

O-177-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2490793  
BY PORTSTABLE LIMITED  
TO REGISTER IN CLASSES 3, 4, 5, 16, 24, 25 & 35 THE TRADE MARK:**

**SO ORGANIC**

**AND**

**OPPOSITION THERETO (NO 99297) BY  
DEBONAIR TRADING INTERNATIONAL LDA**

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**In the matter of application 2490793 by Portstable Limited  
to register in classes 3, 4, 5, 16, 24, 25 & 35 the trade mark: SO ORGANIC**

**and**

**Opposition thereto (no 99297) by Debonair Trading International Lda**

### **The background and the pleadings**

1) So Organic Limited ("Sol") filed an application for registration on 10 June 2008. The application was published in the Trade Marks Journal on 24 April 2009. The mark sought to be registered consists of the words SO ORGANIC. Registration is sought in respect of various goods and services in classes 3, 4, 5, 16, 24, 25 & 35, but the only ones relevant to this opposition are certain goods in class 3, and all of the goods sought to be registered in class 25, namely:

**Class 3:** Soaps, essential oils, cosmetics, deodorants, toiletries, beauty products; bleach and bleaching preparations included in Class 3; perfumes, colognes, fragrances, eau de toilette; hair lotions; dentifrices, toothpaste; preparations for the body, hair, scalp, skin, eyes and nails; makeup; lipstick, lip gloss, lip balms, lip liner, lip colour, lip contour, nail care preparations; nail enamel, nail colour; foundation, face powder, blush; mascara, eyeliner, eye shadow; moisturising creams, lotions, cleansers, serums and toners, facial masks, face creams; body creams; talc; anti perspirants; body lotions; creams; emulsions; hair care products, shampoo, conditioner, hair gel, hair colour, hair mousse; eye makeup; depilatories; cotton sticks for cosmetic purposes; pumice stones; cosmetics and skin care products, namely, foundation, concealer, mascara, eye shadow, eye and/or brow liners, lipstick, lip liner, lip balm, face powder, bronzer, blusher, moisturisers, make-up remover; non-medicated body powder; bath gel, bath oils, bath salts, bath beads, and bath fizzies; scented room fragrances, incense sticks, potpourri and sachets; all being organic.

**Class 25:** Clothing, footwear and headgear; clothing for babies and children; footwear for babies and children; headgear for babies and children; all being organic.

It should be noted that after the hearing that subsequently took place before me, Sol assigned its mark to a company called Portstable Limited ("Portstable"). Portstable have had sight of the claims and evidence filed in the proceedings and make no suggestion that it does not stand by them. Portstable also accepts the liability/benefit of any costs award I may make. Portstable stand, therefore, as the

applicant in these proceedings, but the decision that follows will still refer primarily to Sol because it was its evidence and claims that are being considered.

2) On 10 July 2009 Debonair Trading International Lda (“Debonair”) opposed the registration of the application. It opposes only the goods identified above. The opposition is under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 (“the Act”). One of the earlier marks (Community trade mark 485078 for the mark “SO...?”) relied upon by Debonair is subject to the requirement to prove that it has been used<sup>1</sup>, the others are not. The table in the annex to this decision sets out the details of Debonair’s earlier marks/signs and the grounds and claims made in respect of them. For summary purposes, the earlier marks/signs are:

Earlier marks:

SO...?  
SO...? SUPERSTAR  
SO...? SENSUAL  
SO...? SEXY  
SO...? SINFUL  
SO...? KISS ME  
SO...? WHAT  
SO...? WILD  
SO...? CHIC  
SO...? CONNECTED  
SO...? DESIRABLE  
SO...? INSPIRED  
SO...? LUXURIOUS  
SO...? HERE  
SO...? ONE

Earlier signs:

SO...?  
SO CHILLED  
SO COSMETICS  
SO...? DESIRABLE  
SO...? ETERNAL  
SO...? EXCITING  
SO HIM  
SO...? INSPIRED  
SO...? INTO THE NIGHT  
SO...? KISS ME ALL OVER  
SO MAX  
SO...? ON THE BEACH  
SO...? ON THE WILD SIDE

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<sup>1</sup> The requirements relating to proof of use are contained in section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004.

SO...? SHOP TO YOU DROP  
SO...? SINFUL  
SO...? SUPERSTAR  
SO...? KISS ME  
SO...? WHAT  
SO...? WILD  
SO...? WITH A TWIST

3) Debonair claims that the word SO will be the element recalled by the average consumer in its marks and the applied for mark. It also claims that it has used its marks and that confusion is even more likely because of its family of SO based marks.

