

## TRADE MARKS ACT, 1996

### Decision in Hearing

IN THE MATTER OF an application for registration of Trade Mark No. 223660 and in the matter of an Opposition thereto.

**REYNOLDS METALS COMPANY**

**Applicant**

**COFRESCO FRISCHALTEPRODUKTE GMBH & CO. KG**

**Opponent**

#### **Application for registration**

1. On 24 October, 2001, Reynolds Metals Company, a corporation organised and existing under the laws of the State of Delaware, United States of America of 6601 West Broad Street, Richmond, Virginia, United States of America, made application (No. 2001/03355) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the term TUB-ITS as a trade mark in respect of a specification of goods in Class 21 which was amended in the course of the examination of the application to read, “*storage containers, not of common metal, for household and kitchen use*”.
2. The application was accepted for registration and advertised accordingly under No. 223660 in Journal No. 1947 on 24 July, 2002.
3. Notice of opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 17 October, 2002 by Cofresco Frischalteprodukte GmbH & Co. KG of Melittastrasse 17, 32427 Minden, Germany. The Applicant filed a counter-statement on 15 January, 2003 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).
4. The matter became the subject of a Hearing before me, acting for the Controller, on 9 October, 2006. The parties were notified on 9 November, 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 refers to its proprietorship of Community Trade Mark No. 1377514<sup>1</sup> in respect of the trade mark TOPPITS (and device) and then raises objection to the present application under the following Sections of the Act:

- Section 8(1)(a) – *sign not a trade mark within the statutory definition,*
- Section 8(1)(b) – *mark devoid of any distinctive character,*
- Section 8(1)(c) – *mark consists exclusively of signs or indications designating characteristics of the goods,*
- Section 8(1)(d) – *mark consists exclusively of signs or indications that have become customary in the trade,*
- Section 8(3)(b) – *mark of such a nature as to deceive,*
- Section 8(4)(a) – *use of mark prohibited by enactment or rule of law,*
- Section 8(4)(a) – *application for registration made in bad faith,*
- Section 10(2)(b) – *likelihood of confusion on the part of the public,*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent’s mark,*
- Section 10(4)(a) – *use of mark liable to be prevented by virtue of rule of law protecting an unregistered trade mark or sign used in the course of trade,*
- Sections 37(2) and 42(3) – *requirements for registration not satisfied as Applicant does not use or intend to use the mark in relation to all of the goods covered by the application.*

## **Counter-statement**

6. In its counter-statement the Applicant denies all of the grounds of opposition and admits only the Opponent’s proprietorship of Community Trade Mark No. 1377514 but it does not admit the validity or relevance of that trade mark, which it notes is under opposition at the Office for Harmonisation in the Internal Market, Trade Marks & Designs (OHIM)<sup>2</sup>.

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<sup>1</sup> details in Appendix I

<sup>2</sup> opposition subsequently rejected at OHIM

## **Evidence**

### *Rule 20*

7. Evidence submitted by the Opponent under Rule 20 consisted of a statutory declaration (and one exhibit), dated 25 March, 2003, of Dr. Franz Josef Konert, its Managing Director, which does not, in my opinion, add to the facts set out in the notice of opposition in any material aspect<sup>3</sup>.

### *Rule 21*

8. Evidence submitted by the Applicant under Rule 21 consisted of a statutory declaration (and one exhibit) dated 4 November, 2004 of Donna C. Dabney, its Vice President. She says that the trade mark TUB-ITS was first used in the State in January, 2002 and exhibits a copy of sample packaging showing the mark used in the form “tub-its!” in red lettering against a blue background. It is used in respect of re-sealable plastic food storage containers, which are sold in retail outlets including Dunnes Stores and SuperValu. Approximately €28,500 worth of such goods had been sold as of the date of the declaration. The trade mark has been the subject of applications for registration in a number of other countries of the European Union and has been registered in the United Kingdom, notwithstanding the existence of the Opponent’s Community Trade Mark.

## **Hearing and issues for decision**

9. At the hearing the Opponent was represented by Paul Coughlan, BL instructed by Tomkins & Co., Trade Mark Agents and the Applicant by Jonathan Newman, BL instructed by F.R. Kelly & Co., Trade Mark Agents. Mr. Coughlan confined his submissions in support of the opposition to the ground of opposition raised under Section 10(2)(b) of the Act and there was no discussion whatsoever of the other grounds cited in the notice of opposition. In the absence of any evidence in support of those other grounds and given that no arguments were presented at the hearing to justify any of them, I am satisfied that they may simply be dismissed as unsubstantiated and that it is sufficient to consider the opposition under Section 10(2)(b) only.

