

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 2186236  
by Natural Organics, Inc. to register a trade mark  
in Class 3**

**AND IN THE MATTER OF Opposition thereto  
under No 49887 by The Gillette Company**

1. On 14 January 1999 Natural Organics Inc of the United States of America applied to register the trade mark NATURE'S PLUS in Class 3 in respect of:

Body and skin creams; body and skin moisturisers; body and skin oils; cleaning preparations; soaps, shampoos, hair conditioners and nail strengtheners.

2. On 17 June 1999 The Gillette Company of Boston USA filed notice of opposition. The grounds of opposition are based upon Sections 5(2) and 5(4)(a) of the Trade Marks Act 1994. The objection under Section 5(2) arises because the opponent is the proprietor of three earlier trade marks registered in Class 3.

3. These are registration No 1312710, consisting of the word NATREL, registration No 1489701, consisting of a series of trade marks the dominant feature of which is the word NATREL with the word PLUS used in a variety of ways, all of which are smaller and secondary to NATREL, and registration No 1578031, consisting of the words NATREL PLUS in equal size and block capital letters.

4. The opponent says that the mark in suit is similar to the earlier trade marks and is to be registered for goods which are either the same or of the same description as the goods in respect of which the earlier trade marks are protected and, as a result, there is a likelihood of confusion on the part of the public. The application should therefore be refused under Section 5(2)(b) of the Act.

5. The opponent further says that it has used its NATREL marks and acquired a substantial reputation and goodwill under those marks. In consequence it says that use of the applicant's trade mark was, at the date of application, liable to be prevented by the law of passing-off. Registration should therefore be refused under Section 5(4)(a) of the Act.

6. The applicant denies the grounds of opposition.

7. Both sides seek an award of costs.

8. The parties subsequently filed evidence and the matter came to be heard on 26 November 2001, when the applicant was represented by Mr D Kitchin QC instructed by Kilburn and Strode and the opponent was represented by Mr C Morcom QC instructed by Gillette Management Inc.

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

9. Section 5(2) of the act is 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."*

10. It is common ground that the marks cited by the opponent are "earlier trade marks" within the meaning of section 6 of the Act. Mr Morcom relied primarily upon the opponent's earlier trade mark NATREL PLUS, which is registered for "*deodorants, anti-perspirants, perfumery and perfumed body sprays; all included in Class 3.*" He accepted that the opponent's registration of a series of NATREL PLUS marks under No 15178031 in respect of an identical specification of goods added nothing to the opponent's case. However, the opponent's registration of NATREL under No 1312710 is protected in respect of a wider range of goods, namely "*perfumes; cosmetics; non-medicated toilet preparations; soaps; shampoos; preparations for the hair; dentifrices; anti-perspirants; deodorants for personal use; all included in Class 3.*"

11. I approach the matter taking account of the following guidance from the European Court of Justice (ECJ) in Sabel BV v Puma AG (1998 RPC 199 at 224), Canon v MGM (1999 ETMR 1) and Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698) and Marca Mode CV v Addidas AG & Others (2000 ETMR 723):

- a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, 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;
- c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 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;

e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

f) there must be evidence of similarity between the respective goods or services and objective factors such as those set out in British Sugar PLC v James Robertson & Sons Limited [1996] RPC 281 are relevant in assessing such similarity;

g) 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;

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);

i) but if the association between the marks results in a likelihood that the average consumer will 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;

j) a positive finding of a likelihood of confusion is required; even where the earlier mark enjoys a reputation with the public, it is not sufficient to find that confusion cannot be ruled out because of a likelihood of association.

12. It is convenient to turn at this point to the applicant's evidence. It consists of a statutory declaration by Marci Dunnder, who is the President of Natrel Organics Inc, and a further statutory declaration by Ralph Pike, who is the Director of the National Association of Health Stores UK. Mr Pike is also a health products retailer.

