

TRADE MARKS ACT, 1963

Decision in Hearing under Section 26

IN THE MATTER OF an application for the registration of Trade Mark No. 171850 and in the matter of an opposition thereto.

THE SUNRIDER CORPORATION

Applicant

UNILEVER PLC

Opponent

The application

1. On 6 April, 1995, The Sunrider Corporation, a corporation organised and existing under the laws of the State of Utah, United States of America of 1625 Abalone Avenue, Torrance, California 90501, United States of America, Manufacturers and Merchants (trading as Sunrider International) made an application (No. 95/2447) to register the following mark

The logo for 'SunSmile' features the word 'SunSmile' in a stylized, serif font. The 'S' is large and prominent. The 'm' and 'i' are connected, and the 'l' is tall. The 'e' is also large. The letters are filled with a dark, textured pattern that resembles a forest or a dense thicket of trees, with some lighter areas suggesting sunlight filtering through. The overall effect is a dark, textured, and somewhat abstract representation of the words.

as a Trade Mark in Part A of the Register in Class 3 in respect of a specification of goods that was amended in the course of the examination of the application to read as follows:

Preparations included in Class 3 for the care of the skin, face and body; articles included in Class 3 for personal and beauty care; perfumes; soaps; bubble bath; bath and shower gel; moisturizing and cleansing creams, lotions, gels, scrubs, oils, splashes and balms for use on the body, eyes, hands and face; body and face powder, make-up brush sets, make-up sponges, rouge, eyebrow pencils, eyeliner, eyeshadow, lash enhancer

mascara, lipstick, lip liner, facial cleansing and moisturizing masks; articles included in Class 3 for the care and beauty of the hair; shampoo, conditioner, tonic, creme rinse, styling glaze, styling spray, styling mousse and styling gel; shaving cream, shaving foam and shaving gel; after shave lotion; skin cleansing cream and foam; nail enamel; nail lacquer; sunscreens; body shampoo; cellulite creams, cellulite gels and cellulite lotions; contour creams, contour gels and contour lotions; anti-perspirants and deodorants for personal use; articles included in Class 3 for dental use, toothpastes, mouth washes, whitening gels, lip balms; household cleaning preparations included in Class 3; dishwasher detergents; cleaning detergents for clothes; detergents for use in washing dishes and detergents for use in washing produce, all being goods included in Class 3.

2. The application was accepted for registration in Part A of the Register and advertised accordingly under No. 171850 in Journal No. 1798 on 30 October, 1996.
3. Notice of Opposition to the registration of the mark pursuant to Section 26 of the Act was filed on 1 April, 1997 by Unilever PLC, a British Public Limited Company of Port Sunlight, Wirral, Merseyside, United Kingdom, Manufacturers and Merchants. The Applicant filed a Counter-Statement on 15 July, 1997 and evidence was, in due course, filed by the parties under Rules 37, 38 and 39 of the Trade Marks Rules, 1963.
4. The Opposition became the subject of a Hearing before me, acting for the Controller, on 20 May, 2004. The parties were notified on 17 November, 2004 that I had decided to dismiss the opposition and to allow the application to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat.

Notice of Opposition

5. In its Notice of Opposition the Opponent itemises a number of facts and grounds of opposition, which may be summarised as follows:

- (i) The Opponent and its subsidiaries have for many years carried on business as manufacturers and merchants of, *inter alia*, soaps, perfumery, eau de cologne, essential oils, cosmetics, detergents, cleaning, polishing, scouring and abrasive preparations and rinse aids.
- (ii) The Opponent and its Irish subsidiary Elida Lever Ireland Ltd. are the proprietors of a “family” of marks (see Appendix A) having the prefix SUN, which are used in connection with detergent products and soaps.
- (iii) The Opponent and Elida Lever Ireland Ltd. have for many years extensively used their “SUN” prefix trade marks in connection with detergent products and soaps and those marks denote both to the trade and to the public goods manufactured by them and distinguish such goods from the like goods of other traders.
- (iv) The proposed use of the trade mark that the Applicant has applied to register is calculated to deceive and cause confusion and the mark is otherwise disentitled to protection in a court of law and registration would, therefore, be contrary to the provisions of Section 19 of the Act.
- (v) The trade mark so nearly resembles the marks listed in Appendix A as to be calculated to deceive and cause confusion and registration would, therefore, be contrary to the provisions of Section 20 of the Act.
- (vi) The trade mark is calculated to deceive and to lead to the Applicant’s goods being passed off as those of the Opponent.
- (vii) The trade mark is neither adapted to distinguish nor capable of distinguishing the Applicant’s goods from those of other traders and does not qualify for registration under either Section 17 or Section 18 of the Act.
- (viii) The Applicant does not use or intend to use the trade mark for the purpose of indicating a connection in the course of trade between it and the goods of the application and registration would, therefore, be contrary to the provisions of Sections 2 and 25 of the Act.
- (ix) Registration of the mark would be contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to Trade Marks.
- (x) Registration of the mark ought to be refused in exercise of the discretion of the Controller.

