the guidance in the *Lloyd Schuhfabrik v Klijsen* case that "mere aural similarity between trade marks may create a likelihood of confusion" (paragraph 29).

37. However, I do not read the *Lloyds'* case as saying that aural similarity on its own, if established, necessarily results in a finding of confusion. It is a global test taking all relevant circumstances into account including the relative importance of aural considerations in the normal course of trade. What is not clear to me from the evidence is the extent to which business is conducted in this way (that is over the telephone) rather than by fax, order pad or a visual inspection of goods or how goods are actually ordered in a telesales context ie. whether by product code, name, main brand, sub-brand, product description or combinations thereof.
38. What I can draw from the evidence is that Deb Ltd offer a large range of cleaning and janitorial products (see paragraph 7 above). Three product brochures are exhibited at JD1, one covering the automotive range, one the industrial products and the third headed "Dispense with washroom problems". Each of these contains a wide range of product offerings to meet a variety of cleaning and hygiene needs. Whilst I would not rule out customers phoning through an order for e.g. a Deb hand cleaner it is far more likely that they would use some supplementary description because that is how the products are presented. This might be a sub-brand SWARFEGA, JIZER etc. or Deb in conjunction with a descriptive indicator e.g. Deb Peach, Deb Pure, Deb Natural, Deb Restore. Mr Hepburn's comments are of interest in this respect:

"The name DEB is recognised by distributors and ultimately customers alike as a brand name for the company's products, all of which carry the name DEB as well as an individual product name, such as LIME, PURE or SWARFEGA."

and

"4. Because DEB is such a well known and well respected brand name, we always sell DEB products using the name DEB, as in DEB PURE, DEB LIME, DEB PEACH, DEB PROTECT or even DEB SWARFEGA, DEB TUFANEGA or DEB SUPREGA PLUS. The name DEB means quality hand care products and sells the products."

39. That accords with what I would have expected namely that distributors and customers faced with a wide selection of goods will specify by reference to secondary indicators and not just the name DEB. A customer who was not already familiar with DEB would specify the product requirement before encountering brand names.
40. None of this is to suggest that a customer will never ask for e.g. a DEB hand cleaner but the likelihood of that happening (and the consequences) must be judged against the normal circumstances of trade.
41. I have indicated above that I find the evidence of trade experts of value in reaching a view on DEB's reputation in the market place. Those same trade experts have also given their views on the issue of similarity of marks and confusion. I referred Mr Alexander to the following passage from *The European Limited v The Economist Newspaper Ltd*, 1998 FSR 283 at 291:

"The function of an expert witness is to instruct the judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge may otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity."

and

"In the end the question of confusing similarity was one for the judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses."

42. Applying that principle I cannot give any weight to that part of Messrs Sleight and Calver's evidence that touch on similarity/confusion. However Mr Alexander indicated that he would not wish to concede that for the purposes of Section 5(2) evidence from a properly qualified trade association representative or distributor as to the likelihood of confusion was not properly admissible in the light of the decision of the ECJ. If that is a reference to paragraph 24 of the Lloyd's decision (to the effect that statements from chambers of commerce and industry or other trade and professional associations should be taken into account) I am not convinced it is correct. The issue being dealt with at that point in the Lloyd's decision was factors relevant to determining the distinctive character of the mark and not the views of trade experts on the general likelihood of confusion. However in his view we do not get to that stage because Mr Fletcher and Mr Hepburn say that they themselves were confused. The relevant passages from their evidence are as follows:-

Mr Fletcher

"4. I have no doubt that the names DEB and DAB-HAND would be confused. When I was telephoned by Deb's trade mark agent Jonathan Couchman and he said "DAB-HAND", I understood him to say "DEB-HAND", a name I would think to come from Deb Limited. The reasons why I heard "DAB-HAND" as "DEB-HAND" are, firstly, that "DEB" is so well known and, secondly, that the word "HAND" leads to Deb because hand care products and Deb are so closely associated that they are virtually synonymous. The use of "DEB" in any

form, - e.g. "DEB-HAND" - would lead customers to the belief that the product concerned came from Deb Limited."

