

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2138247
BY DR SCHOLVIEN GMBH & CO**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 48551
BY EXTER AROMA BV**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2138247
by Dr Scholvien GmbH & Co**

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and

**IN THE MATTER OF Opposition thereto under
No 48551 by Exter Aroma BV**

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BACKGROUND

15 On 14 July 1997 Dr Scholvien GmbH & Co. applied under the Trade Marks Act 1994 to register the trade mark PLANT-TECH for a specification which, after amendment, reads:

Class 2 Colour extracts from fruit and plants.

20 **Class 3** Flavour extracts made from fruit and plants; essential oils; etheric essences.

Class 29 Flavour extracts made from fruit and plants; juices made from fruit and vegetables.

25 **Class 30** Flavour extracts made from fruit and plants; including extracts of cocoa and coffee; all for use in industry.

Class 32 Flavour extracts made from fruit and plants for use as beverages.

30 The application is numbered 2138247.

The application was accepted and published and on 13 May 1998 Exter Aroma BV filed Notice of Opposition to the application. The grounds of opposition as set out in the accompanying statement of case are, in summary:

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(1) that the opponents are the proprietors of the registered trade mark PLANTEX number 1399367 in respect of sauces; aromatic preparations, aromatic substances; farinaceous products; vermicelli; all included in Class 30;

40 (2) that the opponents have use the trade mark PLANTEX extensively in the United Kingdom in relation to goods for which the mark is registered;

(3) that registration of the applicants' trade mark would be contrary to the provisions of section 5(2) of the Act in that the mark applied for is similar to the earlier trade mark owned by the opponents and is proposed to be registered in respect of goods which are identical or similar to those for which the opponents' earlier trade mark is registered;

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- (4) that registration or use of the trade mark in suit would be contrary to the provisions of section 3(1) of the Act;
- (5) that the application should be refused under the provisions of section 3(6).

The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs. Both parties filed evidence in these proceedings and have requested that a decision be taken from the papers filed in the proceedings. Acting on behalf of the registrar and after a careful study of the papers, I give this decision.

Evidence

As stated above, both parties filed evidence in the proceedings. This evidence was directed to the use made by the opponents of their registered trade mark and also made various submissions as to the likelihood of confusion. The evidence was directed to the ground of opposition under section 5(2) of the Act. For reasons that will be explained below, I need not summarise this evidence.

DECISION

The opponents seek to oppose the application under section 5(2) of the Trade Marks Act 1994 which reads:

5.- (1)

(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.

The term “earlier trade mark” is itself defined in Section 6 as follows:

“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,

5 The “earlier trade mark” on which the opponents sought to rely was trade mark number 1399367. At the time the opposition was filed the opponents were shown as registered proprietors, however, after the date of filing of the opposition there were various changes of proprietor and the trade mark now stands in the name of DSM N.V. The fact that the opponents are no longer the proprietors of the earlier trade mark is not relevant, as there is no requirement in the Act for an opponent to be the proprietor of the earlier right; *Balmoral Trade Mark* [1999] R.P.C. at page 299 line 35. However, the trade mark on which the opponents sought to rely was the subject of an application for revocation on the grounds of non-use under sections 46(1)(a) and (b) of the Act. In a decision of today’s date I have found that the grounds for revocation have been made out and that the trade mark should be revoked in its entirety with effect from 9 August 1996. It follows that the trade mark 1399367 was not an “earlier trade mark” as defined by section 6 of the Act at the relevant date in these proceedings, 14 July 1997, the date of the application for registration. As the opponents cannot rely on trade mark 1399367 they do not have a ground of opposition under section 5(2) and therefore, I dismiss that ground of opposition accordingly. In their statement of case, the opponents have not sought to rely on any unregistered trade mark and so I need not consider that point any further.

10 I will go on to consider the opponents’ remaining grounds of opposition under section 3 of the Trade Marks Act 1994. The opponents’ statement of grounds refers to sections 3(1) and 3(6). The relevant provisions of the Act read as follows:

- 20 “3.- (1) The following shall not be registered -
- 25 (a) signs which do not satisfy the requirements of section 1(1),
 - (b) trade Marks which are devoid of any distinctive character,
 - 30 (c) trade Marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
 - 35 (d) trade Marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

40 Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

- 45 (2)
- (3)
- (4)

(5)

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

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Under section 3(1) the opponents’ statement of grounds claims that the trade mark applied for is:

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“.....devoid of any distinctive character and/or that it consists exclusively of signs of indications which may serve in the trade to designate the kind, quality or other characteristic of the goods and/or that it consists exclusively or signs or indications which have become customary in the current language or in the bona fide and established practices of the trade, being a combination of two purely descriptive words.”

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From this wording I take it that the opponents are seeking to rely on the provisions of section 3(1)(b),(c) & (d). I should say that I agree with the comments made in Mr Porteous’ first declaration to the effect that the opponents have filed no evidence in support of these grounds of opposition nor have they made any submissions. In the absence of such I doubt that I should consider these grounds at all. However, I go on to consider their objection. The opponents say that the trade mark is devoid of any distinctive character which is the language of sub-section (b) of Section 3(1). I am mindful of the comments of Aldous LJ in *Philips Electronics NV v Remington Consumer Products Ltd* [1999] E.T.M.R. 816, where he commented in relation to the application of Section 3(1)(b):

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“The scheme of the Directive and Act appears to require that signs which are not capable of distinguishing are excluded for registration at the initial stage. Those which are capable of distinguishing will be excluded unless they have or have acquired some distinctive character. An example is the trade mark WELDMESH to which I have referred. It is capable of distinguishing, but without use would retain its primary meaning of, welded mesh. It would therefore be devoid of any character that was distinctive. However, use could provide a secondary meaning, namely that the welded mesh to which the trade mark was applied came from a particular trader. Upon that being established it would become registerable as it would pass the dual test laid down by Section (Article) 3(1)(a) and (b).

