

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 220571 and in the matter of an Opposition thereto.

ARKEMA FRANCE Applicant

DEGUSSA AG Opponent

The application

1. On 2 March, 2001, Atofina (now known as Arkema France), a company organised and existing under the laws of France, of 4-8 Cours Michelet, 92800 Puteax, France made application (No. 2001/0688) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the word PEROXAL as a Trade Mark in Classes 1, 3 and 5 in respect of the following specification of goods:

Class 1: *Chemicals used in industry, hydrogen peroxyde used for oxydation process and aseptic (sic) packaging processes*

Class 3: *Hydrogen peroxyde used for cosmetic purposes*

Class 5: *Hydrogen peroxyde used for medical purposes*

2. The application was accepted for registration and advertised accordingly under No. 220571 in Journal No. 1931 on 12 December, 2001.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 11 March, 2002 by Degussa AG of Benningsenplatz 1, Düsseldorf 40474, Germany. The Applicant filed a counter-statement on 14 June, 2002 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996.

4. The opposition became the subject of a hearing before me, acting for the Controller, on 25 September, 2006. The parties were notified on 17 October, 2006 that I had decided to dismiss the opposition and to allow the mark 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 states that it has carried on business as manufacturer and merchant of chemicals and pharmaceuticals for many years and that it is the proprietor of Community Trade Mark Registrations¹ in respect of the trade marks PEROXYNET and PEROXYBRIGHT in Classes 1, 39 and 42. It then raises objection against the present application under Sections 6, 8, 10 and 37 of the Act, claiming that -

- the mark applied for is not capable of distinguishing the Applicant's goods (*Section 6*),
- the mark is devoid of any distinctive character and consists exclusively of a sign or indication which may serve to designate characteristics of the goods (*Section 8(1)*),
- the use of the mark is prohibited by law (*Section 8(4)(a)*),
- the application for registration is made in bad faith by the Applicant (*Section 8(4)(b)*),
- the mark applied for is identical with the Opponent's trade marks and is to be registered in respect of identical goods (*Section 10(1)*),
- there is a likelihood of confusion on the part of the public as between the respective marks (*Section 10(2)*),
- the use by the Applicant of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's marks (*Section 10(3)*),
- the mark applied for is not used or intended to be used by the Applicant or with its consent in relation to the goods of the application (*Section 37(2)*).

¹ Nos. 1607548 and 2147510, respectively

Counter-Statement

6. In its Counter-Statement the Applicant denies all of the grounds of opposition raised against the application and admits only that the Opponent is the proprietor of the trade marks cited in the Notice of Opposition. As regards Community Trade Mark No. 2147510, however, the Applicant notes that its application predates that registration and asserts that the application is not open to opposition based on that registration.

The evidence

Rule 20

7. Evidence filed by the Opponent under Rule 20 consisted of a Declaration (and one exhibit) dated 30 January, 2003 of Dr. Wolfgang Weber and Dr. Volker Bugdahl, both procurement professionals of the Opponent. In addition to offering their opinion on the merits of the opposition, they state that the Opponent's Community Trade Mark No. 160748, PEROXYNET, is also registered in many countries around the world, a list of which they exhibit.

Rule 21

8. Evidence filed by the Applicant under Rule 21 consisted of a Statutory Declaration (and Exhibits P1-P3) dated 16 December, 2003 of Laetitia Valençon, Head of the Trade Mark Department of the Applicant. She says that the trade mark PEROXAL was first registered in France in 1989 by a predecessor in title of the Applicant and that the Applicant first used the mark in France in 1998 in relation to hydrogen peroxides. Since that date, the use of the mark has extended to over thirty countries, including Ireland (since April, 2000). Products bearing the mark have been promoted through advertisements in publications and trade magazines such as "European Chemical News" and on the Applicant's websites. Ms. Valençon asserts that the prefix PEROX which is shared by both the Applicant's and the Opponent's trade marks is a well known prefix derived from the word "peroxide".

Rule 22

9. Evidence filed by the Opponent under Rule 22 consisted of a further Declaration (and one exhibit) dated 26 May, 2004 of Messrs. Weber and Bugdahl. They say

that they have carried out research in technical dictionaries and on the internet and have found no reference to PEROX being a well known prefix or abbreviation associated with the word “peroxide” and they exhibit the results of a search of the Community Trade Mark Register indicating that the prefix is not commonly used in trade marks.

