

TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 1530537  
BY ERIC PETERSON  
TO REGISTER A TRADE MARK  
**NATURAL WHITE AND DEVICE**  
IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 41828  
BY NATURAL WHITE INC.

BACKGROUND

On 23 March 1993, Eric Peterson of 50c Kings Road, Richmond Surrey, TW10 6EP applied under the Trade Marks Act 1938 for registration of the trade mark shown below:



In respect of "Essential oils included in Class3".

The application was advertised before acceptance by reason of trade evidence. The application form also contains the following disclaimer: -

"Registration of this mark shall give no right to the exclusive use, separately, of the words 'Natural' and 'White'."

On 29 December 1994, Natural White Inc. of 15449 Yonge St., Suite 206, Aurora, Ontario, Canada, filed notice of opposition to the application. The grounds of opposition are:

1) The opponents are the applicants for registration of their trade mark NATURAL WHITE filed in Class 3 on 19 February 1994 under trade mark number 1562905. The mark applied for by Eric Peterson is confusingly similar to the opponents' pending trademark application and therefore offends against Section 12(3) of the 1938 Trade Marks Act.

2) The opponents have made extensive use of the trademark NATURAL WHITE in the UK in relation to goods covered by their application and have acquired a valuable goodwill and reputation in this trade mark in the UK. In addition they have made extensive sales of products under their NATURAL WHITE trademark all around the world and have acquired a very valuable goodwill and reputation in association with this

trademark.

5 3) The trade mark applied for so nearly resembles the opponents' pending application and, by reason of the reputation and goodwill of the opponents' trademark which is in use, of the mark sought to be registered by the applicant would be deceptive and disentitled to protection in a Court of Justice and therefore offends against Section 11 of the Trade Marks Act 1938. Indeed there have already been instances of confusion in that a member of the UK public who was familiar with the opponents' product purchased the applicant's product in the mistaken belief that it originated from the opponents.

10 4) The trade mark which is the subject of the present application is neither adapted to distinguish nor capable of distinguishing the applicant's goods as covered by this specification from those of third parties and therefore is not a registrable trademark under the provisions of Sections 9 or 10 of the Trade Marks Act 1938.

15 5) At the time of filing the application, the applicant was not the true proprietor of the trademark and the application should be refused under provisions of Section 17 of the Trade Marks Act 1938.

20 6) At the time of filing the application the applicant had no intention of using it as a trademark and therefore registration should be refused under the provisions of Section 68 of the 1938 Trade Marks Act.

25 7) The conduct of the applicant or the nature of their trademark or its use is such that registration of this trademark should be refused in the exercise of the Registrar's discretion.

30 The applicant filed a counterstatement denying all of the grounds of opposition and also stated that he was the rightful proprietor of the mark in the UK. The applicant also asks the Registrar to exercise her discretion in his favour and both sides seek an award of costs in their favour. Both sides filed evidence in these proceedings and the matter came to be heard on 8 February 2000 when the applicant was represented by Ms Clark of Counsel instructed by Marks & Clerk. The opponents were represented by Ms Reid of Counsel instructed by Eric Potter Clarkson.

35 By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the Trade Marks Act 1938 ( as amended) unless  
40 otherwise indicated.

#### OPPONENTS' EVIDENCE

45 This consists of a statutory declaration, dated 9 September 1997, by Mr Findlay McClymont. Mr McClymont states that:

"I am a director of FDD Limited, of Unit 1, 94 - 106 Church St., Staines, Middlesex,

TW18 4YA, which company acts as UK importer and distributor for Natural White Inc. a corporation organised and existing under the laws of the State of New York, United States of America, of 15449 Yonge St., Suite 206, Aurora, Ontario, L46 1P3, Canada (hereinafter referred to as the opponent). I hold a Power of Attorney from the opponent, which authorises me to act in the capacity of an officer of the opponent, and to have access to the opponent's books and records. I am therefore authorised to make this declaration on behalf of the opponent, and the contents of this my declaration are from my own knowledge or have been obtained by consultation of and reference to the opponent's books and records."

"The opponent was incorporated on 17 August 1992. I am familiar with the business and the activities of the opponent, which has, in addition to its offices and place of business at 15449 Yonge St. aforesaid, a place of business in Buffalo, New York State, United States of America. I am especially familiar with and knowledgeable concerning the opponent's business and activities in the UK."

Mr McClymont states that the opponents manufacture, market and sell dentifrices, toothpastes and preparations for cleaning polishing and whitening teeth. These he claims are sold under the trade marks NATURAL WHITE (the word mark) and NATURAL WHITE AND SMILE DEVICE (the combination mark). Applications for both are said to have been filed in the UK under Numbers 2050442 and 2050391 respectively, in each case in respect of "all goods included in Class 3".

Mr McClymont states that the opponents use of the word mark and combination mark "commenced immediately upon the incorporation of the opponent". They were, he says, initially used on a component product comprising a mouth rinse, a bleaching gel and a polishing toothpaste and in January 1993 extended to use on a toothpaste.

