

O-134-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2280262  
BY JOSEPH OLIVER TO REGISTER A SERIES OF TRADE MARKS IN CLASS 42**

**AND**

**IN THE MATTER OF OPPOSITION No. 90097  
BY ARUN AMIRSINH DARBAR**

**TRADE MARKS ACT 1994**

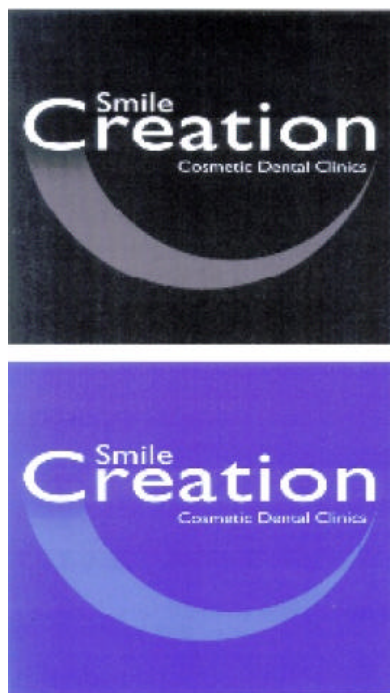
**IN THE MATTER OF Application 2280262  
by Joseph Oliver to register a series of Trade  
Marks in Class 42**

**and**

**IN THE MATTER OF Opposition No. 90097  
by Arun Amirsinh Darbar**

**BACKGROUND**

1. On 11 September 2001 Joseph Oliver applied to register the following series of two trade marks in relation to cosmetic dental services (Class 42):



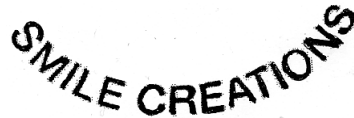
2. I note that the applicant claims the colours blue and white as an element of the second mark in the series.

3. On 21 February 2002 Arun Amirsinh Darbar filed notice of opposition to this application. He is the proprietor of registration No. 1416234 covering 'dental services' in Class 42. The mark is:



4. Mr Darbar contends that the respective marks are similar and the services (the reference to goods appears to be a clerical error) identical or similar such that there is a likelihood of confusion. Objection is, therefore, raised under Section 5(2)(b).

5. The opponent also claims to have used the following mark:



in relation to the services in question since 1990 and has goodwill in relation thereto. He says that use of the applied for mark will offend Section 5(4)(a) and in particular the law of passing off.

6. Dr Oliver filed a counterstatement denying that the marks are similar and that the services are identical (but conceding similarity of services). The grounds of opposition are denied.

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

8. Both sides filed evidence. Neither party has asked to be heard. Both sides have filed written submissions.

## **EVIDENCE**

### **Opponent's evidence**

9. Mr Darbar has filed a witness statement. He is a qualified dentist and owner of the practice AA Darbar & Associates in Leighton Buzzard.

10. He says that the Smile Creations logo was devised in 1989. Because of difficulties presented by the advertising rules and regulations of the General Dental Council early use of the mark was restricted to the practice letterhead and other surgery stationery.

11. Since that time (in or about 1991) the words SMILE CREATIONS and the logo have been used both together and separately in various marketing materials, leaflets, business cards/labels, Christmas cards, advertisements and the like. In support of this Mr Darbar exhibits:

AAD 2 - a 1992 calendar showing the logo usage. Such calendars are said to have been used yearly until about 1995/6;

AAD 3 - a copy of an article from a magazine entitled Lifestyle Summer '94 showing use of both marks. The magazine is a regional one with a free circulation covering several towns and believed to have a circulation of around 10,000 copies;

AAD 4 and 5 - the cover of 1996 and 1998 diaries distributed by the practice and showing the word mark;

AAD 6 - a copy of a certificate issued by a charity dated December 1994 (in relation to fund raising) and showing the word mark;

AAD 7 - a copy of an advertisement published in the Reg Vardy 1996 magazine. The magazine was circulated to customers and employees of the Milton Keynes Reg Vardy dealership. It shows both the word and device marks;

AAD 8 - a copy of an advertisement appearing in the Milton Keynes Journal dated 11 December 1999;

AAD 9 and 10 - a Christmas card having a copyright notice of 1990 showing both marks; and a further card showing a 1995 copyright date. These are advanced as examples of cards distributed by the practice for the years in question;