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<sup>3</sup> In addition to Community Trade Mark No. 1377514, Dr. Konert refers to the Opponent’s proprietorship of Community Trade Mark No. 281626 but, because that registration was not cited in the notice of opposition and no application to amend same was subsequently made, it falls outside of the scope of these proceedings and I have not had regard to it in reaching my decision in the matter.

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

10. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

*“A trade mark shall not be registered if because –*

*(a) .....*

*(b) it is similar to an earlier trade mark and would be registered for goods  
..... 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.”*

11. As is evident from the wording of the Section itself, the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii) the mark applied for must be similar to that earlier trade mark, (iii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected and, (iv) there must be a resultant likelihood of confusion on the part of the public. The first three of these conditions are clearly fulfilled in this case. The Opponent’s Community Trade Mark No. 1377514 was filed at OHIM on 10 November, 1999 and claimed priority from a German application dated 10 May, 1999. It has since proceeded to registration and, by virtue of Section 11(1)(c) of the Act, it is an earlier trade mark as against the present application for the purposes of Section 10. The respective marks are clearly similar since the verbal element of the earlier trade mark is its dominant and distinctive component and that element shares four of its seven characters in common with the mark applied for, which characters are arranged in the same order in each mark. Finally, the goods of the application for registration, namely *storage containers, not of common metal, for household and kitchen use* are the same as some of the goods for which the Opponent’s earlier trade mark stands protected, viz., *household or kitchen utensils and containers (not of precious metal or coated therewith)* as both specifications of goods include plastic containers for household or kitchen use. The only question at issue,

therefore, is whether there is a likelihood of confusion on the part of the public and the objection under Section 10(2)(b) turns entirely on that question.

12. There was no dispute between Mr. Coughlan and Mr. Newman as to the principles of interpretation to be applied in deciding that question, which principles are now well established. The basic principle is that the likelihood of confusion must be assessed globally, taking account of all of the circumstances of the case. Those factors always include the degree of similarity between the respective marks and the respective goods, the extent of the distinctiveness of the earlier mark, the nature of the goods and the level of attention likely to be paid to their purchase by the average consumer, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture of them that he carries in his mind. Furthermore, in assessing the degree of similarity between marks, regard must be had to the visual, aural and conceptual similarities between them and to the relative significance of each of those elements, having regard to the category of goods and the way in which they are marketed. In making that assessment, one must look primarily at the overall impressions created by the respective marks as the average consumer normally perceives a trade mark as whole and does not proceed to analyse its individual components or details.

13. Messrs. Coughlan and Newman were, of course, at odds as to the outcome of the application of those principles to the circumstances of the present case and I think it is true to say that the main point of dispute was the extent to which the respective marks could be said to be similar or different and the effect of that factor on the overall assessment of whether confusion was likely. Mr. Coughlan pointed to the visual and aural similarities between the marks arising from their common initial T, their identical endings, ITS, and the fact that the B in the middle of the Applicant's mark produces a similar sound to the PP in the Opponent's. He did not accept that a conceptual difference between the marks could be established arguing that the average person could not be assumed to attribute any meaning to the Applicant's mark used in the form as applied for, i.e., without the exclamation mark signifying the imperative "tub it!" or "put it in a

tub”<sup>4</sup>. He pointed in particular to a decision of the District Court of The Hague in proceedings between the same parties in which the court declared the Applicant’s Benelux registration of the trade mark TUB-ITS invalid on the basis of a likelihood of confusion with the Opponent’s earlier registration of the word mark TOPPITS. In Mr. Coughlan’s submission, the reasoning underpinning that decision was equally applicable in this case.

14. Mr. Newman relied primarily on the conceptual difference between the respective marks, which he said arises from the fact that the Opponent’s mark is an invented word that conveys no meaning whereas the meaning of the mark applied for would be understood intuitively by the average consumer, i.e., with the word “tub” used as a verb and “it” referring to the material that the consumer requires to store. In this regard, Mr. Newman agreed with my suggestion that his argument was to the effect that “tub it” would be understood analogously with the known term “bin it”. Citing the decision of the European Court of Justice in the *Ruiz-Picasso* case<sup>5</sup>, he argued that the conceptual difference between the two marks in this case was sufficient to counteract the slight visual and aural similarities between them with the result that the average consumer would be unlikely to make an association between goods bearing the respective marks.

