

O-225-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2392932  
BY RAZA SYED TO REGISTER THE TRADE MARK  
WITCHCRAFT IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO 93936 BY EC DE WITT & COMPANY LIMITED**

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### BACKGROUND

1. On 27 May 2005 Raza Syed applied to register the trade mark WITCHCRAFT in Class 3 for a specification of goods which, after amendment during the course of these proceedings, reads “Eau de toilette, perfume, deodorant”.
2. On 24 November 2005 EC De Witt & Company Limited filed notice of opposition to this application raising objections under Sections 5(2)(b) and 5(3) of the Act on the basis of the following earlier trade marks:

No	Mark	Class	Specification
CTM 1656800	WITCH	03	Pads impregnated with witch hazel for cleansing of the skin and astringent purposes and liquid skin cleanser and astringent containing witch hazel.
		05	Medicated solid stick with witch hazel for treatment of irritated skin and medicated gel with witch hazel for treatment of irritated skin.
CTM 1656834		03	Pads impregnated with witch hazel for cleansing of the skin and astringent purposes and liquid skin cleanser and astringent containing witch hazel.
		05	Medicated solid stick with witch hazel for treatment of irritated skin and medicated gel with witch hazel for treatment of irritated skin.
UK 912985	WITCH DOCTOR	03	Cosmetics in the form of lotions, creams and of gels.
UK 912986	WITCH DOCTOR	05	Medicated preparations for use on the skin and scalp, all in the form of lotions, creams and gels.

UK 968265	WITCH STIK	05	Medicated preparations for use on the skin and the scalp, all in the form of solids and gels and all shaped as rods or sticks.
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3. The statement of grounds refers to the conceptual similarity between the marks and also invites the tribunal to take account of the fact that the opponent's earlier trade marks WITCH, that word in device form, WITCH DOCTOR and WITCH STIK constitute a family of marks with the element WITCH in common.

4. The applicant filed a counterstatement denying the above grounds. Both the statement of grounds and counterstatement contain what amount to submissions. I take these into account in reaching my decision.

5. Only the opponent has filed evidence. The matter came to be heard on 24 July 2007 when the opponent was represented by Giles Fernando of Counsel instructed by Murgitroyd & Co. The applicant was not represented at the hearing but filed written submissions under cover of a letter dated 20 July 2007 from Barlin Associates.

#### **Opponent's evidence**

6. David Fowler, the Marketing Director of EC de Witt & Company has filed a witness statement. He says his company is the manufacturer and distributor of personal care products including goods sold under the WITCH and WITCH DOCTOR marks. The goods are sold nationwide in large high street chains such as Tesco, Boots, Superdrug, Asda, Sainsburys, Safeway and Savers.

7. In particular the WITCH mark is said to have been in continuous use in the United Kingdom in relation to "pads impregnated with witch hazel for cleansing of the skin and astringent purposes and liquid skin cleanser and astringent containing witch hazel; medicated solid stick with witch hazel for treatment of irritated skin and medicated gel with witch hazel for treatment of irritated skin" since at least 1992. The WITCH DOCTOR mark has been in continuous use in the United Kingdom in relation to "cosmetics in the form of lotions, creams and of gels" since at least 1970. The goods are aimed at females in the age group 15 to 34.

8. The WITCH range is intended for everyday use for cleansing and moisturising the skin and the WITCH DOCTOR range is a more concentrated formula for use as the need arises. The earlier trade marks are applied to the goods, appearing on the front of packaging. Invoices showing use of the marks are exhibited at DF1.

9. Annual turnover under the WITCH mark is said to have been as follows:

<b>YEAR</b>	<b>£</b>	<b>UNITS SOLD</b>
2005	4,080,151	2,622,098
2004	4,607,354	2,960,584
2003	4,283,304	2,760,711
2002	3,460,931	2,308,003
2001	2,398,022	1,615,689

2000	1,040,021	636,998
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10. Annual turnover for goods sold under the WITCH DOCTOR mark is said to have been:

<b>YEAR</b>	<b>£</b>	<b>UNITS SOLD</b>
2005	628,907	511,614
2004	683,219	578,085
2003	743,277	625,248
2002	779,263	658,418
2001	825,857	693,106
2000	882,624	869,406

11. Annual expenditure on advertising and promotion has been:

<b>YEAR</b>	<b>£</b>
2005	405,058
2004	871,577
2003	1,228,422
2002	1,097,232
2001	2,300,291

12. The marks have been advertised in the press and on television. In 2003, the WITCH brand underwent a revamp accompanied by an advertising campaign, which included a TV campaign aired at peak times on nationwide television for four months. Exhibit DF2 contains copies of press releases and articles that accompanied this campaign.