Counter-Statement

6. In its Counter-Statement the Applicant denies all of the grounds of opposition raised against its application and admits only that the Opponent and Elida Lever Ireland Ltd. are the registered proprietors of the trade marks listed in Appendix A, although it says that it does not admit the validity of any of those registrations. The Applicant refers in particular to the fact that the SUN-prefixed trade marks referred to in the Notice of Opposition already co-exist on the Register in the names of two separate legal entities, namely the Opponent and Elida Lever Ireland Ltd. and asserts that this undermines the Opponent's opposition to its application under Section 20 of the Act.

The evidence

Rule 37

7. Evidence submitted by the Opponent under Rule 37 consisted of a Statutory Declaration (and Exhibits U1-U3) dated 16 January, 1998 of Katrina Burchell, Senior Trade Marks Manager of Unilever PLC., who states that she is authorised to make the Declaration on behalf of the Opponent and its subsidiaries which she refers to collectively as "Unilever". In addition to expressing opinions on the merits of the opposition, Ms. Burchell makes a number of statements of fact, which I would summarise as follows:

- (i) Unilever has used the prefix SUN for a family of marks in relation to soap and detergent products for a long number of years.
- (ii) Unilever has secured registration of the trade mark SUNLIGHT in various countries throughout the world (a list is exhibited) including in Ireland (Registration No. 31692 dated 2 February, 1884 cited).
- (iii) Circa 1970 Unilever commenced use of the trade mark SUN in Ireland in relation to dishwasher products, which include machine dishwasher detergent, salt, rinse, cleaner and deodoriser. A product information leaflet and sample packaging is exhibited.
- (iv) The estimated turnover of goods sold under the trade mark SUN in Ireland is £15 million and the estimated amount spent on advertising or otherwise making the mark SUN known in Ireland is £900,000. Print advertising is

not used; advertising takes the form of television commercials on R.T.E. and U.T.V. (Segregated annual figures are given for the years 1991-1996 in respect of turnover and advertising.)

Rule 38

8. Evidence submitted by the Applicant under Rule 38 consisted of a Declaration (and Exhibits SC1-SC4) executed on 1 October, 1998 by Oi-Lin Chen, President of the Sunrider Corporation. Ms. Chen refers to the Opponent's evidence under Rule 37, which she challenges and criticises on a number of fronts. I would summarise the main points that emerge from her evidence as follows:

- (i) The Applicant has secured registration of the trade mark SUNSMILE in block letter form in respect of cleaning preparations and detergents in Australia, Colombia, Spain and the United States, in which territories the Opponent's mark SUN is, according to the Opponent's own evidence, also registered. Particulars of the Applicant's registrations in the relevant countries are exhibited.
- (ii) The prefix SUN is a common feature of numerous trade marks owned by the Applicant and derives from the initial word of the Applicant's name. A list of SUN-prefixed marks registered in Ireland in the name of the Applicant is exhibited.
- (iii) The Sun-prefixed trade marks cited in the Notice of Opposition are not all held in common ownership with a number being registered in the name of Elida Lever Ireland Ltd., which is a separate legal entity from the Opponent.
- (iv) There are numerous registrations of Sun-prefixed trade marks in respect of goods in Class 3 which are owned by entities other than the Opponent. A list is exhibited.
- (v) The Applicant cannot adduce evidence of pre-application use of the trade mark which it seeks to have registered but the mark is currently in use in Ireland in relation to herbal toothpaste, all-purpose household cleaners and a rinse for fruit and vegetables. Samples of labels and packaging and a copy of a promotional/information brochure are exhibited. The products

are sold direct to the consumer (*it is not specified how*) rather than through retail outlets.

