O-217-05

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2309112
BY COLGATE-PALMOLIVE COMPANY
TO REGISTER THE TRADE MARK:

FOAM WORKS

IN CLASS 3

AND

THE OPPOSITION THERETO
UNDER NO 91524
BY PZ CUSSONS (INTERNATIONAL) LIMITED

BASED UPON THE EARLIER TRADE MARKS:

FOAMBURST

AND

Trade Marks Act 1994

In the matter of application no 2309112
by Colgate-Palmolive Company
to register the trade mark:
FOAM WORKS
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and the opposition thereto
under no 91524
by PZ Cussons (International) Limited

BACKGROUND

1) On 27 August 2002 Colgate-Palmolive Company, which I will refer to as Colgate, applied to register the trade mark **FOAM WORKS** (the trade mark). The application has an international priority date of 27 February 2002. The international priority claim derives from an application made in the United States of America. The goods of the United States application are: *personal care products* in class 3. The application was published for opposition purposes in the "Trade Marks Journal" on 4 December 2002 with the following specification:

personal care products; toiletries and cosmetics; soaps, body wash, shower and bath products, shower gels, bath oils, bath foam, bar soap and liquid hand soap; body and skin oils, lotions and creams; hair care products, shampoos, conditioners, hair lotions and gels.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 3 March 2003 PZ Cussons (International) Limited, which I will refer to as Cussons, filed a notice of opposition. Cussons is the owner of the following United Kingdom trade mark registrations:

- No 2122023 of the trade mark **FOAMBURST**. It was filed on 28 January 1997 and registered on 19 September 1997 for the following goods:

  non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; shower gels and shower creams; bath creams and bath foams; soap; deodorants and anti-perspirants; talc; shaving preparations; after-shaving preparations; perfumes, eau de toilettes and after-shaves; hair preparations.

  The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- No 2193335 of the following trade marks (a series of two):

The trade marks were filed on 30 March 1999 and registered on 17 September 1999 for the following goods:

non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; shower gels and shower creams; bath creams and bath foams; soap; deodorants and anti-perspirants; talc; shaving preparations; after-shaving preparations; perfumes, eau de toilettes and after-shaves; hair preparations; shampoos.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Cussons claims that the trade mark is similar to its two trade marks and that the respective goods are identical or similar. There is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Cussons states that it has used the trade mark FOAMBURST and trade marks including the word FOAMBURST in the United Kingdom in relation to goods falling within the specification of its two trade mark registrations. This use commenced in the financial year 1997-1998, in the first financial year there were sales of £1.3 million and in 2002-2003 there were sales of £9.5 million. Cussons states that the amount spent on advertising products bearing the FOAMBURST trade mark in the United Kingdom has ranged from £1.3 million to £4.8 million.

4) Cussons states that it is not aware of any other party having used the word or prefix FOAM in relation to the goods of the application or similar goods to those of the application, other than in a descriptive form.

5) Cussons claims that it enjoys a goodwill in the name FOAMBURST and in trade marks incorporating the name FOAMBURST such that should use of Colgate's trade mark be commenced, it would suffer substantial damage to its goodwill. The application, therefore, offends against section 5(4)(a) of the Act and use of the trade mark would be liable to be prevented by the law of passing-off.

6) Cussons seeks the refusal of the application and an award of costs.

7) Colgate filed a counterstatement. Colgate denies that its trade mark is similar to those of Cussons. It states that the trade marks only share the ordinary and well

understood word 'foam', a word that is obviously descriptive and non-distinctive in relation to the goods of Cussons' registrations and Colgate's application. The second word elements of the trade marks are ordinary and well understood dictionary words with no phonetic, visual or conceptual similarities. Colgate does not admit that the respective goods are identical or similar. Colgate denies that there is a likelihood of confusion. Colgate denies and/or puts to proof all the other claims of Cussons. It does, however, state:

> "The Applicant admits the second allegation in the second sentence of numbered paragraph 4 of the further Statement of Grounds that there is no likelihood of visual confusion between the marks FOAMBURST and FOAM WORKS, and observes furthermore that there is no prospect of conceptual similarity either pleaded or apparent."

