



DECISION

of 23/04/2007

RULING ON OPPOSITION No B 817 272

Opponent: **Johannes Teiser**
Köhlerweg 12
59821 Arnsberg
GERMANY

Representative: **Charrier Rapp & Liebau**
Anwalthaus Volkhartstr. 7
86152 Augsburg
GERMANY

Trade Mark: **Dentia**

against

Applicant/holder: **Mars, Incorporated**
6885 Elm Street
McLean, Virginia 22101-3883
UNITED STATES OF AMERICA

Representative: **Clifford Chance LLP Mars Co-Ordination Team**
10 Upper Bank Street
London E14 5JJ
UNITED KINGDOM

Contested trade mark:



I. FACTS AND PROCEDURE

On 20/11/2003, the applicant filed application No 3 553 476 to register the figurative mark as reproduced on the cover page for goods in classes 3, 18 and 31.

The application was published on 10/01/2005.

The opposition is directed against the goods of the application in class 3.

The opposition is based on the following earlier rights:

German trade mark registration No 2 099 114 of the word mark "Dentia", registered for goods and services in classes 3, 21 and 44. The opponent bases its opposition on all these goods and services.

International trade mark registration No 730 535 with effect in Austria of the word mark "Dentia", registered for goods and services in classes 3, 21 and 42. The opponent bases its opposition on all these goods and services.

The grounds of the opposition are those laid down in Article 8(1)(b) of the Community Trade Mark Regulation (CTMR).

Both parties filed observations and evidence within the time limits set by the Office. The applicant requested that the opponent submit proof of use of the earlier German mark on which the opposition is based. The opponent submitted documents as evidence of use.

The opponent argues that there is a likelihood of confusion because of the similarity of goods and services and marks in question and therefore the CTM application should be rejected for all the contested goods.

The applicant argues that there is no likelihood of confusion, in particular because the marks are dissimilar.

II. DECISION

A. ON THE PROOF OF USE

The request of the applicant that the opponent prove use of his earlier German trade mark "Denia" is valid. The obligation to prove use of the earlier mark on which the opposition is based arises when at the date of publication of the contested Community trade mark application, it was registered for more than five years (Article 43 (2) CTMR). This is the case as it was registered on 29/02/1996 and therefore more than five years

before the date of publication of the contested Community trade mark application, which was 10/01/2005.

The proof shall consist of indications concerning the place, time, extent and nature of the use of the opposing trade mark for the goods and services for which it is registered (Rule 22 (2) IR).

Following the applicant's request, the opponent had to file proof that it had put the earlier German mark No 2 099 114 to genuine use for *cosmetics, dentifrices, products for oral hygiene, mouth washers (not for medical purposes); tooth brushes, interdental tooth brushes, electric tooth brushers, mouth washing apparatus, tooth picks; services of a dentist, of a dental clinic and of a dental laboratory* within the period of five years prior to 10/01/2005.

The opponent filed the following evidence of use:

- 1 affidavit signed by the opponent certifying
 - that since 1994 he is running a shop annexed to his dental practise where the respective goods are purchased (i.e. *dentifrices* such as *tooth brushes, dental creams, mouth washers, etc.*);
 - that the trade mark "Dentia" was used in the respective period also in the internet in the opponent's website;
- Copy of a picture of the opponent's "Dentia shop", copy of a picture of an advertisement "Dentia shop" used on a car (these copies are not dated, therefore they can not be taken into account Article 43(2) CTMR));
- Examples of sticking labels (without dating);
- Printout from the opponent's website www.dentia.de (dated beyond the relevant time period, therefore it can not be taken into consideration (Article 43(2) CTMR)).

In connection with the sufficiency of the evidence submitted by the opponent, it must be mentioned that the Court of First Instance held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (see the judgment of the Court of First Instance of 12 December 2002 in case T-39/01 *Kabushiki Kaisha Fernandes v OHIM-Harrison (Hiwatt)*, ECR II-5233, paragraph 47).

It is not sufficient for genuine use to appear probable or credible; actual proof of that use must be given (see the judgment of the Court of First Instance of 6 October 2004 in case T-356/02 *Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM (Vitakraft)*, paragraph 33).