Rule 39

9. Evidence submitted by the Opponent under Rule 39 consisted of a Declaration (and Exhibit U4) dated 14 April, 1999 of Nicola Hope, Trade Mark Manager of Unilever PLC, who rebuts a number of the assertions made by Ms. Chen for the Applicant and confirms the figures given earlier by the Opponent in respect of turnover and advertising in Ireland under the trade mark SUN. She also exhibits a video cassette of television advertisements shown during the period 1991-1996 in respect of the Opponent's SUN dishwasher products.

The hearing

10. At the Hearing the Opponent was represented by Mr. Brian O'Moore, SC instructed by F.R. Kelly & Co., Trade Mark Agents and the Applicant by Mr. Paul Coughlan, BL instructed by MacLachlan & Donaldson, Trade Mark Agents.

Preliminary matter

11. At the hearing, Mr. Coughlan raised an objection against the Opponent's reliance on prior use of its SUN trade mark as one of the bases of its opposition to the present application in circumstances where it was not established clearly in the Opponent's evidence that the use in question had been use by the Opponent rather than use by its subsidiary. The objection is somewhat complicated in nature and there was considerable confusion at the hearing as to the precise grounds on which it was being advanced and, consequently, as to how it might be rebutted. Nevertheless, I am satisfied that the basis for an objection was made out and that I must consider it as a preliminary matter before going on to decide the merits of the opposition.
12. As I understand it, the Applicant's objection can be expressed as follows: The Opponent in these proceedings is Unilever PLC. The central basis of its opposition under Section 19 of the Act is that it has used a trade mark (SUN) in relation to dishwasher detergents, salts, etc. and the public have come to know that mark by virtue of the use made of it such that, if the Applicant were to use the

trade mark for which it seeks registration in relation to those same products, it will cause confusion among the public who will be caused to wonder whether the products in question are not those of the Opponent. However, the Opponent's evidence is to the effect that the use that has been made of its SUN trade mark was use by "Unilever", meaning the Opponent *and its subsidiaries* (Katrina Burchell Declaration under Rule 37). The Irish subsidiary is Elida Lever Ireland Ltd. and it seems likely that it was that entity which actually used the trade mark SUN in Ireland (it is certainly not definitely established that the Opponent itself used the mark here). Because Elida Lever Ireland Ltd. is not a Registered User of the Opponent's trade mark SUN, any use of the mark made by that entity is not "permitted use" within the meaning of Section 36(1)(b) of the Act and, by virtue of Section 36(2), the Opponent cannot rely on it for the purposes of the present opposition. I also understood Mr. Coughlan to object to the Opponent's reliance, for its opposition under Section 20, on a number of earlier registrations that stand in the name of its subsidiary, Elida Lever Ireland Ltd., given that the latter is not a party to these opposition proceedings.

13. In response to these objections, Mr. O'Moore asserted that Section 36 of the Act was not relevant as the registrations cited by the Opponent as the basis for its opposition were not the subject of Registered User agreements and so the question of whether there had been "permitted use" of the marks within the meaning of that Section did not arise. Neither did he accept that the Opponent could not legitimately mount an opposition based on the existence of registrations that stood in the name of its subsidiary, given the commercial relationship that subsists between a parent and subsidiary and the obvious stake that the former has in the protection of the latter's interests, etc.

14. Section 36 of the Act, which makes provision for Registered Users of registered trade marks, reads as follows:

"(1) (a) Subject to this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (other than as a defensive trade mark) and either with or without conditions or restrictions, provided that there

subsists a prescribed relationship between the proprietor and the proposed registered user.

(b) The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the permitted use thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor for the purposes of section 34 of this Act and for any other purposes for which such use is material under this Act or at common law.”