In fact the sentence referred to in the statement of grounds reads:

> "Further, both the words FOAMBURST and FOAM WORKS are marks consisting of two syllables with confusion without prior use more likely on an oral rather than a visual basis."

8) Colgate seeks the registration of the trade mark and an award of costs.

9) Both sides filed evidence.

10) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. Colgate filed written submissions.

EVIDENCE

Main evidence of Cussons

Witness statement of Nicola Tod

11) Ms Tod is a brand manager in the marketing department of PZ Cussons (UK) Limited. She has worked in the marketing department for three years. Prior to this she was an assistant product manager at Smith & Nephew Medical Ltd.

12) Products bearing the FOAMBURST trade mark have been sold within the United Kingdom since 1998, when a shower gel was launched. Sales of products bearing the FOAMBURST trade mark have continued since then. Hand wash products were sold under the trade mark FOAMBURST from 2001.

13) Ms Tod states that there are two defined types of shower gels/shower mousse products available in the United Kingdom; there are shower gels/mousses released through an aerosol can and those in squeezable plastic containers. She describes the former as aerosol shower gels and the latter as plastic container shower gels. The PZ Cussons Group of Companies are subscribers to the data produced by IRI Limited, an independent company. As part of the subscription details of the brand shares of

various products are supplied. She exhibits at NT1 a copy of the most recent data concerning shower and body wash products which has been provided by IRI Limited. The exhibit covers the period 11 August 2002 to 10 August 2003, it is headed "Shower and Bodywash Products". It shows figures for various IL F'burst products. (I assume, from other evidence in the case, that IL stands for Imperial Leather and F'burst is short for FOAMBURST.) The data indicates that on 11 August 2002 the various IL F'burst products had a 5.1 per cent share of the market. Ms Tod identifies the figures as relating to shower gels.

14) Ms Tod states that there are three main aerosol shower gel/shower mousse products in the United Kingdom: FOAMBURST shower gel, DOVE ULTRA mousse and PH5.5 shower mousse. Ms Tod states that DOVE ULTRA mousse enjoys 0.4 per cent of the market and PH5.5 0.2 per cent of the market. She states that expanding the IRI figures would show that sales of FOAMBURST products make up 89 per cent of the branded aerosol shower gel market. The data exhibited at NTI show inter alia the following market shares for shower and body wash products: IL Std Shower (Imperial Leather Standard Shower?) 12.6 per cent; Radox products 12.2 per cent (Radox Showerfresh having 11.1 per cent); Dove products 5.5 per cent, Lynx 7.7 per cent, Olay products 5.8 per cent, PH5.5 products 5.4 per cent.

15) Ms Tod states that the FOAMBURST range of products extends to liquid hand wash products. She exhibits at NT2 data from IRI in relation to liquid soap and adult wipes. This data shows that as of 11 August 2002 IL Foamburst enjoyed 2.2 per cent of the liquid soap market. Over the period 11 August 2002 to 10 August 2003 the average market share was 2.2 per cent. The data shows that this was a 47.5 per cent increase on the previous year.

16) Sales of FOAMBURST products are made throughout the United Kingdom and are sold through all the major supermarket stores as well as a large number of pharmacies and health and beauty product stores, including Boots and Superdrug. Exhibited at NT3 are annual sales figures (for years ending in August):

	August 1998	**August 1999**	**August 2000**	**August 2001**	**August 2002**
Gross sales value (£000)	2,273	5,730	6,941	8,444	9,828

17) Exhibited at NT4 are figures for expenditure on advertising FOAMBURST marked products:

	Sep 1998 – May 1999	**June 1999 – May 2000**	**June 2000 – May 2001**	**June 2001 – May 2002**
Media spend (£000)	101	1,900	3,784	4,394

Ms Tod states that advertising FOAMBURST products has been done throughout the United Kingdom by means of radio, television, brochures, leaflets, posters and the

sides of taxis. Exhibited at NT5 are examples of advertisements. All of the advertisements show use of FOAMBURST with Imperial Leather. The photograph of a taxi shows inter alia the wording "VOTE FOR YOUR FOAM FAVOURITE" and a picture of a man whose torso is covered in foam or lather holding a can of the product. Two of the advertisements, from Summer 2003, show respectively a naked man and a naked woman covered in foam or lather with the legend "Release the lather".