Furthermore, the Court of First Instance held in a case similar to the present one (see judgment of the Court of First Instance of 7 June 2005 in Case T-303/03 *Lidl Stiftung & Co. KG v OHIM ('Salvita')*) that an affidavit drawn up by the employee of the opponent (a German company) mentioning the sales figures and supported by a list of goods sold under the trade mark at issue together with undated examples of the packaging of the goods were not sufficient to prove genuine use of the trade mark.

With regard to the circumstances of the case, the Office considers that an affidavit coming from the opponent, four copies of pictures and one copy of examples of sticking labels, both of them undated and a printout from his website outside the relevant time period do not constitute a solid and objective evidence of effective and sufficient use of his earlier German trade mark. Consequently, it is concluded that the opponent did not succeed in proving that his earlier mark had been put into genuine use in Germany within the relevant period of time. Therefore, the opposition must be rejected in so far as it is based on the earlier German trade mark No 2 099 114.

B. ON THE SUBSTANCE

1. Likelihood of confusion

According to Article 8(1) CTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

a) Comparison of goods and services

When making an assessment of similarity of the goods concerned, all relevant factors relating to these goods should be taken into account. These factors include, *inter alia*, their nature, their purpose and method of use and whether they are in competition with each other or are complementary (see *Canon*, paragraph 23). Further factors include the pertinent distribution channels (in particular the sales outlets), the relevant public, and the usual origin of the goods.

The contested goods are the following:

Soaps, medicated soaps; detergents; disinfectants; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants; cosmetics; dermal sprays, powders, drops, creams, lotions, treatments and preparations; mouthwashes, breath fresheners and dentifrices for animals in class 3.

The opposition is based on the following goods and services:

Cosmetics, dentifrices, products for oral hygiene, mouth washers (not for medical purposes) in class 3.

Tooth brushes, interdental tooth brushes, electric tooth brushes, mouth washing apparatus, tooth pics in class 21.

Services of a dentist, of a dental clinic and of a dental laboratory in class 42.

Class 3

cosmetics; mouthwashes

The applicant's *cosmetics* and *mouthwashes* are included in the opponent's specification. Therefore they are identical thereto.

breath fresheners and dentifrices for animals

The applicant's *breath fresheners and dentifrices for animals* are covered by the opponent's wider notion of *dentifrices* and *products for oral hygiene*. Since the Office cannot dissect *ex officio* the broader opponent's specification, the applicant's above mentioned goods have to be considered as identical to the opponent's goods.

dermal sprays, powders, drops, creams, lotions, treatments and preparations

The applicant's *dermal sprays, powders, drops, creams, lotions, treatments and preparations* and the opponent's goods, namely *cosmetics*, are products intended to be applied to the human body, for cleansing or beautifying purposes. Even if some of the designated goods can be intended to have curative effects, it cannot be excluded that they are sold also at the same places and through the same distributional channels as the opponent's *cosmetics*. Moreover, all these goods are aimed at the same part of the relevant public. Hence, they are similar.

soaps, medicated soaps; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants

The opponent's specification contains also goods which can be applied to the body with the intention of beautifying it or which are relating to the teeth in order to clean or treat the teeth. In contrast, the applicant's goods are used for cleaning the skin of the human body and they do not relate to the teeth. Although they can be sold at the same places but they are usually separated according to their mentioned purpose of use. Moreover, these goods are not likely to be distributed through the same trade channels and also their manufacturers are not likely to be the same. In addition, the relevant consumers of the category of goods concerned are deemed to be reasonably circumspect and well-informed. Thus, they will be able to differentiate the goods in question (*soaps, medicated soaps; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants* from *cosmetics*, such as powders, lotions, rouge, lipsticks, or other preparations for beautifying the face, skin, hair, nails, etc.). Consequently, the Office concludes that the goods in question are dissimilar.

detergents

The contested *detergents* do not have the same function as the cosmetic products listed in the earlier mark. They are similar inasmuch as they all can be used for hygienic purposes. However, the goods of the CTM application are used for domestic purposes whereas cosmetic products are used in relation with the human body, in order to clean and to give a pleasant fragrance or aspect to the body for example. Furthermore, they are not manufactured by the same companies nor are they sold in the same sales outlets or in the same departments of department stores. Therefore, these goods have to be considered as dissimilar.

