

O-339-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. 2278608 AND 2278612
BY WELLMAN, INC. TO REGISTER THE TRADE MARKS
COMFORTREL PLUS AND COMFORTREL IN CLASS 22**

AND

**IN THE MATTER OF OPPOSITION NOS. 91241 AND 91242
BY INVISTA TECHNOLOGIES S.À.R.L.**

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By Invista Technologies S.à.r.l.**

Background

1. On 21 August 2001 Wellman, Inc (hereinafter referred to as Wellman) applied to register the mark **COMFORTREL** for the following goods in Class 22:

Synthetic textile staple fiber; raw fibrous textile materials.

And the mark **COMFORTREL PLUS** for the following goods in Class 22:

Synthetic textile filament fiber; raw fibrous textile materials.

2. On 13 November 2002 Invista Technologies S.à.r.l. (hereinafter referred to as Invista) filed notice of opposition to these applications citing a single ground under Section 5(2)(b) of the Act. Invista is the proprietor of Community Trade Mark No. 852228 for the mark COMFOREL. It is registered in four classes namely 22, 23, 24 and 25. Invista claims that the trade marks applied for are similar to its trade mark and the goods are said to be identical or similar to the goods covered by Invista's registration.

3. Wellman filed counterstatements that deny the above claims. They state that they own the company Fiber Industries Inc and claim that they are therefore the beneficial owners of a number of earlier UK registered trade marks in Classes 22, 23, 24 and 25 for the trade mark FORTREL. Wellman claim that COMFORTREL is an extension of FORTREL, in which they have a long standing equity and in which considerable goodwill resides.

4. Only Wellman has filed evidence. By letter dated 28 June 2007 the parties were invited to say whether they wished to be heard or to file written submissions. Despite initially requesting to be heard, Wellman subsequently opted to file written submissions in lieu of attending a hearing. Invista indicated they did not wish to attend a hearing. After a careful study of the papers I give this decision.

Consolidation

5. For reasons which are not entirely clear to me it would appear that the two oppositions have never been formally consolidated. However since the issues are fundamentally the same, and the evidence and submissions near identical, it seems to me that these oppositions ought to have been consolidated. With that in mind I intend

to issue a single decision covering both oppositions, although the parties will have an opportunity to appeal the oppositions individually if desired.

Applicant's Evidence

6. Janice Treble, a trade mark attorney and partner with Saunders and Dolleymore has filed a witness statement dated 10 October 2006. Exhibit JMT1 is a printout from www.wellmaninc.com, Wellman's website. It comprises a brief history of the company and shows that in November 1989 Wellman acquired Fiber Industries Inc, a company that owns the trade mark FORTREL.

7. Exhibit JMT2 is a print out showing registration details of the FORTREL trade marks. These registrations have been merged into UK registration No. 803683, which is registered with effect from 25 March 1960 and the goods covered include 'Raw or partly prepared artificial fibrous textile materials, not being threads or yarns' in class 22. This, Ms Treble states, means that Wellman are the beneficial owners of the mark FORTREL for the goods in Class 22.

Applicant's written submissions in lieu of attending a hearing

8. The submissions were written by Janice Treble. The first part of the submissions expands upon what has been filed in evidence. In summary Wellman calls into question whether Invista's registration is an earlier right under Section 6 of the Act, in view of the fact that the earlier FORTREL trade mark stands in the ownership of a company which is wholly owned by Wellman.

9. The remainder of the submissions relate to why Ms Treble considers that the opposition should fail, taking into account the relevant case law from the ECJ and also because of the earlier FORTREL trade mark. Ms Treble's penultimate paragraph is:

"On this basis whilst the marks are superficially similar, in view of the earlier FORTREL marks, and the fact that the average consumer of these products is likely to be versed in the marks used in the market, and the source of various fibres and textiles purchased, there is no likelihood of confusion or association and so the opposition must fail."

DECISION

10. The single ground of objection is under Section 5(2)(b).

The Law – Section 5(2)(b)

Section 5(2)(b) reads:

“(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.”

11. Section 6(1)(a) defines an earlier trade mark as follows:-

“6. - (1) In this Act an “earlier trade mark” means –
(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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.”

12. Invista’s trade mark has a filing date of 12 June 1998 and is therefore an earlier trade mark. The presumption of its validity stems from article 4 of the Community Trade Mark Regulations 2006 [S.I. 2006/1027].

13. I should say at the outset that even if I accept that Wellman has proprietary rights in the FORTREL registration, I do not consider that there is merit in Ms Treble’s submission that it acts in such a way as to neutralise any legal right to prevent the registration of the mark applied for that would otherwise arise on the basis of Invista’s earlier Community trade mark. That submission/evidence will therefore have no bearing upon my decision.

14. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods that cumulatively lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

Comparison of Goods

15. The respective sets of goods are as follows taking Invista’s Class 22 goods only, this being the most relevant Class.