### **The Applicant's 'Reputation for Related Goods' Argument**

13. Ms Dunnder states that the applicant has used the mark NATURE'S PLUS in the UK since 1982 in respect of various dietary food supplements. She claims that the applicant's interest in vitamin based products for care of the skin and hair are a natural extension of its trade.

14. There is no suggestion that the opponent traded in hair or skin care products at the relevant date in these proceedings. Nevertheless, Mr Kitchin submitted that it was relevant that there was no evidence of confusion despite the fact that the applicant's goods had been on sale in the UK for nearly 20 years before the date of the application. Mr Kitchin invited me to consider whether the applicant's use of the mark for the goods listed in the application was likely to be regarded by the public as a legitimate extension of its existing business in the UK, rather than signifying any connection with the opponent.

15. The parameters of the enquiry under Section 5(2) of the Act are clear. It is appropriate to consider whether the similarities between the respective goods and trade marks combined to create a likelihood of confusion on the part of the public. There is nothing in Section 5 of the Act which suggests that it is appropriate to factor into the enquiry any reputation the applicant may have for (in this case tenuously) related goods or services. If that were so it would be a

license for large companies to expand their trade into new areas in the face of earlier trade marks in the names of other parties. That is an unappealing prospect. I believe that the suggested approach is, in principle, wrong. In any event, the applicant's trade in the UK has been on a relatively modest scale. Ms Dunnder claims that the applicant sold around £600,000 worth of goods under the NATURE'S PLUS trade mark over the last ten years. Average sales of around £60,000 per annum in relation to different (albeit loosely related) goods could have no bearing on the likelihood of confusion, even if it were appropriate to take such sales into account. I do not therefore intend to attach any weight to the evidence of the applicant's pre-existing trade in the UK in assessing the likelihood of confusion.

### **The Weight to be Afforded to the Applicant's Trade Evidence**

16. The most relevant parts of Mr Pike's evidence is as follows:

*"I do not see how a customer could confuse the first word NATURE'S with NATREL, or NATURE'S PLUS with NATREL PLUS. In my own association, for example, we have two members, one being called Nature's Aid and the other Nature's Own; the trade has a plethora of other businesses using Nature's in their name and branding, further examples being Nature's Best, Nature's Fingerprint and Nature's Store. There is even Natracare and Natural Brand. Customers seem to be able to navigate their way around all these marks with ease, despite the same element appearing in a number of brands in the market. If customers can distinguish between products which all include the word 'Nature's' in their branding, they can certainly distinguish a product which bears the word 'Natrel.'"*

*I have a good knowledge of the natural health products market, including the supply of body care preparations, which is an integral part of the business. I know the company Natrel Organics, Inc. to be a dedicated health food stores supplier. It would be unlikely that mass market anti-perspirants sold under the marks NATREL or NATREL PLUS would be sold in the body care area of a health food shop, as the ethos of mass market manufacturers is very different to that of the average health food store owner. However, even if the two products were sold through the same outlets under the marks NATURE'S PLUS and NATREL PLUS, I would not expect consumers to confuse the two marks which are very different."*

17. Mr Pike indicates that he is aware of the trade mark NATURE'S PLUS having been used by the applicant in relation to a range of food supplements. He also claims to be aware of the use of the mark NATREL by the opponent, but not of the trade mark NATREL PLUS. Consequently, Mr Pike is not in a position to give any relevant evidence about the absence of confusion as a result of the concurrent use of the respective trade marks in relation to the goods at issue in this opposition. He merely offers an opinion as to the likelihood of confusion in the future.

18. In the European Limited v The Economist Newspaper Limited [1998] FSR 283, Millett L.J. stated that:

*"The function of an expert witness is to instruct the judge on those matters which he*

*would not otherwise know but which it is material for him to know in order to give an informed decision on the question which is called upon to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special feature of that market of which the judge might otherwise be ignorant and which might be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two marks are confusingly similar. They are experts in the market, not on confusing similarity. In the end the question of confusing similarities is one for the judge”.*

19. I do not therefore intend to attach any weight to Mr Pike’s opinion on whether NATURE’S PLUS is confusingly similar with NATREL PLUS. Mr Pike provides no relevant information about any special feature of the market for the goods in question which assists me in reaching a determination of the matter. He appears to assume that the opponent’s goods under the mark NATREL or NATREL PLUS would not be sold in the body care area of a health food shop, which is where he assumes that the applicant’s goods will also be sold. By contrast, it was common ground at the hearing that it was appropriate for me to consider all normal and fair uses of the respective trade marks and that this would include the respective goods being sold through the same outlets, including supermarkets and chemists.