4) Sol filed a counterstatement denying the grounds of opposition. Sol asked Debonair to provide proof of use in respect of the mark subject to the proof of use requirement and it also put Debonair to proof on its claims as to possession of a reputation/goodwill. Sol claims that the word SO in its mark is non-distinctive. It also argues that it has its own reputation through trade conducted in the UK since 2004; Sol claims that there have been no instances of confusion.

5) Both sides filed evidence. A hearing took place before me at which Sol were represented by Mr Tom Farrand of Harrison Goddard Foote and Debonair by Mr Peter Smart of Beck Greener.

#### **The material dates/period**

6) In relation to the section 5(2)(b) & 5(3) grounds of opposition, the material date at which a likelihood of confusion and/or reputation (and the subsequent heads of damage) must be established is the date of filing of the application, namely 10 June 2008. In terms of the proof of use requirement, the use condition must be met in the five year period ending on the day on which the application was published. The relevant period is, therefore, 25 April 2004 to 24 April 2009.

7) In terms of the section 5(4)(a) ground of opposition, I note the judgment of the General Court ("GC") in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07 where it was stated:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant

date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

8) Therefore, as with the other grounds, the material date is 10 June 2008. Debonair must have been able to succeed in a passing-off claim and possessed a protectable goodwill at this date. The position at an earlier date may also be relevant. It could establish a senior user status, or that there has been common law acquiescence or that the status quo should not be disturbed as the parties have a concurrent goodwill<sup>2</sup>; I will return to this later, if it is necessary and relevant to do so.

### **The evidence**

#### *Debonair's evidence - witness statement of Karim Gangji*

9) Mr Gangji is a director of Incos Limited (“Incos”) who, he explains, is the exclusive UK licensee of Debonair’s trade marks. Debonair primarily licenses its marks to other companies in various countries around the world. It is estimated that goods bearing the trade marks are sold in some 40,000 retail outlets worldwide.

10) In terms of UK sales, this is said to relate to a range of cosmetic and fragrance goods and also gift sets which include clothing. The range is said to include toiletries, hair care products, perfumery, cosmetics, deodorants, fragrances and sachets, body lotions, shower gels and shimmer lotions, as well as t-shirts and other items of clothing. He explains that the goods are targeted at the teenage market. The sales are made under marks containing the word SO which Mr Gangji describes as its family of trade marks.

11) Sales under the marks began in 1994 by the original owner, Yardley and Company. Debonair acquired the SO brand in 1998 via a company called Wasserstein and Co Inc. Since January 1999 Incos has sold products such as fragrances and body sprays to retailers and use has also been made in respect of t-shirts (and other unspecified clothing) as part of fragrance gift sets or given away for promotional purposes.

12) In terms of the use by Yardley & Co, some of the key facts are:

- SO...? launched in 1994 in respect of perfumery products including eau de toilette and deodorant.

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<sup>2</sup> See, for instance: *Croom's Trade Mark Application* [2005] R.P.C. 2 and *Daimlerchrysler AG v Javid Alavi (T/A Merc)* [2001] R.P.C. 42.

- SO...? INSPIRED/CONNECTED/THERE launched in 1997.
- So...? DESIRABLE/WICKED launched in 1988.
- SO... FOR HIM, SO... MAX FOR HIM and SO...COMICAL FOR HIM launched in 1988 (these are men's fragrances, deodorants and bath/shower products).
- The respective sales figures (in the UK and Ireland) are:

| Mark          | 1994  | 1995   | 1996   | 1997    | 1998    |
|---------------|-------|--------|--------|---------|---------|
| SO...?        | £1.3m | £1.79m | £1.97m | £2.0m   | £1.53m  |
| INSPIRED      |       |        |        | £1.8m   | £1.1m   |
| DESIRABLE     |       |        |        |         | £0.23m  |
| CONNECTED     |       |        |        | £0.484  | £0.235  |
| THERE         |       |        |        | £0.456  | £0.145  |
| WICKED        |       |        |        |         | £0.136m |
| FOR HIM range |       |        |        |         | £1.34m  |
|               | £1.3m | £1.79m | £1.97m | £4.760m | £4.725m |

- Yardley & Co spent £1.42 million on advertising and promotion of the brand in 1994.

