

O-172-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2483293
IN THE NAME OF UNILEVER PLC TO REGISTER THE TRADE MARK
STRATYS-3 IN CLASSES 3 AND 5**

AND

**OPPOSITION THERETO UNDER NO 98486
IN THE NAME OF GORDON R LUCAS**

Trade Marks Act 1994

**IN THE MATTER OF Application No 2483293
in the name of Unilever Plc
to register the Trade Mark STRATYS-3
in Classes 3 and 5**

And

**Opposition Thereto Under No 98486
in the name of Gordon R Lucas**

BACKGROUND

1. On 26 March 2008, Unilever Plc made an application to register the trade mark STRATYS-3 in Classes 3 and 5 in respect of the following specifications of goods:

Class 3 Essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; skin care preparations; oils, creams and lotions for the skin; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs, medicated soap.

Class 5 Medicated skin and hair preparations.

These specifications reflect the position following the filing of a Form TM21.

2. On 19 December 2008, Gordon R Lucas filed notice of opposition to the application, the ground of opposition, in summary, being as follows:

Under Section 5(2)(b) because the mark applied for is similar to an earlier mark and is in respect of goods that are identical and/or similar to those of that earlier mark.

3. The applicants filed a counterstatement in which they deny that the respective marks are the same or similar, and consequently submit that there can be no confusion.

4. Only the applicants filed evidence in these proceedings which insofar as it may be relevant I have summarised below. The opponents filed written submissions which I have not summarised but will take them fully into account in my determination of the case. The matter came to be heard on 5 May 2010, when the opponents were represented by Mr Alan Bryson of Counsel, instructed by J A Kemp & Co, their attorneys. The

applicants were represented by Ms Denise McFarland of Counsel, instructed by Murgitroyd & Company, their trade mark attorneys.

Applicant's evidence

5. This consists of one Witness Statement dated 4 January 2010 which comes from Katrina Burchell, Global Head of Trade Marks and Global/European Regional Category Counsel skin of Unilever Plc. Ms Burchell says that she works closely with the marketing department and has considerable experience of her company's skin care business.

6. Ms Burchell explains about the skin, in particular that it is made up of layers; the top, core and deep layers and that the outer layer is called the stratum corneum. She gives details of the process by which the skin repairs itself stating that this can be aided by moisturising, and that the purpose of the STRATYS-3 product is to deliver moisture to the stratum corneum. Exhibit KB1 consists of an extract from the Vaseline.com website which illustrates the labelling and packaging of the product, giving an explanation along the lines of that given by Ms Burchell.

7. Ms Burchell says that use of the term stratum corneum is widespread, mentioning, in particular its use in academic papers, by competitors and regulatory authorities, examples of which are shown as Exhibit KB2, with Exhibit KB3 being a receipt for the purchase of one of the reference works shown. The exhibit includes a copy of an ASA Adjudication report, and extracts from anatomy/physiology reference works relating to the skin which describes the stratum corneum as the fifth and outermost layer of the skin, and another that shows "stratum" being used to describe all five of these layers.

8. Ms Burchell goes on to say that the plural of "stratum" is "strata" which she asserts is habitually used to refer to the various layers, going on to refer to these by "stratum". Exhibit KB4 consists of an extract from the 2006 edition of Collins English Dictionary. For "Strata" the dictionary says it is the plural of "stratum" and is "sometimes wrongly used as a singular noun; the stratum (not strata) of society..." The entry for "Stratum" says "*n* pl strata or stratums. 1. (*usually pl*) any of the distinct layers into which sedimentary rocks are divided. 2. *biol* a single layer of tissue or cells. The definition also says it means "a layer of any material...". Exhibit KB5 consists of a further example from the reference work "The Fundamentals of Anatomy and Physiology" (also part of KB2) which states "...The epidermis is composed of strata (layers) with various functions"

9. Ms Burchell goes on to give details of the opponent's use of their mark STRATA and device, Exhibit KB6 consisting of literature illustrating the range of goods sold, contrasting what she describes as their bulk trade in cleaning materials with the applicant's consumer-facing brand. She concludes giving submissions on the circumstances that show that there is no convergence between the respective marks and goods.

10. That completes my summary of the evidence insofar as it may be relevant to these proceedings.

Decision

11. The opponents rely on one earlier mark No. 2419255 which achieved registration on 2 February 2007, which being less than five years prior to the publication date of the mark in suit. Which means that the Trade Marks (Proof of Use, etc) Regulations 2004 do not apply.

12. The registration is for the following mark and goods:



- Class 03** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumes, body and hair lotions, deodorants for personal use and perfumed room fresheners.
- Class 05** Disinfectants; fungicides for use as cleaning preparations in catering premises, restaurants and bars.
- Class 16** Paper goods for use in wiping including; towels, rolls, folded sheet, flat sheet, wet wipes, absorbent pads.

13. The ground of opposition is under Section 5(2)(b). That section 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.”

14. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV*

v Adidas AG & Adidas Benelux BV [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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 & Co. 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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(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 and Adidas Benelux BV*,

(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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

15. The applicants are seeking to register the word and numeral STRATYS 3 as compared to the opponent's earlier mark STRATA with a green circular device. From a visual standpoint it is easy to see that the mark applied for and the opponent's earlier mark have the first five letters in common, but that does not make them similar. The opponent's mark has one more letter, a letter "A" whereas the mark applied for has two more, the letters "YS" followed by a hyphen and a numeral 3. So whilst there is similarity in part, when compared as a whole the marks are visually different. However, the earlier mark is not just STRATA, it is the word represented in a modern script with a coloured circle device. In respect of the device I consider that represented as it is in a graduated colour it has significance in the mark. Having mentioned the stylised script of the opponent's mark I asked whether this would come within what could be regarded as "normal and fair use". The answer was that there is a degree of creativity in the stylisation which took it beyond, a view with which I have to agree. For the avoidance of doubt, my view is that STRATA and STRATYS-3 are visually different without taking account of the device and letter stylisation, but are even less similar when these are factored in.

16. Looking at the question of whether there is aural similarity. It is difficult to argue that a consumer will describe the graphical element when enunciating the mark and I shall proceed on the basis that in composite marks such as the opponent's it is the words that will be the aural point of reference. The opponent's earlier mark consists of two syllables, which given the tendency to slur or place less emphasis on the termination of a word, the strongest will be "STRAT". That said, the terminal letter "A" has the potential to change the enunciation of the mark by elongating the "TRAT" syllable from "at" to an "ah", and as a whole, "strah-teh" or "strah-tah". It is of course possible that STRATA will be spoken as "stratter". The mark applied for also has the "STRAT" element so to this extent will sound the same. In this case the STRAT is followed by "ys" which will have a "tiss" or possibly "tizz" sound, and the numeral three. Unlike something graphical the numeral is most likely going to be included in a verbal reference of the mark, said as seen. The enunciation of the beginning of "Three" will require a significant change from the ending of "STRATYS" which in my view increases the emphasis on the end of the first element and beginning of the second, but even if that were not the case the sound of

“three” will impact. Taken together I take the view that the respective marks are not aurally similar.

17. The next consideration is the conceptual similarity, or to put it another way, how the mark will be perceived by the consumer; what, if anything will it say? It is here that the applicant’s evidence is focused. Ms Burchell explains about the skin, in particular that it is made up of layers, the outer layer being generally referred in academic papers, by competitors and regulatory authorities as the stratum corneum. She shows that the plural of “stratum” is “strata” (Exhibit KB4) and this is habitually used to refer to the various layers. This exhibit (consisting of the extract from Collins English Dictionary) confirms “Stratum” say “*n pl strata or stratums*. 1. (*usually pl*) any of the distinct layers into which sedimentary rocks are divided. 2. *biol* a single layer of tissue or cells. The definition also says it means “a layer of any material...”. Further exhibits from the reference work “The fundamentals of Anatomy and Physiology” (Exhibits KB2 and KB5) state that “...The epidermis is composed of strata (layers) with various functions”.

18. Whilst STRATYS may have its roots in “strata” or “stratum” it is not a dictionary word. The argument goes that STRATA being an ordinary and well-known English word that has the potential to convey a descriptive meaning in relation to skin care products, whereas STRATYS is an invented word that at best might allude to such goods. Mr Bryson sought to counter this alleged descriptiveness by arguing that to the relevant consumer the most usual meaning of STRATA will be the layers of rock. These arguments are all very interesting, at least to those who encounter marks in an intellectual capacity. The word STRATA may well be understood as being descriptive by academics of physiology and those in the skin-care industry, but is that the position in respect of the consumer? I do not believe that the arguments reflect the thought processes or perceptions of the purchasing public who are just as capable of misinterpreting or believing that STRATYS refers to layers as going down the tortuous lane of physiological analysis in respect of STRATA. I have disregarded the numeral as it can also be taken as descriptive of the relevant goods, for example, having 3 effects. In my view both marks have the potential (and I put it no stronger than that) to convey a similar meaning to the relevant consumer.

19. My consideration of the issue of “conceptual similarity” has already touched on the question of distinctiveness, and whether there is a dominant component. The consumer “may” understand STRATA to be a reference to layers of the skin, and therefore descriptive of products such as those for skin-care. However, to my mind this reference is allusive such that the consumer will not scratch beneath the surface of the word. If they understand STRATA to mean layers, this will most likely be as Mr Bryson argued, for rocks, but see little, if any connection with skin-care products; it is a distinctive mark. The same considerations apply in the case of STRATYS except that it is even less likely the consumer will draw a descriptive relevance, and being invented it is clearly distinctive. And as I have already said, single numerals are generally not considered to be distinctive, for example, because they are used for codification of products or features of products. Accordingly, STRATYS is both the distinctive and dominant component.