20. Mr Pike states that he is aware of a number of trade marks beginning with the word NATURE or NATURE’S in use by members of his association. This could be relevant. However, he does not specify the goods in relation to which those marks are used, and I cannot therefore assume that he is aware of any of those marks being used in relation to body care products. I therefore find Mr Pike’s evidence to be of very little assistance.

### **The Opponent’s Claim that its Mark has become Highly Distinctive through Use**

21. The opponent’s evidence consists of two statutory declarations by Andrew James Redpath, who is the Assistant Secretary of the Gillette Company. Mr Redpath says that Gillette UK Limited launched a range of deodorants and anti-perspirant products under the trade mark NATREL PLUS in 1988. There is no suggestion that the trade mark has been used in respect of any other products. It appears that the product has been successful. Mr Redpath says that over 12 million units of NATREL PLUS products were sold through Gillette UK Limited in 1996. It appears that sales figures for 1997- 1999 were not available at the time he drafted his declaration. However, he says that sales have continued at around the rate for 1996. The opponent spent approximately £4 million promoting the mark in the UK in 1997.

22. Exhibit AJR3 to Mr Redpath’s first declaration consists of specimen advertising material. This appears to have been directed primarily at trade buyers. It indicates that deodorant/anti-perspirants under the trade mark NATREL PLUS have been marketed along side similar products under another of the opponent’s trade marks, RIGHT GUARD. These marks appear to have been applied to different products. There is no indication that NATREL PLUS is a secondary trade mark used in conjunction with RIGHT GUARD. In use, the word NATREL dominates, with the word PLUS appearing in much smaller letters in a subsidiary roll.

23. Exhibit AJR4 consists of some undated point of sale promotional material. Exhibit AJR 5 consists of copies of various press articles which mention the opponent’s NATREL PLUS trade

mark. Two of these are from trade papers; the other four are from local rather than national publications. All of these articles date from 1992, some seven years prior to the relevant date in these proceedings.

24. On the basis of this evidence the opponent submits that the distinctive character of the mark NATREL PLUS have been substantially enhanced as a result of the use made of it prior to the relevant date. Although the sales figures provided by the opponent appear large, I have not been provided with any information which would allow me to calculate the share of the market that the NATREL PLUS product enjoyed at the relevant date. Further, the trade mark which appears on the opponent's goods is, as I have already noted, predominately the word NATREL with the word PLUS appearing in smaller letters and in a subsidiary role. It is not self evident that the nature of this use would have led to a reputation arising under the trade mark NATREL PLUS rather than simply NATREL. This is consistent with Mr Pike's evidence. He claims to be aware of NATREL but not NATREL PLUS, yet the opponent's evidence points to the use of just one mark, which it regards as NATREL PLUS. It is true that the few examples of the opponent's promotional material I have been shown generally represents the trade mark as NATREL PLUS in block capital letters, but there is very little information about, or examples of, the opponent's promotion of its goods despite its claim to have spent around £4 million advertising its product in 1997 alone (and similar amounts in the preceding two years). There is a suggestion that the opponent's product has been advertised on television, but no further details have been provided. These deficiencies are not compensated for by any independent supporting evidence of the opponent's claim to have enjoyed an extensive reputation under the trade mark NATREL PLUS at the relevant date.