15. Having given the matter careful consideration, I have come to the conclusion that the Applicant’s case should prevail for the following reasons. Firstly, there is the matter of the type of goods concerned here, which are essentially low-cost plastic boxes or tubs for general household or kitchen use. Such goods may be expected to be purchased by most householders at one time or another but I doubt that they would form part of the regular weekly shopping of many consumers. In my opinion, they are likely to be purchased as required for specific purposes and, in selecting them, the consumer is most likely to be concerned with functional considerations as to whether a given product is of the size, shape and sturdiness that he requires. Because the goods are relatively low-cost and relatively infrequently purchased, I think it unlikely that the average consumer would be especially brand-aware, much less used to choosing a particular brand. In fact, I

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<sup>4</sup> which is how the Applicant has used the mark – see paragraph 8 above

<sup>5</sup> Case no. C-361/04, *Ruiz-Picasso v OHIM and Daimler Chrysler AG*

would say that trade marks play a relatively lesser role in the selection of these goods by the average consumer than in the case of many other consumer goods, such as food and clothing, for example.

16. That is not to say that trade marks are not important, either to their proprietors or to consumers, in the context of these types of goods and it is, of course, the case that the basic function of a trade mark in identifying the goods of its proprietor and distinguishing them from the like goods of competitors is maintained regardless of the category of goods concerned. However, in assessing the likelihood of confusion between opposing marks, I am required to consider the average purchasing scenario and to assess the extent to which reliance is likely to be placed by the average consumer on the identity of the trade mark in making his selection and the relative importance that he is likely to attach to that factor as against other factors, including functional, aesthetic and cost considerations. I have no evidence before me on the matter one way or the other but I must make the best assessment I can of it, having regard to the category of goods in question and to my own knowledge and experience as a consumer. In my opinion, the average consumer would be likely to pay at least as much attention to functional considerations as he would to brand names in choosing plastic kitchen and household storage containers and the likelihood of confusion arising as a result of the simultaneous use of similar trade marks by unrelated undertakings is somewhat reduced accordingly.

17. Nor am I convinced that the trade marks in question here can fairly be said to be as similar to each other as the Opponent contends. I am not influenced in this aspect of my decision by the fact that the Opponent's mark contains a figurative element; that element is decorative in nature and really only serves to frame and emphasise the word "Toppits", which dominates the mark. And, of course, the word TOPPITS looks and sounds like TUB-ITS but that does not mean that the respective trade marks are confusingly similar. That question turns more on whether that which is striking and memorable in TOPPITS is reproduced or suggested in TUB-ITS such that exposure to the latter would be likely to subliminally trigger recollection of the former in the mind of the average consumer in such a way as to cause an association in his mind between the

respective marks and goods. As the authorities demonstrate, that depends on the extent of the correlation of the distinctive and dominant features of the respective marks and not on a coincidence of letter sequences alone.

18. TOPPITS is a meaningless, invented word and its distinctiveness as a trade mark stems from its very meaninglessness. It has the appearance and sound of a slightly whimsical word and is a perfectly good and memorable trade mark, if not of the “once seen, never forgotten” variety, then certainly a “once seen, likely to be remembered” word. TUB-ITS, on the other hand, is clearly a conjoining of two dictionary words, TUB and ITS; the hyphenation makes it so. The word TUB has an obvious meaning and connection with the goods in question here and, in the context of those goods, I think that the intended meaning of the term TUB-ITS (put it in a tub!) would be immediately apparent to the average person, notwithstanding the unusual syntactic composition and even without the use of the exclamation mark importing the imperative sense. Here again, there is no evidence as to what the average consumer’s reaction is likely to be and my speculation may well be wrong but that was certainly my own response to the mark at first sight and I think it is the most obvious and most likely one. We naturally expect words to have meaning and we are apt to subconsciously perceive meaning in words even when that meaning is hidden or only obliquely disclosed, as is often the case with verbal trade marks.

19. I also believe that the distinctive feature of the Applicant’s mark is the message that it conveys or, more particularly, the linguistic novelty employed to convey the message. In other words, the striking thing about TUB-ITS is not the look or the sound of it but the economic use of language to tell the consumer that the product so marked is a multi-pack<sup>6</sup> of general purpose storage containers. That message is delivered in a flash and quite unmistakably, in my opinion. It may be going too far to describe it as zen-like but it is certainly a clever little trade mark! In terms, therefore, of the distinctive features of the respective trade marks in this case, I think that there is a clear difference between the two. The Opponent’s mark is defined by its look and sound and its very meaningless while the dominant aspect

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<sup>6</sup> the use of the plural TUB-ITS achieves this



of the Applicant's mark is its meaning and how that meaning is conveyed. Notwithstanding its similar sound and appearance to the Opponent's mark, I think it unlikely that the impression created in the mind of the average person by the Applicant's mark would have the effect of bringing to mind the former.

