

## TRADE MARKS ACT, 1963

### Decision in Hearing under Section 26

IN THE MATTER OF applications for the registration of Trade Marks Nos. 164895, 164896, 164898 and 164899 and in the matter of oppositions thereto.

ORO-PRODUKTE-MARKETING GmbH

Applicant

ELIDA LEVER IRELAND LIMITED

Opponent

### The applications

1. On 26 May, 1994, ORO-PRODUKTE-MARKETING GmbH, a Gesellschaft mit beschränkter Haftung organised and existing under the laws of the Federal Republic of Germany (as it then was), of Dieselstrasse 10, D-32120 Hiddenhausen, Federal Republic of Germany, Manufacturers and Merchants, made four applications for the registration of Trade Marks in Part A of the Register, the details of which were as follows:

Applic. No.	Advertised as No.	Mark	Class	Goods
94/3185	164895	ORO (stylised)	3	Household cleaning materials in solid, fluid, powder and paste forms, excluding the foregoing for the cleaning of precious metals; scouring salts, preparations for body care and beauty care; soaps, perfumery, hair lotions, shampoos, dentifrices, teeth polishing preparations, deodorants for personal use, all included in Class 3
94/3186	164896	ORO (stylised)	5	Air freshening preparations in fluid, sprayable and solid form
94/3188	164898	ORO FRISCH AKTIV (stylised) and device	3	Cleaning preparations and care preparations for surfaces of wood, plastics, glass, lacquer, metal as well as for textile and ceramic surfaces; floor cleaning preparations and floor care preparations, preparations for the care of

				furniture, WC cleaning preparations, washing and bleaching preparations, rinsing agents, all purpose cleaning agents, household cleaning preparations, cleansing, scouring and polishing preparations, soap, all included in Class 3
94/3189	164899	ORO FRISCH AKTIV (stylised) and device	21	Hand operated cleaning apparatus, cleansing and polishing utensils, polishing wheels, brooms, brushes, sponges, cleansing, polishing and cleaning cloths

(The marks themselves are reproduced in the attached Appendix I.)

2. The Applications were advertised as accepted for registration in Part A of the Register in Journal No. 1773 on 15 November, 1995. Notices of Opposition to the registration of the marks pursuant to Section 26 of the Act were filed on 15 April, 1996 by ELIDA LEVER IRELAND LIMITED, an Irish company, of P.O. Box 231, Harcourt Centre, 33/39 Harcourt Road, Dublin 2, Ireland. The Applicant filed counter-statements on 18 December, 1996 and the Opponent filed evidence under Rule 37 on 7 July, 1998. The Applicant did not file any evidence under Rule 38 and, following some correspondence with the Office, both parties indicated that they did not wish to attend an oral hearing in the matter and desired the Controller to determine the opposition on the basis of the documentation submitted.
3. Acting for the Controller, I decided the opposition on 29 July, 2003. The parties were notified on 13 August, 2003 that I had decided to dismiss the opposition and to allow the applications to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

#### **Notice of Opposition**

4. While there were four Notices of Opposition filed by the Opponent (one in respect of each application), they are all in the same terms and may be summarised as follows:

- The Opponent has for many years manufactured cleaning preparations and material and detergents.
- The Opponent is the registered proprietor of Trade Marks Nos. 56966, OMO and 129435, OMO and device in Class 3 (see attached Appendix II), which marks have been used for many years in connection with the sale of cleaning preparations and detergents, etc.
- Because of the similarity between the marks for which registration is sought and the Opponent's registered marks, there exists a likelihood of confusion and deception between them such that the Applicant's marks are disentitled to registration under Sections 19 and 20 of the Act.
- The Applicant's marks are neither adapted to nor capable of distinguishing their goods and are disentitled to registration under Sections 17 and 18 of the Act.
- The Applicant does not use or propose to use the marks for the purposes of indicating a connection between it and the relevant goods and the applications do not, therefore, accord with the provisions of Sections 2 and 25 of the Act.

### **Counter-Statement**

5. The four Counter-Statements submitted by the Applicant are, likewise, all in the same terms and amount to a flat denial of the statements made by the Opponent in its Notice of Opposition. In particular, the Applicant denies any knowledge of the Opponent's trading history and, while acknowledging the Opponent's proprietorship of the marks cited in the Notices of Opposition, the Applicant denies that its marks so nearly resemble those of the Opponent as to be likely to deceive or cause confusion.