13. Also exhibited, at DF3, are samples of invoices for the advertising space purchased by the opponent company showing that advertisements were run on national television channels such as ITV, Channel 4, Sky 1, UK Gold, E4, VH1 and on regional television channels such as Carlton, Central, LWTW, Scottish and Ulster.

14. A survey conducted in February 2004 by Capibus, after the advertising campaign in 2003 following the relaunch is said to have shown that 52% of a representative sample of 15 to 34 year female age group were aware of the WITCH brand. I observe that no further details of the survey have been supplied.

15. In the period 2002 to 2004, the WITCH brand had the following market share of the medicated skincare market, and was the number three leading brand based on market share:-

<b>Year</b>	<b>Total Market Value shares</b>	<b>Witch Brand Value Sales</b>	<b>Market Share</b>
2004	86,182,512	8,285,988	9.6%
2003	81,332,504	7,224,950	8.9%
2002	76,725,976	6,442,961	8.4%

16. Exhibited at DF4 are extracts from the [www.witchskincare.com](http://www.witchskincare.com) website illustrating use of the marks.

17. Mr Fowler says that items from the WITCH brand are often listed in beauty articles in magazines aimed at females in the 15-34 age group such as beauty magazines, Cosmo Girl, Cosmopolitan, Elle Girl, More!, Just 17, Company, Heat, Closer, Bliss, Sugar and Best. In addition, the WITCH brand is frequently referenced in articles in magazines aimed at an older target audience, such as Woman's Weekly, Black Hair & Beauty, Top Sante, Men's Fitness and Marie Claire, and nationwide newspapers and local papers such as The Times, Daily Mirror, Sunday Mirror and the Evening Herald. Exhibit DF5 contains examples of such articles.

18. The goods have also won the COSMO GIRL Kiss of Approval award in each of the years 2003 to 2006. Correspondence and an article relating to this award are exhibited at DF6.

19. Finally, in relation to the applicant's goods, Mr Fowler says:

"I consider the goods "perfume, eau de toilette, deodorants" are similar to the goods which are produced under the Earlier Trade Marks as many skin care manufacturers also produce such goods under the same mark as a skin care range. As my Company's range are naturally based products, formulated to refresh the skin, qualities which can apply equally to perfume, eau de toilette and deodorants, use of a similar mark on such goods would be seen as an extension of the range.

My company's competitors, such as DOVE and BODYSHOP, have ranges including deodorants and fragrance and I attach, at Exhibit DF7, extracts from the brands' websites evidencing this."

20. The opponent has also filed a witness statement by Eleanor Coates, a trade mark attorney with Murgitroyd & Company Ltd, its professional representatives in this matter. Much of her witness statement is in the nature of submission which I bear in mind but do not propose to record at this point.

21. Ms Coates exhibits two pieces of evidence directed at the issue of similarity of goods. The first, Exhibit EC1, is an extract from Collins Concise Dictionary giving a definition of the term 'cosmetic'. The second, Exhibit EC2, consists of extracts from the websites of a number of cosmetic manufacturers showing that they include the goods of the application in their cosmetics ranges.

22. That completes my review of the evidence.

### **Status of the preliminary indication**

23. The opponent's evidence and Mr Fernando's skeleton argument refer to the preliminary indication in this case and endeavour to build on and, where necessary, differentiate the position that was held to exist at that stage. The recent judgment of Mr

Justice Lindsay in *esure Insurance Limited and Direct Line Insurance plc*, [2007] EWHC 1557 (Ch), dealt with the status of preliminary indications (paragraphs 14 to 17 of the judgment). He concluded that:

“The Registrar’s view was arrived at before there was any evidence on either side, before there was any argument on either side and in a context in which it could not be regarded as a decision against the interests of either side without the prospective loser being given an opportunity to be heard, an opportunity which was not given. So far from it being an error of principle to fail to take the Registrar’s preliminary view into account, it would, in my judgment, have been a serious error of principle for it to have been taken into account.”

