

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996

**IN THE MATTER OF APPLICATION No M749994
BY POURELLE COSMETICS GMBH TO PROTECT A TRADE MARK
IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 70637
BY GO-JO INDUSTRIES INC**

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**IN THE MATTER OF Opposition thereto under No 70637
by Go-Jo Industries Inc**

DECISION

1. On 16 November 2000 Pouelle Cosmetics GmbH, on the basis of a registration held in Germany, requested protection in the United Kingdom of the following trade mark:

PURELL

for a specification of goods which reads "soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices." The International Registration is numbered M749994.

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and the particulars of the International Registration were published in accordance with Article 10.

3. On 11 July 2001 Go-Jo Industries, Inc filed notice of opposition to the conferring of protection on this International Registration. They are the proprietors of a CTM registration for the mark PURELL under No. 537803 in respect of "hand sanitizing and disinfecting preparations, especially with antibacterial and antimicrobial properties; antibacterial and antimicrobial soaps". The CTM registration is said to constitute an earlier trade mark under the provisions of Section 6(1)(a) of the Act. The opponents express their objections as follows:

"Registration of the mark of the opposed Application in respect of the goods specified in Class 3 should therefore be refused under the provisions of Section 5(1) of the Trade Marks Act 1994 to the extent that the marks and goods to which the marks are to be applied are identical and under Section 5(2)(a) of the Trade Marks Act 1994 to the extent that the marks are identical and the goods to which the marks are applied are similar, or under Section 5(2)(b) of the Trade Marks Act 1994 to the extent that the marks and the goods to which the marks are to be applied are similar."

4. The International Registration holders (for ease of reference I will refer to them hereafter as the applicants) filed a counterstatement denying the above grounds.

5. Both sides ask for an award of costs in their favour.

6. Only the opponents filed evidence. At the conclusion of the evidence rounds I wrote to the parties indicating I considered that a decision could be reached on the basis of the papers filed but reminding them of their right to a hearing. In the event neither side has asked to be heard. Written submissions have however been received from the opponents. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

7. The relevant statutory provisions read as follows:-

"5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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 trade 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."

8. The opponents have put their case on a number of alternative bases. Two of them, that is the claims under Sections 5(1) and 5(2)(a), depend on there being identical marks. The question of whether marks are identical or simply very similar has been considered in IDG Communications Ltd's Trade Mark Application [2002] RPC 10 at page 283 where the marks in issue were DIGIT and digits. The Hearing Officer concluded that the marks were not identical. His reasoning by reference also to Simon Thorley QC's decision in BAYWATCH (unreported SRIS O/051/01) can be found on pages 286 to 288 of the decision.

9. I also bear in mind the opinion of Advocate General Jacobs in *SA Societe LTJ Diffusion v SA SADAS* Case C-291/100 where he concluded that:

"The concept of identity between mark and sign in Article 5(1)(a) of Council Directive 89/104/EEC covers identical reproduction without any addition, omission or modification other than those which are either minute or wholly insignificant."

10. The opponents' mark is the word PURELL in plain black capital letters. The applied for mark differs only to the extent that the leg of the letter R is extended so that it underlines the letters that follow. I have no hesitation at all in concluding that both marks will be seen as PURELL marks. That word constitutes the whole of the opponents' mark and by far the most significant element of the applicants' mark. But are they identical? The 'underlining' in the applicants' mark is plain to see. It is not the normal way of presenting a letter. It is not particularly remarkable either. But it is enough in my view to conclude that the mark applied for is not identical to that of the opponents though I accept it is a marginal decision.

11. The matter, therefore, falls to be considered under Section 5(2)(b) rather than under Section 5(1) or 5(2)(a).

12. In approaching the ground based on Section 5(2)(b) I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & 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.

Comparison of marks

13. Although I have found that the respective marks are not identical, they are without doubt very closely similar.

Distinctive character of the opponents' mark

14. The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or be acquired through use. In this case, although the opponents have filed evidence, it is largely silent on the extent of any use in this country. For practical purposes it is only the inherent character of the mark I need to consider. I regard PURELL as being an invented word. It is in my view a strong mark in relation to the goods at issue.

Comparison of goods

15. It was held in *CANON* that:

"22. It is however, important to stress that, for the purposes of applying Articles 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services

covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar."

16. In order to assess the similarity of the goods, I note the test set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- (a) the uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) the physical nature of the goods or services;
- (d) the trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found on the same or different shelves; and
- (f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

17. These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45 - 48. In its judgment, the ECJ stated at paragraph 23:

"23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary."