### **The evidence**

#### *Rule 37*

6. Evidence submitted by the Opponent under Rule 37 consisted of a Statutory Declaration (and Exhibits DW1-DW3) dated 25 June, 1998 of Dermot Walsh, Brand Manager of Elida Lever (Ireland) Limited. In his Declaration, Mr. Walsh refers to his company's OMO and OMO & device trade marks, which are cited in the Notices of Opposition and registered in Ireland under No. 56966 dated 25

August, 1954 and No. 129435 dated 29 June, 1988. Mr. Walsh states that his company and its parent company, Unilever Plc, and related subsidiaries have applied for or obtained registrations of these marks in countries throughout the world and he exhibits a list of the relevant countries together with sample registration certificates from a number of them. He states that the trade mark OMO has been used in Ireland continuously since 1955 in relation to detergents and he exhibits a sample product packaging bearing the mark. Sales of over IR£2 million of OMO products have been achieved since the date of first use of the mark and sales figures for the years 1991-1995 are given, totalling approximately IR£1.25 million. By virtue of the extensive sales of OMO products, Mr. Walsh contends that the mark has acquired a significant reputation in Ireland. He then expresses his company's concern at the adoption by the Applicant of the ORO marks, which he regards as deceptively similar to his company's marks and which he thinks are likely to lead to confusion between the respective products. He alleges that the Applicant has adopted the ORO marks in order to cash in on his company's reputation in its marks. He refers to the visual and phonetic similarities between the marks and claims that the fact that the Applicant's mark is written in stylised script leads to the visual perception that it is the mark OMO rather than ORO. Mr. Walsh also states that his company and its parent and related subsidiaries have opposed applications for registration of the Applicant's mark in Finland, Germany and Sweden, in which latter jurisdiction the opposition was successful and Mr. Walsh exhibits a copy of the relevant judgement together with a translation.

### **The issues**

7. While the Opponent has cited several sections of the Act as grounds for its opposition, it is really only Sections 19 and 20 that are relevant in this case as the question at issue is solely that of the similarity between the marks applied for and those owned by the Opponent. No evidence or reasoned argument has been put forward in support of any of the other grounds of opposition. For example, the challenge to the applications under Sections 17 and 18 of the Act has not been substantiated in any way. As an invented word, ORO is *prima facie* registrable under Section 17(1)(c) and Section 18(1). In the absence of any evidence or argument calling this into question, I have no hesitation in dismissing the

opposition under those sections. Similarly, the allegation that the Applicant does not use or intend to use its marks so as to indicate a connection in trade between it and the goods of the applications has not been backed up by any evidence and, accordingly, I dismiss the opposition under Sections 2 and 25 of the Act. As to the Opponent's claim that the Applicant is seeking to gain benefit from the reputation and goodwill of its marks, again no evidence to support this allegation has been submitted. In the circumstances, I have confined my consideration of the matter to the grounds of opposition based on Sections 19 and 20 of the Act.

### **The law**

8. The relevant parts of Sections 19 and 20 read as follows:

“19. – It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, .....

“20.- (1) ..... no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.”

### **Decision**

9. The determination of an opposition to the registration of a mark based on an opponent's earlier mark requires a consideration both of the respective marks of the parties and of the goods to which those marks are applied. In the present case, the Opponent has registrations of its OMO marks in respect of all goods in Class 3 (No. 56966) and for a number of specific goods in that Class, including detergents, laundry preparations, bleaching and fabric conditioning preparations, cleaning, polishing and scouring preparations (No. 129435). It has produced evidence of use of its mark in relation to laundry powder for use in washing machines. Comparing these goods with those of the present applications, I am satisfied that they may be regarded as the same description of goods, certainly in

the case of Applications Nos. 164895 and 164898 and, somewhat more tenuously, in the case of the other two applications, particularly No. 164899. All of the goods in question are offered for sale through the same retail outlets and in the same parts of those stores; they are used together and stored together in the home – the “under the kitchen sink” products; in addition, they are goods of the same general nature. The test for comparing goods as set down in *Jellinek* (1946) [63 RPC 69] requires a comparison of (i) the nature and composition of the goods, (ii) the uses of the goods, and (iii) the trade channels through which the goods are sold. Applying that test, I am satisfied that the oppositions are well-founded insofar as the similarity of the respective goods is concerned.

