

TRADE MARKS ACT 1938 (AS AMENDED)

AND TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 1589316
BY ORAL-B LABORATORIES A DIVISION OF GILLETTE CANADA INC**

AND

**IN THE MATTER OF OPPOSITION NO. 44495 THERETO
BY ADDIS LIMITED**

**TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 1589316
by Oral-B Laboratories a division of Gillette Canada Inc.**

and

**IN THE MATTER OF Opposition No. 44495 thereto
by Addis Limited**

BACKGROUND

On 28 October 1994 Oral-B Laboratories, a division of Gillette Canada Inc., Kirkland, Quebec, Canada, applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark CONTURA in Class 21 in respect of the following goods:-

Toothbrushes; electric toothbrushes; bristles for the aforesaid goods; toothpicks; all included in Class 21.

On 30 April 1996 Addis Limited filed notice of opposition against the application the grounds of which were as follows:

1. Under Sections 9 and 10, because the trade mark is neither adapted to distinguish the goods of the applicant from those of other traders, nor capable of doing so.
2. Under Section 11, by reason of the opponents' use of the trade mark WISDOM CONTOUR.
3. Under Section 12, by reason of the opponents' application for registration of the trade mark WISDOM CONTOUR.
4. Under Section 17, in exercise of the Registrar's discretion.

Details of the application referred to above are as follows:-

<u>Trade Mark</u>	<u>No.</u>	<u>Class</u>	<u>Goods</u>
WISDOM CONTOUR	2008229	21	Toothbrushes and parts and fittings therefore; all included in Class 21.

The applicants filed a counter-statement denying the grounds of opposition.

Both sides seek an award of costs in their favour.

5 The matter came to be heard on 24 July 1998 when the applicants were represented by Mr Christopher Morcom of Queen's Counsel, instructed by Gillette Management Inc. The opponents were represented by Mr Guy Burkill, of Counsel, instructed by Hughes Clark & Co.

10 By the time the matter came to be heard the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act However, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

15 At the start of the Hearing, Mr Burkill stated that his clients were only pursuing the grounds of opposition based upon Sections 9 and 10 of the Act. In the circumstances I need say nothing further about the other grounds, based upon Sections 11 and 12, other than to formally dismiss the opposition insofar as those Sections of the Act are concerned.

20 **Opponent's Evidence (Rule 49)**

The opponents filed no evidence in chief directed toward their grounds of opposition based upon Sections 9 and 10 of the Act, or none that I could discern. It was all in support of the grounds of opposition based upon Section 11 and 12 which are now dismissed.

25 **Applicants' Evidence (Rule 50)**

30 This consists of a Statutory Declaration by Andrew James Redpath, an Assistant Secretary of the Gillette Company with whom he has been employed for a period of 28 years. Mr Redpath is also a Vice President of Oral-B Laboratories, a division of Gillette Canada Inc., which is a wholly and subsidiary of the Gillette Company. He is therefore duly authorised to make the declaration on behalf of both companies. The facts stated therein are from his own knowledge or taken from the books and records of his company or from the books and records of Oral-B Laboratories, to both of which he has full access.

35 As far as the distinctiveness of his company's CONTURA trade mark is concerned he refers to his company's registrations of the trade mark CONTOUR in Class 3, Class 16, Class 8. These details are exhibited at AJRAPP1. Although very similar, it is Mr Redpaths view that the trade mark CONTURA is rather more distinctive than CONTOUR which was registered in Part B first of all and later in Part A, on the basis of evidence of use. He also refers to a
40 previous acceptance by the Trade Marks Registry in Part A of the word CONTOUR.

Opponent's Evidence in Reply (Rule 51)

45 This consists of a Statutory Declaration by Janice Collins. She is Sales and Marketing Director of the opponents and has access to the company's books and records. She states that she has read the declaration by Andrew Redpath and notes that the registrations of CONTOUR referred to by Mr Redpath are all in relation to completely different types of

goods from toothbrushes. She has no knowledge of the circumstances in which the registrations were obtained and thus no reason to regard these other trade marks as having any relevance in the present case. She notes that there is no suggestion that any of these trade marks have ever been used by the applicant in relation to toothbrushes.

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Janice Collins goes on to agree with Mr Redpath that the trade mark CONTURA is very similar to the trade mark CONTOUR. She considers that visually and phonetically they are very close.

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She attaches as Exhibit "JC1" a copy of the entry for the word Contour in the Collins English Dictionary and notes that the meanings include "the shape or surface, especially of a curving form". She states that it has been commonplace, long before 1994, for toothbrushes to have a curving shape or form and a further definition of the word contour is "shaped to fit the form of something: a contour chair". Thus *prima facie* a "contour toothbrush" would be expected to mean a toothbrush shaped to fit the teeth and mouth or the hand. A "contura toothbrush" sounds almost identical to a "contour toothbrush" or a "contoured toothbrush". Therefore Ms Janice Collins cannot agree that the mark CONTURA is rather more distinctive than CONTOUR, as Mr Redpath suggests.