18. To assist me in the process of evaluating the issue of similarity I have evidence and written submissions from Mark S Lerner, Chief Operating Officer of GOJO Industries, Inc and Steven Howe of Lloyd Wise Tregear, the opponents' UK Trade Mark Attorneys. I do not propose to provide a full summary of this evidence though I have read and considered all the material filed. The main points to emerge are that:

- the opponents' hand sanitising products are sold to the public through drug stores, grocery stores, pharmacies, mass merchandisers and the internet as well as the professional and institutional markets such as hairdressers, beauty parlours, hospitals, restaurants, hotels etc (Mr Lerner's witness statement).
- anti-bacterial or anti-microbial hand washing and cleansing products are increasingly used in the home and promoted with this market in mind (Mr Lerner's witness statement).
- hand washes are displayed side-by-side with other personal hygiene products such as soaps, toothpaste, mouthwashes, deodorants and hair products. Other goods such as perfumes, essential oils, cosmetics and hair lotions are typically

sold through the same outlets and displayed in the same area of the store (Mr Howe's witness statement and Exhibits 1 and 2).

- the Boots website displays soaps and handwashes under the heading 'Personal Care' and perfumes, cosmetics and hair care products under the heading 'Beauty' (Mr Howe's witness statement and Exhibit SH 3).

19. For ease of reference I set out the respective goods as follows:

Applicants' goods

Soaps, perfumery, essential oils cosmetics, hair lotions, dentifrices. (Class 3)

Opponents' goods

Hand sanitizing and disinfecting preparations, especially with antibacterial and antimicrobial properties; antibacterial and antimicrobial soaps. (Class 5)

20. As the goods have been placed in different Classes, I take the view that they cannot be identical. Are they similar? Two preliminary points need to be made about the opponents' specification. Firstly, I must bear in mind the notional scope of the specification. It seems from their evidence that the main product area of interest to them is antibacterial or antimicrobial soaps. The first part of their specification is not restricted to soaps. I take the term 'preparations' to cover other items such as creams and lotions. The second point is that there is an element of ambiguity in the words 'disinfecting preparations'. Is that term qualified by the word 'hand' as are the 'sanitizing preparations'? On a natural reading of the specification I take the view that 'disinfecting preparations' are qualified in this way. But the point is not entirely clear.

21. In approaching the comparison I accept the opponents' evidence (which confirms my own experience) that antibacterial and antimicrobial soaps and other preparations are now commonly sold for use in the home. It would not, therefore be surprising to find such goods used in, say, a kitchen, utility room or toilet and ordinary or perfumed soap in a bathroom. That strongly suggests that the users and physical nature of the goods are likely to be the same. The uses may strictly be different but are undoubtedly complementary to one another. Trade channels, too, will coincide. I have no hesitation in concluding that (cosmetic) soaps in Class 3 are similar to their antibacterial and antimicrobial equivalents in Class 5.

22. With the exception of hair lotions and dentifrices, the applicants' goods are not restricted as regards the parts of the body they are directed at. The terms cosmetics and essential oils cover products that are for the care of the body and the skin including the hands. Thus, for instance, the applied for specification would include a cosmetic hand cream which, for the same reasons given in relation to soaps, would be similar to a hand sanitizing or disinfecting preparation.

23. Hair lotions might at first glance appear to be somewhat different to the opponents' goods but hair lotions may be used to treat the hair and the scalp and be similar in nature, and complementary to, a dermatological soap. I note that Collins English dictionary defines a

lotion as "a liquid preparation having a soothing, cleansing or antiseptic action applied to the skin, eyes etc."

24. The remaining items in the applied for specification, that is to say perfumery and dentifrices, do not seem to me to be similar, having regard to the CANON/TREAT tests. The users would be the same at a high level of generality but the uses are different and the physical nature of the goods is different, particularly so in the case of dentifrices. The opponents' evidence on the claimed overlap in channels of trade is not convincing so far as these goods are concerned. Nor can perfumery and dentifrices be said to be complementary to, or in competition, with the opponents' goods.

Likelihood of confusion

25. In *Raleigh International Trade Mark* [2001] RPC 11 page 202 Geoffrey Hobbs QC, sitting as the Appointed Person, said:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

26. I have held that the marks are about as closely similar as it is possible to be without being identical and that PURELL is a strong mark. In so far as the goods are concerned my conclusions are that soaps and cosmetics (given the generality of the latter term) are quite closely similar to the opponents' goods; that essential oils and hair lotions are also similar but at the outer reaches of similarity; and that perfumery and dentifrices are not similar.

27. According to *Sabel v Puma* (paragraph 24) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character. In the circumstances I consider that there is a real likelihood of confusion if the applied for mark was registered and used for those goods which I have found to be similar. The opposition succeeds in this respect under Section 5(2)(b).

28. The request for protection will be allowed if, within 28 days of the expiry of the appeal period, the applicants (International Registration holders) file a form TM21 restricting their specification to 'perfumery and dentifrices' in Class 3. If they do not do so the application for protection will be refused in its entirety.

29. The opponents have been successful but not completely so. In the circumstances I order the International Registration holders to pay the opponents the sum of £600 as a contribution towards their costs. This 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 17TH day of July 2002

M REYNOLDS
For the Registrar
the Comptroller-General