



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

Trade Marks Department

B206b

**Notification to the applicant/holder of a decision**

Alicante, 07/11/2011

*CONTEGO IP LLP*  
*90 Long Acre*  
*Covent Garden*  
*London WC2E 9RZ*  
*REINO UNIDO*

*Your reference:*

**CTM**

*Number of the opposition:*

**B 001562555**

*Trade mark number:*

**008442261**

*Name of the applicant/holder:*

**Oral 7 International Pty Ltd**

Please see the attached decision which ends the opposition proceedings referred to above.  
It was delivered on **07/11/2011**.

**Catherine MEDINA**

Enclosures (excluding the cover letter): 05 pages.

Sent by Ecomm

**Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office according to Rule 55(1) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 207/2009 on the Community trade mark (codified version of Council Regulation (EC) No 40/94).**



**OPPOSITION No B 1 562 555**

**Procter & Gamble Business Services Canada Company Suite 800**, 1959 Upper Water Street P.O. Box 997 Halifax, Nova Scotia B3J 2X2 Canada (opponent), represented by **Procter & Gamble France SAS**, 163/165 quai Aulagnier, 92600 Asnières-sur-Seine France

a g a i n s t

**Oral 7 International Pty Ltd**, Butler Settineri Level 1 Unit 16 100 Railway Road Subiaco Western Australia 6008 Australia (applicant), represented by **Contego IP LLP**, 90 Long Acre Covent Garden London WC2E 9RZ United Kingdom.

On **07/11/2011**, the Opposition Division takes the following

**DECISION:**

1. Opposition number B 1 562 555 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300

**REASONS:**

The opponent filed an opposition against all the goods of Community trade mark application No 8 442 261, based on Benelux trade mark registration No 371 310. The opponent invoked Article 8(1)(b) CTMR.

**LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR**

A likelihood of confusion exists 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. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs and the relevant public.

**a) The goods**

The goods on which the opposition is based are the following:

Class 3: *Dentifrices and fluoride compositions for cleaning the teeth and rinsing the mouth.*

The contested goods are the following:

Class 3 *Dentifrices; mouthwash – not for medical purposes; mouth gel.*

The contested *dentifrices* are also registered under the earlier mark. There is identity.

The contested *mouthwash – not for medical purposes* are products used to wash or rinse the mouth. They cover, as a broader category, the earlier more specific *fluoride compositions for rinsing the mouth*. It is impossible for the Opposition Division to filter these goods from the above-mentioned category. Since the Opposition Division cannot dissect *ex officio* the broad category of the applicant's goods, they are considered to be identical.

The contested *mouth gel* refers to products in the form of gel used to treat different affections of the mouth as dry mouth, mouth ulcers, mouth fungi, etc. These products also include the earlier *fluoride compositions for cleaning the teeth and rinsing the mouth* since these can take the form of gels to be applied topically. These goods are also identical.

#### b) The signs

| ORAL-B             | ORAL 7         |
|--------------------|----------------|
| Earlier trade mark | Contested sign |

The relevant territory is the Benelux.

**Visually**, the marks are similar to the extent that they coincide in the word element "ORAL". On the other hand, they differ in "-B" and "7".

**Aurally**, irrespective of the different pronunciation rules in different parts of the relevant territory, the pronunciation of the marks coincides in the sound of the word element "ORAL" present identically in both signs, and to that extent the marks are aurally similar. The pronunciation differs in the pronunciation of the letter "B" of the earlier mark and of the figure "7" of the contested sign.

**Conceptually**, both signs contain the word "ORAL" which means "related to the mouth" in French and in German, and which will also be understood as such by the Dutch-speaking part of the public due to its high proximity with the Dutch equivalent "Oraal". The other elements of the marks do not have any meaning. Given that both signs refer to the mouth, they are conceptually identical.

#### c) Distinctive and dominant elements of the signs

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The word "ORAL" present in both marks will be perceived by the entire relevant public as referring to the mouth. Given that all the goods at hand are oral care products, the Opposition Division considers that this element has a reduced distinctive character in relation to these goods. As such, it becomes a weak element of the signs and consumers will not pay as much attention to this element as to the other more distinctive elements of the marks. In the case at hand, consumers will therefore not pay so much attention to the common element "ORAL", as to the rest of

the marks, namely “-B” and “7”, which are meaningless with respect to the goods at issue.

**d) Distinctiveness of the earlier mark**

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness *per se*. Considering what has been stated above in section c) of this decision, the distinctiveness of the earlier mark must be seen as normal despite the presence of some non-distinctive or weak elements in the mark.

**e) Relevant public – level of attention**

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. 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.

In the case at hand, the goods are directed at the public at large.

**f) Global assessment, other arguments and conclusion**

The signs have been found similar and the goods are identical.

The opponent argues that the coincidences are placed in the initial part of the signs and are therefore highly relevant since consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. Though it is true that beginnings of trade mark are usually given a greater relevance in the assessment of the likelihood of confusion between two signs, the Opposition Division considers that in the present case, the fact that the coincidence is placed in the initial element of the signs is counteracted by the fact that this element has a low distinctive character with respect to the goods at hand.

The similarities between the signs affect the three aspects of the comparison however they lie in an identical element that has been deemed weak with respect to the goods at hand, and which will, as such, not be the main focus of the public's attention.

In identifying the origin of the respective oral care goods, the relevant public will not rely on the initial shared word “ORAL” but on the marks as a whole including the respective additional elements “B” and “7”.

As these additional, more distinctive elements of both marks, are altogether different, one being a letter and the other one a figure, and as they are combined with the initial element in a different manner (juxtaposed in one case, hyphenated in the other), the Opposition Division considers that the coincidence in the weaker element

is not enough to induce the relevant public to believe that one of the signs is a variant of the other and that the respective goods come from the same or economically-linked undertakings.

The opponent refers to what it considers previous analogous decisions of the Office to support its arguments. However it must be noted that the Office is not bound by its previous decisions as each case has to be dealt with separately and with regard to its particularities. This practice has been fully supported by the General Court which stated that it is settled case-law that the Community trade mark system is autonomous and, second, that the legality of decisions is to be assessed purely by reference to the CTMR, and not the Office's practice in earlier decisions. Accordingly, the Office is bound neither by national registrations nor by its own previous decisions (judgment of 30/06/2004, T-281/02, 'Mehr für Ihr Geld'). Additionally, it is considered that the cases mentioned bear no resemblance to this case since none involve signs coinciding in a weak element. Therefore they are not relevant to the present proceedings.

Regarding the established low distinctive character of the element "ORAL", the opponent indicates that there are no other active marks on the market containing this element, than its own and the applicant's. In this respect it should be clarified that this element has not been deemed weak because the public is used to seeing this element in relation to mouth care products but because of the fact that it intrinsically describes "something pertaining to the mouth".

Considering all the above, the Opposition Division finds that there is no likelihood of confusion on the part of the public, despite the identity of the goods. Therefore, the opposition must be rejected.

## **COSTS**

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Rule 94(3) and (7)(d)(ii) CTMIR, the costs to be paid to the applicant are the costs of representation which are to be fixed on the basis of the maximum rate set therein.



### **The Opposition Division**

Begoña URIARTE  
VALIENTE

Catherine MEDINA

Frédérique SULPICE

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 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 EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. Under Rule 94(4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.