

O-309-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2364976  
BY UNILEVER PLC  
TO REGISTER THE TRADE MARK:**

**ENERGY GLOW**

**IN CLASS 3**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92885  
BY NAZIH TRADING LLC**

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by Unilever Plc  
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by Nazih Trading Co LLC**

### INTRODUCTION

1) On 4 June 2004 Unilever Plc, which I will refer to as Unilever, filed an application to register the trade mark **ENERGY GLOW**. The application was published for opposition purposes in the *Trade Marks Journal* on 13 August 2004 with the following specification:

*soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.*

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 21 October 2004 Nazih Trading Co LLC, which I will refer to as Nazih, filed a notice of opposition to the application. Nazih is the owner of Community trade mark registration no 2214526 of the trade mark:

**ENERGY  
COSMETICS**

The application for registration was made on 9 May 2001 and the trade mark was registered on 10 July 2002. It is registered for the following goods:

*washing preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, cosmetic dyes, hair colorants, shampoos, gels, hair lacquers and nail varnish, dentifrices.*

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Nazih claims that the respective trade marks are similar and that the respective goods are identical or similar. Consequently, registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) Unilever filed a counterstatement. It denies that the respective trade marks are similar. Unilever states that there are a large number of trade marks on the register which consist of the word ENERGY together with added matter. Printouts of details of ten such registrations are attached, as well as two printouts of details of two registrations for the trade mark ENERGYS. Unilever claims that, consequently, Nazih cannot claim a monopoly in all trade marks containing the word ENERGY in relation to class 3 goods. Unilever states that the words GLOW and COSMETICS are phonetically, visually and conceptually different and, therefore, the totality of its trade mark is distinguishable from that of Nazih. Unilever also states that the trade mark examiner when examining its application did not consider the respective trade marks to be similar.

5) Both sides filed evidence. The evidence is in the form of witness statements by the trade mark representatives of the sides. The witness statements consist essentially of submissions rather than evidence of fact. Consequently, I will not give a summary of the comments of the witness statements but I will take into account the comments therein in reaching my decision.

6) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing or filed written submissions; although as stated above their evidence is in effect submission.

## **DECISION**

### **Likelihood of confusion – section 5(2)(b) of the Act**

7) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

The trade mark the subject of registration no 2333976 is an earlier trade mark as per section 6(1)(a) of the Act<sup>i</sup>

### **Average consumer and nature of purchasing decision**

8) The respective goods are everyday goods, they are goods that could be very cheap and bought without a great deal of consideration; they might be sold in a prestige department store or from a market stall. I consider that the public at large is the average consumer. The goods could well be bought with little care and consideration, although I take into account that the average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant<sup>ii</sup>”. They are goods that could be bought in a supermarket dash; they are not goods by their nature which require a careful and educated purchasing decision. The degree of attention that is taken in the purchasing will have an effect on the extent that imperfect recollection is relevant; the lesser the attention, the greater the effect of imperfect recollection.

### **Comparison of goods**

9) Unilever has not commented upon the claim that the respective goods are identical or similar. I consider that it is clear that the respective goods are identical or highly similar.

### **Comparison of trade marks**

10) The trade marks to be compared are:

**Trade mark of Nazih**



**ENERGY  
COSMETICS**

**Trade mark of: Unilever**

**ENERGY GLOW**

11) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>iii</sup>. 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<sup>iv</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>v</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>vi</sup>.

12) COSMETICS will be seen as a descriptor of the goods of the earlier registration. The distinctive and dominant element of Nazih’s trade mark is the word ENERGY. I have no evidence before me as to the descriptiveness of either the words ENERGY or GLOW and

so consider that each element of Unilever's trade mark has equal dominance and distinctiveness. (State of the register evidence has been attached to the counterstatement. However, this neither shows what is happening in the market place nor that ENERGY has a meaning for the goods of the respective trade marks<sup>vii</sup>. ENERGY certainly has no obvious meaning in relation to the goods.) I consider that for the relevant public that the two trade marks are partially identical in relation to one relevant aspect, the presence of the word ENERGY<sup>viii</sup>; consequently the trade marks must be considered to be similar.