10. In considering the respective marks themselves, I have had regard to the test for comparing marks as set out *Pianotist* (1906)[23 RPC 774], in which Parker J. stated,

“You must take the two words. You must judge them, both by their look and by their sound. You must consider the nature and kind of customer who would be likely to buy the goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion – that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but there will be a confusion in the minds of the public which will lead to confusion in the goods – then you may refuse registration, or rather you must refuse registration in that case”.

11. Applying that test and considering the marks from a visual, phonetic and connotative aspect, I find that there are sufficient differences between them to obviate the likelihood of confusion or deception. Visually, the Opponent’s marks differ significantly from the word ORO presented in ordinary typeface. The stylisation applied to the letters results in the word that they form not being immediately perceptible and the viewer must take a moment to correctly comprehend the word in question. The visual comparison is not between the

words OMO and ORO but between the actual marks of the parties as shown in the appendices and, on that comparison, clear differences between them emerge. The Opponent's device mark contains a "swoosh" or "comet tail" device emerging from the first O together with a semi-circle device joining the M and the second O. The Applicant's device mark consists essentially of the presentation of the words "oro frisch aktiv" in stylised lettering on a three dimensional parallelogram or "block" device. The words "frisch aktiv", while centrally placed in the mark, are likely to be taken as conveying "active freshness" or some such concept, which is relatively commonplace in the description of the relevant products and I do not think that these elements necessarily dominate the "oro" element of the mark, which is its primary distinguishing feature. Nevertheless, the respective device marks are visually quite dissimilar and I do not think it likely that they would be mixed up, one with the other. As to the word marks, the Applicant's ORO (stylised) and the Opponent's OMO, again these are sufficiently visually dissimilar, in my opinion. Apart from the fact that the middle letter of each word is different, the stylised presentation of the Applicant's mark makes it look quite different from that of the Opponent. I see no reason to believe that a person looking at a product marked with the Applicant's ORO(stylised) would read the mark as "OMO" and so be misled.

12. As to the phonetic similarity of the marks, while I accept that this is apparent, I do not regard it as determinative of the matter. Certainly, the words ORO and OMO sound alike and it is possible that one might be misheard as the other. For that to happen, however, I think it is necessary for some instance of mispronunciation or other miscommunication to occur. The words ORO and OMO, properly pronounced, sound differently and I do not think it reasonable to assume that the average consumer will be unable or unlikely to perceive the audible difference between them.

13. I have also considered the connotative or conceptual significance of the respective marks and the extent to which any similarity or otherwise in this regard may affect the likelihood of confusion between them. It appears to me that the marks of both the Applicant and the Opponent are formed from words that have no meaning and do not convey any concept to the average consumer. This is not unusual in the

context of the relevant goods and one can think of a number of marks in this field which either have no meaning or one that is so remote to the average consumer as to be negligible – “CIF”, “DAZ”, “PERSIL”, “ARIEL”, etc. Given this, I think it can be concluded that the only factor that is common to the respective marks from a connotative aspect is that neither has any meaning; that cannot properly be regarded as a similarity, in my opinion, and it does not support the argument that there is a likelihood of confusion between the marks.

14. In summary, I have concluded that the aural resemblance between the respective marks in this case is not such as to outweigh the clear visual differences between them. There is no general prohibition on the registration of marks that sound like other registered marks; it is only where the use or registration of such a similar sounding mark would be likely to lead to confusion in the minds of the relevant public that registration is prohibited. Having given the matter careful consideration, I am of the opinion that the use by the Applicant of its marks on the relevant goods will not lead to confusion and will not damage the reputation and goodwill that the Opponent has established under its marks. While I accept that the question is not free from doubt, I have not been persuaded that the average consumer, whom I regard as being reasonably circumspect and used to selecting from differently branded products, will be confused by the use of the Applicant’s marks or will associate those marks in any way with the Opponent. For these reasons, I have decided to dismiss the oppositions.

Tim Cleary  
Acting for the Controller

September, 2003



The Applicant's Marks

Nos. 164895 and 164896



No. 164898 and 164899



**The Opponent's Marks**

No. 56966

**OMO**

No. 129435