20. In making an assessment of the likelihood of confusion, the scenario to be considered is that of the average consumer, who must be assumed to be already familiar with the Opponent's product sold under its earlier trade mark, being exposed in the course of a typical shopping experience to goods bearing the mark applied for. Is such a person likely to be confused, i.e., to seriously entertain the thought that the goods before him are those that he has known previously under the Opponent's mark or are connected with those goods in some way? Because of the differences that I have outlined in the distinctive and striking aspects of the respective marks, I think that that question should be answered in the negative. While it is not inconceivable that a given consumer might subconsciously focus more on the structure of the Applicant's mark, in the sense of the letters of which it is formed, rather than on the message that it conveys and might, as a consequence, be caused to remember the Opponent's similarly constructed name, I do not think that that would be the response of the average person. In any event, I am not persuaded that a likelihood of confusion would ensue even in that scenario because the selection of the goods is likely to be the subject of some more attention than a mere glance at the trade mark. Even a perfunctory examination of the goods should result in a reasonably observant person noticing that they are not a TOPPITS product or a related product and should obviate any possibility of confusion that might be said to exist. For these reasons, I find that there is not a likelihood of confusion on the part of the public and that the opposition under Section 10(2)(b) of the Act against the application for registration should be dismissed.

21. I wish to refer briefly to the decision of the District Court of the Hague which Mr. Coughlan brought to notice at the hearing. While that decision is not binding on me, nevertheless I have taken good note of it but I have decided, respectfully and not without hesitation, to take a different view for two main reasons. Firstly, I think that the profile of the average consumer must differ as between the Benelux

and the State, specifically with regard to language and interpretation of meanings of English words. In this regard, I note that the court acknowledged that “*the qualified public in the Benelux that is competent in English might (my emphasis) comprehend TUB-ITS in a more descriptive way in the sense “put it in”*” but it considered that that did not detract sufficiently from the aural and visual similarities between the marks. It will be apparent that I do not believe that the same could be said as regards the likely perception of the average Irish consumer.

22. There is also the fact that the evidence in the case under reference was to the effect that the Opponent’s earlier trade mark, the word mark TOPPITS, had been extensively and successfully used within the territory in question such that the court found that it enjoyed a considerable degree of consumer awareness. That factor, which is not in play here, influenced the court in reaching its finding that there was a likelihood of confusion between the marks. In this regard, I should refer to the submission made on behalf of the Opponent to the effect that, notwithstanding that there is no evidence of consumer recognition of the Opponent’s earlier trade mark in this jurisdiction, the mark is inherently distinctive and should be accorded a broad scope of protection for that reason. While I accept that submission, in principle, I regard the inherent distinctiveness of the Opponent’s earlier trade mark as stemming from aspects of it (its look, sound and the absence of any meaning in it) that are different from that which renders the Applicant’s mark distinctive and, consequently, that the distinctiveness of the earlier trade mark does not contribute to a likelihood of confusion in this particular case.

Tim Cleary  
Acting for the Controller

29 November, 2006

**Opponent's Community Trade Mark No. 1377514**



**Class 6**

Aluminium foil; metal foil materials for packaging; grill pans; baking and roasting tins of aluminium foil; inserts of aluminium foil for baking tins and pans; closing clips of metal; plastic coated aluminium foil.

**Class 16**

Packaging material of paper, cardboard and/or plastic in the form of foils, tubes, sheets, rolls, bags, boxes and containers for household and kitchen use for storing, baking, cooking, keeping fresh and freezing; bags for ice cubes; microwave foil; labels; implements for writing on films; baking and roasting tins of paper; baking and roasting paper.

**Class 21**

Household or kitchen utensils and containers (not of precious metal or coated therewith); freezer tins and boxes; plastic tableware; plastic drinks vessels; closing clips of plastic; cake moulds, baking and roasting tins; cooker hoods; splash-guard covers; foil dispensers; bottle coolers (included in class 21); plastic containers and casings filled with fluid (gel) for cooling or heating drinks and keeping drinks hot and/or cold.