13) In terms of Incos' use (since 1999), some of the key facts are:

- The products are available at around 4000 retailers in the UK including Boots, Superdrug, Sainsbury's, Tesco, Asda & Morrison's.
- The "SO...?" marks have been applied to various goods both individually and as part of gift sets. Exhibit KG3 shows various of the earlier marks including: SO...?, SO...? KISS ME, DESIRABLE, SINFUL, WHAT, INSPIRED, WILD, SO HIM, SO MAX, SO CHILLED. The goods include gift sets including two or more of body lotions, fragrances, body sprays (some other goods are contained but the prints do not lend to easy identification) other individual goods include eau de toilet, aftershave (SO HIM/MAX) and shower gel (SO CHILLED).
- The gift sets sometimes contain clothing (although none are pictured in the above exhibit). Examples are said to include a set in 2004 (SO...? KISS ME AND SLEEPOVER) which contained a shirt/nightshirt and which sold 45,000 units in the UK, Finland and Sweden; two similar sets in 2005, one of which sold 15,000 units via Boots in the UK and the other over 44,000 units in the UK and Malta; in 2006 two SO...? SUPERSTAR sets were sold, the first selling 20,000 in the UK via Boots and the second around 4,800 in the UK and Ireland (the clothing they contained is not identified);

in 2007 a SO...? KISS ME set (including a camisole and knickers) sold almost 15,000 via Boots.

- Incos has recently started selling t-shirts on its website.
- The core target market consists of 14-17 year olds with average disposable funds. It is stated that significant numbers of women in their late teens to early twenties also buy the products.
- Sales figures (by pieces sold) are provided for numerous of the SO brands. The biggest seller is “SO...? KISS ME” with sales rising from just over 366,000 in 2001 to over one million in 2008. “SO...?” has sales in a similar range. I do not intend to list them all, but other big sellers include “SO...? INSPIRED/SINFUL/SUPERSTAR” which have all sold more than 2 million pieces each between 2000 & 2009.
- Sample invoices to various retail buyers are provided in Exhibit KG-5 dated between 2000 and 2008.
- UK advertising and PR expenditure has ranged between just under £300,000 in 2003 to over £400,000 in 2008. Further marketing figures for “UK In-store” ranged from just over £170,000 in 2003 to just under £230,000 in 2008. “UK Promotions” has ranged from just over £1million in 2003 to just over £1,746,000 in 2008.
- From 2000 Incos has operated a website at [www.so-cosmetics.com](http://www.so-cosmetics.com) and from 2006 at [www.so-fragrance.com](http://www.so-fragrance.com). Some example statistics are given. For example, in November 2008 there were 736,963 hits from over 11,000 unique IPs. Various screen prints are provided from the later website. A number from May 2008 are provided featuring “SO...?” fragrances with options to click on other fragrances “SO...? INSPIRED/KISS ME/WILD/DESIRABLE/SINFUL/SUPERSTAR/EXCITING”. Other pages show competitions for various prizes. One prize includes a make-up set but this does not appear to be SO branded.
- Advertising has taken place in various “young women’s magazines”. Examples include Cosmo Girl!, Sugar, Heat, Shout, Elle Girl, TV Hits, Pride, Beauty, Bliss, Reveal, Mizz and Bratz. Examples are provided which date between 1999 and 2008. (They show: Him, max, wild, so inspired, kiss me, what sinful, superstar, exciting, eternal). An advertising schedule for 2007 lists various publications including CG! (SO...? Superstar to appear in June & August), Sugar (SO...? Superstar to appear in June & July and SO...? Exciting in October, November, December and January (presumably 2008)) and Bliss (SO...? Exciting to appear in October and January (2008)). An advertising schedule for 2008 is also provided (but I will only detail the advertisements that were to be placed