15. In my opinion, the Applicant’s objection based on the provisions of Section 36 is misconceived. Section 19 of the Act may be invoked by an Opponent on the basis of prior use of a mark, whether or not that mark is a registered trade mark. Section 36 applies only in respect of registered trade marks and its effects must be understood accordingly. I cannot accept the Applicant’s contention that, because the Opponent’s SUN mark happens to be a registered trade mark and because it appears that the mark may have been used by the Opponent’s subsidiary, which is not a Registered User of that registered trade mark, then I should ignore the fact (if such is proven) that there has been use of the mark when considering the opposition under Section 19. In my opinion, that would constitute a complete distortion of the purpose and effect of Section 19. It has been observed that Section 19 serves a purpose that is in the public interest insofar as it prohibits the registration of marks the use of which would be likely to lead to confusion among the public. I would be loath to see the effects of the Section set aside owing to a form of technical objection that would make no practical difference to the public awareness that exists in respect of an earlier mark by virtue of the actual use that has been made of it.

16. In any event, I do not agree with the suggestion that appears to be made on behalf of the Applicant to the effect that Section 36(2) is to be interpreted as providing

that use of a trade mark other than “permitted use” by a Registered User is not to be regarded as use of the mark for any purposes under the Act or at common law. The primary purpose and effect of Section 36(2) is to provide that the use of a registered trade mark by a Registered User thereof is to have the same statutory and legal effect as the use of the mark by the proprietor. So, for example, a proprietor of a registered trade mark who can show that the mark has been used by a Registered User thereof within the relevant period can successfully defeat an application for revocation of the registration on the grounds of non-use, even though he may not have used the mark himself. But the Section makes no provision with regard to use other than “permitted use” and I do not accept that it has any application in the context of Section 19 of the Act. The first question to be addressed when considering an objection under that Section is whether there has been use of the earlier mark cited by the Opponent. That is a question of fact that must be decided by reference to the evidence filed and that factual enquiry is not affected by the provisions of Section 36.

17. As to the question of whether the Opponent is entitled to oppose the present application under Section 20 of the Act on the basis of a number of prior registrations, some of which are owned by its subsidiary, I am also satisfied that that is perfectly in order. Section 26 provides that, following the advertisement of the acceptance of a mark for registration, any person may, within the prescribed time, give notice of opposition to the registration provided that the notice is given in writing and includes a statement of the grounds of opposition. The Opponent has complied with the relevant statutory provisions and there is no additional statutory requirement whereby an Opponent must be the owner of an earlier registration that it may cite in support of an opposition under Section 20. The present scenario, whereby a company opposes to protect its own rights in registered trade marks and its subsidiary’s rights in other, similar registrations is not, in my opinion, excluded by the Act.

18. For the foregoing reasons, I have decided that the Opponent’s assertions in respect of prior usage of the trade mark SUN and its reliance on registrations that it does not itself own are not, *prima facie*, invalid and I reject the Applicant’s claims to that effect.

The substantive issues

19. Of the grounds of opposition cited in the Notice of Opposition, a number have not been supported by any evidence. So, for example, the Opponent did not file any evidence in support of its assertion that the Applicant does not use or propose to use the mark for which it seeks registration in order to indicate a connection between it and the goods of the application. The opposition under Sections 2 and 25 of the Act is therefore not supported and I dismiss it accordingly. Nor is there any evidence that the Applicant's mark is not adapted to distinguish or capable of distinguishing its goods from those of other traders and so the objections under Sections 17 and 18 of the Act have also not been proven. As to the claim that registration of the mark would be contrary to the provisions of Council Directive 89/104/EEC, the fact is that this application was filed prior to the enactment in the State of legislation giving effect to that Directive and opposition to it on the basis of non-conformity with the Directive is unsupportable.

20. The only remaining objections are those under Sections 19 and 20 of the Act and I have confined my consideration of the matter to those sections.

Section 19 – would the mark be disentitled to protection in a court of law?

21. Section 19 of the Act reads as follows:

“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, or would be contrary to law or morality, or any scandalous design.”

22. The test for an objection under Section 19, as formulated by Evershed J in *Smith Hayden & Co. Ltd.'s Application* [1946] 63 RPC 97 and adapted by Lord Upjohn in *BALI Trade Mark* [1969] 86 RPC 472, is as follows:

“having regard to the user of the [earlier mark], is the Court satisfied that the mark applied for, if used in a normal and fair manner in connection with any

goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons.”