The hearing and issues for decision

10. At the Hearing the Opponent was represented by Ms. Hazel Tunney, Trade Mark Agent of F.R. Kelly & Co. The Applicant was not represented. Ms. Tunney confined her submissions in support of the opposition to the ground of opposition based on Section 10(2) of the Act and I am satisfied that it is sufficient for me to consider in detail only that ground and to simply dismiss the remaining grounds of opposition, i.e., those based on Sections 8, 37 and 42, as unsupported by any evidence or argument.

Section 10(2)(b) – is there a likelihood of confusion on the part of the public?

11. Section 10(2)(b) of the Act reads as follows:

“A trade mark shall not be registered if because –

.....

(b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.”

Earlier trade mark

12. In the present case, the Opponent’s Community Trade Mark No. 1607548 PEROXYNET, which was filed on 12 April, 2000 constitutes an “earlier trade mark” within the meaning of the Act as against the application for registration. Its Community Trade Mark No. 2147510 PEROXYBRIGHT was filed on 23 March, 2001, which was subsequent to the date of filing of the present application and

cannot, therefore, be relied upon to ground an objection under Section 10(2) of the Act.

Identical or similar goods

13. Community Trade Mark No. 1607548 is registered in respect of the following specification of goods and services:

Class 1: Chemicals used in industry, sulphinic acids, sodium chlorate, per-compounds, in particular hydrogen peroxide, perethanoic acid and persulfates

Class 39: Storage and transport of chemicals by road, rail, water and air

Class 42: Information and consultancy with regard to the handling and use of chemicals

14. The goods *chemicals used in industry* and *hydrogen peroxide* in Class 1 in both the earlier trade mark and the application for registration are identical. The goods *hydrogen peroxide used for cosmetic purposes* and *hydrogen peroxide used for medical purposes* in Classes 3 and 5, respectively, in the application for registration are similar to *hydrogen peroxide* in Class 1 in the earlier trade mark, the only difference being their respective intended purposes. The criterion of identity or similarity of goods specified in Section 10(2) is therefore satisfied in the present case and it is not necessary to consider the question of whether there is similarity between the goods of the application and the additional goods and services in respect of which the Opponent's earlier trade mark is protected.

Similar marks

15. The marks in question are PEROXYNET and PEROXAL. On any objective assessment, those marks must be seen as similar to each other. They each consist of a single word, they share their first five letters in common, are of similar length and differ only in their terminal syllables, which generally have a lesser influence on the pronunciation of words. For these reasons, there are clear and close visual and aural similarities between the marks. There are also some obvious visual and aural differences arising from the different endings of the respective marks but

these are not such as to outweigh the overall similarity between them arising from the shared element, “perox”.

Average consumer’s perspective

16. Of course, the comparison of trade marks consisting of words must not be confined to an abstract assessment of their visual and phonetic similarities only. By their nature, words are expected to have some meaning and even invented words, when used as trade marks, frequently have some conceptual connection with the relevant products. In considering whether word marks are similar, one must consider also the impression likely to be created by them in the mind of the average consumer of the relevant goods, i.e., his conceptual appreciation of the words in question. In the present case, the Applicant has asserted that “perox” is a well known prefix derived from the word “peroxide”, the implication being that the “perox” element of the respective trade marks PEROXYNET and PEROXAL would be perceived by the average consumer as indicative of the nature of the respective products rather than as suggesting that they share a common commercial origin. Ms. Tunney argued strongly at the hearing that the Applicant had failed to substantiate its assertion that “perox” has the meaning that it claims it has and she asserted, accordingly, that there is no basis on which I can accept that claim, absent proof and in the face of the Opponent’s denial of same. I accept that argument and agree with the Opponent that the Applicant has failed to show that “perox” is a commonly used abbreviation of “peroxide” or that the average consumer may be expected to be already familiar with its use in that way in the course of trade.