24. Accordingly, I intend to disregard the preliminary indication.

### **Section 5(2)(b)**

#### **The law**

25. Section 5(2)(b), the opponent’s primary ground of objection, reads as follows:

“(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (b) it is similar to an earlier trade mark and is to 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 with the earlier trade mark.”

26. In this case three of the registrations relied on by the opponent are subject to The Trade Marks (Proof of Use, etc) Regulations 2004, the relevant part of which reads:

#### **“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

27. In each case (that is to say nos. 912985, 912986 and 968265) the opponent’s statement of grounds claims use for all the goods of the registrations.

28. The counterstatement indicated that the applicant did not accept the statement of use in relation to the WITCH DOCTOR. In the written submissions it was suggested that any use has been restricted to “gels containing witch hazel for cleansing and moisturising the skin”. In relation to the mark WITCH STIK it was suggested that the

evidence was deficient with the result that I should find there had been no genuine use of this mark.

29. Mr Fernando responded to the applicant's written submissions by referring me to the approach and guidance adopted in *Extreme Trade Mark O-161-07* where Richard Arnold QC, sitting as the Appointed Person said, firstly in relation to distinguishing between mere assertion and statements made in narrative form by a witness with knowledge of the facts:

“31. Basing himself upon the first three sentences of the passage I have quoted from *MOO JUICE*, counsel for the applicant submitted (1) that a mere assertion of use of a trade mark by a witness did not constitute evidence of use sufficient to defeat an application for non-use, and (2) it followed that mere testimony from a representative of the proprietor was not enough and such testimony had to be supported either by documentary records or corroborated by an external witness. I accept submission (1) but not submission (2). Kitchin J's statement that “bare assertion” would not suffice must be read in its context, which was that it had been submitted to him that it was sufficient for the proprietor to give evidence stating “I have made genuine use of the trade mark”. A statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark has been used would not in my view constitute bare assertion. As counsel for the applicant accepted, it might not be possible for a trade mark proprietor to produce documentary evidence: for example all the records might have been destroyed in a fire. In such circumstances I do not see anything in either the Directive, the 1994 Act or the 2000 Rules which would require the proprietor to adduce evidence from an external witness (which is not to say that it might not be advisable for the proprietor to do so).”

and secondly in relation to unchallenged evidence:

“33 *Phipson on Evidence* (16<sup>th</sup> ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil case as it does in criminal. In general the CPR does not alter that position.

This rules [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficult in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the



Court of Appeal in *Markem Corp v Zipher Ltd* [205] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.
36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.
37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark* (O/068/07). Another recent example is *Scholl Ltd's Application* (O/199/06). I consider that hearing officers should guard themselves against being beguiled by such submissions (which is not, of course, to say that they should assess evidence uncritically)."

30. Mr Fowler is Marketing Director of the opponent. As such he is clearly in a position of authority and knowledge. He has held his position since 13 October 1997 and is thus in a position to comment on trading in the relevant timeframe. There is nothing "obviously incredible" about his evidence.

31. He gives an account of the lengthy history of the brand, the sales made and the number of units sold. The opponent enjoys a substantial share of the market in medicated skincare preparations. I do not accept that it is appropriate to restrict the specification to the extent suggested by the applicant. Exhibit DF4 (which in terms of dates shows a © 2004 symbol) clearly indicates that the WITCH DOCTOR product is offered in lotion as well as gel form and for skin treatments. I accept that the products

are likely to contain witch hazel. In *Reckitt Benckiser (Espana), SL v OHIM*, Case T-126/03 it was held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

32. In that case the CFI found that the OHIM Board of Appeal had incorrectly held the earlier trade mark to be registered solely for a “product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)”. The relevant sub-category of goods could be adequately captured in the term polish for metals. Having regard to the use shown, Mr Fowler’s evidence and the applicant’s submissions it would be appropriate to consider the opponent’s use as being in respect of skincare preparations. I see no need to further restrict in terms of form (lotions, creams, gels etc) or ingredient (witch hazel). That approach also seems to me to be consistent with the Court of Appeal’s guidance in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] R.P.C. 32 to the effect that the court should inform itself of the nature of the trade and then decide how the notional consumer would describe such use.