- before the material date) which lists advertising in Sugar (SO...? Exciting in January & June, and SO...? Special in May) and in Bliss (SO...? Exciting in January).
- Other types of press coverage has been received. Most are in the form of product reviews/recommendations (alongside other brands) or references contained in articles about celebrities who use/have used SO...? products. Examples come from Sugar, Cosmo Girl, the Daily Express, My Weekly, Bliss, Sneak, 19, J-17, Pride, Beauty Mag, Bliss, Sunday World, Kissandmakeup (a website), Reveal, London Paper, Mizz, Sugarfix. The articles range in date between 2004 and 2008.
  - Television advertising has also taken place in 2006 (10 times a week for 10 weeks) and 2007 (500 times between May and June). Statistics for 2008 are provided but they are from after the material date. Printed extracts are shown in KG-10 for SO...? SUPERSTAR and SO...? ETERNAL. The advertising took place on the following television channels: Channel U, Fizz TV and Bubble Hits Sky TV.
  - Promotion has also taken place by way of competitions and giveaways in various magazines. The magazines are similar to those already mentioned. The extracts provided date between 2001 and 2009. Some are after the material date but a good many are not. Giveaways have also included clothing bearing the earlier marks. This includes 5000 SO...? KISS ME t-shirts since 2001. In 2003 a competition in Cosmo Girl gave away 10,000 SO...? KISS ME belts. Other giveaways/competitions have been in relation to SO...? KISS ME knickers, tankinis, vest tops and caps.
  - Incos has run a number of events/competitions including a search to find the new “face” of the brand in 2002, 2004 & 2006. Other events include “search for a supergroup” in 2007. Promotional material for all of this is shown in Exhibit KG-13. SO...?, KISS ME/WHAT featured in Cosmo Girl (Jan 2006, May 2007), Sunday World (July 2007), Reveal (August 2007), Beauty Mag (September 2007), NOW (December 2007) & Bliss (April 2008).
  - Incos has promoted the SO brands at trade shows, but the only ones listed are outside the UK.
  - The products have received a number of awards: Cosmo Girl number one self-selection fragrance (2002 & 2003 – SO...? KISS ME), Pure Beauty Fragrance Awards (2002 – SO...? KISS ME), Bliss Magazine best budget perfume range (2004 – the SO range), Kiss of Approval Beauty Award (2004 – SO...?). It is stated that recently Boots Loyalty Card Holders voted SO...? as the best repeat fragrance brand.



- Business research information is provided, one example dates from 1998 showing that SO...? has the greatest brand usage (11-16 YEAR OLDS) when compared to four competitors. Another example is from 2005 when Euromonitor ranked SO...? as No15 in eau de toilette sales. Mr Gangji estimates that as this figure does not include gift sets and as SO...? sell a higher proportion of gift sets than other brands then, in reality, he estimates that SO...? would be in the top 10.

*Sol's evidence - witness statement of Samantha Nyree Burlton*

14) Ms Burlton founded Sol (which was incorporated in September 2003) and is a director and shareholder of it. Ms Burlton's idea to start the business came in early 2003 – the idea was, effectively, to provide a one-stop-shop for various organic products. Her witness statement is 34 pages long. A lot of it sets out the background and origins of the business, its marketing strategies etc. Whilst I have read the witness statement in full and all of it will be borne in mind, the following represents the key aspects of the evidence:

- Ms Burlton came up with the name SO ORGANIC in August 2003. Various domain names were then registered which included these words. Further domain names were registered in February 2005.
- Ms Burlton resigned from her job in April 2004 to start the SO ORGANIC business and to focus on the implementation of her business plan.
- Although the business did not go live until February 2005, Ms Burlton invested time and resources into promoting the brand before then. Examples include booking a place at The Vitality Show at London Olympia in November 2004 (the show took place in April 2005), discussing attendance at the Bristol Organic Food Festival with its organizers in January 2005, discussing in January 2005 advertising and editorials with Ecologist Magazine. Post launch promotion includes Ms Burlton being a judge at the Brighton Natural Trade Show awards (February 2005) and Sol's products appearing on ITV's This Morning whereby a presenter went green (environmentally friendly rather than the colour) for the week. SO ORGANIC was apparently mentioned in the show which 6.1 million people watched the week the show was aired. After the airing which featured its name, Sol's website crashed due to increased traffic.
- The SO ORGANIC business has received press exposure in various publications. Exhibit SNB-1 contains a large number of examples. They are dated between 2005 and 2008 in publications such as Natural Beauty Year Book, Pure Beauty, Easy Living Magazine, Top Sante, The Times, Red Magazine, Daily Express, Marie Claire, Daily Mail, Time Out, Vogue, The Guardian, Grazia. This list is not exhaustive. Most are editorial in nature including, for example, product recommendations. There are also

some more traditional advertisements. Other articles refer to a dispute Sol has had with Sainsbury's supermarket regarding the name and other articles refer to the company, its business ethos and operation. The context of most of these is that SO ORGANIC is the business name, the retailer of organic products. Some use has, though, been made of SO ORGANIC products e.g. "So Organic Gentle Everyday Shampoo".