17. That is not the end of the matter, however, as the question must still be addressed as to whether the average consumer of the goods in question here – chemicals, in particular, hydrogen peroxide - would instinctively and intuitively perceive the inclusion of the “perox” element in the respective trade marks as primarily descriptive of the nature of the products so marked, notwithstanding that he has no prior understanding of that element as directly indicative of “peroxide”. There is no evidence before on that question but it is fundamental to the determination of the matter and I must make the best assessment of it that I can having regard to my own knowledge and experience. That assessment must be made from the

perspective of the average consumer of the goods in Class 1, namely, chemicals, in particular hydrogen peroxide, used in industry, as that is the common consumer pool embraced by both the Opponent's and the Applicant's specifications of goods. So, what is the likely effect on the mind of the average person engaged in the purchase of chemicals for use in industry of the respective trade marks PEROXYNET and PEROXAL and, in particular, what meaning, if any, is such a person likely to take from those words? In my opinion, it is likely that he will assume that the goods so marked are or contain a peroxide of some kind. Certainly, the names in question consist of invented words with no dictionary meanings but I think it is inescapable that their similarity to the dictionary word "peroxide" and their use in relation to chemicals would convey a clear message to the average person using chemicals on an industrial scale.

Likelihood of confusion

18. That finding is significant in the context of the assessment of the likelihood of confusion between the respective marks. It follows from it that the average consumer of the relevant goods is more likely to perceive the common element shared by those marks as descriptive of the nature of the goods rather than to understand it as signifying a commercial connection between goods bearing the respective marks or between the undertakings putting those goods on the market. The PEROX element of the Opponent's mark is not, in itself, such a memorable and distinctive part of that mark that the average consumer having once been exposed to goods of this kind bearing the mark would, on a subsequent occasion of purchase, be likely to rely on it alone to identify the Opponent's goods. Indeed, the obviousness of the PEROX element of each mark in terms of its allusion to the nature of the goods is likely to cause consumers to focus more on the additional parts of the trade marks to identify and distinguish between the different products on offer. The adoption and simultaneous use by different undertakings of trade marks for chemicals consisting of words commencing with PEROX is not, in my opinion, likely to be perceived by consumers as unusual or unlikely. In such circumstances, the inclusion of the PEROX element in the marks is not determinative of the likelihood of confusion between them, notwithstanding that that element dominates the look and sound of each of the marks.

19. I regard that assessment of the matter as consistent with the statement of the European Court of Justice in the case of *Sabel BV v Puma AG and Rudolph Dassler Sport (Case No C-251/95)*, to the effect that *a global appreciation of the visual, aural and conceptual similarity between trade marks must be based on the overall impression created by the marks, bearing in mind, in particular, their distinctive and dominant components*. In my opinion, the allusion to peroxide made by each of the marks at issue cannot be regarded as the distinctive component of either of them as that allusion is apt to be understood generically by consumers and is not such as to signify or identify the goods of one trader only. So, while the PEROX element may dominate in each of the **words** PEROXYNET and PEROXAL, the conceptual significance of that element in the respective **trade marks** PEROXYNET and PEROXAL, in the context of the relevant goods, renders it of considerably lesser significance in terms of the likelihood of confusion between those marks.

20. In my opinion, such a likelihood of confusion could be said to exist only if the remaining elements of the respective marks were sufficiently similar such that the overall impression created by each, leaving aside the allusion to peroxide, was essentially the same. That is not the case here as the YNET and AL components of the respective marks are sufficiently different to distinguish them, one from the other, and to render the overall impressions created by them as sufficiently different to eliminate the likelihood of confusion. In particular, I think the NET element of the Opponent's mark imbues it with an identity that is not replicated or hinted at in the Applicant's mark. For that reason, I think it is correct to say that, in terms of the likely perception of the average consumer of these goods, the overall impressions created by these trade marks are not so similar as to create a likelihood of confusion. When due allowance is made for the conceptual significance of the PEROX element, I do not think that the trade mark PEROXAL is likely to be taken as signifying a connection with goods marked PEROXYNET or with the undertaking putting those goods on the market. I find therefore that the application for registration is not open to objection under Section 10(2) of the Act based on the Opponent's earlier Community Trade Mark No. 160758 and that the opposition on that ground must be dismissed.

Tim Cleary
acting for the Controller
2 November, 2006