## **Conclusion**

11) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>ix</sup>. In this case the goods are either identical or highly similar. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion<sup>x</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xi</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods 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<sup>xii</sup>. Unilever has argued that ENERGY is not distinctive for the class 3 goods of one particular undertaking. It has put in no evidence in relation to this, it has just attached details of a number of trade marks that include ENERGY with its counterstatement. I have commented upon this state of the register evidence above. ENERGY has no obvious meaning in relation to the goods of the earlier registration; these are not goods that impart energy. Nazih's trade mark has a presumption of validity<sup>xiii</sup>. I consider that Nazih's trade mark has a reasonable, if not necessarily enormous, degree of inherent distinctiveness. I consider that the distinctiveness must rest squarely with the presence of the word ENERGY, I cannot see that the get-up or the presence of COSMETICS could give distinctiveness to a non-distinctive word. Unilever claims that Nazih cannot claim a monopoly in the word ENERGY. The question as to whether one party can appropriate to itself the word ENERGY is not relevant to my considerations<sup>xiv</sup>. Unilever's approach is one based on disregarding the similarity of the trade marks in favour of one based on the distinctive character of the earlier trade mark; an approach that has been rejected by the European Court of Justice<sup>xv</sup>. Unilever's trade mark includes the word GLOW as well as the word ENERGY, I do not consider that the presence of GLOW would be sufficient for the relevant public to distinguish the trade marks; I must consider the respective trade marks in their entireties. In my view, the relevant public would be likely to consider that, at the very least, the goods sold under the respective trade marks came from the same undertaking or economically linked undertakings<sup>xvi</sup> and so there must be a likelihood of confusion.

12) Reference to the preliminary indication has been made by the parties. I am obliged to take no account of the preliminary indication in reaching my decision<sup>xvii</sup>. Nazih considers that Unilever should be punished in costs for not accepting the preliminary indication. The preliminary indication is there to assist parties, it is not a stick with which to beat one side or the other. To punish parties for not accepting preliminary indications would be to effectively give them a legal status that they do not enjoy. I will make no adjustment of the award of costs in relation to the preliminary indication. Unilever refers to the fact that a citation was not raised at examination stage. This tells me nothing about the likelihood of confusion, all it tells me that a particular examiner on a particular day did not raise a citation.

**13) The application is refused in its entirety.**

### **COSTS**

14) Nazih has been successful and is entitled to a contribution towards its costs. As I have stated the “evidence” furnished was effectively submission, consequently, the contribution that I have awarded in relation to the evidence is effectively for the furnishing of written submissions. Nazih has requested its costs in full; there is nothing in this case that suggests that I should depart from the standard scale of costs.

15) I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Evidence	£200
<b>TOTAL</b>	<b>£900</b>

I order Unilever Plc to pay Nazih Trading Co LLC the sum of £900. 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 22<sup>nd</sup> day of October 2007**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”.

<sup>ii</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>iii</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>iv</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>v</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>vi</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>vii</sup> See *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 and *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 re state of the register evidence.

<sup>viii</sup> *Koipe Corporación SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-363/04:

“98 It must also be recalled that, according to case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 30, and Case T-168/04 *L & D v OHIM – Sämann (Aire Limpio)* [2006] ECR II-0000, paragraph 91).”

<sup>ix</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>x</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>xi</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>xii</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

<sup>xiii</sup> Article 95 of Council Regulation 40/94 of December 20, 1993.

<sup>xiv</sup> In *Koipe Corporación SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-363/04 the Court of First Instance held:

“83 However, OHIM submits that a single competitor cannot exclusively appropriate to itself the representation of a woman. The question whether the elements which make up a trade mark may be freely used by other competitors does not form part of the examination of the distinctive character of the figurative elements of a trade mark (see, by way of analogy, Case C-329/02 P *SAT.1 v OHIM* [2004] ECR I-8317, paragraph 36). The only relevant issue in that examination is whether the sign examined is distinctive or not, a question which, as regards the seated woman, OHIM has already answered affirmatively.”

<sup>xv</sup> *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-235/05 P:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

<sup>xvi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

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<sup>xvii</sup> Lindsay J in *esure Insurance Limited v Direct Line Insurance plc* [2007] EWHC 1557 (Ch):

“17. As a subsidiary argument, esure argues before me that the Hearing Officer was wrong to reject the Registrar's preliminary view in the way that he did. Mr Hobbs, drawing attention to the Rules to which I have referred and also to Article 6 ECHR, argues that the Hearing Officer was right in doing as he did. I have no doubt but that the Hearing Officer was right to do as he did. 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.”