- Online sales commenced on 1 February 2005. The current website is shown in SNB-2. It features, predominantly, a stylized version of the SO ORGANIC name. The words themselves are used in the body of the text. The website is clearly a retail website for a large range of organic products. A large number of third party brands are sold. A "SO ORGANIC" range is also sold (e.g. hand and body lotion, candles, body wash, shampoo & conditioner etc). Archive prints for the website are provided in SNB3 from June 2005. The stylized version is shown, as are the words themselves in the body of the text. There is nothing to suggest that SO ORGANIC goods were sold at this point, only third party brands are listed. Later evidence shows that the sale of SO ORGANIC products did not commence until the end of April/beginning of May 2007 (SNB3a shows some of the SO ORGANIC goods featuring the logo version of the mark).
- In February 2005 a trade mark was applied for by Ms Burlton for the logo version of the mark in class 3 (soaps, essential oils, cosmetics, deodorant, toiletries, beauty products) and class 35 (retailing of organic produce). The mark was later assigned to Sol. The mark is now registered.
- Sol monitors the market for other traders using the words SO ORGANIC. For example, it subscribes to a Google system which provides alerts every time Google finds that phrase. Other than the disputed use by Sainsbury's, the only other use was by a café in Leigh-on-sea. There was also a company called "So Organic UK Limited" but there is no evidence of it trading under that name and it may be connected to the café which has not traded significantly. Searches of domain names have brought similar results in that of the many that contain the words SO ORGANIC, all are registered to Sol (or its principals) other than one which is "on hold" and not active.
- Ms Burlton's business research demonstrated that higher income females aged 25-60 are willing to spend more on organic products and that this is more so for women at the lower end of this age group and particularly those with children. This seems to represent the core customer to whom the goods are marketed. Ms Burlton stresses, though, that its customers come from all backgrounds.
- The SO ORGANIC logo is used on the website, on the boxes in which goods are delivered (SNB-5) and on its invoices (SNB 6). Ms Burlton

states that the business is referred to as SO ORGANIC due to the use of the words throughout the website (so not just in logo form) and she also knows this because she speaks to visitors to its retail outlet.

- In terms of access to Sol's website, some statistics are provided. By way of example, on January 2006, hits were over 3.2 million (18,880 individual users) and in the period February 2006 to 11 December 2007 hits were 92.8 million (547,520 individual visits). The individual visit statistic is an estimate based on being 0.59% of hits which Ms Burlton understands to be an appropriate measure based on information given to her by Sol's hosting company.
- Statistics regarding Sol's Google Pay-Per-Click advertising is also provided. This is where advertisements for Sol appear as a sponsored link on a Google search. By way of example, between 1 February 2006 and 11 December 2007 there were over 12 million impressions (each time the advertisement appears) with over 200,000 click-throughs.
- Further promotion has come in the Times newspaper where Sol has sponsored, since February 2007, the weekly "star letter". The winner receives some products from Sol. An advertisement for the SO ORGANIC business appears alongside the winning Star Letter (see Exhibit SNB 8).
- Sol has won a number of press and industry awards including: Best Internet/Delivery Business (Natural Products Industry Awards Finalist 2006); Ms Burlton was the winner of the Grazia/O2 business women of the year award in 2006; Management Today 35 Under 35s 2007 (a list of 35 women under 35 predicted to reach the top of their industries); HSBC Start Up Star and Green Award Finalist 2007; Ms Burlton was a semi-finalist for the Ernst and Young Entrepreneur of the Year 2008 Award.
- Sol operates a number of employee/customer schemes (Exhibit SNB9 with further details provided in SB10). The schemes are with the Soil Association, Environment Agency, Barclaycard, Co-operative Bank, Legal and General, Britannia Building Society, Newcastle Building Society, Chelsea Building Society, RBS, NatWest, BT Total Broadband, Bupa). A print is included of the Buba Website where, under "Member's offers", an advertisement for the SO ORGANIC business appears.
- Sol has attended trade fairs and exhibitions including the Vitality Show (2005), Organic Festivals (2005) and the Soil Association's Annual National Conference (2006). Photographs from the latter event are shown in Exhibit SB10 which shows the logo version of the mark; Sol was a sponsor and hosted an area called the Chill Zone. Ms Burlton has given speeches at a number of events which, she says, is clear evidence of Sol's standing in the industry.