18) Ms Tod states that part of her job includes being aware of and considering the positions of competitors in the marketplace. She states that at no time has she been aware of any product in the aerosol shower gel, plastic shower gel or any of the person care markets, other than FOAMBURST, which have incorporated the word FOAM as anything other than a reference to the exact nature of the products eg foam bath and shaving foam.

Evidence of Colgate

Witness statement of Iain Alexander Stewart

19) Mr Stewart is a trade mark assistant with Kilburn & Strode, the representatives of Colgate.

20) Mr Stewart states that the term 'bath foams' appears in the specifications of the registrations of Cussons. He states that the "Shorter Oxford English Dictionary" (fifth edition) defines foam in the following terms:

Foam (noun)

"a mass of small bubbles formed on the surface of water or in liquid by agitation, fermentation, etc."

Foam (verb)

a. "cover (as) with foam"
b. "emerge as foam"
c. "Of a liquid: froth, gather foam; run foaming along, down etc."

Exhibited at IAS1 is a copy of the relevant page from the dictionary. In relation to the verb definitions, the first is followed by *rare* ME-M16 (Middle English to middle of 16th century -1150 to 1569), the second as "only in LME" (late Middle English – 1350 to1469). Both these definitions are also proceeded by the † symbol, which the editors of the "Shorter Oxford English Dictionary" use to indicate that the usage is obsolete.

21) Mr Stewart states that exhibited at IAS2 are printouts from Cussons' websites. He refers to references to lather as part of the product description of IMPERIAL LEATHER FOAMBURST.

22) Mr Stewart goes on to give definitions of lather from the "Shorter Oxford English Dictionary (and exhibits at IAS3 a copy of the relevant part of the dictionary):

Lather (noun)

"A froth or foam made by the agitation of a mixture of soap and water."

Lather (verb)

a. "Cover (as) with lather; apply lather to; wash in or with a lather"
b. " Now chiefly of a horse: become covered with foam or frothy sweat"
c. "Produce and form a lather or froth".

23) Mr Stewart states that the words foam and lather are close to being synonyms, and on occasion are synonyms. Exhibited at IAS4 is a printout from the trade mark classification area of the Patent Office website. This shows twenty six terms in class three of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, which include the word foam, foams, foaming and foamable. Terms that are included in the list are: foaming bath gels, foams for use in the shower, body cleansing foams, foamable non-medicated toilet preparations and shower foams. Also included in the exhibit are three terms that refer to lathering products in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

24) Exhibited at IAS5 is a printout from the SAEGIS database. This shows 45 United Kingdom trade mark registrations, five Community trade mark registrations and four international trade mark registrations containing the word FOAM. Mr Stewart states that a number of these either cover generically or specifically goods such as toiletries, non-medicated toilet preparations and soaps, or refer to bath/shower preparations. He lists these as follows:

FOAMRUSH	non-medicated toilet preparations
HYFOAM	soaps
HANDIFOAM	soaps
FOAM CARE	soaps
ACTIFOAM	soaps
JETFOAM	soaps
AQUA FOAM	soaps, preparations for the bath and/or shower
FOAMSAN	soaps and skin cleansers
SEAFOAM	cosmetic bath products, bath oils, toilet soaps
BRYLFOAM	shampoos
MEGA FOAM	cosmetics and hair lotions.

Mr Stewart exhibits at IAS6 printouts of details of the above registrations.