AAD 11 - an example of a label showing both marks. Mr Darbar says that it was the practice to attach such labels to business cards and other literature distributed by the practice;

AAD 12 - a further example of a label in use;

AAD 13 - a letter from a firm of printers confirming the supply of labels. The letter is not in proper evidential form;

AAD 14 to 16 - copies of Yellow Pages advertisements as follows:

Oxford	1993/94
Watford and St Albans	1992/3
Bedford	1993/4

Both the word and device marks are shown;

AAD 17 - practice growth and advertising figures for the years 1988 to 2002. Mr Darbar says that the practice, under the name of SMILE CREATIONS, has grown

considerably since 1992/3. Advertising figures range from just over £1000 to some £2500 per annum during the relevant period;

AAD 18 to 20 - extracts from General Dental Council publications between 1993 and 2000 showing how the advertising laws in relation to dentistry have become more relaxed.

12. Mr Darbar says that the marketing materials referred to were distributed to patients of the practice and potential future patients, friends, family and fellow dental professionals. The practice is said to be known by the name SMILE CREATIONS to various groups such as laboratory technicians, professional and commercial dental dealers, equipment companies and patients. In support of this he exhibits witness statements by the following:

AAD 21	-	Colin Lee (dental technician)
AAD 22	-	Kim Woods (dental technician)
AAD 23	-	Richard Greenwood (dentist)
AAD 24	-	CG deBelder (dentist)
AAD 25	-	John Balshaw (patient)
AAD 26	-	Norma Fisher (patient)
AAD 27	-	John Yardley (patient)

13. In addition Mr Darbar exhibits:

AAD 28 and 29 - copies of envelopes from equipment companies (date franked May 2001) addressed to the practice and showing the name as SMILE CREATIONS;

AAD 30 - a copy of a letter (dated December 1998) from an equipment supplier showing use of the name SMILE CREATIONS.

14. Mr Darbar concludes by saying that he treats patients from various parts of the country and some from abroad and that it is not uncommon for patients to travel long distances to seek the professional services of his practice.

### **Applicant's evidence**

15. Dr Oliver has filed a witness statement. He too is a qualified dentist and has a cosmetic dental practice in Harley Street, London.

16. Dr Oliver says he started to use the mark which is the subject of this application in October 2001. He exhibits business papers and brochures showing use of the mark (JO1, JO2(a) and JO2b).

17. The mark is used in advertisements (examples given at JO3), mainly in national magazines such as Marie Claire, Vogue, FHM etc. In addition several publications have put out PR articles about the practice (JO4). I note that these publications include Men's Health, OK, national newspapers, Sainsbury's magazine, Woman's Own and Dentistry magazine. He contrasts his own largely national-publication-based advertising and PR with what he considers to be the very specific geographical coverage of Mr Darbar's advertising.

18. Dr Oliver goes on to exhibit the results of an online search using the Marquesa system to show that the word SMILE is increasingly being used and incorporated into trade mark registrations covering dental services (JO5).

19. He exhibits, at JO6, letters obtained from patients, colleagues and technicians showing that his clinic is known as SMILE CREATION. I comment in passing that these documents appear to have been solicited for the purposes of these proceedings and are in the form of 'To whom it may concern' letters.

20. Finally, he exhibits at JO7, copies of letters and invoices showing that the practice is generally referred to as SMILE CREATION.

21. He concludes with the following observations on the parties' respective practices:

- “21. Not only are the trade marks not similar, the nature of the respective practices are also dissimilar in as much as patients attending my clinic are doing so on the sole purpose of obtaining high quality cosmetic treatment to correct “crooked teeth”, close gaps, reshape uneven teeth, mask discolorations and whiten their teeth. They do not attend for general dental purposes and in many circumstances, I would say 90% of the time, after having this treatment they will attend their own dentist for routine dental work. My patients, and prospective patients, look upon me as a specialist in the field. To the best of my knowledge and believe [sic] the Opponent's practice is a general practice dedicated to carrying out general dental work. In his area he would be classified as a “family practice” and he would only carry out cosmetic work if asked by patients already on his books. I very much doubt that such cosmetic treatments will amount to more than 10% of his total turnover, whereas cosmetic treatment amounts to approximately 90% of my practice's turnover. The Opponent would not be considered a specialist in his field, instead, he would be known locally as a “family clinician”.
22. Whereas the Opponent's evidence does show there is an awareness, possibly a reputation, in his practice in the Leighton Buzzard area, he fails to establish any kind of goodwill and / or reputation in his Trade Mark or specifically in respect of cosmetic dental surgery.”

