

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 2190151A
BY THE PREMIERE POLISH COMPANY LIMITED
TO REGISTER A TRADE MARK IN CLASS 5**

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DECISION

On 25 February 1999, The Premiere Polish Company Limited, of Oakley Gardens, Bouncers Lane, Cheltenham, Gloucestershire, GL52 53D applied under the Trade Marks Act 1994 to register the trade mark RAPIER in Classes 3 and 5 of the register in respect of:

Class 3 Surface cleaning preparations.

Class 5 Disinfectants for janitorial use.

Objection was taken to the application under Section 5(2) of the Act in respect of the following marks:

Section 5(2) The following marks were considered to be identical and in respect of the same or similar goods:

Number	Mark
1588101	RAPIER

Specification

Pesticides; herbicides; all included in Class 5

Number	Mark
2135708	RAPIER

Specification

Perfumery, eau de cologne, toilet water, body sprays; dentifrices; deodorants, anti-perspirants; bubble bath preparations; shower gel; preparations for conditioning the hair, preparations for styling the hair, hair spray; skin make-up; shaving and aftershave preparations; shaving gel; shaving cream; shaving foam; depilatory preparations.

At a Hearing, at which the applicants were represented by Mr Dunlop of Wynne-Jones, Lainé & James, their trade mark agents, the objection based on 2135708 was waived against Class 5 of the application and outright against Class 3. Subsequently the Class 3 goods were divided out of the application and I need say nothing further in regard to this matter. Objection

against number 1588101 in Class 5 was maintained.

Following refusal of the application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

No evidence of use has been put before me. I have, therefore, only the prima facie case to consider.

Section 5(2) of the Act reads as follows:

5(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected.

or

- (b) it is similar to an earlier mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

Since the mark of this application is identical to the earlier mark the matter must be decided under Sub-Section (a) of Section 5(2). The question, therefore, is whether the goods of this application are so similar to those of the earlier mark that there exists a likelihood of confusion on the part of the relevant public. In this I have regard to the decision by Jacob. J. in *British Sugar Plc v James Robertson & Sons* [“TREAT” 1996 RPC 281]. In that case the court stated that:

“The following factors must be relevant in considering whether there is or is not similarity:

- a) The respective uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of service;
- d) The respective trade channels through which the goods or services reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

In applying this test it is clear the physical nature and uses of the goods are closely related. It is likely both will utilise chemicals, most usually in liquid or powder form, to kill or inhibit the growth of organisms which may cause disease or harm. Although pesticide use is most usually thought of in an agricultural context, use in buildings to control rodents, fungi, fleas and other insect infestation is commonplace. Given this use the respective users of the goods are likely to be the same. I therefore consider that there are similarities between the goods of this application and those for which the earlier mark is protected.

I have also taken account of the comments in the *Sabel v Puma* trade mark case in the European Court of Justice (C-251/95), 1998 RPC 199 at page 223 lines 52-54 and page 224 lines 1-23 which stated:

“..... In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive-” there exists a likelihood of confusion on the part of the public” - shows that the perception of marks in the minds of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

The judgement links the question of a likelihood of confusion to two factors; the visual, aural and conceptual similarities between the marks and goods and whether the earlier mark has a particularly distinctive character, either *per se*, or by reputation.

In this case, the mark RAPIER has a highly distinctive character *per se* in respect of the specified goods.

Therefore, given the strength of the marks and their identity I conclude that the similarities between the respective goods are sufficient to give rise to a likelihood of confusion between the applicant's mark and the cited mark, which includes the likelihood of association with the earlier mark.

Having concluded that there is a likelihood of confusion, I determine that the application is debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 23 day of July 2001.

MARTIN LAYTON
For the Registrar
The Comptroller General