Mr Hepburn

"5. I am sure that there would definitely be confusion between DEB on the one hand and DAB-HAND on the other, because DEB and DAB are so similar and because HAND is just a product description (as in "hand cleaner" or "hand cream") which people will link with DEB. I find that DEB and DAB sound very similar - in fact, in talking with Deb's trade mark agent Jonathan Couchman, I confused the two and for a long time thought he was saying "DEB HAND" when he was talking about "DAB-HAND". In the same way, people in telesales situations talking about, say, "DAB HAND cream" would I am sure take it that what was being talked about was familiar DEB hand cream.

6. At A & J we still take telesales orders in handwriting. What happens is that I or whoever else writes down the customer's order and then passes the written order on for processing. In such hand-written orders, DAB could easily be misconstrued for DEB or, indeed, DEB could be read as DAB - the difference between an "a" and an "e" is not much."

43. I approach this evidence with some caution. There was no request to cross examine either of the declarants. I therefore do not know precisely what questions were asked or how the respective marks were introduced into the conversation. I do not mean to imply any criticism of Mr Couchman, the attorney who conducted the enquiries, or to suggest that his line of questioning may have led the declarants. It is simply that the circumstances were, inescapably, different to those pertaining in actual trade. Without a full text of the conversations or knowledge of precisely how comments came to be made I am not prepared to give significant weight to this evidence. Furthermore I do not altogether follow Mr Fletcher's reasoning when he says "HAND" leads to Deb. Mr Hepburn too appears to extract 'HAND' from the applicants' mark and treat it purely as a descriptive element. These comments suggest they are not giving sufficient weight to the overall character of the applicants' mark. Equally I cannot give any weight to the absence of instances of confusion. The applicants' trade is of fairly recent origin and very limited indeed at the material date in these proceedings. There has, therefore, been little scope for actual confusion in the marketplace and even if it had occurred it might have gone unreported.
44. Before drawing my own conclusions on the issues before me there is one further matter on which I need to comment and that is the assumptions that are to be made about the average customer. The guidance in Lloyd Schuhfabrik case is that for the purpose of the global appreciation of the likelihood of confusion "the average consumer of the category of products is deemed to be reasonably well-informed and reasonably observant and circumspect". When Mr Bell refers to the risks arising from "end users who employ young purchasing clerks who are completely ignorant of the products they are ordering....." that seems to me to be going beyond the accepted test of the average consumer. I cannot take into account any likelihood of confusion arising in these circumstances.
45. As a result of the above considerations and circumstances I conclude that
- the respective marks are easily distinguishable on a straightforward comparison

- oral use in relation to a part of the product range (hand care products) could reduce the distance between the marks
- the incidence of oral as opposed to written ordering is not clear but there is likely to be some
- the product descriptions used by the opponents largely point away from any risk of confusion arising from a 'read-through' from the marks to the name of the goods. It seems highly likely that the sub-brands or descriptors will play a part in product ordering
- the opponents appear to give insufficient weight to the overall character of the applicants' mark and to envisage a below average level of attention being paid to the marks in trading circumstances.

46. This suggests to me that the high point of the opponents' case must be that it is possible to devise a situation where confusion might arise but that this would require a somewhat unlikely combination of circumstances to come together. The test I have to consider is whether there is a likelihood of confusion (and not a mere possibility). I am not persuaded that such a likelihood exists. The Section 5(2)(b) ground fails.
47. I do not propose to comment in detail on the Section 5(4)(a) ground. It is, I think, accepted that if the opponents do not succeed under Section 5(2) they are unlikely to be in any better position under Section 5(4)(a). For my part I cannot see that any substantially different issues would arise in terms of marks and the range of goods on which those marks are employed. The outcome would, therefore, be no different as misrepresentation and damage would not occur.
48. 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 £600. That award reflects the fact that there is evidence in common between this case and the companion Class 21 case; substantially the same issues have been addressed; a composite set of submissions were made at the hearing; and a separate award has been made in respect of the Class 21 case. The above sum is 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.

Dated this 24 day of April 2001

M REYNOLDS
For the Registrar
the Comptroller-General