### **Opponent's evidence in reply**

22. Mr Darbar has filed a further witness statement with Exhibits AAD 31 to AAD 48. The first of these exhibits contains copies of misdirected e-mails which, Mr Darbar suggests, is indicative of the fact that confusion is likely. He also says that a patient of his practice who lives in Kent was given Dr Oliver's telephone number by a directory enquiry service when he was trying to contact his (Mr Darbar's) surgery.

23. Mr Darbar supplements certain information from his first statement which was criticised by Dr Oliver. He says that approximately 500 of each of the calendars and diaries were produced. The growth figures for his practice (referred to in AAD 17) are given in relation to percentage increase in patient numbers (however, the actual patient numbers are not given).

24. Mr Darbar devotes part of his statement to rebutting what he sees as unjustified assumptions made by Dr Oliver about the nature of his business (namely that it is a family practice and to be distinguished from a specialist practice dealing with cosmetic dental work). He estimates that 80 per cent of his practice relates to cosmetic dentistry. In particular, it would seem that Mr Darbar's particular area of expertise is in the field of laser dentistry. Exhibits AAD 35 to AAD 47 deal largely with Mr Darbar's specialist recognition.

25. I do not propose to record further details as this particular point is of marginal relevance to the issues I have to decide.

26. That concludes my review of the evidence.

### **The parties' submissions**

27. These appear to have come in in piecemeal fashion. I have before me letters from Marks & Clerk, the opponent's trade marks attorneys, dated 22 April 2004, 6 December 2004 and 25 April 2005 (two letters). For the applicant, Jensen & Son, trade mark attorneys, have filed submissions under cover of a letter dated 25 April 2005. These are in addition to points contained in the evidence which are in the nature of submissions. I bear these submissions in mind and will comment on them below where they are relevant to the issues before me.

### **DECISION**

#### **Section 5(2)(b)**

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

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

- (a) .....
- (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.”

29. I have been referred to and 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.

30. 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*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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 & C. GmbH v. Klijsen Handel B.V.*;
- (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*;

- (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*;
- (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*;
- (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*;
- (g) account should be taken on the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*;
- (h) 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*;
- (i) 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*;
- (j) 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*.

### **Comparison of services**

31. The applicant concedes that the respective services are similar but not that they are identical. The comparison is between the opponent's dental services and the applicant's cosmetic dental services. As a matter of plain language dental services must be taken to include all kinds of dental services. Cosmetic dental services is simply a sub-category of the broad term. In *Galileo Trade Mark, O/269/04*, Professor Annand, sitting as the Appointed Person, held that:

“I believe that overlapping specifications satisfy the test for identical goods or services in Section 5(1) of the TMA. There is no necessity for such specifications to co-extend”.

The same must be true when considering whether services are identical or similar for the purposes of Section 5(2)(b). I, therefore, find that the services in question are identical. In doing so I am of course considering the matter from the point of view of the notional scope of the specifications. The parties have been at pains to emphasise the precise nature of their actual trade and I will need to touch on this below. But the mere fact that existing trade has been within the scope of the existing specifications does not mean that their full scope need not be considered.

### **Distinctive character of the respective marks**

32. The opponent's mark consists of a device of a smiling cartoon bear. The bear is wearing a t-shirt with the words SMILE CREATIONS. The bear has upraised thumbs either side of the words so that it appears to be signifying approval. Between the words SMILE CREATIONS there is what I take to be conjoined letters. It may well be the letters AD indicating the initials of



the opponent's name but, even if that is the case, it would only be apparent to someone who associated the mark with Mr Darbar and paused to consider what the conjoined lettering might mean. That is not a process the average consumer is usually credited with undertaking and certainly not when there are other more easily identifiable elements in the mark.

33. It has been suggested by Dr Oliver that the word SMILE "is increasingly being used in the field of dental services and that no one entity is entitled to claim a complete monopoly in the word". I have been referred to a number of trade mark registrations incorporating the word. The suggestion is, therefore, that the word is of low distinctive character in relation to dental services and that, as a consequence, "the average consumer would remember the figure of the bear and not the words of the opponent's mark" (applicant's written submissions at 7.1).