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That completes my review of the evidence so far as it is relevant in this case.

DECISION

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The opposition is based upon Sections 9 and 10 of the Act. However, as I do not consider that I have the power to accept, at this stage, an application for registration in Part A on transfer to Part B, only Section 9 is relevant. This states:-

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9.-(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

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(a) the name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) an invented word or invented words;

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(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.

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(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

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(3) In determining whether a trade mark is adapted to distinguish as aforesaid the tribunal may have regard to the extent to which -

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(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

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The application stands or falls on whether the word CONTURA is adapted to distinguish the goods as specified in the application and set out earlier in this decision, namely toothbrushes, insofar as Sections 9(1)(c) and (d) are concerned. The trade mark clearly does not fall to be considered under 9(1)(a) or (b).

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There is an abundance of authority about what constitutes invention in words put forward as trade marks. Perhaps the earliest is that recorded in the case of Eastman’s Application (1890) 15 RPC 476 otherwise known as the SOLIO case. There is also the case of the DIABOLO trade mark (1908) 25 RPC 565. Various criteria for invented words were set out in the judgements in those cases, and, with great respect to the learned judges, I summarise them as follows:

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(i) an invented word must be newly coined,

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(ii) it must not be a word which conveys some obvious meaning to an ordinary English-speaking citizen within the jurisdiction,

(iii) it must not be a mere combination of two English words, though it may be a compound word,

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(iv) it may be traceable to a foreign source, but a foreign word will not qualify merely because it has not been current in English usage,

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(v) it may be a word containing an allusion to the character or quality of the goods, provided that allusion be covert and skilful,

- (vi) it may not be a word which has undergone a mere variation of its orthography or termination, if, in its slightly varied form, it still conveys the idea of the original word, or if it refers to the character or quality of the goods.

5 I take the view that the word CONTURA meets all six criteria. As far as I am aware it is newly
coined - and therefore meets (i). Despite the fact that both witnesses consider the word
CONTURA to be similar to the word `contour' I do not. There was no evidence before me as
10 to how the public at large are likely to perceive the word CONTURA. In my view the word
looks like one derived (or being) from a Spanish or Portuguese source and as a result would
be pronounced with the emphasis on an elongated `U' sound (as in tour). Thus it is a word
15 which would not convey any meaning to the ordinary citizen and meets criteria (ii). It meets
(iii) and (iv) without difficulty. Insofar as (v) is concerned, it is unlikely, as I have said above,
that the citizen at large is likely to associate the word CONTURA with the ordinary English
word `contour'. The transformation of the word `contour' into CONTURA requires more
20 than `mere variation of its orthography or termination'. And if the citizen did associate the
word CONTURA with `contour' it would be on the basis of an allusion to that word, but no
more. The trade mark therefore meets criteria (vi). In my view, and on the basis set out
above the word CONTURA is an invented word which qualifies under sub-section 9(1)(c).

25 In reaching this view I take fully into account the submissions of Mr Burkill based upon Kerly
8-21 and 8-22, that the trade mark was simply the word `contour' with an a on the end and
therefore not an invented word by reference to the ORLWOOLA 26 RPC 850. As already
indicated I do not take the view that the word CONTURA is a mere misspelling of the word
contour and therefore is not on all fours with the ORLWOOLA case.

30 Given my findings in relation to Section 9(1)(c) I have no hesitation in stating that the trade
mark CONTURA has no direct reference to the character or quality of the goods to be sold
under the trade mark and therefore also qualifies under Section 9(1)(d). Mr Burkill was
concerned that registration of the word CONTURA would enable the applicants to prevent
others from using the word contour in respect of the same or similar goods and thus,
35 paraphrasing the words of the then Master of the Rolls Cozens-Hardy L J in the ORLWOOLA
case, "allow wealthy traders to monopolise part of the great common of the English language
unfairly to the exclusion of other people". My finding is based upon the fact that there is no
similarity between the two words. Had there been so then the trade mark would not have
been acceptable for registration because the word contour does have a meaning insofar as
40 toothbrushes are concerned - the head or handle being shaped to fit either the mouth or hand.

45 For the reasons outlined above the opposition based upon Section 9 of the Act is dismissed. I
should add that in reaching this decision I have not taken any cognisance of the earlier
acceptance by the Trade Marks Registry of the word CONTURA mentioned in Mr Redpath's
evidence. As has been clearly stated in the past the Registrar's Hearing Officers take little
notice of `precedents' without detailed evidence of the circumstances in which the acceptance
occurred (in all cases).

As the opposition has not succeeded I order the opponents to pay to the applicants the sum of £2000. This is somewhat higher than is usual but takes account of the fact that the opposition based upon Section 11 and 12 was not proceeded with and the opponents chose not to inform the applicant (or the Registrar) until the start of the hearing.

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Dated this 12 day of October 1998

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**M KNIGHT
Principal Hearing Officer
for the Registrar
the Comptroller General**

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