25) Exhibited at IAS7 is a printout from the United Kingdom website dooyoo. It shows various comments about the FOAMBURST product, from 8 May 2001 to 4 August 2003. The printout shows that the product is often referred to as IMPERIAL

LEATHER FOAMBURST or CUSSONS IMPERIAL LEATHER FOAMBURST as well as simply FOAMBURST.

26) Mr Stewart goes on to exhibit data of market share of FOAMBURST products from December 2003 onwards. As this is well after the material date I do not see that this can have a bearing upon my deliberations.

Evidence in reply of Cussons

Witness statement of Nicholas Francis Preedy

27) Mr Preedy is a trade mark attorney at HallMark IP Limited, which is acting for Cussons. Mr Preedy's statement consists of submissions and a critique of the evidence of Colgate. It contains no evidence of fact and so I will say no more about it. (In its submissions Colgate states that this evidence should be disregarded as it is not evidence in reply. On the basis of my view of this evidence nothing turns upon this issue. However, I bear in mind the submissions that the evidence represents in reaching my decision in this case.)

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

28) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

> "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."

Section 6(1)(a) of the Act defines an earlier trade mark as:

> "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"

In this case the application claims an international priority date. Section 35(1-3) of the Act reads as follows:

> "35. - (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a "Convention application"), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.
>
> (2) If the application for registration under this Act is made within that six-month period-

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and
(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

A "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application."

Section 55(1) of the Act reads:

"55. - (1) In this Act-
(a) "the Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,
(aa) "the WTO agreement" means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15th April 1994, and
(b) a "Convention country" means a country, other than the United Kingdom, which is a party to that Convention."

The documentation filed at the examination stage shows that an application for the trade mark was filed in the United States of America on 27 February 2002. The United States of America is a Convention country, within the meaning of the Act. The application for registration in the United Kingdom was made on 27 August 2002, and so within the six month period allowed. The United States application is for *personal care products* in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. This term encompasses all the goods of the United Kingdom application, in my view. Consequently, the claim to an international priority date of 27 February 2002 is valid and the material date for the matters of concern in this case is 27 February 2002. Taking 27 February 2002 as the material date, the trade marks of Cussons are earlier trade marks as defined in the Act.

29) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (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 BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)* C-106/03 P.

Comparison of goods

30) The goods of the application are:

personal care products; toiletries and cosmetics; soaps, body wash, shower and bath products, shower gels, bath oils, bath foam, bar soap and liquid hand soap; body and skin oils, lotions and creams; hair care products, shampoos, conditioners, hair lotions and gels.

The goods of the earlier registrations are:

non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; shower gels and shower creams; bath creams and bath foams; soap; deodorants and anti-perspirants; talc; shaving preparations; after-shaving preparations; perfumes, eau de toilettes and after-shaves; hair preparations.

Registration no 2193335 also includes *shampoo*. I consider that, with or without the 2193335 addition, the goods of the application are clearly identical or highly similar to the goods of the earlier registrations.

Comparison of trade marks

31) I cannot see that Cussons can be in any better position in relation to its word and device trade mark than it is for its word only trade mark. I will, therefore, confine myself to comparing the word only trade mark of Cussons against the Colgate trade mark. The trade marks to be compared are:

Earlier trade mark:	**Application:**
FOAMBURST	**FOAM WORKS**

32) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). "The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public" (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

33) A major plank of Colgate's argument that the respective trade marks are not similar is that, for the goods, FOAM is non-distinctive. Ms Tod in her witness statement states:

> "At no time have I been aware of any product in the aerosol shower gel, plastic shower gel or any of the personal care markets other than Foamburst which have incorporated the word FOAM as anything other than a reference to the exact nature of the product, examples being FOAM BATH and SHAVING FOAM."