33. The position in relation to the WITCH STIK is rather less clear as it is not separately dealt with in Mr Fowler’s evidence. However, for reasons which will emerge below I do not consider that it adds materially to the opponent’s case.

## The principal authorities

34. An objection under Section 5(2)(b) requires me to consider whether there are similarities in the marks and similarities in the goods and services that, cumulatively, lead to a likelihood of confusion. The leading guidance from the European Court of Justice is contained in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

35. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*; paragraph 22
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & C. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG and Adidas Benelux BV* paragraph 41;

- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

36. Mr Justice Lindsay has recently given a very full consideration to issues of similarity and likelihood of confusion in *esure Insurance Limited and Direct Line Insurance plc* [2007] EWHC 1557 (Ch). He considered, inter alia, whether there was a threshold to be crossed before marks (and goods or services) could be considered similar.

37. He said:

“..... I would hold there to be some form of threshold, albeit a low one. In a case such as the one before me, the threshold, in my judgment, is arrived at as follows. First, overall impressions of the rival marks are formed, paying full regard to all the requirements of the autonomous concept of 4(1)(b) similarity. Next one has to have in mind the types of confusion which are then relevant, namely (as I shall come on to below) those identified in *Sabel* supra at its para 16. Then the threshold question arises: are those overall impressions such that one can reasonably say that a likelihood of confusion could not thereby be created?” (paragraph 46)

and

“Once that low threshold test I have described is passed then the fact-finder is, in my judgment, obliged to go on to consider whether, in consequence, there is a likelihood of confusion – see *Soffass* para 31. That is not to say that any party can safely decide to assert no more, as to similarity, than that so low a threshold has been exceeded because similarity and the likelihood of confusion are so inter-related that proof of a higher degree of similarity may conduce to a greater willingness in the fact-finder to hold that there is, on the facts, a likelihood of confusion.” (paragraph 48).

### **Similarity of goods**

38. Against the above background I go on to consider the respective sets of goods. In assessing the similarity of the goods and services concerned, all the relevant factors relating to those goods and services should be taken into account. Such factors include *inter alia* their nature, intended purpose and method of use, and also whether they are in competition with each other or are complementary (see judgment of the European Court of Justice in, *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, Case C-39/97). Further factors include the users and their pertinent distribution channels and sales outlets (see *Ampafrance v OHIM*, Case T-164/03).

39. The applicant’s written submissions also refer to *British Sugar plc v James Robertson & Sons Limited* [1996] R.P.C. 281 where it was said that “when it comes to

construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade.”

40. The applicant’s submissions based on the opponents’ CTM registrations point to the fact that ‘pads’ or ‘medicated solid sticks’ are different in form to the applicant’s goods which would be in the form of a spray, liquid or lotion. The intended purpose is cleaning of the skin rather than fragrancing. Their method of use/application differs. Nor, in the applicant’s view are they in competition with each other or complementary. It is conceded that they may be sold through the same trade channels but it is unlikely that they would be sold side by side.

41. Similar considerations are said to apply in relation to the goods of the opponent’s UK registrations but that, of course, is based on a narrower interpretation of use than I have allowed above. The written submissions reiterate that there is a distinction between products for the beautification of the skin or body (a cosmetic function) and products with a fragrancing function.

42. Mr Fernando submitted that all the goods in issue were to enhance attractiveness and that the applicants’ goods were natural brand extension areas. I will come onto this latter point below having first considered the respective sets of goods against the guidance contained in the cases referred to above.

- (i) nature - all the goods, be they perfumery items, deodorants or skincare preparations are products formulated from synthetic or naturally occurring substances for use on the person. The physical nature of perfumes and eau de toilettes is generally different to the opponent’s skin care preparations (to take the term used by Mr Fernando which most neatly encapsulates its goods). The former will be in spray, liquid or lotion form (as submitted by the applicant). Skin care preparations may be in a variety of forms including pads, washes, sticks, powders, creams etc. DF4 shows that they may also be in lotion form which suggests some overlap at the margins with the expected form of the applicant’s goods which it is acknowledged would include goods in liquid or lotion form. Deodorants also occur in a variety of forms including sprays and stick applications that again points to some overlap with the opponent’s goods which also include products in stick form.
- (ii) intended purpose - the competing goods fall into the general category that they are for personal grooming and beautification purposes. They differ in that perfumes and eaux de toilette are primarily fragrancing products (and deodorants partially so), whereas skin care preparations and cosmetics generally are applied to improve or change the physical appearance of the face or body either through a cleansing function or an adornment one.
- (iii) method of use - this will largely be determined by the form the products take as mentioned above but all are in general terms for physical application to the face or body.