23. As I have already noted, the first thing to be established in the context of an objection to registration under Section 19 is whether there has been use by the Opponent of the mark or marks on which it relies as the basis for the objection. The Opponent's evidence in this regard is that it and its subsidiaries have used the prefix SUN for a “family” of marks in relation to soap and detergent products for a long number of years (paragraph 3 of Katrina Burchell Declaration under Rule 37). No corroborating evidence has been filed in support of that assertion by way, for example, of sales and advertising figures, samples of promotional material, product packaging, statements from persons in the trade, etc. While I do not wish to impugn Ms. Burchell's evidence on the point, I think I cannot accept the Opponent's claim with regard to the use of a “family” of SUN-prefixed trade marks on the basis of the materials before me. The onus lies on the Opponent to substantiate its claim by reference to concrete evidence and Mr. Coughlan for the Applicant quite legitimately called that claim into question at the hearing. The Opponent has not provided the type of evidence that would reasonably be expected of it and, so, the opposition under Section 19 must be rejected as unsubstantiated insofar as it is based on prior use of a “family” of SUN-prefixed trade marks.

24. The Opponent has also asserted that it and its subsidiaries have used the trade mark SUN in Ireland since approximately 1970 in relation to dishwasher products. In support of this claim, the Opponent has furnished estimates of the total turnover in goods sold under the mark (£15 million) and has provided segregated turnover figures for the years 1991-1996. Similarly, it has given an estimate of the total amount spent on advertising (£900,000) and segregated figures for advertising expenditure for the years 1991-1996. It has exhibited a product information brochure and sample product packaging showing how the mark has been used together with a video cassette showing some of the television advertisements that have been run in respect of SUN products. I am satisfied that, in the absence of rebuttal evidence on behalf of the Applicant, the evidence in question is sufficient to establish that there was use of the SUN trade mark in relation to dishwasher

detergents, salts and rinse aids in this jurisdiction prior to the date of filing of the present application for registration and that that use was sufficient for the mark to have come to the notice of a significant number of consumers of the relevant products.

25. The prior use of the trade mark SUN having been established, the question then turns to whether use by the Applicant of the mark put forward for registration would be likely to cause confusion among consumers. That question requires consideration of (i) the look and sound of the respective marks, (ii) the goods to which they are to be applied, (iii) the nature and the kind of customers likely to buy the goods and, (iv) all the other surrounding circumstances of the trade in those goods¹. If, having undertaken that consideration, I am satisfied that the use by the Applicant of its mark would cause confusion, then I am bound to refuse the application for registration.

The marks

26. The Applicant's mark is as shown in paragraph 1 above. The exhibits filed with the Opponent's evidence show that the SUN trade mark has been used in the format as registered under Nos. 166745, 166746 and 166747 (see Appendix A). Notwithstanding this, I think the trade mark that will have become known to the relevant class of consumers by virtue of the sale of SUN dishwasher detergent products is, primarily, the word mark SUN. I say this for two reasons. Firstly, it is generally accepted that words in trade marks "speak" to consumers and are apt to outweigh the impact created by accompanying figurative elements, particularly where, as in the present case, the word of which the trade mark consists gives the product its name (as opposed, say, to marks consisting of slogans). Secondly, the figurative elements that have been used in conjunction with the word SUN consist mainly of representations of goods on which the relevant products are intended for use (a glass, a cup and saucer) and I believe that the use of those images on SUN product packaging will have been perceived by consumers as indicative mainly of the purpose of the products rather than as serving a trade mark function, i.e., indicating the commercial origin of the products. It is also the case that the

¹ Parker J in *Application of Pianotist Co. Ltd.* [1906] 23 RPC 774

figurative elements concerned appear in proximity to the word SUN on the packaging of the products but are not entwined with or otherwise linked to it. The effect is that the word SUN has the appearance of standing alone and I think it is that word, and not any accompanying figurative elements, that will have impressed itself on the minds of consumers as being the name and identifier of the relevant products. For these reasons, I propose to consider only the word SUN as being the earlier mark that has been used for the purposes of the comparison of the marks and the consideration of the opposition Section 19.