I cannot see how this can be read other than an acceptance that the word FOAM is a descriptive and non-distinctive term in relation to the goods. That the Registry's classification data base lists so many goods that can be described by reference to foam or their foaming action shows that the word is descriptive. In the context of this case the terms that I have specifically referred to above - foaming bath gels, foams for use in the shower, body cleansing foams, foamable non-medicated toilet preparations and shower foams – seem particularly significant. Cussons own specifications include the term bath foams. Colgate has put in evidence to show the similar meanings of the words lather and foam, and that Cussons refers, in its publicity, to the lather that the goods produce. Various of the pictures used in the promotional material show people covered in lather or foam. I do not consider that there can be any doubt that in relation to most of the goods of the application FOAM is a non-distinctive and descriptive word. In relation to the non-distinctiveness of FOAM, Colgate has also produced state of the register evidence. State of the register evidence does not have any effect on reaching a decision as to whether there is a likelihood of confusion (see *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281). However, it can be indicative of a term being descriptive and/or non-distinctive. Owing to the other evidence in this case I do not consider that anything turns upon this evidence. In relation to the goods upon which Cussons has shown use it is certainly descriptive of the effect of the product. In relation to *personal care products; toiletries and cosmetics* of the application, I consider that although FOAM could be descriptive of some of the goods covered by the term, it would not be descriptive of certain other goods covered by these terms eg lipstick, nail varnish and mascara. Consequently, I will put *personal care products; toiletries and cosmetics* to one side for the moment.

34) Ms Tod states that she is not aware of any other personal care products which use the word FOAM as part of a trade mark. Colgate, in its submissions, comments that she has put in no evidence to support this claim. It would have been possible, from my experience of cases relating to similar goods, to have exhibited lists of goods that are supplied to druggists and pharmacies. However, Ms Tod makes her statement from her knowledge of the market. I see no reason to doubt that she is not aware of any other trade marks using the word FOAM and that she has a knowledge of the market. She works for Cussons but that does not negate her experience and knowledge. If Colgate wished to challenge the basis of her statement, it could have filed counter evidence and/or requested a hearing so that Ms Tod could be cross-examined. I accept Ms Tod's evidence on the basis of her experience. However, I could not describe her evidence as definitive as it rests on her personal knowledge; unlike the case where product lists are furnished. However, the evidence of Ms Tod, however probative, is not greatly to the point. Her own evidence accepts that FOAM is a descriptive word. It is the effect of the descriptive word upon the average

consumer for the goods that is key. (In this case I consider that for the goods of the application, the average consumer is the public at large. There will be very few persons who do not use some of the goods encompassed by the specification.)

35) In *José Alejandro SL v Office for Harmonization in the Internal Market (Trade Marks and Designs), Anheuser-Busch Inc Intervening*(Case T-129/01) [2004] ETMR 15 the Court of First Instance (CFI) stated:

> "The Court notes that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark."

This is a view that the CFI has also upheld in *Koubi* v *OHIM – Flabesa (CONFORFLEX)* Case T-10/03, paragraph 60; *Grupo El Prado Cervera* v *OHIM – Debuschewitz (CHUFAFIT)* Case T-117/02, paragraph 51. The CFI has held recently that "in general terms, that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects" (*Faber Chimica Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-211/03). This approach has appeared in other recent judgments of the CFI. This issue was dealt with by Richard Arnold QC, sitting as the appointed person, in *Buffalo Creek* BL O/169/05. Having surveyed the case law Mr Arnold came to the following conclusion (at paragraph 37):

> "The conclusion I draw from this review of the case law is that there are no special rules to be applied when comparing a composite mark which includes an earlier mark with the earlier mark. The principles laid down in *SABEL*, *Canon*, *Lloyd* and *Marca Mode* remain the applicable principles. In particular, the tribunal must consider the overall impression given by each mark as a whole bearing in mind its distinctive and dominant components. In some cases the overall impression given by a composite mark may be dominated by one component of that mark."