- (iv) in competition or complementary? - I cannot see that the respective goods are in direct competition with one another. As regards complementarity it has been held in *Mühlens GmbH & Co KG v OHIM*, Case T-150/04, that even goods whose nature, purpose, and method use are different may be functionally and/or aesthetically complementary in the eyes of the relevant public. The issue in that case involved perfumery products on one side and bags and clothing on the other. The Court held:

“36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No. 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR ii-685, PARAGRAPHS 60 and 62).

37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (*SISSI ROSSI*, paragraph 63).”

In relation to the goods I have to consider there appears to be no or minimal functional complementarity but there is likely to be some aesthetic complementarity for reasons discussed below in considering brand extension.

- (v) distribution channels/sale outlets - the applicant partially concedes an element of commonality here. From my own (probably imperfect) knowledge and experience there is no single model as to how perfumes and skincare preparations (cosmetics) are sold. In some retail outlets they occupy their own discrete areas (i.e. perfumes sold in a different area to skincare preparations) but in, for instance, department stores products may be grouped by manufacturer with the full range of that manufacturer's goods offered in one place. But even that is probably an oversimplification and I am aware that it is not unusual for combination or gift set packs to be offered containing both perfumes and other cosmetic items. I consider that there is some overlap in sales outlets.
- (vi) users - the opponent has a clear target market of females in the 15-34 age group, though in practice I imagine it would be happy to sell to anyone, a position that is confirmed by Mr Fowler's evidence to the effect that the WITCH brand is frequently referred to in articles in magazines aimed at an older target audience such as *Woman's Weekly* along with national and local papers. I have no reason to suppose that

the applicant targets a radically different set of consumers. Even if the respective audiences are not co-extensive it is reasonable to assume that they will overlap in terms of consumers.

43. Before drawing conclusions in relation to similarity I need to consider the opponent's evidence and submissions on brand extension. Mr Fernando put his case on the basis that strictly it is not necessary to adduce evidence about the expectations and shopping habits of consumers. It was in his submission, common knowledge that manufacturers of skin care preparations under a particular brand also produce deodorants and perfumes under the same brand as part of what is commonly known as brand extension. In this case there is also the evidence of Ms Coates (paragraph 6 and Exhibit EC2) and Mr Fowler (paragraph 12 and exhibit DF7) to support and illustrate the point.

44. I accept that these exhibits show that certain traders offer both skincare preparations and perfumes and deodorants. Moreover, in the case of Dove, brand extension from skincare products into deodorant lines was one of its earliest developments in the UK (in 2001). Mr Fernando attached particular importance to the Dove evidence because exhibit DF7 claims that 35% of the population bought a Dove product in 2004. His point was that the activities and behaviour of a market leader is likely to have a particular influence in fashioning consumer perception and expectation.

45. Even so, the brand extension argument can be taken too far. The mere fact that a number of leading cosmetic houses such as Estée Lauder, Clarins and Chanel, along with a large retailer such as the Body Shop, offer a wide range of perfumery and cosmetic items does not necessarily mean that consumers have a general expectation that there will be brand extension and cross-over trade amongst the generality of traders in what is after all a very large and diversified market. I would prefer to put the matter negatively by saying that at least consumers would not be surprised to find brand extensions in this area of trade.

46. It will be clear from the above analysis that I consider there are points of similarity as well as points of difference in the respective sets of goods. But consumers are unlikely to compartmentalise the market to the extent that applicant's submissions invite me to accept. Rather, they will in my view regard the respective goods as part of a product continuum for personal grooming and beautification purposes. Taking the matter in the round the similarities outweigh the differences.

### **Similarity of marks**

47. The comparison is between WITCHRAFT and the opponent's marks WITCH, that word in slightly stylised form, WITCH DOCTOR and WITCH STIK taken individually. I must take account of visual, aural and conceptual similarities and differences. In use both the plain word and the stylised version are apparent. In what follows I will consider the matter primarily on the basis of the word only mark.