- As well as internet sales and sales through its retail outlet, sales are made over the telephone. The telephone is always answered with *Hello/Good Morning/Good Afternoon, So Organic*. In the 3 months ending 11 December 2007, 1630 incoming calls were received. Orders are often placed after someone has received a catalogue. Catalogues are provided in Exhibit SNB11 (Winter 2005/Spring 2006), SNB12 (Summer/Autumn 2006) & SNB13 (Christmas 2006). The second two had print runs of 10,000; the first 5,000.
- The amounts spent on advertising and promotion were 2004 (£1520), 2005 (£21,507), 2006 (£45,276), 2007 (£56,512).
- Sol opened its first physical shop in July 2007 in Greenwich. This area was chosen because of the number of independent retailers in that area and because of the higher income base of the local population. Sol has now moved to a larger shop but in the same area.
- Financial year turnover figures are: 2005-2006 (£144,309), 2006-2007 (£420,883), 2007-2008 (£765,430), 2008-2009 (£1,007,839)<sup>3</sup>. 80% of sales come from the website. A list of towns and cities is provided from across the UK where goods have been delivered.
- A breakdown of the products sold is provided in SNB17. 18.76% are beauty products, 4.19% are hair care products, 17.50% are body care products and toiletries. There is no breakdown regarding its own brand products from third party products.
- The on-going dispute Sol has with Sainsbury's is referred to. Sol actively looks for instances of confusion due to this. Whilst it has found some confusion with Sainsbury's, it has found none with Debonair's products.

### **The proof of use provisions**

15) As stated in paragraph 2, the proof of use provisions apply to CTM 485078 ("SO...?"). The relevant legislation 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,

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<sup>3</sup> A good proportion of this will be from after the material date.

- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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, ...

...

(5) In relation to a Community trade mark or international trade mark (EC), 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...”

16) Section 100 is also relevant which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the

European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). It is also worth noting the Court of Appeal’s (“COA”) judgment ([2006] F.S.R. 5) in the latter of these cases when it had to apply the guidance given by the ECJ. From these judgments the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer* (COA), paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer* (COA), paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer* (COA), paragraph 44).

18) Only one mark, SO...?, is subject to the proof of use provisions. The mark is registered in class 3 only. The relevant period in which genuine use must be shown is 25 April 2004 to 24 April 2009.

19) The mark has clearly been used. Indeed, it is a longstanding and successful brand. Whilst there may be a number of brand extensions<sup>4</sup> where the mark is accompanied by another word(s) (KISS ME, SUPERSTAR etc.) the mark is often used alone as a self-standing brand. Even when the brand extensions are being used the mark is sometimes used alone in accompanying advertising. Some of the use predates the relevant period but a good deal falls within it. The use is not internal nor is it token use. The goods in class 3 for which the mark has been used is, though, limited to perfume, body spray and body lotion. There may be other goods but, as stated earlier, the exhibits do not lead to easy identification. The use relates to use of a Community trade mark. The decision of The Fourth Board of Appeal of the Office for Harmonization in the Internal Market in *ILG Ltd v Crunch Fitness International Inc* [2008] ETMR 17 is noted:

“11 The relevant period is October 1998 to October 2003. Use in one country of the Community, such as Italy, is sufficient (Joint Statements by the Council and the Commission entered in the Minutes of the Council meeting at which the CTMR was adopted, No.B.10, OH OHIM 1996, 607, 613), provided that it is [ *sic.* ] genuine.”

20) In *PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07 the ECJ considered the requirements for establishing a reputation in respect of a Community trade mark:

“30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

21) It would be anomalous if reputation in one member state may be enough to satisfy the requirement of Article 9(1)(c) but use in one member state could not

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<sup>4</sup> The use of the brand extensions cannot be relied upon per se because they are the subject of other registrations. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-234/06 P the ECJ stated:

“86 In any event, while it is possible, as a result of the provisions referred to in paragraphs 81 and 82 of the present judgment, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.”

satisfy the use requirement. In considering whether genuine use is established it is necessary to consider, within the context of the EC as a whole, the sector of the industry in which Debonair (or its licensee) operates and the nature of the goods, whether the use is warranted in the market place and if the use creates and preserves an outlet for the goods. I have little hesitation in concluding that the nature and scale of the use demonstrated, even when contextualised against the EC as a whole, is sufficient to meet the genuine use requirement. Taking into account all of the above factors, it is considered that the use shown establishes genuine use within the EC.

22) It is necessary to decide upon a fair description for the goods for which genuine use has been shown which falls within the parameters of the specification and the statement of use. The description must not be pernickety<sup>5</sup>. It is necessary to consider how the relevant public (which in this case is the general public) would describe the goods<sup>6</sup>. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 held:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has

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<sup>5</sup> *Animal Trade Mark* [2004] FSR 19.

<sup>6</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.



been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

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 relating to which the goods or services for which the trade mark has actually been used actually 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.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

23) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

24) The statement of use reads:

**Class 03:** Toilet preparations; preparations for use in the shower and the bath; all being non-medicated; perfumes; fragrances; aftershaves, creams, gels, and lotions; cosmetics; eau de cologne; toilet waters; hair styling products; antiperspirants; deodorants for personal use.