In comparing the trade marks I start on the basis of that set out by Mr Arnold and that of the CFI in relation to non-distinctive elements of trade marks. Of course, the comparison must be made on the basis of the trade marks in their entireties but the distinctive and dominant components must be taken into account. In relation to the goods, other than those I have put to one side for the moment, the FOAM element is clearly descriptive, it is clearly non-distinctive. I cannot see that it can be considered the distinctive or dominant component of either trade marks. The second elements of the trade marks are clearly different phonetically, visually and conceptually. The CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 held:

> "54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous

> paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks."

In this case the BURST and WORKS components of the trade marks are conceptually dissonant; a dissonance that is strengthened owing to each of the words having well-known meanings. Geoffrey Hobbs QC, sitting as the appointed person, stated in *Torremar* [2003] RPC 4:

> "At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283)."

In this case the point upon which the trade marks converge is a non-origin specific one; an element that the average consumer is likely to see as fundamentally a descriptor and not, of itself, an indicator of origin. The perception of the average consumer will be governed by the nature of the goods, goods that produce foam.

36) Taking into account the nature of the goods, the average consumer (the public at large), the convergence in relation to a descriptive term, the dissonance in relation to the other components of the trade mark, and bearing in mind that the trade marks may be imperfectly reflected, I come to the conclusion that in respect of the goods of the application, with the exception of *personal care products; toiletries and cosmetics*, that the respective trade marks are not similar.

37) The FOAM element, as stated above, will not be descriptive in relation to certain goods encompassed by *personal care products; toiletries and cosmetics*. There will be others, such as the rest of the specification, for which foam will be descriptive. I have to deal with these portmanteau terms on the basis that they cover goods for which foam is neither descriptive or non-distinctive. The FOAM element of the respective trade marks is obviously identical, the fact the FOAM and BURST are conjoined will not stop the average consumer seeing the word FOAM. The FOAM element, in my view, is a distinctive part of both trade marks. The final parts of the trade marks are also distinctive. However, I am of the view that owing to its position at the beginning of the trade mark that the FOAM element is a more dominant element of each trade mark than the final element – although not to an enormous

extent. I have already commented upon the differences and dissonance between the final components. It is necessary to consider the trade marks in their entireties. Mr Hobbs in *Torremar* does not state that a coincidence in a distinctive element will make trade marks distinctively similar automatically. The common element has to be perceived in the context of the trade marks in their entireties. There are the two elements into which each of the two trade marks can be divided. However, there is the third element of the trade marks in their entireties, which has to be considered. There is a conceptual dissonance of the final elements of the trade marks, an absence of any argument or evidence of a family of trade marks beginning with FOAM. If there were a family of trade marks then the circumstances might be different. I consider that the conceptual dissonance must carry to some extent to the trade marks as a whole. I am also of the view that the respective trade marks 'hang together'; they create a definite entity.

38) Taking into account all the matters which I referred to in paragraph 36, I come to the conclusion that in relation to the remaining goods that the respective trade marks are not similar.

Conclusion

39) To succeed under section 5(2)(b) of the Act the goods have to be similar; that is what the Directive states, it is what the Act states. It is what is pointed out in *Sabel BV v Puma AG* [1998] RPC 199:

> "it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, "there exists a likelihood of confusion on the part of the public."

The ECJ in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)*stated:

> "51 For the purposes of applying Article 8 (1)(b) of Regulation No 40/94, the likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered in the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (see to that effect, on the identical provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 22).
>
> 52 Contrary to Vedial's claim, the Court of First Instance did not rely on the visual, aural and conceptual differences between the earlier mark and the mark applied for in deciding that there was no likelihood of confusion.
>
> 53 After making a comparative study, at paragraphs 48 to 59 of the judgment under appeal, of the two marks in the visual, aural and conceptual senses, the Court of First Instance concluded, as stated at paragraph 65 of the judgment,

> that the marks could in no way be regarded as identical or similar for the purposes of Article 8(1)(b) of Regulation No 40/94.
>
> 54 Having found that there was no similarity between the earlier mark and the mark applied for, the Court of First Instance correctly concluded that there was no likelihood of confusion, whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned."