27. The single, obvious similarity between the marks SUN and SUNSMILE (and device) is the inclusion in both of the word SUN. I regard the fact that the entire of the Opponent's mark is contained within the Applicant's mark as adding to the significance of this point of similarity and I have taken due note of that fact in comparing the marks. Having said that, I think it is undeniable that there are very significant and immediately apparent visual, aural and conceptual differences between the two marks. The marks do not look or sound alike and they have entirely different meanings. The Opponent made much of the fact that the second "s" in the Applicant's mark is capitalised, giving the clear impression of the separate words "Sun" and "Smile" notwithstanding that the mark is presented as the single word "SunSmile". While I agree that the Applicant's mark will be perceived as no more than a combination of the words "Sun" and "Smile", I think that makes no difference to the question of whether that mark is similar to the Opponent's trade mark SUN. The terms "SunSmile" and "Sun Smile" are equally meaningless and are equally distinguishable, from a conceptual point of view, from the ordinary dictionary word "Sun". Even if the differences between the respective marks arising from their different figurative elements are disregarded, I would conclude, therefore, that there is only a very low level of similarity between these marks.

The goods

28. The Opponent's evidence is to the effect that the trade mark SUN has been used in relation to dishwasher products, namely detergent, salt, rinse, cleaner and deodoriser. The goods covered by the application are listed at paragraph 1 above and they include dishwasher detergent. It makes sense to first of all consider the

likelihood of confusion in the context of those goods. If that is established, then I can proceed to consider the other goods covered by the application; if, on the other hand, I find that there would be no appreciable likelihood of confusion if the Applicant's mark were used in relation to dishwasher detergents, then I could not hold that there would be any such likelihood if it were used in relation to the other goods of the application.

The customers and the circumstances of trade in the goods

29. The customers for these goods are all persons who own dishwashers. Given the increased affluence in Irish society over recent years, the number of such persons would constitute a substantial percentage of consumers generally. The goods are most often purchased in supermarkets where they are selected by the consumer who can usually choose between a number of different brands that are displayed together. These goods are domestic consumables; they are everyday items and would be among the items frequently included in the regular weekly or fortnightly shopping of the relevant consumers. For that reason, I think that the average consumer would not pay particular care or attention to the purchase of these goods but would, through habit, become used to selecting a particular brand and would be likely to know and remember the name of the brand he usually chooses.

Likelihood of confusion

30. In the present case, the question of likelihood of confusion may be expressed as follows: *having regard to the use of the trade mark SUN in relation to dishwasher detergents and related goods, would the use of the mark SUNSMILE (and device) on dishwasher detergents be likely to cause confusion among a substantial number of consumers?* In view of what I regard as the relatively low level of similarity between the marks, I have concluded that the likelihood of direct confusion, whereby consumers who are familiar with SUN dishwasher detergent select and purchase SUNSMILE detergent in the mistaken belief that it is the product they usually choose, is negligible. I do not think that there are any grounds for holding that the average consumer, being reasonably circumspect and observant, would be likely to make such a mistake.

31. As to the possibility of indirect confusion, whereby consumers assume some connection between the two brands, SUN and SUNSMILE, I do not think that that is really likely either. The two words are fundamentally different and I do not think that the respective impressions which they are likely to make on the minds of consumers are such as to suggest any link between them. In addition, the fact that the Applicant's mark includes a figurative element that is completely unlike any figurative element that has been used in conjunction with the SUN mark leads me to conclude that consumers would be unlikely to assume any connection between the two.

32. For the reasons that I have outlined, I find that the use of the Applicant's mark SUNSMILE (and device) in relation to dishwasher detergents would not be likely to cause deception or confusion, notwithstanding the earlier use of the trade mark SUN in relation to those goods. That finding must apply, *a fortiori*, in respect of the other goods covered by the application for registration. I have decided, therefore, to dismiss the opposition to registration of the mark under Section 19 of the Act.

Section 20 – should the application be refused in light of the earlier registrations?

33. Section 20 of the Act prohibits the registration of marks that are identical with or closely resemble existing registered marks. The relevant part of the Section reads as follows:

“(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.”

34. The registered trade marks on which the Opponent bases its opposition under this Section are listed in Appendix A. Given that the mark which the Applicant seeks to have registered is not identical with any of those marks, the question to be decided for the purposes of Section 20 of the Act is whether it so nearly resembles any of them as to be likely to deceive or cause confusion. Of course, the question

only arises insofar as the application for registration is in respect of goods that are the same goods or the same description of goods as those in respect of which each of the earlier marks is registered. In this regard, I consider that several of the goods included in the present application for registration (make-up sponges, rouge, eyebrow pencils, etc.) are not the same goods nor the same description of goods as those covered by any of the registrations cited by the Opponent. However, it has not been necessary for me to go into detail on this aspect of the matter as I have concluded, for the reasons set out below, that there is not a real likelihood of confusion between the Applicant's mark and any of those covered by the relevant registrations, even if the respective marks are used² on identical goods.

