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TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 2 591 985

IN THE NAME OF TURNAGAIN LTD

OF THE TRADE MARK: KLEENEASE

IN CLASS 01

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO 84402

BY FINDEL PLC

Background and pleadings

1. Kleenease is a trade mark registration standing in the name of Turnagain Ltd. It was applied for on 19 August 2011 and completed its registration procedure on 23 March 2012. Kleenease is registered in respect of cleaning preparations in Class 01.
2. Findel PLC (“the applicant”) filed an application on 1 May 2012 to have the trade mark declared invalid under section 47(2) of the Trade Marks Act 1994 (“the Act”). Section 47(2) states:

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

3. The applicant for invalidity argues that the registered trade mark should be declared invalid under Section 5(2) (b) of the Act as it is similar to its earlier trade marks and is registered for similar goods. As such, it argues there is a likelihood of confusion. Further, under Section 5(3) of the Act as the earlier trade marks have a reputation in respect of cleaning products and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier trade marks. Finally, under Section 5(4) (a) of the Act as the applicant’s business has established goodwill in the United Kingdom and use of the later mark would amount to a misrepresentation causing damage to the applicant’s business. The following earlier trade marks/rights are relied upon:

Earlier trade mark/right	Date of application/first use	Date of Registration	Registered goods and services/ goods and services earlier right used
UK 1 360 033 KLEENEZE	6 October 1988	14 June 1991	Class 03: soaps and cleaning preparations, all for personal or household use; polishing preparations and polish remover preparations; carpet shampoos; all included in Class 03.
CTM 2 174 55 KLEENEZE	1 April 1996	3 July 2001	soaps and cleaning preparations, all for personal or household use; bleaching preparations and other substances for laundry use; polishing, scouring

			and abrasive preparations; polish remover preparations; carpet shampoos
KLEENEZE	Bristol in 1923	N/A	Used on: floor cleaners, furniture cleaners, stain removers, window cleaning products, metal polish, laundry products, ironing products, cleaning wipes, house fresheners, beauty products, cookware, storage sets and bags, shoe storage solutions, brooms, mops, dusters, cloths, bin bags, pillows, pill organisers, magnetic health products, artificial flower cleaner, hair removal products, ironing board covers, towels, bath mats, and bathroom cleaning products.

4. In its counterstatement, the Registered Proprietor denies the claims made. Specifically, it argues that the manner of use greatly differs. For example, the products sold are, according to the registered proprietor, more concentrated and are also sold in a different manner, through its representatives selling to industry and not public or private homes. Further, it has no interest in selling many of the applicant's products. Different areas and different markets is the thrust of the registered proprietor's defence.

Applicant's evidence

5. This is a statutory declaration from Mr William John Black, the Commercial Manager for Kleeneze Limited. The following relevant information is contained therein:

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- Kleeneze branded products have been distributed in the UK since 1923 and offer a variety of products for use in the house, care of the home and for personal care and use.
- Currently, there are over 12,000 registered independent distributors who offer the range or products by delivering or presenting catalogues to the door.
- The approximate monetary turnover in respect of goods sold is: £16.6 million in 2007 and the same in 2008, £15.6 in 2009, £15.2 in 2010 and £14.2 in 2011.
- In respect of cleaning preparations, these figures are as follows: £4.8 million in 2007 and the same in 2008, £4.5 in 2009, £4.4 in 2010 and £4.1 in 2011.
- Annual amount spent in respect of catalogue printing and other promotional activities is £6.5 thousand in 2007, £5.8 in 2008, £5.5 in 2009, and £4.8 each year from 2010 to 2012.
- Specimens of Kleeneze catalogues since 2001, a promotional leaflet dated 1936 and a customer order form, all showing use of the Kleeneze trade mark are included in Exhibit WJB3. The catalogues, according to Mr Black, are the main method of selling the goods to UK customers.

Conclusions on the applicant's evidence

6. The evidence shows that the earlier trade mark has been used for a fairly significant period of time. There are sales figures provided. However, no details of market share are included and so these figures cannot be placed into any context within the cleaning preparations market as a whole. Further, there are no clear details of advertising activities mentioned beyond the printing of catalogues and "other promotional activities". Finally, though the main method of selling employed by the applicant is by delivering catalogues to the door, there is no information provided as to the numbers involved. These flaws mean it is impossible to gauge the level of recognition among the relevant public, which in the case of these goods will be the public at large. As such, it is considered that the evidence is unpersuasive as regards any reputation for the purposes of sections 5(3) and 5(2)(b) of the Act enjoyed by the earlier trade marks.

DECISION

The proof of use provisions

7. In its TM8 and Counterstatement, the registered proprietor, when asked whether or not it wished the applicant to provide proof of use of its earlier trade marks, replied "no". A notional assessment based on the earlier specification of goods and services as they are registered, must therefore be made.