34. It may be that the word SMILE is an attractive one in relation to dental services because the act of smiling is one of the means of displaying healthy teeth or the positive effects of cosmetic dental treatment. To that extent it has desirable associations. The evidence falls short of establishing whether the word is in common use in the trade. The existence of trade mark registrations containing the word does not in itself tell me anything about use in the marketplace or consumer perception of the word.

35. In any case, marks must not be unduly dissected. The words appearing in the opponent's mark are SMILE CREATIONS and I have little doubt that the combination is both distinctive in its own right to a reasonable degree and also a distinctive but not dominant element within the totality of the mark. The visually dominant feature of the mark is the cartoon bear device but it is usually said that words talk in trade marks so the words (and to a much lesser extent the conjoined letters) still play an important part in the make-up of the mark. I would suggest the whole mark commands a high degree of distinctive character.

36. So far I have been considering the inherent characteristics of the mark. The guidance from *Sabel v Puma* is that consideration must also be given to distinctive character acquired through use. The point was considered in *Steelco Trade Mark*, O/268/04, where Mr D Kitchin Q.C, sitting as the Appointed Person, said:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion."

37. Mr Darbar's evidence establishes use of the logo mark from at least 1992. Use would appear to be largely concentrated around the catchment area of the practice though I note that Mr Darbar says he has customers from further afield. The extent of the latter claim is not clear. Advertising expenditure has been running at a modest but consistent level. Account must be taken in this respect of the restrictions on the freedom of such practices to advertise in the conventional sense and the fact that this is essentially a local service which does not generally need to engage in high profile advertising.

38. As patient numbers and/or turnover figures have not been provided it is somewhat difficult to judge the size of the business. The evidence shows that Mr Darbar has a reputation that extends outside the UK particularly in the field of laser dental treatment. But this seems to relate to his expertise as an individual rather than reflecting reputation under the practice name or logo. On the basis of the material before me use cannot be said to have added to the distinctive character of the logo mark. But as I regard the mark as of high distinctive character anyway that is not a matter of particular consequence for the course of this opposition.

39. The applied for mark is also a composite one containing the words SMILE CREATION COSMETIC DENTAL CLINICS and what the applicant describes as a swoosh device with the whole being set within a box. Colour is claimed as an element of one mark in the series but does not appear in itself to be of particular importance. The word SMILE is in much smaller script to the word CREATION and the descriptive words COSMETIC DENTAL CLINICS are smaller still. The swoosh device is not particularly remarkable or memorable but makes some visual contribution to the mark. Dr Oliver says that his clinic is known as SMILE CREATION. I infer that, notwithstanding the relative proportion of the elements and presence of other matter, that is how the mark is perceived by consumers. It is a fair reflection in my view of where the distinctive character of the mark can be said to lie. These words are the dominant and distinctive component of the mark.

### **Comparison of marks**

40. It is well established in the cases referred to above that I must consider the visual, aural and conceptual similarities and differences between the marks. I have been referred by the opponent to a judgment of the Court of First Instance as offering guidance on how to approach marks where figurative elements are present. The particular paragraph relied upon is the following:

“Even if it could be found that there is no visual similarity between the conflicting signs, the Board of Appeal was right to find that there is a likelihood of confusion in the present case. Given that the goods concerned are identical and that the signs in question are conceptually similar – to which must be added that, in view of the relevant public, the signs are phonetically identical – visual differences between the signs are incapable of ruling out a likelihood of confusion on the part of that public (see, to that effect, *Fifties*, paragraph 46).”

41. The applicant’s written submissions counter this by pointing out that the subject mark appears to have had relatively minor stylistic embellishments and the Court based its comparison on a closely similar word only mark and not a second mark incorporating the same word with a stylised dog device (the goods were foodstuffs for dogs and the device was of a dog). The particular circumstances of that case were rather different but I accept the general proposition that likelihood of confusion must take account of similarities and differences between marks. The existence of a likelihood of confusion cannot be discounted simply because of the existence of points of difference any more than it can be inferred because of the existence of points of similarity.

42. The visual differences between the opponent’s logo mark and the applied for mark are clear to see. The opponent’s bear device creates a lively and memorable image which will fix itself in the consumer’s mind. The words SMILE CREATIONS and to a lesser extent the conjoined letters will also be noticed. They are neither so small as to be ignored or descriptive to an extent that they will be discounted.