35. In considering the merits of the opposition under Section 20 of the Act, I have looked at each of the earlier registrations cited by the Opponent separately and I have attached no weight to the fact that those registrations may be viewed collectively as constituting a series of marks containing the prefix SUN. For the purposes of Section 20, I do not think it relevant that an Opponent (or, as in this case, an Opponent and its subsidiary) may hold registrations in respect of a series of marks containing a common element. While I am required to assume a notional fair usage of each of the marks that are the subject of the earlier registrations when considering the opposition under this Section, I think it would be wrong to also assume a recognition by consumers of the existence of a series of SUN-prefixed marks which serve to identify the products of the Opponent in circumstances where no such public awareness has been proven. To do so would be to allow the monopolisation by a single undertaking of a particular word as an element of any trade mark for certain goods through the registration of a number of marks containing that word, notwithstanding that it might use only one of the marks so registered. I do not regard that as a proper application of Section 20 and I have not, therefore, taken any account of the existence on the Register of a so-called "family" of SUN-prefixed marks.

² assuming use of each in a normal and fair manner as a trade mark for the respective goods

Registrations Nos. 166745-166747 – SUN (and devices)

36. I have already considered the likelihood of confusion between the Applicant's mark and the primary element of these registered marks, viz., SUN. For the reasons that I have outlined, I have found that there is no appreciable likelihood of confusion and that finding must apply also insofar as the marks covered by these registrations are concerned. If anything, the figurative elements contained in these marks make them even more dissimilar from the Applicant's trade mark and would reduce even further any likelihood of confusion.

Registration No. 174880 - SUNFRESH

37. SUNFRESH and SUNSMILE (and device) are, in my opinion, quite different in terms of their look, sound and meaning. While marks must always be judged and compared in their entirety, I believe that the respective elements FRESH and SMILE create in these marks very different overall impressions. FRESH is a word that has an obvious meaning and significance in the context of cleaning products generally whereas SMILE has no such meaning. On an overall assessment, I consider that the Applicant's mark does not so nearly resemble SUNFRESH as to be likely to deceive or cause confusion.

Registrations Nos. 31692, 31693, 34442, 34444, 66622, 71850 and 120187 – SUNLIGHT and SUNLIGHT (and device)

38. SUNLIGHT is an ordinary dictionary word that is commonly known and understood. While the word SUNSMILE is similar to it in some respects (same prefix, same number of letters, same vowel in second syllable) it is an invented word that has no proper meaning and which would, as a consequence, create an entirely different impression on the mind of the average consumer. Together with the fact that the Applicant's mark contains a device element that is significantly different from those included in Registrations Nos. 66622, 71850 and 120187, I am satisfied that it does not so nearly resemble any of these earlier registered marks as to be likely to deceive or cause confusion.

Registrations Nos. 50024 and 74148 – “SUNSILK” and SUNSILK

39. I regard SUNSILK and SUNSMILE (and device) as being quite different for largely the same reasons that I have already stated at paragraph 37 above in

relation to SUNFRESH. While SILK does not have any obvious meaning in relation to detergent products generally, neither does it have any conceptual similarity to SMILE. The marks look and sound differently and I do not think that there would be a serious likelihood of confusion if both were used in a normal and fair manner as trade marks for the same goods.

Registration No. 56628 - SUNSET

40. As in the case of SUNLIGHT, SUNSET is an ordinary dictionary word. It does not look or sound similar to SUNSMILE (and device) and nor does it convey a similar meaning. The latter mark does not so nearly resemble it as to be likely to deceive or cause confusion.

Registration No. 61843 - SUNIL

41. The differences that I have already alluded to in comparing the other registered trade marks and the Applicant's mark are evident also in the comparison of SUNIL and SUNSMILE (and device). Indeed, the difference is even more pronounced in this case as SUNIL does not, in my opinion, immediately convey the impression of the prefix SUN followed by a separate and distinct suffix IL. In my opinion, there are insufficient grounds for holding that there is even a passing resemblance between SUNIL and SUNSMILE (and device).