disinfectants

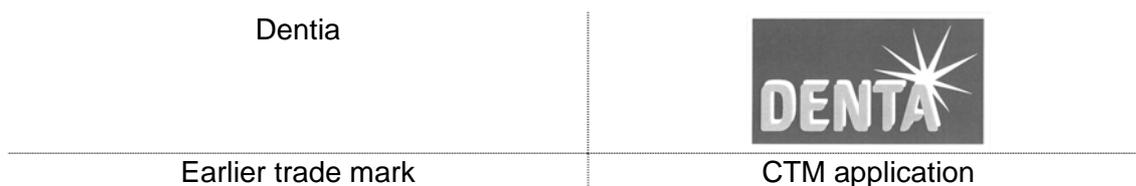
Disinfectant is a substance which contains chemicals that kill bacteria and is used especially for cleaning surfaces in toilets and kitchens. The opponent's goods are

cosmetic products used for cleansing or beautifying purposes and applied to the human body. The conflicting goods do not complement or compete with each other on the same market and their nature, their purpose and their channels of distribution are different. It is therefore considered that *disinfectants* are dissimilar to *cosmetics, dentifrices, products for oral hygiene, mouth washers (not for medical purposes)*.

b) Comparison of signs

In determining the existence of likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between the marks. The comparison must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (cf. Judgment of the Court of Justice, Case C-251/95 *Sabèl BV v Puma AG, Rudolf Dassler Sport* [1997] OJ OHIM 1/98, p. 91, paragraph 22 et seq.).

The signs to be compared are the following:



The earlier trade mark is the International trade mark registration with effect in Austria. Therefore, Austria is the relevant territory for comparison.

Likelihood of confusion in only one part of the Community is sufficient as a relative ground for the rejection of the application in issue. This results from the unitary character of the Community trade mark (See Judgment of the Court of First Instance of 9.3.2005 in case T-33/03, "Hai/Shark", paragraph 39).

Generally, the word elements of figurative trade marks are considered to be dominant, because the public will be likely to remember the word element and consequently use the word element to refer to the products sold under the trade mark. Therefore, the word "DENTA" is considered to be the dominant element of the contested application, moreover its figurative element forms only a rectangle and a star under the last letter "A".

The dominant element of the applicant's mark and the earlier sign share five letters. They both begin identically with the combination of letters "DENT-". This common element is followed by letters "-A" and "-ia" respectively. Thus, the only difference is that the earlier mark has one additional letter "i" at the end. However, both marks are fairly short signs where even small differences can be noticeable. Furthermore, both marks share the common part "DENT" which will be suggestive of the word "*dental*", the word of Latin origin which relates to the teeth or to dentistry. In view of the foregoing, and in particular in view of the fact that the relevant public, who is usually circumspect and observant, will immediately see and understand that common part and thus focus on the different endings, the Office concludes that there are noticeable visual differences between the relevant signs.

From the phonetic point of view, the first syllables of the signs are pronounced identically, i.e. /den/. They differ in their following syllables /ta/ and /ti/a/. Therefore, the contested mark has two and the earlier mark three syllables. However, as mentioned above, the marks in dispute are relatively short marks where even small differences will be more striking. The additional letter “i” makes a significant difference for the German speaker for whom the different endings are certainly notable. Therefore, the Office finds that despite the identical stressed initial syllables, the marks have different syllables in their endings.

Conceptually, neither of the two signs “DENTA” or “Dentia” has any meaning as a whole. However, both of them could be suggestive of the word *dental*, i.e. the word of the Latin origin which means *relating to the teeth or to dentistry*. To this extent there is a conceptual identity.

c) Global assessment

It constitutes a likelihood of confusion within the meaning of Article 8(1)(b) CTMR if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically-linked undertakings (see Judgment of the Court of Justice, Case C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn Mayer Inc*[1998], OJ OHIM No. 12/98, page 1407 *et seq.*, paragraph 29.)

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question (Judgment of the Court of Justice Case C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, OJ OHIM No 12/1999, p. 1585, paragraph 26).

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings. In making that assessment, account should be taken of all relevant factors and, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered (see *Lloyd*, paragraph 28 *et seq.*).

