

O-067-07

**TRADE MARKS ACT 1994 AND THE TRADE MARKS (INTERNATIONAL
REGISTRATIONS) ORDER 1996 (AS AMENDED)
IN THE MATTER OF APPLICATION NO M875384
BY DORIS BRUGGER
TO PROTECT A TRADE MARK
IN CLASS 3**

TRADE MARKS ACT 1994

AND

THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996 (AS AMENDED) IN THE MATTER OF INTERNATIONAL REGISTRATION No M875384 AND THE REQUEST BY DORIS BRUGGER TO PROTECT A TRADE MARK IN CLASS 3

Background

1. On 2nd March 2006 Doris Brugger of Ismaninger Str.55, 81675 Munchen, Germany designated the UK under the provisions of the Madrid Protocol in respect of the following mark:

M875384:

DORISSIMA

The goods for which registration is sought are:

Class 3 - Essential oils, cosmetics, soaps.

2. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 4 of the Trade Marks (International Registration) Order 1996 (as amended) and a notice of Provisional Total Refusal under Article 9(3) of that order was issued. The ground of refusal was stated as being under Section 5(2) of the Trade Marks Act 1994.

3. The following earlier conflicting rights were identified as citations against the Holder's mark in class 3:-

Registered UK mark 747983 in the name of Parfums Christian Dior:

DIORISSIMO

Class 3

Non-medicated toilet preparations, cosmetic preparations, brilliantine, hair lotions, toilet shampoos, dentifrices, soaps, perfumes, essential oils, and toilet articles (not included in other classes)

Registered Community Trade Mark E329334 in the name of PARFUMS CHRISTIAN DIOR, S.A.:

DIORISSIMO

Class 3

Soaps; perfumery; beauty products; make-up; essential oils; cosmetics; Hair lotions; dentifrices.

4. No reply was received to the examination report dated 19 April 2006 and on the 21st November 2006 notice of refusal was issued under Article 9(3).

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Marks Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

The case for registration

7. No submissions were filed by the Holder or their representative in answer to the objections raised.

DECISION

Comparison of marks (Section 5(2))

The Law

8. **Section 5(2)** of the Act reads as follows:

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

(a) it is identical with an earlier 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”

9. An earlier trade mark is defined in Section 6(1) which states:

“6-(1) In this Act an “earlier trade mark” means-

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

10. I take into account the guidance provided by the European Court of Justice (ECJ) in the following cases: *Sabel BV v Puma AG* [1998] R.P.C. 199. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel .bV.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723.

11. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally taking into account 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*. The average consumer 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 kept in his/her mind. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel*,

(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 global assessment of the likelihood of confusion implies some interdependence between the relevant facts, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks and vice versa. *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Incm*,

(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*,

(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*,

(h) 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,

12. The global comparison of marks therefore means that a number of elements must be analysed before effective judgement can be made.

Distinctive Character of the earlier trade marks

13. It is clear from the ECJ's judgement in the case of *Sabel BV v Puma AG* that the likelihood of confusion may be increased where the earlier trade marks have a highly distinctive character.

14. The earlier trade mark numbers 747983 and Community Trade Mark 329334 "DIORISSIMO", are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). The earlier trade marks have an Italian 'feel', however, as far as I am aware they have no meaning in either English or Italian. They are therefore invented words.

15. Invented words take nothing out of the common language, they are highly distinctive marks and therefore deserving of a high level of protection.

Comparison of the goods

16. The cited marks cover the following goods between them:

747983 - Non-medicated toilet preparations, cosmetic preparations, brilliantine, hair lotions, toilet shampoos, dentifrices, soaps, perfumes, essential oils, and toilet articles (not included in other classes) and Community trade mark 329334 - Soaps; perfumery; beauty products; make-up; essential oils; cosmetics; Hair lotions; dentifrices. The present designation covers - Essential oils, cosmetics, soaps.

17. There is no doubt that identical goods are involved between the cited Community trade mark 329334 and the present designation as both list 'essential oils and soaps'. The term 'cosmetics' in the present designation is considered to be covered by the term 'beauty products' of the cited mark.