40) Cussons has claimed a reputation. In its submissions Colgate has attacked the evidence of Cussons in relation to this claim, mostly on the validity of the evidence of Ms Tod. Ms Tod's statement and accompanying exhibits have not been challenged by way of evidence or by way of cross-examination. I can find nothing in her evidence that would lead me to discount it or question that data that it exhibits. Ms Tod comments about the market share of the aerosol shower gel market. However, the evidence she has submitted does not indicate that the shower gel market can be divided into aerosol and non-aerosol parts. The IRI evidence does not make this distinction. Colgate attacks the evidence in that it shows use with IMPERIAL LEATHER. A trade mark can still have a reputation or gain distinctiveness from use with other matter or trade marks (see *Société des produits Nestlé SA v Mars UK Ltd* Case C-353/03). The effect of reputation in relation to likelihood of confusion can have two effects: create a greater likelihood of confusion where the goods or services are similar to only a limited extent (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*) and to make a trade mark more distinctive (*Sabel BV v Puma AG*). *Sabel BV v Puma AG* held that "the more distinctive the earlier mark, the greater will be the likelihood of confusion". In this case the respective goods are identical or similar and so there can be no assistance to Cussons upon that front. Reputation cannot make trade marks similar, as Advocate General Ruiz-Jarabo stated in his opinion in *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM)*:

> "59. This claim is, at best, to no avail. From the moment that the Court of First Instance reached the conclusion, in paragraphs 48 to 59 of the judgment under appeal, that the signs were not similar to each other (as it categorically states in paragraph 65), there is neither the likelihood of confusion nor the likelihood of association to which the appellant refers. In the absence of such similarity, it is pointless to wonder whether the public would think that products identified by the new mark originate from an undertaking which is economically linked to the proprietor of the earlier mark. In addition, the judgment at first instance stated, also in paragraph 62, that, 'Consequently, there is no risk that the targeted public might link the goods identified by each of the two marks which evoke different ideas'."

Having decided that the respective trade marks are not similar Cussons has reached a cul- de-sac. Its case falls. There is nothing in the evidence of Cussons to support a claim that in relation to the goods upon which it has used the trade mark – all of which foam – that FOAM has in anyway become distinctive of its goods. Any reputation accrues to the trade mark as a whole, it is not a reputation that, on the evidence, would give rise to FOAM followed by another dissonant word being linked with Cussons for goods that foam – the goods upon which it uses the trade mark.

The nature of the goods upon which the trade mark is used re-enforce the descriptive nature of the first element of the trade mark and to show to the public that it is the trade mark as a whole that indicates origin. For these reasons I do not consider it necessary to make a judgment on what if anything Cussons has proved in relation to its use of the trade mark. However, that is not to say that I accept the submission of Colgate:

> "The opponent cannot legitimately seek to monopolise use of word (sic) foam as the primary element of composite trade marks for this type of Class 3 product."

My job is not to consider what Cussons can or cannot legitimately seek to do in relation to its trade mark; it is to decide upon the facts before me whether I consider that there is a likelihood of confusion.

41) Having found that the respective trade marks are not similar, the inevitable and only finding that I can come to is that there is not a likelihood of confusion. Claimed reputation, identity of goods, nature of the purchasing decision (in this case not necessarily a very educated or careful one), the average consumer (in this case the man or woman in the street), imperfect recollection; all of these factors are smashed on the rock of an absence of similarity.

Passing-off – section 5(4)(a) of the Act

42) I cannot see that Cussons can be in a better position in relation to passing-off. Indeed, taking into account how the trade mark has been used and upon which goods it has been used, its case must be worse. **This ground is, therefore, dismissed.**

COSTS

43) Colgate-Palmolive Company having been successful is entitled to a contribution towards its costs. I order PZ Cussons (International) Limited to pay Colgate-Palmolive Company the sum of £1075. This sum is 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 1st day of August 2005

David Landau
For the Registrar
the Comptroller-General