

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2204593
BY LINSEAL INTERNATIONAL LTD TO REGISTER
A TRADE MARK IN CLASS 1**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50491 BY HOKOCHEMIE GMBH**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2204593
by Linseal International Ltd to register a
Trade Mark in Class 1**

and

**IN THE MATTER OF Opposition thereto under
No 50491 by Hokochemie GmbH**

BACKGROUND

1. On 31 July 1999 Linseal International Limited applied to register the trade mark OKO in Class 1 for a specification of "Chemical preparations for use in the manufacture, treatment and repair of tyres; sealants; preparations for repair of tyres and for preventing punctures in tyres; all included in Class 1".

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 3 December 1999 Hokochemie GmbH filed a Notice of Opposition. In summary the grounds were:-

- (i) Under Section 5(2)(b) of the Act because the mark applied for is confusingly similar to the following trade mark, for which protection has been sought in the United Kingdom by the opponent under the provisions of the Madrid Protocol on the basis of registration held in Switzerland:-

INTERNATIONAL CASE NUMBER: 701295
DATE OF DESIGNATION IN THE UK: 31 July 1998

MARK:



GOODS/SERVICES

- Class 1** Chemicals used in science, agriculture, horticulture and silviculture; unprocessed artificial resins, unprocessed plastics; soil fertilizers; chemical substances for preserving foodstuffs; chemicals for industrial, scientific, photographic, as well as agricultural, horticultural and silvicultural processing purposes; products for folia, soil and hydroponic fertilisation; vine disease preventing chemicals; carbolineum for the protection of plants; plant growth regulating preparations; seed preserving substances; chemical additives for biocides, fuel oils and abrasives; biological preparations other than for medical or veterinary purposes; microorganism cultures for (non-medical use); but not including any such goods being preparations for use in the manufacture, treatment or repair of tyres, or for preventing punctures in tyres, and not including sealants.
- Class 2** Paints, varnishes, lacquers; preservatives against rust and deterioration of wood; dyes, mordants; unprocessed natural resins; metals in foil and powder form for painters, decorators, printers and artists; chemical additives for paints, varnishes, lacquers, preservatives against rust and deterioration of wood, dyes and mordants.
- Class 5** Biological preparations for medical and veterinary use; biocides; pharmaceutical, veterinary and sanitary products; dietetic preparations for medical use; food for infants; disinfectants; products for destroying vermin; fungicides, herbicides; products for destroying, attracting, repelling and affecting the life cycle of pests and life forms (except for flies) undesirable to human beings, animals and plants or other life forms or inanimate objects; insecticides, particularly for repelling mosquitoes and flies; acaricides; rodenticides; molluscicides; products for crop protection; mordants for seeds; products for protecting wounds; game repelling products, nematocides; biocides for household and industrial use; plant extracts for medical, veterinary use and for plant protection, preparations containing plant extracts for plant protection, hygienic purposes or hygiene for household or industrial use (disinfectants); chemical additives for pharmaceutical and veterinary preparations; additives to fodder for medical purposes; mineral additives for forage for medical purposes; nutritive substances for microorganisms; bacteriological culture media.
- Class 31** Agricultural, horticultural and silvicultural products, included in this class; seeds; living and genetically modified organisms; live animals, including pluricellular organisms and life forms with limited life functions, included in this class; fresh fruits and vegetables; animal feed also in the form of mixed feed; natural additives for forage; active ingredient enriched forage additives; animal feed concentrate; malt

Class 39 Travel organisation; booking of seats for travel.

Class 42 Services in the field of pharmacology, veterinary medicine and agriculture; scientific and industrial research; crop production and animal rearing consultancy; quality control; consultancy for registering restricted products; legal services.

- (ii) Under Section 3(6) of the Act because the application was made in bad faith as the applicants were aware of the opponent's prior application 701295 at the time of applying for the mark in suit.
 - (iii) Under Section 5(4)(a) of the Act because use of the applicant's mark in the United Kingdom is liable to be prevented by virtue of the law of passing off.
 - (iv) Under the Registrar's discretion. However, there is no provision for this ground under the 1994 Act.
3. On 10 April 2000 the applicants filed a counterstatement denying the grounds of opposition, stating that the mark in suit is in use. They drew attention to the following registration in their proprietorship:-

REGISTRATION NO: 1585175
DATE OF REGISTRATION: 22 May 1998
MARK:



SPECIFICATION OF GOODS: Chemical preparations for use in the manufacture, treatment and repair of tyres; sealants; preparations for repair of tyres and for preventing punctures in tyres; all included in Class 1.

4. Both parties ask for their costs, but no hearing was requested.

Opponent's Evidence

5. The opponent's evidence consists of a statutory declaration by Dr Wolfgang Munk dated 1 September 2000. Dr Munk is one of the founders and is the principal partner of Hokochemie GmbH (the opponents). He has been managing the company since its incorporation in 1994.

6. Dr Munk states that the opponent's international trade mark IR 701295 has been in use in the UK since 1997 for consulting services in crop protection products, has been affixed to merchandise exported continuously since March 1998 and is also in use for services exported to the UK. At Exhibit WM3 to his declaration is a table (Hokochemie Order Details) compiled by Hockley International Ltd, his company's supplier in the UK.

7. Dr Munk also explains that the applicants were aware of his company's mark IR 701295 when the mark in suit were applied for, as they were approached on a consent issue by Dr Munk, in relation to their registration No 1585175, on 10 May 1999 (copy letter at Exhibit WM4) and 12 July 1999 (telephone call, invoice showing relevant number at Exhibit WM5).

8. This concludes by summary of the evidence filed in this case. I now turn to the decision.

DECISION

9. Firstly, I will consider the ground of opposition under Section 5(2)(b) which reads 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. An earlier right is defined in Section 6, the relevant parts of which state:

6.-(1)....