18. The UK trade mark 747983 contains the terms 'soaps, essential oils and cosmetic preparations', identical goods to those of the present designation. Also the general terms 'non-medicated toilet preparations and toilet articles (not included in other classes)' could contain items identical to the goods claimed for this trade mark i.e. 'essential oils, soaps and cosmetics'.

19. I have also considered the remaining goods in the specifications of the cited marks, 'non-medicated toilet preparations, brilliantine, hair lotions, toilet shampoos, dentifrices, perfumes, toilet articles (not included in other classes), perfumery, beauty products, make up', bearing in mind the relevant factors as laid out under *BRITISH SUGAR PLC v JAMES ROBERTSON & SONS LTD*. [1996] R.P.C. 281, Mr Justice

Jacob. I have concluded that the goods under consideration may be expected to: share the same end users (being consumers of beauty and cleansing products); be sold in close proximity in retail outlets; and be viewed as competing goods purchased for the same end purpose as 'essential oils, soap, cosmetics', claimed for M875384.

Similarity of the marks

20. Since the trade mark of this designation is not identical to the earlier trade marks the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade marks that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

21. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgement of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks, bearing in mind their distinctive and dominant elements.

22. The Holder's mark M875384, is a single word mark "DORISSIMA" . It differentiates itself from the cited marks with the omission of an "I" following the first letter "D", plus the vowel at the end of the word is modified from an "O" to an "A". The marks utilise many of the same letters and all are presented in capitals in a common typeface.

23. Aurally the marks are exceptionally close with only the slight variations of a missing "I", the change in vowel at the end doing only little to distinguish the Holder's mark. Indeed the end vowel has little impact on the pronunciation and tends to fall away. The additional "I" following the "D" in the cited marks is subsumed by the stronger "D" and "O" pronunciations on either side.

24. Turning to the visual similarity of the marks, I have no doubt that they could easily be mistaken one with the other. They have the letters "DORISSIM" in common, the addition of the "I" and the alteration at the end of the word of an "O" to an "A" does little to vary the visual impression of the marks. I therefore conclude that the marks are very close.

25. I also find that conceptually they are remarkably close. Both marks give the impression that they are Italian words, but, as mentioned earlier with no apparent meaning in either the English or Italian languages. Therefore they are conceptually both invented words, with no apparent difference in meaning to help distinguish them.

26. For the reasons set out above I consider that "DIORISSIMO" is a distinctive term in relation to the goods under consideration. Given that both cited marks consist of one word in capital letters, with no other matter present which may help to distinguish them from the later mark, I have concluded that there is a high degree of similarity when comparing the Holder's mark to the earlier marks.

Likelihood of confusion

27. I must bear in mind that a mere possibility of confusion is not sufficient (see e.g. *React Trade Mark* [2000] RPC 285 at page 290). The Act requires that there must be a likelihood of confusion. I have already found that the goods for which the earlier trade marks are registered are either identical or closely similar to the goods applied for. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably observant and circumspect. In relation to these goods I consider the average consumer to be the general public. The goods at issue are everyday beauty and cleansing items that are purchased with an average degree of care and attention, but no more.

28. I must further consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity in the marks. As set out above, I consider the marks to be extremely close, with only minor differences between the letters used. In addition, both are presented using capital letters, that is to say with no stylisation. The average consumer generally relies upon the imperfect picture of the earlier trade mark that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion. I do not consider that the slight differences in spelling between the present mark and the earlier registered marks are such that they would avoid a likelihood of confusion, particularly given the limited degree of care that an average consumer is likely to exercise when selecting the goods at issue. I also consider the likelihood of confusion is greater when considering invented words with close visual and aural similarities, and no other means by which they can be easily remembered. This makes them more prone to imperfect recollection.

29. I have therefore concluded that the identical and similar goods that I have identified coupled with the level of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

Conclusion

30. The designation is therefore refused protection in the UK under the terms of Articles 3, 9(3) and 11(5) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under Section 5(2) of the Act.

Dated 1st March 2007

**Gail Ashworth
For the Registrar
The Comptroller General**