

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2225617
IN THE NAME OF DION BEAUTY CARE PRODUCT LTD
TO REGISTER A TRADE MARK IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 51316
BY TURA INTERNATIONAL LIMITED**

Trade Marks Act 1994

**In the matter of Application number 2225617
in the name of Dion Beauty Care Products Limited
to register a trade mark in class 3**

And

**In the matter of Opposition thereto under
number 51316 by Tura International Limited**

Background

1. On 14 March 2000, Dion Beauty Care Product Ltd applied to register the trade mark “NURA” for “ medicated toilet soap” in class 3.

On 21 August 2000, Tura International Limited filed notice of opposition in which they say they are the proprietors of an earlier trade mark. The grounds of opposition are in summary:

1.Under Section 5(2)(b) because the mark applied for is similar to the opponent’s earlier mark and is sought to be registered for goods that are identical or similar.

2. Under Section 5(4)(a) by virtue of the law of passing off.

2. The earlier mark relied upon by the opponents is as follows:

Number	Mark	Class	Specification
	TURA	3	Soap; cosmetics; perfumes; shampoos; non-medicated toilet preparations; non-medicated preparations in the form of powders for the care of the skin.

3. The applicants filed a counterstatement in which the grounds of opposition are denied. Both sides asked for an award of costs to be made in their favour.

4. Both sides filed evidence and in accordance with Trade Marks Registry practice, I reviewed the case and advised the parties that, in my view, it was not necessary for a hearing to be held in order that the matter be decided. Neither side has since requested a hearing nor filed written submissions.

5. Acting on behalf of the Registrar, and after a careful study of the papers, I give this decision.

Opponent's evidence

6. This consists of an affidavit, dated 4 June 2001, from Gul Mulchandani, the General Manager of Tura International Limited. Mr Mulchandani explains that he has held this position for over 5 years and confirms that the information contained in the affidavit comes either from his own knowledge or the company records to which he has full access. He further confirms that he is authorised to make the affidavit on his company's behalf.

7. Mr Mulchandani offers his opinion on the marks in question and argues that they are for identical goods and that the marks are visually and phonetically similar. As a result of this similarity, Mr Mulchandani believes that the applicant's application should be refused.

8. Mr Mulchandani goes on to explain that his company's trade mark "TURA" was first used in the UK in 1986. However, active marketing and sales in relation to soaps and creams under the mark have taken place in the UK since 1989. Examples of packaging currently used and used prior to the date of the subject application are shown at exhibit GM. The exhibit consists of packaging for a medicated soap and a skin lightening cream, the background being a bright yellow, the word TURA being shown in dark blue with a light blue shadow effect, running diagonally upwards. Two are embossed "EXP 07/2000" which is an indication that they originate from before that date, but not prior to the relevant date.

9. Annual turnover figures from 1996 to 2000 under the company's trade mark are as follows:

1996: £207,297
1997: £110,703
1998: £153,989
1999: £151,686
2000 (up to July): £112,125

10. Mr Mulchandani says that exact turnover figures for the years 1990 to 1995 are not available. He gives an approximate total figure for sales under the mark in the UK during that period, which is stated as being £960,000, but he does not say on what information he makes this estimate. The amount spent on advertising in the UK since 1989 is given as being approximately £80,000, with the goods sold under the mark being advertised at various times since 1989 in the publications "Black Beauty" and "West Africa".

11. The goods sold under the company's trade mark have formed part of the company's stands at various beauty product and pharmacy trade exhibitions over the years including "Afro Hair and Beauty" in 1993 and 1994 and "Birmingham Spring Fair" in 1994 and 1995. Mr Mulchandani confirms that the goods sold under the trade mark have been sold and are available in most towns and cities throughout the UK.

12. Mr Mulchandani argues that his company's trade mark is a well established brand and is particularly popular amongst ethnic beauty suppliers and consumers alike. He further argues that his company has, over a number of years built up goodwill in the mark "TURA" in the UK and that the applicant's use of "NURA" would constitute a misrepresentation which is likely to cause confusion amongst the public and consequently cause damage to the company.

Applicant's evidence

13. This consists of an affidavit, filed by the applicant company-Dion Beauty Care Limited. They argue that the applicant's trade mark "NURA" is neither visually nor phonetically similar to the opponent's trade mark, and that the applicant's goods are clearly indistinguishable from the opponent's. The applicant's trade mark has been intensively and extensively advertised internationally and has enjoyed widespread usage and has acquired substantial goodwill and reputation amongst purchasers globally. The applicant's goods were and are still marketed with the conspicuous device/design of the applicant's mark, which makes it absolutely impossible for any purchaser to buy any other goods, other than the unique goods of the applicant.

14. In relation to the sales figures given by the opponents from 1996-1999, the applicants argue that these were not connected to the applicant's trade mark and therefore the opponent should stop pursuing the shadow but rather face the market trend by streamlining their processes and strategies to break even. The applicant's further point out that the opponent's exhibit (GM1) is inconclusive without the applicant's own package for easy comparison by the Registrar.