25. If an opponent wishes to claim that its trade mark is entitled to a more extensive scope of protection because of its highly distinctive character as a result of the use made of it, it is incumbent upon that opponent to provide sufficient evidence of reputation to make good that claim. In my judgement the opponent's evidence is insufficient to establish that its trade mark NATREL PLUS was known to a significant proportion of the relevant class of persons at the material date. I must therefore proceed on the basis that the protection afforded to NATREL PLUS, like the opponent's other mark NATREL solus, depends upon its inherent qualities.

### **NATREL v NATURE'S PLUS**

26. The opponent's trade mark NATREL is registered for, inter-alia, "*cosmetics, non-medicated toilet preparations, shampoos, preparations for the hair.*" These terms are broad enough to encapsulate all of the applicant's goods. Accordingly, the comparison of the marks NATREL and NATURE'S PLUS must proceed on the basis that the respective goods are identical. NATREL appears to be an invented word. It has what I expect is a deliberate resemblance to the word "natural". The first word in the applicant's mark is the word NATURE'S. The words 'nature's' and 'natural' have a degree of visual resemblance and they also share some conceptual similarity.

27. I believe that the differences between NATREL and 'natural', 'natural' and 'nature' and 'nature' and NATURE'S PLUS are, in combination, sufficient to avoid a likelihood of confusion between the marks NATREL and NATURE'S PLUS, even where the respective goods are identical. The opposition based upon this trade mark must fail.

## NATREL PLUS v NATURE'S PLUS

### The Similarity of the Goods

28. The opponent's earlier trade mark NATREL PLUS is registered in respect of "*deodorants, antiperspirants, perfumery and perfumed body sprays*". The applicant seeks protection for its trade mark in respect of "*body and skin creams, body and skin moisturisers, body and skin oils, cleaning preparations, soaps, shampoos, hair conditioners and nail strengtheners*". Mr Morcom submitted that, with the exception of nail strengtheners, closely similar goods were involved. It is common ground that in assessing the degree of similarity between the respective goods I should have regard to the factors identified by Jacob J in British Sugar PLC v James Robertson & Sons Limited [1996] RPC 281. The factors are:

- (a) The respective uses of the respective goods;
- (b) The respective users of the respective goods;
- (c) Physical nature of the goods;
- (d) The respective channel of trade in which the goods reach the market;
- (e) In the case of self-service consumer items, whether they are or are likely, to be found on the same or different shelves;
- (f) The extent to which the respective goods are competitive.

29. Mr Morcom submitted that the respective goods were all intended to improve the cleanliness/well being of the body. He said that the users of the respective goods were likely to be the same. The nature of the respective goods was also the same in that they were all properly classified as toilet preparations. As such they were likely to reach the markets through the same trade channels and appear on the same shelves in the supermarket and chemist.

30. Mr Kitchin did not dispute that the users of the respective goods were likely to be the same. However, he did not accept that the opponent had established any further points of similarity between the respective goods. In particular, he submitted that the purpose of the opponent's goods was to prevent or mask body odour. By contrast he said that body and skin creams, moisturisers, and oils were for the purpose of toning the skin and/or moisturising. He submitted that the purpose of the other goods listed in the applicant's specification was even less similar to those for which the earlier trade mark is protected. He said that the opponent's goods were likely to come in the form of a spray or roll-on whereas the physical nature of most of the applicant's goods, particularly body and skin creams, moisturisers and oils, was different. He pointed out that there was no evidence about the channels of trade through which the respective goods reach the market. Nor was there any evidence as to whether the respective goods were likely to be stocked on the same or adjacent shelves. Mr Kitchin submitted that, as a matter of common sense, it was unlikely that deodorants and antiperspirants would be stocked on the same shelves as body and skin creams or hair care

products. Given the different purposes of the respective goods, Mr Kitchin submitted that they were not in competition with each other.

31. Mr Kitchin pointed out that the onus is upon the opponent in opposition proceedings under Section 5. He submitted that it was therefore for the opponent to show that the respective goods were similar. In his view, the opponent had failed to do so.