- (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,

11. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] ETMR 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*

Inc[1999] ETMR 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

12. 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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 BV* paragraph 27;
- (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*, paragraph 23;
- (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*, paragraph 23;
- (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*, paragraph 17;
- (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*, paragraph 24;
- (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 v Puma AG*, paragraph 26;
- (h) 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; *Marco Mode CV v Adidas AG*, paragraph 41;
- (i) 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*, paragraph 29.

13. In essence the test under Section 5(2)(b) is whether there are similarities in the marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion

must be appreciated globally and I need to address the visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the category of goods in question and how they are marketed.

14. While both parties have provided written submissions, I have received no comments in relation to the similarity of the respective marks.

15. The mark applied for consists of the invented work OKO while the opponent's mark consists of the word OKO over two vertical devices. A description of these devices does not spring readily to mind but they are a significant element within the mark. Visually and conceptually I believe the marks to be very close in that the word OKO in the opponent's mark is readily assimilated and retained, and bearing in mind imperfect recollection I have no doubt that in the normal course and circumstances of trade, customers are likely to believe that the goods sold under the respective marks came from the same source or undertaking. Furthermore, in aural use I doubt that the device element within the opponent's mark would be referred to at all and both marks are likely to be referred to as OKO marks when used aurally in the normal course of trade.

16. While the applicant claims use of the mark in suit and the opponents have demonstrated use of their mark, the opponents have not shown that they possess a reputation for the purposes of these proceedings. Accordingly, I must consider use of the marks on a fair and notional basis in respect of all the goods covered within the relevant specifications.

17. While the application in suit and the opponent's mark both cover goods in Class 1, they do not cover the same goods as the opponents Class 1 specification precisely excludes all those goods applied for in the mark in suit. In their written submission the applicant's representatives state that the exclusion within the opponent's specification was required to overcome the Registry's citation of the applicants registration No 1585175 against the opponent's designation (currently under opposition). However, notwithstanding the existence of registration number 1585175, which may yet act as a barrier to the opponent's designation, I must deal with the opposition in suit on its own merits and decide whether the specifications covered by the application in suit and the opponent's application (an earlier right by virtue of Section 6(1) of the Act), include similar goods. While the opponent's specification includes goods and services in a number of classes, their strongest case is in relation to their Class 1 specification and their other specifications place them in no stronger position in the current proceedings.

18. In determining whether the goods covered by the application are similar to the goods covered by the opponents' trade mark I have considered the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 (Pages 296, 297) as set out below:

“The following factors must be relevant in considering whether there is or is not similarity:

(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

19. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK government in its submissions (which are listed in TREAT) are still relevant in respect of a comparison of goods.

20. The Class 1 specification of the opponent’s mark is wide and includes chemicals for industrial processing purposes. This would include chemicals for use in the manufacture, treatment and repair of rubber products; not tyres, by virtue of the exclusion. The applicant’s specification includes chemical preparations for use in the manufacture, treatment and repair of tyres. It seems to me, given that “tyres” are manufactured from rubber, both sets of goods ie the chemicals or chemical preparations (the raw product), are likely to be produced and sold by the same manufacturer or processor and would be suitable for use both in relation to tyres and other rubber products without any separate adaptation. Therefore, the physical nature of the goods would be the same and the uses, users and trade channels would overlap. Accordingly, I find that the respective specifications include similar goods.

21. In relation to the Section 5(2)(b) ground, on a global appreciation, I have come to the conclusion that the respective marks are similar visually, aurally and conceptually and that the respective Class 1 specifications cover similar goods. Given the degree of similarity I believe that a likelihood of confusion exists and the opposition under Section 5(2)(b) is successful

22. As the opponent has been successful under Section 5(2)(b) I have no need to go on and consider the additional grounds of opposition. However, I will do so for the sake of completeness.

23. I next consider the ground of opposition under Section 5(4)(a) which states:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

24. In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case [1998] 14 RPC 455. In that decision Mr Hobbs stated that to succeed in a passing off action, it is necessary for the opponent’s to establish, at the relevant date (31 July 1999), that: (i) they had acquired goodwill under their mark; (ii) that use of the mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

25. I have already found that the opponent has not demonstrated reputation or goodwill in the UK in the trade mark applied for under No 701295. Therefore, it seems to me that the necessary misrepresentation required by the fact of passing off would not occur. The ground of opposition under Section 5(4) therefore fails.

26. Finally, the bad faith ground. Section 3(6) of the Act States:-

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

27. In the opponent's submissions I was referred to Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd [1999] RPC 367, where Lindsay J stated at page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealing which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing just so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

28. Thus bad faith can be exercised where there is no actual dishonesty as such. Have the applicant’s fallen short of the standards of acceptable commercial behaviour, however? The opponents submit that as the applicants were aware of the opponent’s earlier application No 701295, I should infer bad faith. However, I do not think that I am able to make such an inference. It seems to me that there is a genuine dispute between the parties and I bear in mind that the applicant has a registration of the mark OKO plus device in Class 1 (No 1585175) which pre-dates the opponent’s application and which may yet act as a barrier to registration of the opponent’s designation. The opposition under Section 3(6) fails.

29. I have found the opposition to have been successful under Section 5(2)(b) of the Act. However, under the provisions of Section 6(2) the final outcome is dependant upon the earlier International trade mark owned by the opponents securing protection in the UK. Accordingly, this is a provisional decision, dependant on that occurrence. The opponents are to inform the registry once registration has been achieved, and a supplementary, final decision will be issued at that time. Consequently, I make no order on costs now. Further, the period for appeal will begin from the date of that final decision.

Dated this 28 Day of June 20001

**JOHN MacGILLIVRAY
for the Registrar
The Comptroller-General**