Likelihood of confusion – Section 5(2) (b)

8. The relevant parts of section 5 of the Act read as follows:

“(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”.

9. The leading authorities which guide in this ground are from the CJEU: *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] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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 for 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*,

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(e) 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*

(f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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.*

Preliminary remarks

10. In response to the arguments of the registered proprietor as regards the nature of the respective businesses in the marketplace, the current, or past, marketing undertaken by the parties is not relevant to the issues to be determined, as the GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant’s goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

11. That the registered proprietor is only currently interested in particular products and methods of selling is therefore not relevant. The correct comparison to be made is between the respective specifications as they appear on the Register.

Comparison of the goods

12. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have

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pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

13. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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 service;

(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 practice 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.”

14. The earlier goods include cleaning preparations, all for household use. The later goods are cleaning preparations in class 1. In comparing these goods with those of the later trade mark, it is considered that their nature, purpose and method of use coincide in that they will include, for example, liquid or powder based products

intended to clean a variety of items. These items could also coincide. As an illustrative example, a cleaning product could clean an industrial oven and a household oven. The applicant stresses that the channels of trade differ as its products are not intended for household use. However, this does not alter their inherent similarity with the earlier goods as regards nature, purpose and method of use. Further, even in respect of trade channels, it is considered that the distinction between cleaning products in class 1 and those in class 3 is not clear cut and could overlap. For example, the only difference between them may be in respect of quantity in that products intended for industry may be offered in larger quantities or as bulk buys. There may be no actual difference in the products themselves and bulk buys may also be available to the general public. It is considered therefore that the respective goods are similar, potentially highly so.

Comparison of the marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

16. The respective trade marks have already been displayed above but for convenience are also shown below:

KLEENEZE	Kleenease
Earlier trade mark	Contested trade mark

17. Visually, the trade marks coincide in the first six letters “kleene”. They differ in respect of their respective endings, “ze” and “ase”. Despite this, it is considered that they are highly similar visually.

18. Aurally, the matter is even clearer. They are identical.

19. Conceptually, each of the trade marks is comprised of a made up word, though it is considered that both allude to ease of cleaning. They, therefore, share, a conceptual meaning.

Distinctive and dominant components

20. Each of the trade marks is comprised of only one component and so the answer here is straightforward; they do not have separate distinctive and dominant components. Bearing in mind all of the foregoing, it is considered that the trade marks are highly similar.

Degree of Distinctiveness of the earlier trade mark

21. Though the opponent claims that the earlier trade marks have a reputation, the evidence has not demonstrated this. As such, it has no impact on distinctiveness.
22. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00*). It is true that the earlier trade mark may allude to ease of cleaning, however it is also clearly a made up word. Bearing in mind both of these factors, it is considered therefore to have, overall, an average degree of distinctiveness.

The average consumer

23. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM (Case T-112/06)*).
24. In these proceedings, the average consumer of the earlier goods will be the general public. For the contested goods, it will be those working within industry that have responsibility for cleaning/cleanliness etc and for the purchase of the requisite products in this regard. It is considered that there is an overlap here and that those who purchase for industry will also purchase for household use as a member of the public at large. Cleaning products are purchased fairly frequently, but probably not so frequently as to classify them as an everyday product. Most likely there will be a range within so some products are purchased more frequently than others and this is likely to influence the level of attention displayed during the purchasing process. For those purchased frequently, the level of attention is like to be fairly low while it will be higher for products that offer a more specialist function, such as a deep cleaner for an oven that is undertaken twice a year for example. This analysis is considered to be reasonable whether the products are aimed at industry or households. The average level of attention therefore is expected to be reasonable.

Global Assessment – Conclusions on Section 5(2) (b)

25. It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
26. The trade marks have been found to be very highly similar and the earlier trade marks are averagely distinctive. The goods are considered to be similar in nature, purpose and method of use. It is also considered that there is potential for the relevant public to overlap as the trade channels and methods of distribution can coincide. It is true that on average a reasonable degree of attention will be displayed during the purchasing process. However, account must also be taken of the fact that the relevant public rarely have the opportunity to consider trade marks side by side and so must rely on an imperfect picture of them. The degree of similarity between the trade marks here together with the potentially high degree of similarity in respect of the goods leads inevitably to the conclusion that confusion is likely. The application for invalidity therefore succeeds in its entirety.
27. As the application under Section 5(2)(b) of the Act has succeeded, there is no need to go on to consider the remaining grounds.

COSTS

28. The application for invalidity has succeeded in its entirety. As such the applicant is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither sought a hearing. In the circumstances I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing application - £200

Filing application and considering counterstatement- £200

Filing evidence - £400

Total - £800

29. The above sum should 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 12TH day of June 2013

Louise White

For the Registrar,