32. I did not understand Mr Morcom to dissent from that proposition that the onus is on the opponent in this respect, and support for that view can be found in the decision of the ECJ in the Canon case (at paragraph 22 of the courts decision [1999] RPC 117 at page 133). In this connection, Mr Morcom pointed out that there was some evidence in exhibit AJR 4 to Mr Redpath's declaration of the opponent's deodorant/anti-perspirant being offered for sale on a shelf adjacent to a cream bath and hair care product. However, the photograph in question appears to show an end of aisle display featuring a number of special offers. I do not think that I can accept this as evidence that these types of goods are generally stocked together on the same shelves in a supermarket.

33. There is evidence in exhibit AJR 3 to Mr Redpath's declaration which suggests that anti-perspirants and deodorants come in the form of creams. There is no evidence that anti-perspirants/deodorants come in the form of any of the other goods within the applicant's specification, such as soap.

34. Exhibit MD 7 to Ms Dunnders declaration consists of the report of a commercial investigator who was asked to conduct an investigation to establish whether certain Class 3 products for human use were available with names containing the prefix Nature and/or with the suffix 'Plus'. I will return to this evidence later, but I note that in paragraph 2.3.5.7 of the report there is a reference to a 'Boots Natural Collection' range of toiletries which includes a "*Daisy Chain dry oil body spray*".

35. In the light of this evidence I do not think I can accept Mr Kitchin's submission that the physical nature of "*deodorants, anti-perspirants, perfumery and perfumed body sprays*" on the one hand and "*body and skin creams, moisturisers and oils*" on the other hand, is necessarily different. I regard "*perfumed body sprays*" as being primarily for the purpose of applying a scent to the body. The purpose of the remainder of the opponent's goods is similar. I do not find it so straightforward to determine the purpose of the applicant's body and skin creams and oils. "*Body and skin moisturisers*" must be regarded as primarily for the purpose of moisturising. However, I would expect that a 'dry oil body spray' could be described either as a "*perfumed body spray*" or as a "*body oil*". Similarly, if anti-perspirants and deodorants come in the form of creams, such goods could be described either as an anti-perspirant/deodorant or as a body or skin cream. There is therefore, in my view, a degree of direct overlap between the goods for which the earlier trade mark is protected and the goods for which the applicant seeks registration. However, that overlap is limited to "body and skin creams" and "body and skin oils".

36. The remaining goods in the applicant's specification are not for the same purpose as the opponent's goods. They are not therefore likely to be in competition with one another. I do not need evidence to know that the respective goods of the parties would all be grouped



together in roughly the same area of a supermarket or sold together through the same sort of specialised outlet, such as a chemist. There is no evidence which assists me in determining whether goods such as moisturisers, hair care preparations, soaps, cleaning preparations, or nail strengtheners, are commonly stocked on the same or different shelves to goods such as anti-perspirants, deodorants, perfumes or perfumed body sprays.

37. I conclude that there is a degree of overlap between the respective goods in so far as the applicants specification covers body and skin creams and oils, and that there is a degree of similarity between the other goods in the applicant's specification and those goods for which the earlier trade mark is protected.

### **The Similarity Between the Marks**

39. I note that the marks NATREL PLUS and NATURE'S PLUS both consist of two words, the second of which is identical. The words NATURE'S and NATREL share the first three letters and both contain the letters RE in the suffix. Apart from this similarity in the composition of the respective words there is, as I have already noted, a conceptual resemblance in that NATREL alludes to "natural", which has a similar meaning to the word NATURE'S.

40. Mr Kitchin submitted that the words NATURAL, NATURE and PLUS were in common use in respect of goods in the personal care category. In support of this submission he referred me to the results of the investigator's report to which I have already referred, which does indeed show that there are a number of trade marks containing the words NATURE or NATURAL or PLUS in use in relation to personal care products. Mr Morcom pointed out that none of the marks identified in the investigation contain the word NATURE or NATURAL in combination with the word PLUS.