15. The applicant's argue that the opposition of their trade mark has been made in bad faith as the applicant's mark is distinctive, distinguishable and registrable under the Trade Marks Act 1994 and could co-exist with the opponent's without causing any confusion. The applicant's also feel that the opponent's have failed to disclose that they have various packages in use for their medicated soap. Exhibit AP1, shows the packaging that the opponent's failed to file.

Opponent's evidence in reply

16. This consists of an affidavit, dated 1 May 2002, from Jonathan James Osbourne. Mr Osbourne explains that he is the Group Managing Director of Edinburgh Holdings Limited, a position held since April 1999. Edinburgh Holdings Limited has acquired the business of Tura International Limited which includes the trade mark "TURA". Tura International Limited still exists as a dormant company. Mr Osbourne confirms that the information contained in this affidavit comes from either his own knowledge or the books and records of the company.

17. Mr Osbourne advises that he is fully aware of the history of the proceedings and has read and discussed the evidence filed by the applicants with Mr Gul Mulchandani (who has previously submitted an affidavit in these proceedings).

18. With reference to paragraph numbers, Mr Osbourne comments as follows on the applicant's evidence:

- Paragraphs 1 and 3 consist merely of opinion relating to the similarity of marks at issue and the resultant likelihood of confusion. The statements are denied by the opponents.
- Paragraph 2 is not supported by any evidence and is denied by the opponents.

- Paragraph 4 of the applicant's evidence is irrelevant; it is the marks as applied for and registered that are to be compared. The addition of any device element in the market place, of which the applicant provides no evidence, is of no consequence to the comparison of marks when assessing the likelihood of confusion for the purposes of registration.
- Paragraph 5 provides no evidence that the turnover figures given in the affidavit of Gul Mulchandani dated 4 June 2001 do not relate to the opponent company's trade mark TURA and in any event the allegation is denied.

19. Mr Osbourne also refers to Exhibit GM1 of Gul Mulchandani's affidavit of 4 June 2001 which is intended to show the mark in use; the applicant's packaging has no bearing in that regard. However, as the applicant's have raised the issue of their packaging, Exhibit JO1 of this affidavit, shows a sample of the packaging used by the applicant. When one compares the applicant's packaging and "get-up" with that exhibited as GM1 by the opponents and exhibit AP1 in the applicant's evidence, it is clear from the obvious similarities between the packaging that the applicants are seeking to draw parallels between the goods sold under the TURA trade mark and their own. The likelihood of confusion between the very similar marks is then exacerbated by the manner in which the applicants have chosen to use the subject mark.

20. With regard to paragraph 7 of the applicant's evidence, Mr Osbourne points out that no attempt has been made to attack the inherent registrability of the applicant's mark. Rather the subject application has been opposed because of the subject mark's close similarity to the opponent company's mark and the identity and similarity of the goods concerned. It is denied therefore, that the opposition has been made in bad faith. Equally it is denied that the marks may co-exist without confusion.

21. As regards paragraph 8 of the applicant's evidence, Exhibit GM1 of Gul Mulchandani's evidence dated 4 June 2001 was intended to show examples of the opponent's trade mark in use in the UK and not be a comprehensive portfolio of the packaging used. The existence of packaging used which has not been exhibited has no bearing in these proceedings.

DECISION

22. Turning first to the ground under Section 5(2)(b). That section 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 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.”

23. In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] RPC 199, *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. 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* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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 Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, 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* page 224;
- (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* page 224;
- (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* page 7, 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* page 8, 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* page 224;
- (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* page 732, 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* page 9 paragraph 29.

24. The mark applied for is sought to be registered in respect of medicated toilet soap in Class 3. The opponents' earlier trade mark is registered in the same class and includes, inter alia, the term "soap" which would encompass all soaps proper to that class, including the medicated toilet soaps covered by the application. Neither specification is limited in any way, so I must proceed on the basis that these are not only identical goods, but that notionally at least, they share the same channels of trade, market sector and consumer.

25. The overlap in the goods is in respect of medicated soaps. The opponents make specific mention of the possibility of aural confusion arising when an order for soap is placed over the telephone, but other than perhaps in the case of an order placed by a retailer with a trader higher up the supply chain, this seems an unlikely scenario for such goods. That aside, there is nothing that suggests that these are goods provided on prescription, or only available over the counter; they are just as likely to be available by self-selection. It would therefore seem that I should consider the aural and visual similarities as being of similar importance.

26. As far as I am aware, both the opponent's earlier registration for the word TURA and the applicant's mark NURA are invented words with no relevance for the goods covered by the registration (it has not been contended otherwise), but this apart, have no conceptual similarity.