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The requirement under section (Article) 3(1)(b) is that the mark must have a distinctive character to be registerable. Thus, it must have a character which enables it to be distinctive of one trader’s goods in the sense that it has a meaning denoting the origin of the goods.”

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The trade mark in question is PLANT-TECH, the goods for which registration is sought seem to relate to extracts from fruit and plants. The opponents assert that the trade mark is a combination of two words, I infer that they mean PLANT and TECHNOLOGY. The opponents have not sought to argue that the trade mark is not capable of distinguishing under section 3(1)(a), but nevertheless a trade mark will be excluded unless it **has** or **has acquired** some distinctive character. The applicants do not seek to rely on the latter of these two scenarios and they have not provided any evidence of use of the trade mark which would support a claim that the trade mark had acquired a distinctive character as a result of the use made of it. Therefore, the question which falls to be determined is whether, absent use, the trade mark PLANT-TECH has a distinctive

character. In my view it does. The trade mark is not descriptive of the goods for which registration is sought which as stated above, relate to colour and flavour extracts from plants and fruit. The use of PLANT is presumably a reference to the origin of the products but the term TECH does not seem to have any direct relation to the goods in question. I also note the following passage, about the word TECH, from the Registry work Manual (October 1999), Chapter 6 - Addendum, page 88:

‘An accepted abbreviation for “technology” (Collins English Dictionary) which is objectionable under Section 3(1)(b) and (c) when used in a combination which is an appropriate description. TEC and TEK should be similarly treated as they are phonetically identical. Acceptable in combination with the name of non-technical goods. So POOLTEC (swimming pools), SEALTEC (seals) have been accepted. Has also been accepted for some technical goods where the other word is not quite the name of the goods, e.g TILLTEC (tilling machines). HI-TEC and NUTECH (new tech) have been refused. COMPUTER TEC and NETWORK TECH would also be refused.’

The use of TECH in PLANT-TECH in my view, falls into the acceptable use of the abbreviation TECH as set out in the Work Manual, that is, it is use in combination with the name of non-technical goods.

The combination of the two words PLANT and TECH joined by a hyphen is in my view enough to give the trade mark a distinctive character such that it satisfies the test under section 3(1)(b). Accordingly the opponents’ ground of objection under this section is dismissed.

The same reasoning can be applied to the ground of objection under section 3(1)(c). PLANT-TECH does not consist exclusively of a sign or indication which may serve in the trade to designate the kind or indeed characteristic of the goods. Whilst PLANT may indicate the origin of goods, the addition of the tag -TECH is enough to find that it does not consist exclusively of such a sign. Therefore, I dismiss the ground of objection under section 3(1)(c). I have no evidence to show that the use of PLANT-TECH has become customary in the current language of the trade and so the ground of opposition under section 3(1)(d) is dismissed also.

I go on to consider the opponents case under section 3(6). The opponents statement of case makes the following assertion:

“The applicant’s earlier application No 2002914 for registration of the identical mark was opposed by the opponents and subsequently withdrawn. An order for payment of costs in respect of the earlier opposition was made on 11th November 1997 but has not yet been discharged by the applicants. On the same date as that on which the earlier application was withdrawn, the Applicants filed the present application for registration of the identical mark in the same classes. Registration of the mark applied for would accordingly be contrary to the provisions of Section 3(6) in that the application is made and the Applicants have acted in bad faith”.

This applicants made the following rebuttal in their counter-statement:

5 “The applicants admit that application No 2002914 was opposed by the Opponents and that the application was subsequently withdrawn. Application No 2002914 was withdrawn for a technical reason and not because of any merits in the opposition which is why a further application was filed on the same day. The applicants have and always have had the necessary intention to use the trade mark. Application No 2138247 has been made in good faith and its registration does not offend against the provisions of Section 3(6).....The order for payment of costs has been discharged by the Applicants”.

10 An allegation that an application was made in bad faith is clearly a serious one. The opponents’ statement of case made various assertions concerning the applicants conduct in the previous proceedings and as to their reasons for making this application. The counter-statement rebuts those assertions. It seems to me that where an opponent makes an assertion that an application has been made in bad faith it is for them to submit cogent evidence in support of their claim. Other than restating the fact that the applicants’ earlier application was withdrawn, no such evidence was filed
15 by the opponents in these proceedings.

20 In all the circumstance of the case I can find nothing that would lead me to the view that the applicants have acted in bad faith and therefore I dismiss the ground of opposition under section 3(6) of the Act.

25 As the applicants have been successful, they are entitled to a contribution towards their costs. I direct that the opponents pay the applicants the sum of £535-00. This sum to be paid within seven days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29 day of November 2000

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S ROWAN
For the Registrar
the Comptroller-General.
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