48. Self evidently, the applied for mark incorporates the whole of the mark WITCH but it is a much longer word. The same considerations come into play from a phonetic standpoint. Conceptually WITCH is likely to be understood to mean a female person who practices magic or sorcery. WITHCRAFT is the art or power of bringing magical

power to bear (Collins English Dictionary). As it is the power exercised by a witch there is a strong conceptual association between the marks. I do not forget that WITCH may also be taken to allude to an ingredient in the opponent's products (witch hazel). There is some evidence that this feature of the products is advertised to potential consumers (see DF4) but not universally so on the evidence of DF5. On the other hand it has not been suggested that WITCH is recognised as short form for witch hazel. To the extent that it alludes it does so without in my view losing the underlying natural meaning of the word witch.

49. The European Courts have held that conceptual differences may be sufficient to counteract visual and aural similarity where at least one of the marks has a clear and specific meaning so that the public is capable of grasping it immediately (see *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01 and *Ruiz-Picasso and Others v OHIM*, Case C-361/04 P). Where the marks in question have a strong conceptual linkage it is likely to point to the opposite effect. I find that to be the case here. That finding is also broadly applicable to the stylised version of the WITCH mark.

50. The 'witch' theme is continued in the mark WITCH DOCTOR. One of the meanings of the term is someone who hunts witches though perhaps it is better understood as simply a shaman, someone who, like a witch, is held to possess magical powers. I find it to have a lower degree of similarity to WITCHCRAFT than the word WITCH solus but it is best considered further in the context of the family of marks argument dealt with below.

51. The final mark is WITCH STIK which Mr Fernando suggested was another play on the 'witch' theme. That seems to require the element STIK to be read as if it is a reference to 'broomstick'. As this mark is used in relation to products in stick form it seems to me that it is this meaning that is likely to present itself most readily to consumers that is to say a stick product from the WITCH brand rather than a reference to broomstick.

### **Distinctiveness/reputation**

52. Mr Fernando accepted, as I think he was bound to do, that on the basis of the evidence most if not all of the opponent's goods contain witch hazel. I would go further and say that the presence of this ingredient is a factor that is pointed out to potential customers at least on the opponent's website and to some extent in the DF5 exhibits. No actual examples of products are exhibited. A number of the exhibits do however show pictures of the products from which the brand itself is visible but generally speaking not sufficient of the small print to be able to say whether the presence of witch hazel is always referred to on the product containers themselves (in a few instances I can see that it is).

53. On balance I think it is a fair reading of the evidence, including the way the opponent promotes its products, to conclude that a significant proportion of consumers will be aware that the products contain witch hazel. If that is the case then the word WITCH, albeit that it has not been shown to be shortform for witch hazel, is nevertheless a clear allusion to that ingredient. If the matter rested on the prima facie qualities of the word I would hold that it was of relatively weak distinctive character.



54. It is now well established that acquired distinctiveness must also be considered (see (f) of the above criteria). The applicant put the opponent to proof of its reputation. Its written submissions refer me to *Steelco Trade Mark*, O-268-04, which I accept as providing appropriate guidance on how to approach the question of distinctiveness acquired through use. David Kitchen QC (as he then was), sitting as the Appointed Person said:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr Thorley Q.C. in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors* EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and must be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

55. The recognition of the earlier trade mark on the market is, therefore, a factor to be taken into account but it does not mean that the mark must have household name status. I also note from the above that acquired distinctiveness may be of particular relevance in the case of marks that have limited inherent qualities because they are descriptive or allusive.

56. Mr Fowler’s unchallenged evidence is that there has been extensive advertising in both the press and on television. The latter includes both national and regional stations. The Capibus survey conducted in February 2004 showed a 52% product awareness within the target consumer group of females in the 15 to 34 age group. I have not been shown details of the survey so cannot say whether this was a prompted or unprompted response rate. Either way it suggests significant market awareness. Furthermore, based on the figures given by Mr Fowler in paragraph 7 of his witness statement the WITCH brand enjoyed a near 10% share of the medicated skincare market in 2004 and is said to have been the number three leading brand on this measure. There is also the very extensive magazine listings and articles in exhibit DF5 and the awards referred to at DF6.