According to the seventh recital of the CTMR the appreciation of the likelihood of confusion “... depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified ...”.

A lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks, and vice versa (see Canon, paragraph 17).

The above comparison of the signs has shown that they have both some similarities and dissimilarities from the visual and phonetic point of view. Since the applicant's *cosmetics* have been found identical to the earlier opponent's specification, this found identity between the goods can offset the lesser degree of similarity between the marks. Consequently, the Office finds that there is a likelihood of confusion between the earlier mark and the contested CTM application in the relevant territory in relation to the identical *cosmetics*. Hence, the CTM application must be rejected for *cosmetics*.

As regards the remaining identical goods, i.e. *mouthwashes*, and also other similar goods relating to the teeth (i.e. *breath fresheners and dentifrices for animals*), it has been already mentioned that the respective consumer will immediately see some reference to teeth in both marks, especially where the respective marks designate the goods which relate to teeth. Since the earlier mark will be clearly perceived as referring to *dentifrices and other goods for teeth*, it must be considered as weak and not particularly distinctive for these goods. Thus, although identical goods are involved, the relevant public will notice the differences between the marks, in particular because of the weakness of the descriptive element "DENT" in both marks. Consequently, there can be no likelihood of confusion as regards the contested *mouthwashes, breath fresheners and dentifrices for animals*.

As for the remaining goods, i.e. *soaps, medicated soaps; detergents; disinfectants; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants; dermal sprays, powders, drops, creams, lotions, treatments and preparations*, there has been found no similarity between them and the opponent's goods. Since one of the cumulative conditions necessary for finding a likelihood of confusion (the identity or similarity of goods at issue, is not fulfilled), there can be no likelihood of confusion with reference to the said *soaps, medicated soaps; detergents; disinfectants; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants; dermal sprays, powders, drops, creams, lotions, treatments and preparations*.

Taking into account all relevant factors of the case, the opposition must be upheld for *cosmetics* and rejected for the rest of the contested goods, i.e. *soaps, medicated soaps; detergents; disinfectants; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants; dermal sprays, powders, drops, creams, lotions, treatments and preparations; mouthwashes, breath fresheners and dentifrices for animals*.

C. COSTS

According to Article 81(1) CTMR, the losing party in opposition proceedings must bear the fees incurred by the other party, as well as all costs.

According to Article 81(2) CTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division shall decide a different apportionment of costs.

According to Rule 94(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR (OJ OHIM 2-3/95, p. 259), the apportionment of costs must be dealt with in the decision on the opposition.

Since the opposition is successful only for part of the contested goods and services, both parties have succeed on some heads and failed on others. Consequently, each party has to bear their own costs.

**THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)**

DECIDES TO:

1. Uphold opposition number B 817 272 for part of the contested goods, namely *cosmetics* in class 3.
2. Reject application number 3 553 476 for all the above goods. It may proceed for the remaining goods of the application, namely
soaps, medicated soaps; detergents; disinfectants; shampoos, medicated shampoos; deodorisers; deodorants, antiperspirants; dermal sprays, powders, drops, creams, lotions, treatments and preparations; mouthwashes, breath fresheners and dentifrices for animals in class 3;

collars, harnesses, leads, muzzles; whips, harness, saddlery; saddles, saddle blankets, saddle covers, saddle trees, saddle bags; halters, bridles, bits, blinders, blinkers, straps, traces, reins, saddle and harness fittings; stirrups, stirrup straps; knee pads for horses; bags; nosebags; blankets, rugs and articles of clothing for animals; non-edible chews for animals in class 18;

agricultural, horticultural and forestry products, grains and seeds, all included in class 31; live animals, birds and fish; foodstuffs for animals, birds and for fish and preparations included in class 31 for use as additives to such foodstuffs; malt; cuttlefish bone; edible bones, sticks and chews for pets; litter for animals; fresh fruit and fresh vegetables and preparations of these for use as additives to foodstuffs in class 31.
3. Order each party to bear their own costs.



Alicante, 23/04/2007

The Opposition Division

Richard THEWLIS

Radka STUPKOVÁ

Daniel GÁJA

Under Article 58 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 59 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 euro has been paid.