At exhibit FM1 Mr McClymont provides copies of sales literature some of which show the address of the UK distributor, and a copy of the packaging from the "peroxide bleaching system". None of the items are dated, although a number have reference to a 1995 copyright, also some show only the USA address of the company.

Mr McClymont states:

"The opponent has extensively marketed and sold the goods under and by reference to the trademark, on an international basis. Such use has included extensive use in and throughout the United Kingdom, where the trade mark was first used in relation to the goods by the opponent immediately following the incorporation of the opponent in August 1992. The opponent's use of the trade mark in relation to goods in the United Kingdom has been continuous since that time."

"Specific and detailed information relating to sales of the goods under the trade mark in the United Kingdom in the years 1992 and 1993 is not available. However, the opponent's informed estimate is that sales in the United Kingdom of the goods under and by reference to the trade mark in 1992 and 1993 was of a value in the order of US\$12,000 - US\$16,000 which represent unit sales of approximately 4,000 - 5,300. The approximate retail value of the opponent's sales in the United Kingdom of the goods under and by reference to the trade mark for past three years

was as follows:

Year	Sales value (US \$)	Units
1994	In excess of 100,000	In excess of 34,000
1995	In excess of 550,000	In excess of 390,000
1996	In excess of 2,200,000	In excess of 1,450,000

Mr McClymont claims that “the opponent has since August 1992 spent more than US\$320,000 in the United Kingdom in advertising and promoting the goods sold under and by reference to the trade mark.” He claims that newspaper and television advertisements were used, and that promotional literature and in store promotions were also used. The television advertisements were on CNN which he claims are available to “several million subscribing households” and also in over 100 hotels.

A list of 38 towns and cities covering the whole of the UK is provided and Mr McClymont claims that sales under the trade mark have been made in each of them. He claims that the long and extensive use of the trade mark in the UK has established a valuable and important rights and reputation in the trade mark. Mr McClymont also provides worldwide sales figures, which rise from US\$2.7million in 1992 to US\$16.2 million in 1996.

Mr McClymont states his view that the mark in suit is confusingly similar to that of the opponent and for the same or similar goods. He claims that the opponents use pre-date the filing of the application and that the applicant’s mark would damage and dilute the goodwill and reputation of the opponents in their trade mark. Finally, he claims that the application was “filed in the knowledge of, and with the intention of trading upon, the opponents’ reputation and goodwill as the result of the opponents’ use of the trade mark.”

#### APPLICANTS’ EVIDENCE

This consists of a statutory declaration, dated 25 March 1998, by Mr Eric Peterson, the applicant.

Mr Peterson does not accept the opponents’ claims to have used their mark in the UK since 17 August 1992 and points to the fact that they are unable to produce detailed information. He states that:

“My belief that the opponent did not commence use of the Natural White trade mark in the UK until after my filing of the opposed application and, indeed my commencement of use of the NATURAL WHITE mark in the UK, is supported by the fact that the opponent did not apply to list such products with the Chemist and Druggist Price Service until some time in 1994. Such a listing is invariably sought prior to the launch of a product.”

Mr Peterson contrasts this with his own listing with the Price Service in December 1993, a date confirmed in a letter from the Chemist and Druggist Price Service dated 8 July 1994 at exhibit

service dated 8 July 1994 at exhibit EP1. This letter states that the newspaper has “been informed of the launch in the UK of Natural White ( a product of Natural White Inc.) By FDD International Ltd.”

5 Mr Peterson also provides at exhibit EP2 a copy of the statement of claim filed by the opponents in High Court proceedings CH-1995-N No 3661. Paragraph one of this exhibit states:

10 “At all material times the Plaintiff has manufactured and sold (inter alia) a toothpaste product which is supplied and promoted under and by reference to the trade mark “NATURAL WHITE” (hereafter referred to as “the trade mark”). In particular, such products have been sold directly in the United Kingdom since 1993 through its distributor FDD International Ltd”.

15 Mr Peterson claims that even if one were to accept the opponent’s claims of sales in the UK during the period 1992 - 1993, sales of less than £10,000 in the 16-month period is very low, and that some would have been after the relevant date, 23 March 1993. He states that products under the mark in suit were first sold by him in the UK in December 1993. The range of products are said to include teeth whitening products, mouth-washes and rinses. He then provides turnover figures for sales under his Natural White trade mark:

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Year	Turnover £
1994	452,810
1995	470,686
1996	883.000
1997	1,034,000

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Mr Peterson claims that because of his extensive use in the UK the mark NATURAL WHITE is associated with his products not those of the opponents. He also claims to have the mark in suit registered in 34 other countries.

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Mr Peterson claims that the High Court action for passing off brought by the opponents against him was dismissed with costs awarded against the opponents.

35 Mr Peterson then answers a number of points raised by the opponents in their evidence. He states that:

- the marks are not identical or confusingly similar
- the goods are not similar
- the opponents use of their mark in the UK does not pre-date his use and application
- use of the mark in suit by him would not cause confusion or deception as to the origin or provenance of the goods

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- use of the mark in suit by him will not dilute or damage the opponents' reputation of goodwill or unfairly prejudice the opponent in the conduct of its business

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- that at the date of filing the application the mark in suit was not well established as the trade mark of the opponents.