57. I have little hesitation in concluding that this is a case where a mark of moderate inherent qualities has been elevated through use to being a fully distinctive one. I have

not been given market share figures for the opponent's non-medicated skincare products. It is reasonable to assume that the opponent's cosmetic skincare products will have benefited from the standing in the market enjoyed by the medicated equivalents. The dividing line between them is likely to be a fine one (turning on the strength of the formulations) and most of the advertising appears to relate to non-medicated products.

58. Rather different considerations apply in relation to the mark WITCH DOCTOR which in my view is an inherently stronger mark than WITCH solus. It too has been used on a significant scale and has been around for rather longer (than WITCH solus) with use having commenced in the UK in 1970.

59. The position on WITCH STIK is less clear. No separate sales figures have been given. Mr Fowler does not develop the claim in relation to this mark. As I have already indicated it seems likely that consumers will simply see this as a stick product from WITCH (and treat the misspelling as being not untypical within the context of advertising usage). In other words it is probably best considered as simply a variant use of the WITCH brand rather than a separate mark such as WITCH DOCTOR.

### **The family of marks case**

60. It is fair to say that Mr Fernando did not press the family of marks point relying instead on what he considered to be the strength of the core WITCH brand. The applicant's position in its written submissions is that the opponent does not have a family of marks and that its own mark must be considered against the earlier trade marks taken separately. In relation to the latter point the applicant relies on *Ener-Cap Trade Mark* [1999] R.P.C. 362.

61. More recently, it has been held in *The Infamous Nat Co Ltd's Trade Marks*, [2003] R.P.C. 7 that:

“35 It is impermissible for s.5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

36 Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by s.6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] R.P.C. 362).

37 In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent *AMOR* [ARMOR] Decision no. 189/199 of the Opposition Division, OHIM O.J. 2/2000, p.235”.

62. Thus, a family of marks claim can be run where it is shown that the opponent has used a number of marks incorporating a common element.

63. Mr Fernando's skeleton argument suggested, in the context of the family point, that in addition to WITCH solus use had been shown of WITCH DOCTOR, WITCH FOAMING FACE WASH, WITCH CLEANSING WIPES and WITCH STICK. It seeks to me that the second and third of these marks cannot contribute to a family claim. They simply represent the WITCH brand being used in association with the name of the goods (they are also not separately registered marks and in any case did not form part of the pleaded case). Likewise the fourth mark (strictly as registered it is STIK) which is simply the use of the core brand with an indication that the product is in stick form.

64. That leaves the mark WITCH DOCTOR. There is some substance to the opponent's claim that there has been lengthy and extensive use of the mark. It is in fact used on a more concentrated formulation of the basic products. It is true that there are fewer examples of this mark in use but there is invoice evidence in DF1 and website material at DF4 in support of the claims in Mr Fowler's witness statement. Its use goes back to 1970. I accept the 'family' argument to this limited extent.

### **The average consumer and circumstances of trade**

65. I have already commented on the profile of the average consumer for products of the kind at issue in this case. Cosmetics and perfumery items can vary considerably in price. The level of care exercised by consumers in purchasing such goods will vary accordingly. Goods of this kind can be purchased from a variety of outlets. In the case of the opponent this includes the leading supermarket chains as well as major high street retailers such as Boots and Superdrug. The applicant has not said how he intends to trade. In the absence of evidence to the contrary I take the view that perfumes, deodorants and cosmetics/skincare preparations are purchased primarily on the basis of a visual inspection of the goods though there may be some word of mouth recommendations or requests including where such goods are being bought as presents. On the whole visual considerations outweigh oral/aural ones.

### **Conclusions on likelihood of confusion**

66. In *esure Insurance Limited and Direct Line Insurance plc* (supra) Mr Justice Lindsay reviewed the case law on likelihood of confusion. He noted the distinction that is to be drawn between direct confusion, where the public confuses the sign and the mark in question, and indirect confusion where the public does not mistake one mark for the other but makes a connection between them and as a consequence is confused into thinking they have a common trade source. These situations are to be distinguished from mere association where the public connects the mark and the sign (a bringing to mind) but is not led to make any inferences as to a common trade origin.