43. The applied for mark is visually easy to distinguish in terms of the overall get-up and impact of the respective marks. But that visual appreciation cannot also fail to notice that both contain the element SMILE CREATIONS/SMILE CREATION. The effect of that will be considered when I deal with the likelihood of confusion.

44. It is apparent from the evidence that both sides suggest that their marks are known by the common word elements. That is scarcely surprising in the case of the applied for mark. It is more difficult to know, absent actual evidence from consumers, how the opponent's logo mark would be referred to in oral usage. Various possibilities present themselves – e.g. by reference to the bear, the words SMILE CREATIONS or the SMILE CREATIONS bear. The evidence suggests that the opponent uses the words as the main reference point. That is in turn supported by the witness statements at AAD 21 to AAD 27 though I am reluctant to place too much reliance on these statements for the reasons given later in this decision. Nevertheless, taken in conjunction with the rest of the evidence I do not think the reaction of the individuals concerned is at all implausible and tends to reinforce my own initial (and unprompted) view of the mark. It is improbable that the applicant's mark would be referred to as anything other than SMILE CREATION. Consumers have, it seems to me, been encouraged to approach the mark in that way. I, therefore, find a high degree of oral/aural similarity.

45. Conceptually, as with visual considerations, there are opposing forces at work. The idea of the cartoon bear has no counterpart in the applied for mark. But both marks share the concept created by the words SMILE CREATIONS/SMILE CREATION.

#### **Likelihood of confusion**

46. As part of the required global appreciation I must say a little more at this point about the parties' evidence and submissions about the nature of their respective businesses and the related matter of the average consumer.

47. Dr Oliver has suggested that the opponent would be considered to be a family clinician rather than a specialist practitioner. He seeks to distinguish the underlying businesses on the basis that he is a specialist in cosmetic dental treatment to correct crooked teeth, close gaps, reshape uneven teeth, mask discolorations and whiten teeth. Mr Darbar counters that he too is a recognised specialist in the laser dental treatment field and that 80 per cent of the work in his practice relates to cosmetic dentistry.

48. As I have already indicated, these submissions based on current trading fail to take due account of the notional coverage of the specifications and what it is open to either of the parties to do (or their successors in title if at some future date the marks are assigned) within the legitimate boundaries of the services described in those specifications.

49. The fact that Dr Oliver and Mr Darbar have operated in rather different areas (both geographically and within the cosmetic dentistry field) also serves to explain why the scope for confusion arising in the period since October 2001 has been limited. Mr Darbar, nevertheless, has pointed to an instance of confusion in the succession of e-mails at AAD 31. Although some 7 e-mails are involved they all appear to stem from the original error. The circumstances in which the confusion arose are not clear. The e-mails relate to vehicles and it seems likely that the originator had wrongly directed the e-mails to Mr Darbar on the basis of the words SMILE CREATION rather than familiarity with the composite mark that is the subject of the Section 5(2)(b) action. It also follows that the alleged instance of confusion did not arise out of any trade in dental services. I do not, therefore, derive any assistance from Exhibit AAD 31 apart from the

fact that it provides further confirmation that SMILE CREATIONS/SMILE CREATION are likely to be the key words by which the respective businesses are known.

50. I turn now to the evidence from witnesses (Exhibits AAD 21 to AAD 27 to Mr Darbar's statement) which is 'matched' by comparable material in Exhibit JO6 to Dr Oliver's statement. The latter can be given no weight as the material is not in evidential form complying with Section 69 of the Act and Rule 55 of the Trade Marks Rules 2000. Mr Darbar's witnesses consist of a mixture of professionals in the dental field and patients of his practice. They claim to have known of the opponent's practice for periods that range between 5 and 18 years and say that it operates under the name SMILE CREATIONS.

51. There are a number of problems with this material. Firstly, some of the statements are couched in similar terms giving rise to the possibility that the statements may not represent the witnesses own words; secondly, the evidence refers to the name SMILE CREATIONS and not the composite mark; thirdly, resulting from this, the evidence does not assist in assessing the likelihood of confusion between the opponent's composite mark and the applied for mark; and fourthly, three of the witnesses, being patients of Mr Darbar's practice, might be expected to make the claims they do and the remaining witnesses do not say what their relationship (if any) is with Mr Darbar or how they were chosen to make statements.