Wellman’s goods	Invista’s goods
Synthetic textile filament fiber, raw fibrous textile materials	Raw fibrous textile materials , padding and stuffing materials; ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials ; all goods in the class.
Synthetic textile staple fiber; raw fibrous textile materials.	

16. The goods that have been highlighted in Wellman's list and Invista's list are plainly identical. Further, I consider that the remaining goods in Wellman's list are closely similar to the goods covered by Invista's mark. I do not think there can be any doubt that raw and synthetic textile fibres are similar goods.

Comparison of Marks – COMFORTREL v COMFOREL

17. The authorities require a comparison of the respective marks to be made from a conceptual, visual and aural standpoint.

Conceptual consideration

18. Neither COMFORTREL nor COMFOREL are ordinary words of the language. No evidence has been provided to suggest that either word has any specific technical meaning in relation to the respective goods. It follows therefore that I regard the competing marks to be invented words with no conceptual meaning or allusive reference to the respective goods.

Visual consideration

19. Visually the marks are of roughly equal length being composed of ten and eight letters respectively. The marks have the first six letters in common and the last three letters. The additional letters TR present in Wellman's trade mark appear as letters seven and eight. The visual similarities suggest a high, but not the highest, degree of visual similarity between the marks.

20. It is generally to be expected that consumers will find it easier to differentiate where ordinary words of the language are concerned. Conversely, where consumers are unable to ascribe any meanings to the words, as will usually be the case with invented words, small differences may be insufficient to differentiate.

Aural consideration

21. Phonetically both marks consist of three syllables. There may be some doubt as to where the syllable breaks will occur. For example, a consumer may pronounce Wellman's mark as COM- FOR- TREL, whereas Invista's mark may be pronounced COM – FO-REL, but both contain three syllables. I therefore consider a reasonable degree of phonetic similarity exists.

Distinctive character of the earlier mark

22. Invista has made no claim to enhanced distinctive character through use of its mark. The matter rests with the inherent qualities of the earlier trade mark. It is generally held that words which have no allusive references to the goods are higher up the scale of distinctiveness. That is particularly so with invented words and is the case here.

The average consumer

23. I have not been provided with any formal evidence as to who is the average consumer of the respective goods; although I note that in Ms Treble's written submissions she states that the average consumers are manufacturers of textiles and textile goods. Examples of what is covered by the term 'raw fibrous textile materials' are provided in the Guide to the Nice agreement [Second Edition]. They include camel hair, ramie fibre, raw cotton and combed wool. It states that the fibres are then made into yarns and threads. Bearing this in mind I consider that the average consumer will in the main be third party manufacturers, that is to say I think it is unlikely that the average consumer will be an ordinary member of the public. I have not been given any evidence as to whether the average consumer would make regular or occasional purchases, so I bear in mind both possibilities in reaching a decision.

Comparison of marks COMFORTREL PLUS v COMFOREL

24. This requires a comparison between a two word mark and a single word mark. The additional word PLUS is a well known word which, when encountered as part of a trade mark, is generally regarded as indicating to the consumer that the goods offer something extra; it rarely has individual distinctive character. I am mindful of the fact that the respective marks must be compared as wholes, but equally mindful of the fact that the average consumer's recollection of them is likely to focus on their dominant and distinctive components.

25. In this case I consider the dominant and distinctive component of the COMFORTREL PLUS mark to be COMFORTREL.

Goodwill and reputation

26. Wellman's counterstatement includes a claim that the marks COMFORTREL/ COMFORTREL PLUS are extensions of Wellman's FORTREL mark in which it has a goodwill and reputation. That being the case it may be wondered whether COMFORTREL would be taken by the average consumer as a derivative of that brand, rather than confused with COMFOREL. However, there appears to be little merit in that point given that COMFORTREL/ COMFORTREL PLUS are more similar to the COMFOREL mark than they are to FORTREL. Further, no evidence was filed to substantiate the claim that FORTREL has an established reputation in the market.

Likelihood of Confusion

27. In addition to the factors considered above I particularly bear in mind that in the global appreciation of the matter imperfect recollection must be allowed for. The risk of imperfect recollection is greater in the case of invented words because the consumer has no clear point of conceptual differentiation. In this respect the European Courts have held that for conceptual considerations to counteract visual and aural similarity at least one of the marks must have a clear and specific meaning so that the public is capable of grasping it immediately (see *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01 and *Ruiz-Picasso and others v OHIM*, Case C-361/04 P)

28. Despite the fact that the average consumer of the goods is liable to be an informed purchaser and may make frequent purchases of the goods, taking all of the above in to account, I consider that there is a likelihood of confusion and the oppositions thus succeed under Section 5(2)(b) of the Act.

Costs

29. The opponent is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1000 in respect of the costs of both actions. This sum takes into account the fact that two sets of statutory fees were payable, but that thereafter the grounds and evidence were in substance identical. 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 15th day of November 2007

**Lynda Adams
For the Registrar
The Comptroller - General**