67. What is required is not confusion itself, which cannot in any case have occurred if the applied for mark is unused, but a likelihood of confusion. The judge went on to say in this regard that:

“A “likelihood” is not a probability; the requirement is less stringent than that. Learning from a quite different area of the law suggests that where “likelihood” is unqualified by other words (e.g. “more likely than not”) then it requires no more than that there is a real prospect that the material consequence – here

confusion – should exist – consider *In re Harris Simons Construction ltd* [1989] 1 WLR 368 per Hoffmann J. and the cases cited in the 2007 White Book at note 24.2.3. Such a view would seem also to accord with the fact that in its German form the corresponding requirement of the Directive is that there need be only a “risk” of confusion – see the Advocate General in *Sabel* at p I-6195.” (paragraph 56).

68. The marks at the heart of this case, WITCHCRAFT and lined up against it WITCH and WITCH DOCTOR, are well known words of the language. I think it unlikely that, despite the common element, consumers would confuse the applied for mark with either of the opponent’s marks or imperfectly recollect them to that extent. I, therefore, rule out direct confusion.

69. I have held that the opponent enjoys a significant reputation particularly in the skincare market. That reputation had its origins in medicated skincare products (and the opponent still enjoys a significant market share and position in that market) but extends into the cosmetic skincare market. It is clear from *Marca Mode* that the mere existence of a reputation does not give grounds for presuming a likelihood of confusion simply because an association is made between the earlier trade mark(s) and the mark applied for. But if the association that is made induces the public to think that products offered for sale under the new mark come from the same or an economically linked trade source then the claim under Section 5(2)(b) will have been made out.

70. I have come to the conclusion that, in the light of the strong conceptual association between WITCH and WITCHCRAFT, coupled with the reputation attaching to the former and the rather greater similarity between the goods than I think the applicant’s written submissions allow, there is a likelihood of confusion. It arises because the relevant public will assume that goods sold under the mark WITCHCRAFT represent an extension in trade of the WITCH brand.

71. That finding in itself is sufficient to determine the opposition. However, the opponent’s position is further strengthened if the family of marks claim is brought into the equation (though my decision does not rely on it). It serves to reinforce in consumers’ minds that there is already a variation on the WITCH theme in the market place but coming from the same trade source. Consumers would in these circumstances consider that the opponent was using another WITCH suffix mark to indicate an extension of the basic brand into a related area of trade.

72. I note that the applicant’s written submissions say that there is no evidence that the opponent has an exclusive reputation in trade marks containing the word ‘Witch’ and that, accordingly, there is no reason the opponent’s rights should extend to the goods of the application. If there were, indeed, other traders in the relevant market place using marks consisting of or containing the word ‘witch’ then it might have been a persuasive indication that the public has been educated to distinguish between them in trade origin terms. It was for the applicant to demonstrate that that was the position. It has not done so. The opposition succeeds under Section 5(2)(b).

### Section 5(3)

73. This is in effect an ‘in the alternative’ ground. In the light of my finding under Section 5(2)(b) I do not need to deal at length with this further.

74. As now amended Section 5(3) reads:

“5.-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

75. A useful summary of the factors to be considered in relation to Section 5(3) can be found in *Mango Sport System S.R.L. Socio Unico Mangone Antonio Vincenzo v Diknah S.L.* [2005] E.T.M.R. 5.

76. I have little doubt that the opponent here passes the threshold test for reputation that is required to get a Section 5(3) case off the ground. There is no requirement that an opponent must establish a likelihood of confusion under this head and I recognise that the adverse consequences envisaged by the Section are expressed in terms of unfair advantage and detriment rather than likelihood of confusion. However, where it has been held that the similarities between marks and goods are such that there is a likelihood of confusion it is difficult to imagine circumstances where there would not also be an unfair advantage accruing to an applicant (assuming as here that the reputation is in relation to broadly the same goods that were considered for Section 5(2) purposes). This would arise because the effect of confusion is that consumers would be attracted to the applicant’s goods believing them to emanate from the opponent having regard to the reputation enjoyed by the latter. That is a form of piggy-backing that Section 5(3) is intended to prevent. It follows that the opposition would also succeed under this head.

## **COSTS**

77. The opponent has been successful and is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £2000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 9th day of August 2007**

**M Reynolds  
For the Registrar  
The Comptroller-General**