52. Again, therefore, apart from confirming the name by which Mr Darbar's practice is known this evidence does not take matters further forward. The individuals do not comment on whether they ever have been, or would be, confused. In considering the likelihood of confusion I must bear in mind not merely those who are already familiar with one or other of the practices but also those who may not previously have encountered either.

53. I should comment at this point on the average consumer for dental services/cosmetic dental services. It is self-evident that consumers will be individuals - any member of the public at large with teeth (or needing them)! The evidence of the parties to this case demonstrates, however, that general descriptions of such services conceal the fact that there are also individual practitioners whose practices have been built on offering specialist care and expertise and who may be sought out for their particular skills. I note, for instance, that Dr Oliver says that 90% of the time individuals who come to his specialist clinic attend their own dentist for routine dental work. Two points arise from this. The first is that whilst I would expect someone seeking general dental treatment to choose a practitioner with some care, rather greater care is likely to be exercised in seeking out specialist treatment. The second point is that I anticipate that personal/oral recommendations are likely to play a part in this process. The relative importance of aural considerations should not, therefore, be underestimated when considering the likelihood of confusion.

54. Making the best I can of the above factors it is inconceivable there would be direct confusion in the sense that one mark would be mistaken for the other on the basis of a visual comparison (even allowing for sequential rather than concurrent acquaintance with the marks). The bear device is simply too strong for that to happen. However, the words SMILE CREATIONS constitute an important, distinctive and memorable feature of the opponent's mark. I think it is likely that consumers encountering the applied for mark would think this was another mark from the same stable as the opponent's composite mark. They might, for instance, consider that the bear device was an additional feature designed to appeal to children or to reinforce the words by giving the practice a friendly image. The opponent's case is even stronger when allowance is made for the effects of oral/aural use. The evidence suggests that both practices are known and referred to by the name SMILE CREATION/SMILE CREATION. There is no evidence that consumers attempt to refer to either practice or the marks under which they trade by other

features. I, therefore, find that there is a likelihood of confusion and that the opposition succeeds under Section 5(2)(b).

55. In the circumstances I do not need to go on to consider the opponent's case under Section 5(4)(a).

## **COSTS**

56. The applicant's written submissions invite me to take into account a number of issues bearing on costs. In summary these are amendments that were required to the opponent's original statement of grounds; the withdrawal of a ground based on Section 5(3); irregularities in the opponent's evidence that required correction; late (and unsuccessful) requests by the opponent to have further evidence admitted; and a failure to copy a piece of correspondence. It is submitted that these matters caused delay and unnecessary costs. The opponent has not commented on costs.

57. So far as the amendment to the original grounds is concerned it should not have inconvenienced the applicant to any appreciable extent as the opposition was not served until the amendments were made. The amendments were also dealt with reasonably expeditiously by the opponent.

58. In relation to the dropping of the section 5(3) ground, this was requested at an early stage and before the filing of evidence. The opponent should not be penalised for withdrawing a ground that he had decided not to pursue. On the contrary, parties should generally be encouraged to act in this way.

59. The procedural irregularities in the opponent's reply evidence were identified by the registry and dealt with by the opponent within the time allotted.

60. There have been requests to admit three different pieces of additional evidence at various times. The requests have either been out of time or refused for other reasons. In two instances it seems that the material the opponent sought to adduce had only recently come to light and could not therefore have been introduced at an earlier stage. In the third case the material was in the nature of submissions and reproduced the contents of a letter which can properly be considered. I cannot see that the applicant has been particularly inconvenienced or put to significant additional costs as a result of these events nor has there been inordinate delay.

61. The circumstance surrounding the non-receipt of a piece of correspondence (Marks & Clerk's letter of 25 November 2004) remains unexplained. But it is not clear that it resulted from a failure on the opponent's attorney to send it rather than a failure on the part of the postal service to deliver it. I note that the registry's copy of the letter indicates that a copy was sent or intended to be sent to Jensen & Son, the applicant's attorneys. It is not suggested that this is other than an isolated and unexplained occurrence.

62. I am not persuaded that the opponent's actions, taken individually or collectively, merit a costs penalty. Accordingly, I intend to make an award to the opponent to reflect his success in the action. I order the applicant to pay the opponent the sum of £1500. 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 12<sup>th</sup> day of May 2005**

**M REYNOLDS  
For the Registrar  
the Comptroller-General**