27. Mr Mulchandani states that his company first used the trade mark in the United Kingdom in 1986, but that active marketing and sales in relation to soaps and creams have only taken place since 1989. This leaves a question over the nature and extent of the trade in the years between 1986 and 1989, and to whether the date of first use should properly be taken to be 1989 rather than 1986 as claimed, although I do not believe anything turns on this. None of the exhibits establish a date of first use prior to the relevant date in these proceedings, let alone back to 1986. Goods on which the TURA trade mark has been used are said to have been sold and be available in most towns and cities throughout the United Kingdom. Turnover figures for the years 1990 to 2000 have been given, although as I said in my summary of the evidence, it is not clear how the ball park figure for the years 1990 to 1995 was arrived at. Whilst the amounts are not insignificant, I do not have any information relating to the market for such goods by which to put them into the context. The amount said to have been spent on advertising in the United Kingdom since 1989 is given as being approximately £80,000, the goods being advertised at various times in publications such as "Black Beauty" and "West Africa", and at various beauty product and pharmacy trade exhibitions over the years including "Afro Hair and Beauty" in 1993 and 1994 and "Birmingham Spring Fair" in 1994 and 1995. The choice of publications and venues, and Mr Mulchandani's comment that the TURA brand is particularly popular amongst ethnic beauty suppliers and consumers alike would indicate that the product is aimed at a particular market, although not exclusively. Taking all of the above into account I do not consider that there is sufficient to establish that the mark has become any more distinctive by virtue of the use made of it, and consequently, that it warrants a wider penumbra of protection.

28. The applicants state that their goods are marketed with the "conspicuous device/design of the applicant's mark", saying that this renders it impossible for there to be confusion. The opponent's response is to say that how the applicants use the mark is irrelevant, that it is the marks as registered or applied for that should be compared. The opponents are, in my view,

correct; it is the mark as applied for that is at issue, and whilst the evidence shows that the applicants and the opponents use their respective marks in a very similar style, this is not a material consideration under Section 5(2)(b).

29. The word NURA and TURA are the same length, differ only in respect of one letter and are both, as far as I am aware, invented words which in my view heightens the likelihood of confusion through imperfect recollection. Against this there is the fact that the difference in the lettering is at the beginning (which is generally regarded as being of most significance) and being very short words, even small differences have a disproportionate effect of similarity.

30. Although the soap is described as “medicated” there is no suggestion that it is for the treatment of particular medical conditions, simply that its use can protect against possible skin or hair problems, which in the case of the applicant’s product, appears to be the prevention of acne. Soap, even medicated is a simple and inexpensive product, and one of a class of goods that in my view the public will be familiar with, for example, medicated shampoos that prevent dandruff are a commonplace item. That the goods are medicated will heighten the degree of care in selection, but as both the applicant’s, and notionally, the opponent’s goods are identical, they should be regarded as being made available to the consumer in the same location within a retail establishment.

31. Compared side by side the differences between NURA and TURA are plain to see. However, as was said in the *Canon* case mentioned above, a consumer “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”. Taking this, and all of the other factors, in particular, the identity in the goods and consumer and the similarities in the respective marks into account, I come to the view that if the applicants were to use their mark in connection with the goods for which they seek registration, that there is a real likelihood of confusion. The objection under Section 5(2)(b) succeeds accordingly.

32. My findings under Section 5(2)(b) effectively decide the issue. However, in their evidence the parties raised a question over the manner in which the respective marks are said to be used, a matter that I consider properly falls to be dealt with under Section 5(4)(a).

33. The applicants make the statement that the fact that their goods are marketed with a conspicuous device or design that renders it impossible for there to be confusion. They do not give details of the device to which they refer, but from the evidence it seems likely that this is the “triple-V” shape in blue with the red semi-circle placed between the legs, which in my view is clearly a distinctive sign. They use the mark NURA in dark green lettering with a lighter green shadow effect, the word running diagonally upwards from left to right, placed on a white background surrounded by yellow. The device is placed above this word, giving it a greater prominence, but to some extent this is lessened by its smaller size relative to the word. The evidence also shows that they include other non-trade mark matter in conjunction with the mark, in particular, the words SAVON, GERMICIDE, MEDICAMENTE in red lettering, placed one above another in that order.

34. The opponent's evidence shows that they also use two "V" shape logos, more akin to a wing-effect in red. The word TURA is shown in dark blue lettering with a lighter blue shadow effect, the word running diagonally upwards from left to right, placed on a white background surrounded by yellow, in conjunction with other non-trade mark matter in particular (but not always) the words SAVON, GERMICIDE, MEDICAMENTE in red lettering, placed one above another in that order.

35. From the above descriptions the similarities in the respective parties packaging is plainly evident. However, in my considerations under Section 5(2)(b) I gave my views on the weaknesses of the opponent's evidence insofar as it fails to establish a reputation prior to the relevant date, and I do not see that they are in any better position in respect of goodwill; there is nothing that establishes use of their earlier mark prior to the relevant date. In the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, and others* (the Reef case), Pumphrey J said:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur."

36. Had the opponent's evidence established that they had the requisite reputation/goodwill, I believe that I would have found in their favour; the device element relied upon would not have saved the application.

37. The opposition having been successful I order the applicants to pay the opponents the sum of £750 as a contribution towards their costs. 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.

Dated this 3rd day of February 2003

**Mike Foley
for the Registrar**