25) Use has been shown in respect of perfumes, body sprays and body lotions. The statement of use is wider than the use shown. Some of the goods specifically listed have not been used. Some of the broad terms are very wide in comparison to the goods used. I consider a fair specification to read:

**Class 03:** Perfumes; fragrances; body lotions; eau de cologne; toilet waters; deodorants for personal use; body sprays<sup>7</sup>; all for personal use<sup>8</sup>.

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<sup>7</sup> Whilst the term body sprays is not specifically listed it would fall within some of the broader terms and is equivalent to a deodorant.

<sup>8</sup> The reference to being for personal use is included as this reflects the nature of the goods and also distinguishes from other fragrances such as those for fragrancing a room which are different types of product.

## **Section 5(2)(b) of the Act**

26) This section reads:

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

(a) .....

(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.”

27) In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

28) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*).

29) As matters must be judged from the perspective of the average consumer I will begin by making an assessment of who this is and the characteristics they possess. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The respective goods in class 3 include body care/cosmetic type products. The average consumer is a normal member of the general public. The goods are not specialised. The frequency of purchase depends on the particular product involved. None would be described as infrequent purchases. Although the cost of the goods will vary (perfume is likely to cost more than a body spray) they are not, generally speaking, high cost items. Nevertheless, the products are not completely casual purchases either. They may be inspected to ensure that they are fit for purpose and, perhaps, inspected for what they smell like. The purchasing process is not materially higher or lower than the norm. The goods are likely to be selected from a shelf or from a website, but, equally, they may also be requested orally – for example, fragrances are often kept behind a counter and, furthermore, sales assistants are often in abundance in the beauty areas of a shop. This means that both visual and aural similarities are important.

30) In relation to clothing, this is also bought by the public at large. The average consumer is, therefore, a member of the general public. The average consumer may try the goods on and is likely to inspect them for colour, size, style etc. That being said, the purchase is unlikely to be a highly considered process as clothing is purchased relatively frequently and, although cost can vary, it is, generally speaking, not a highly expensive purchase. The purchasing process is, therefore, a normal, reasonably considered one, no higher or lower than the norm. The selection of clothing is normally a visual act. This means that visual similarity is more important here.

#### The relevance of the evidence

31) There are a number of factors for which the evidence may have relevance in relation to the issues to be determined. This would include Debonair's claim to having a family of marks and whether its marks are entitled to a higher degree of distinctiveness (which according to the case-law may increase the likelihood of confusion). Also of relevance would be the claimed (by Sol) parallel trading of the two parties and the relevance this may have on whether there is likely to be confusion. I will deal with these issues before assessing any other relevant factors.

32) In relation to the family of marks argument, it is clear from the case-law that the use of a family of marks may increase the likelihood of confusion. The ECJ in *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market* (Trade

*Marks and Designs*) (*OHIM*) Case C-234/06 accepted that having a family of trade marks may be relevant in considering whether there is a likelihood of confusion:

“62 While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.”

33) It is clear from the evidence that a number of the earlier marks have been used. Given the type of use demonstrated in the evidence, I also consider it clear that those consumers who will have encountered such use will perceive the goods sold under the various earlier marks to be the responsibility of a single undertaking. The SO...? mark will be perceived as the primary brand which has been extended to use of that mark together with various different endings. The SO...? KISS ME mark is the biggest selling extension but significant sales have also been made of SO...? INSPIRED/SINFUL/SUPERSTAR. Other extensions have been used and even though, taken individually, they may not equate to a highly significant degree of sales, they will all contribute to the collective strength of the family of marks.

34) A question arises as to whether the family of marks argument is weakened by the fact that the goods sold are targeted at a particular market (girls aged 14 to 17). Whilst this concern is noted, it is considered that the degree to which the marks have been used is more than sufficient to constitute a family of marks. The target market does not prevent a wider range of consumers from seeing the goods on the shelf or, indeed, from buying the products for others as presents etc. I also accept the argument that some consumers, although not in the target market now, will have encountered the family of marks when they were younger – use of the SO...? brand commenced in 1994 and use of SO...? plus marks in 1997.

35) In terms of the family of marks itself, the common characteristic of the family of marks is the designation “SO...?”. It is either presented on its own or together with some other word(s) which the word SO then qualifies. I do not consider the common characteristic to be purely the word SO because all of the family members have the “...?” element other than for a limited range of men’s products. These products have not, according to the evidence, been sold for some time (they have not been sold in significant quantities since 2003). The weight of the evidence is behind the SO...? brands. The goods upon which the family of marks have been used are primarily fragrances, body sprays and body lotions. I do not consider the family of marks to have been used to a significant enough extent for it to be relevant in relation to clothing. Many of the items of clothing have been given away and would be seen as purely a promotional or ancillary aspect to the business. Whilst some items of clothing have been used in gift sets, such use is not in my view sufficient.