20. Ms Burchell gives details of the process by which the skin repairs itself, stating that this can be aided by moisturising, and that the purpose of the STRATYS-3 product is to deliver moisture to the stratum corneum. Exhibit KB1 consists of an extract from the Vaseline.com website which illustrates the labelling and packaging of the product, giving an explanation along the lines of that given by Ms Burchell.

21. Apart from some literature that shows the opponent to have used their mark STRATA and device in relation to what Ms Burchell describes as "...a bulk trade in cleaning materials" there is nothing by which to base an assessment of whether, and to what extent the opponent's have acquired a reputation. Likewise it is not possible to say that the distinctive character of the STRATA mark has been enhanced as a result of its use. Ms Burchell also seeks to use this apparent distinction in the reality of the market to establish that there is some distance between the goods. In the context of an objection under Section 5(2)(b) the question of whether there is similarity in the goods is a notional one based on the usual and ordinary meanings of the terms within the respective specifications.

22. Turning to look at the respective goods, the established tests in assessing the similarity or otherwise of goods and services is set out in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*. I must consider the uses and users of the respective goods or services, the physical nature of the goods or acts of service and the trade channels through which they reach the market. In the case of self-serve consumer items this will also include consideration of where the respective goods are likely to be found, particularly in multi product outlets such as supermarkets. The extent to which the respective goods or services are competitive or complementary is also a relevant consideration guided by how they are classified in trade.

23. Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance S.A. v OHIM – Johnson & Johnson (monBeBé)*).

24. Following the applicant's filing of a Form TM21 limiting the goods for which they seek registration their specifications stand as follows:

Class 3 Essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; skin care preparations; oils, creams and lotions for the skin; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs, medicated soap.

Class 5 Medicated skin and hair preparations.

25. This compares to the following goods of the earlier mark relied upon by the opponents:

- Class 03** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumes, body and hair lotions, deodorants for personal use and perfumed room fresheners.
- Class 05** Disinfectants; fungicides for use as cleaning preparations in catering premises, restaurants and bars.
- Class 16** Paper goods for use in wiping including; towels, rolls, folded sheet, flat sheet, wet wipes, absorbent pads.

26. Self-evidently there is commonality in that both include goods in Class 3, although apart from “soap” not in the list of goods. I take note of the decision of the Court of First Instance in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

27. Insofar as the “essential oils; aromatherapy products, massage preparations, skin care preparations, oils, creams and lotions for the skin, depilatory preparations, sun-tanning and sun protection preparations, cosmetics, make-up and make-up removing preparations, petroleum jelly, lip care preparations, beauty masks and facial packs” are all capable of being lotions, and also for use on the body, they would be identical goods to the “body lotions” contained within the specification in Class 3 of the opponent’s earlier mark.

28. The goods “cotton wool, cotton sticks, cosmetic pads, tissues or wipes, pre-moistened or impregnated cleansing pads and tissues or wipes” are all similar in nature and use to the “paper goods for use in wiping” in Class 16 of the opponent’s earlier mark. I see no reason why the users should be any different, nor the trade channels through which they reach the market. They are all likely to be self-serve consumer items likely to be found in the same outlets, and where available in multi product outlets such as supermarkets will either be on the same or a similar shelf; they will certainly be in close proximity. If these

goods are not competitive they are certainly complementary, and I would say likely to be classified as similar in the trade; these are similar goods.

29. The only remaining item in Class 3 is “talcum powder” which although not a lotion is nonetheless for use on the body, and often perfumed, and as such I consider this item to be similar to the “perfumes, body lotions and deodorants for personal use” covered by the earlier mark. Likewise, the “medicated body and hair lotions” covered by Class 5 of the application should be considered similar to the “body and hair lotions” in Class 3 of the earlier mark.

30. Where, as in this case, similar goods are involved it is not unreasonable to infer that the channels of trade, from manufacture to retail will correspond. It is also reasonably safe to say that the end consumer will be the same. These are goods that will be available at multi-product outlets such as supermarkets, and also large retail chemists. Whilst they are likely to be displayed on the same shelf, where that is not the case they will still be located in close proximity. The goods at issue are capable of ranging from those costing pence that will be selected with minimal attention to the brand, to the high-end expensive where the purchaser will be well informed and circumspect in all aspects of the selection. The consumer will be used to seeing such goods available under a brand-line from a single trader, often marketed in a range for different situations of effects.

31. So where does this take me? Adopting the global approach advocated and taking all factors into account, I come to the view that notwithstanding the similarities such as exist in the goods, market circumstances and consumer this does not counteract the fact that the marks are different. I do not consider that use of STRATYS 3 in connection with the goods for which they seek registration will lead consumers to the belief that they originate from the opponents or some linked undertaking. There is no likelihood of confusion even taking into account the possibility of imperfect recollection. The opposition under Section 5(2)(b) therefore fails.

32. The opposition having failed, the applicant is entitled to a contribution towards his costs. I therefore order that the opponents pay the applicant the sum of £2,250 towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27 day of May 2010

**Mike Foley
for the Registrar
the Comptroller-General**