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- that at the time of filing the application he had no knowledge of or intent to trade upon the opponent's reputation or goodwill, if any, that had been acquired by the opponents use of the mark NATURAL WHITE

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- that at the time of filing he intended to use the mark applied for. He proposes to use it for an essential oil-based product for the treatment of bad breath.

Finally, Mr Peterson claims that the opponents trade mark application 1562905 has been abandoned. At exhibit EP3 is a print out relating to the application showing its status as abandoned

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That completes my review of the evidence.

## DECISION

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The first ground of opposition is under Section 12 of the 1938 Act. This reads as follows:

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*12. - (1) "Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of*

*(a) the same goods,*

*(b) the same description of goods, or*

*(c) services or a description of services which are associated with those goods or goods of that description."*

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*(2)....*

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*(3) Where separate applications are made by different persons to be registered as proprietors respectively of marks that are identical or nearly resemble each other, in respect of -*

*(a) the same goods,*

*(b) the same description of goods, or*

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*(c) goods and services or descriptions of goods and services which are associated with each other,*

*the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or on an appeal ( which may be brought either to the Board of Trade or to the Court at the option of the appellant) by the Board or the Court, as the case may be.*

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The reference in Section 12 to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

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The opponent has referred specifically, and solely, to section 12(3) in the pleadings. The ground of opposition was based on application 1562905, which subsequent to the opposition being filed has been refused by the Registry, a fact acknowledged at the hearing by Ms Reid. This ground of opposition therefore fails.

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The next ground of opposition is under Section 11 of the Act, which reads:

*“11. - It shall not be lawful to register as a service mark or part of a service mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design”.*

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The established test for objections under this provision is set down in Smith Hayden & Co. Ltd’s application [Volume 1946 63 RPC 101] later adapted by Lord Upjohn in the BALI trade mark case [1969 RPC 496]. Adapted to the matter in hand these tests may be expressed as follows:

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Having regard to the user of the opponent’s mark, NATURAL WHITE, is the tribunal satisfied that the mark applied for, NATURAL WHITE AND DEVICE, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

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I must therefore consider the actual user of the opponents’ mark. It is stated that the opponent began use of the mark NATURAL WHITE immediately after incorporation, which occurred in August 1992. Therefore at the relevant date, 23 March 1993, the mark had been in use for a maximum of eight months. There is no corroborative evidence, such as invoices, filed to support this claim. Indeed in the opponent’s evidence it is stated that:

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“Specific and detailed information relating to sales of the goods under the trade mark in the years 1992 and 1993 is not available.”

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The sales figures for these two years are said by the opponent to be an “informed estimate”. It is not clear what this estimate is based upon, in the absence of figures from the opponent’s books. It is not clear whether Mr McClymont or FDD Ltd were the UK distributors prior to the relevant date. The claim of use since 1992 appears to contradict the claim made in the passing off proceedings that the first use in the UK occurred in 1993. I therefore conclude that the opponent’s claim to earlier use is not made out.

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Even if I were to accept these uncorroborated figures as accurate, the sales for the period August 1992 to December 1993 are given as US\$12,000 - 16,000. This equates to approximately £7,500 - 10,000 for a seventeen month period. The opponent's claimed user is therefore small and the goods applied for "essential oils" are significantly different to a peroxide bleaching system for teeth, even allowing for the fact that essential oils includes use as a breath freshener. Consequently, even if there was a small amount of earlier use by the opponent the differences between the respective goods is sufficient to rule out confusion amongst a substantial number of persons.

The opposition under this section fails.

The next ground of opposition is under Sections 9 & 10 of the Act. As this application is for registration in Part B of the Register, the opposition under Section 9 is not relevant. Section 10 reads as follows:

*10. - (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.*

*(2) In determining whether a trade mark is capable of distinguishing as aforesaid the tribunal may have regard to the extent to which -*

*(a) the trade mark is inherently capable of distinguishing as aforesaid; and*

*(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.*

*(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.*

The specification applied for is "Essential oils in Class 3". In evidence the applicant states that they intend marketing a product for the treatment of bad breath. Ms Reid at the hearing claimed that the mark was descriptive of these goods, as she classified them as "oral hygiene products".

To my mind the words NATURAL WHITE do not convey any meaning when used on a product made from essential oils for bad breath. Neither word, separately or combined, relates to a smell and so are not descriptive. The opposition under this section therefore fails.

The opponents have also claimed that the registration should be refused under Section 17(1) as the applicant is not the true proprietor, and under Section 68 as the applicant had no intention of using it as a trade mark. No evidence has been filed to show that the applicant is not the true proprietor and there is no reason to believe that the applicant applied to register a trade mark they did not intend to use. The opposition under these Sections therefore fail.



I do not intend to invoke the Registrar's discretion in favour of the opponents.

5 As the opposition has failed, the applicant is entitled to a contribution towards its costs. I order  
the opponent to pay the applicant the sum of £835. 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.

10 Dated this 9 Day of May 2000

15 George W Salthouse  
For the Registrar  
The Comptroller General

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