41. Mr Kitchin accepted that the distinctive character of the applicant's mark derived from the combination of the non-distinctive words NATURE'S and PLUS. He was, of course, bound to do so because, on the applicant's evidence, neither of these words is distinctive alone. He disputed that the later mark captured the distinctive character of the earlier trade mark. In Mr Kitchin's submission, the word NATREL was the dominant and distinctive feature of the earlier trade mark, the word PLUS adding little to the distinctive character of that mark.

42. I believe that the word PLUS does add less to the distinctive character of the earlier trade mark than is the case with the applicant's mark. This is because the word NATREL is inherently distinctive and the opponent's mark therefore depends less on the combination of the words NATREL and PLUS for its distinctive character. Nevertheless, I do not believe that it is right to say that the second word plus adds little or nothing to the distinctive character of NATREL. The preferable view is that the distinctive character of the earlier trade mark depends partly on the degree of invention inherent in the word NATREL, and partly on the combination of that word with the word PLUS. According to the case law of the ECJ the average consumer normally perceives trade marks as a whole. I do not therefore think it necessarily follows that words with limited distinctive character, such as PLUS, add nothing to the distinctive character of a two word mark.

43. I find that there is visual similarity between the marks NATREL PLUS and NATURE'S PLUS, and that this similarity is enhanced by the allusion in the word NATREL to "natural", which is similar in meaning to NATURE'S, and therefore introduces some conceptual similarity. The conceptual similarity is not, however, limited to the idea of 'nature' or 'natural' (which is not a distinctive concept per se), but is, more particularly, the concept of combining a word conveying this idea with the unrelated second word PLUS. Because the later mark captures part of the distinctive character of the earlier mark they share a similar "feel."

### **Decision - Likelihood of Confusion**

44. There is no problem distinguishing the marks when they are seen side by side. However, I must make some allowance for imperfect recollection. In doing so, I should bear in mind that the average consumer's level of attention varies from one product to another. The goods at issue (with the possible exception of perfumes) are not likely to be highly expensive products purchased with a great deal of care and attention. However, the average consumer is also deemed to be reasonably circumspect and it would not therefore be right to make allowances for those people who are excessively inattentive or prone to making silly mistakes. In my view there is a much greater risk of confusion arising from imperfect recollection where two similar trade marks are in use in relation to the same, or substantially the same, product. This is because there is inherently less likelihood of defective recollection both of the earlier trade mark and of the goods to which it was applied.

45. Taking all the relevant factors into account I have come to the view that there is a likelihood of confusion between the trade marks NATREL PLUS and NATURE'S PLUS through defective recollection. However, this likelihood only exists where the respective goods are the same or substantially the same. The opposition therefore succeeds insofar as "body and skin creams" and "body and skin oils" are concerned because these terms include goods within the opponent's specification.

46. The opposition to the remainder of the goods in the applicant's specification fails. I have asked myself the question of whether the average consumer is likely to be confused into believing that the applicant's mark is being used in relation to an extended range of the opponent's goods. If the applicant's mark was NATREL PLUS there would be clearly be a very strong case for answering that question positively. However, that objection assumes that the average consumer is reasonably familiar with the earlier trade mark and the goods in respect of which it has previously been used. A greater degree of resemblance between the marks is required where the respective goods are not the same. I do not believe that the resemblance between the trade marks at issue is sufficient to support that objection..

### **Section 5(4)(a)**

47. Mr Morcom could not say that had any stronger case under Section 5(4)(a) than under Section 5(2)(b). I agree with that. The opposition under Section 5(4)(a) cannot succeed to any greater extent than the opposition under Section 5(2)(b).

### **Procedure**

48. The application can proceed to registration if, within month of the end of the period allowed for appeal, the applicant files a form TM21 restricting the specification of goods to “body and skin moisturisers, soaps, shampoos, hair conditioners and nail strengtheners”. If the application is not restricted in this manner it will be refused in full.

**Costs**

49. The opposition has partly succeeded and partly failed. In these circumstances I have decided that each side should bear its own costs.

**Dated this 18<sup>th</sup> Day of December 2001**

**Allan James  
For the Registrar  
The Comptroller General**