Registration No. 80094 - SUNJA

42. The observations that I have made in respect of SUNIL apply equally to SUNJA and I do not need to repeat them.

Registration No. 109566 - SUN

43. I have already considered this mark in the context of the opposition under Section 19 and I have found that the Applicant's SUNSMILE (and device) does not so nearly resemble it as to be likely to deceive or cause confusion.

Registrations Nos. 145463 and 147788 – SUN PROGRESS (and device)

44. These marks are substantially the same as the SUN registrations already considered. The inclusion of the word PROGRESS in them does not in any way

add to the likelihood of confusion between them and the Applicant's SUNSMILE (and device).




45. For the reasons that I have set out, I do not regard the mark that the Applicant seeks to register as so nearly resembling any of the registered marks that the Opponent has cited as to be likely to deceive or cause confusion. For that reason, I find that none of the earlier registrations stands as a bar to the entry on the Register of the Applicant's mark and I have decided to dismiss the opposition under Section 20 of the Act accordingly.



Tim Cleary
acting for the Controller




30 November, 2004

APPENDIX A

Trade Mark Registrations cited in Notice of Opposition

No.	Mark	Class	Goods	Date
166745		3	Detergents, (not being for use in industrial or manufacturing processes or for medical use); preparations and substances, all for laundry use; cleaning, polishing, scouring and abrasive preparations; rinse aids; soaps	17/11/1993
166746		3	ditto	17/11/1993
166747		3	ditto	17/11/1993
174880	SUNFRESH	3	Detergents; preparations and substances, all for laundry use; bleaching preparations and fabric conditioning preparations; soaps; saponaceous products; cleaning, polishing and scouring preparations; abrasive preparations; starch for laundry use.	23/04/1996
31692	SUNLIGHT	3	Common soap and detergents.	02/02/1884
31693	SUNLIGHT	3	Perfumed soap, toilet preparations including glycerine for toilet purposes, and other perfumery	02/02/1884

34442	SUNLIGHT	3	Disinfectant and antiseptic soaps.	19/07/1886
34444	SUNLIGHT	3	Medicated soap.	19/07/1886
50024	“SUNSILK”	3	Preparations and substances for laundry purposes, detergents included in Class 3, soaps, perfumes, toilet preparations (not medicated), cosmetic preparations, shampoos and dentifrices.	21/07/1950
56628	SUNSET	3	Preparations and substances for laundry purposes; detergents included in Class 3, soaps, perfumes, toilet preparations (not medicated), cosmetic preparations, shampoos and dentifrices.	02/04/1954
61843	SUNIL	3	Soaps, detergents, cleaning, polishing, scouring and abrasive preparations.	01/12/1959
66622		3	Soaps.	21/11/1963
71850		3	Soaps; detergents (not for use in industrial or manufacturing processes); substances for laundry use; cleaning, polishing, scouring and abrasive preparations.	03/05/1967
74148	SUNSILK	3	Preparations and substances for laundry purposes;	09/10/1968

			detergents included in Class 3, soaps, perfumes, toilet preparations (not medicated), preparations for the hair (non-medicated), cosmetic preparations and dentifrices.	
80094	SUNJA	3	Soaps, detergents (not for use in industrial or manufacturing processes) perfumes, essential oils, non-medicated toilet preparations, cosmetics, anti-perspirants for personal use, preparations for the hair and dentifrices.	29/03/1972
109556	SUN	3	Detergents (not for use in industrial or manufacturing processes or for medical use); preparations and substances, all for laundry use; bleaching preparations included in Class 3; cleaning, polishing, scouring and abrasive preparations; soaps; wetting agents and rinse aids included in Class 3.	18/04/1983
120187		3	Detergents (not for use in industrial or manufacturing processes or for medical use); preparations and substances, all for laundry purposes; soaps; cleaning, polishing, scouring and abrasive preparations.	18/04/1983
145463		3	Dishwashing preparations included in Class 3.	28/01/1991
147788		3	Detergents (not for use in industrial or manufacturing processes or for medical use); preparations and substances,	14/01/1991

			all for laundry use; bleaching preparations and fabric conditioning preparations, all included in Class 3; cleaning, polishing and scouring preparations; abrasive preparations (not for dental use); soaps.	
--	--	--	--	--