36) The above analysis is also relevant to the question of distinctiveness. Whilst from an inherent point of view I do not consider the marks to be highly distinctive, the use made is sufficient to enhance the degree of distinctiveness so that they (particular the marks identified in paragraph 33) should be considered to be reasonably high in distinctive character.

37) That leads to the relevance of the claimed parallel or concurrent trading of the parties. Sol claims that despite both parties using their marks there have been no instances of confusion. Whilst Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 gave weight to an absence of confusion in the marketplace, there is a tranche of case law to the effect that lack of confusion in the market place is often indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-498/07 P. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

38) When I discussed with Mr Farrand this aspect of Sol's case, and whether the actual use of the marks in question here, and the absence of confusion, was truly indicative of there being no likelihood of confusion, he indicated that he would not put it as high as that particularly given that the target market of the parties differed. He advocated more the honest concurrent trading of the parties, and that this could still be helpful in terms of the tribunal reaching a decision on whether confusion was likely. I note Mr Farrand's skeleton argument where he stated:

“SOL is a small business that has been trading honestly and successfully for 6 years. Their primary area of business is in class 3 goods. We would invite the Hearing Officer to consider whether it is in the public interest for SOL to be refused registration of its core trade mark. If the decision is adverse to SOL, then the consequences will be severe and will potentially require them to change their name and may affect the viability of the business. The Hearing Officer should balance that against the potential inconvenience to [Debonair] of allowing the status quo to continue and for the register to reflect the reality of the market place. The tribunal must always consider the public interest and whether it is just to register a trade mark (per *Budweiser* [2000] R.P.C. 906).”

39) In terms of the claim to lack of confusion, this is a clear example of when this is not particularly relevant. As Mr Farrand conceded himself, the target markets are different but, more fundamentally, the trade of Sol is primarily as a retailer of class 3 goods (and other goods) and not of SO ORGANIC branded products per se. Some branded products may have been sold under the SO ORGANIC name but the scale is not identified and, furthermore, they will have always been offered for sale in association with the SO ORGANIC retail business. Whilst this trade may have resulted in no confusion, it is another thing altogether when one considers the use of the SO ORGANIC name on class 3 goods sold in the normal course of business, potentially alongside the products of Debonair/Incos.

40) Honest concurrent use per se is a throw-back. It was previously used in the Act as a mechanism to allow the acceptance (as opposed to registration) of a trade mark. The mechanism was contained in section 7 of the Act, the provisions preventing the registrar from refusing an application on the basis of an earlier mark if honest concurrent use was shown, unless opposition was raised by the proprietor of the earlier mark. The provisions did not, therefore, apply in opposition proceedings. To highlight the relevance (or lack of) it should be noted that section 7 of the Act is no longer in force (in accordance with section 7(5) of the Act) because the Secretary of State has made an order under section 8

whereby refusal on relative grounds can only result from an opposition. This made the section 7 provisions on honest concurrent use redundant.

41) The relevance of Sol's use could, therefore, only be of assistance if it demonstrated confusion-free trade. As stated above, the confusion-free trade that exists between the parties does not represent a true reflection of the potential trade that could exist in the future based on the marks and the goods in dispute. The comments in Mr Farrand's skeleton argument regarding convenience are noted. However, the tribunal has one question to answer, namely, whether it is likely that the average consumer will be confused as to the economic origin of the goods sold under the respective marks. If the answer to that question is in the affirmative then the opposition under that ground must be upheld. There is no discretion in the Act to do otherwise. The reliance on the *Budweiser* case is also not relevant given that it is a case based on the Trade Marks Act 1938 which contained particular provisions for the registration of a trade mark by more than one party on the basis of honest concurrent use – such provisions are not found in the current Act.

Comparison of marks

42) The competing marks (I have listed the five primary family members), for ease of reference, can be seen in the table below:

| Debonair's marks   | Sol's mark |
|--|------------|
| SO...?<br>SO...? KISS ME<br>SO...? SUPERSTAR<br>SO...? INSPIRED<br>SO...? SINFUL | SO ORGANIC |

43) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

44) In terms of the dominant and distinctive elements of "SO...?", Mr Farrand argued that the "...?" aspect was the more dominant and distinctive element on account of its unusualness especially in comparison to the common English word SO. However, I agree with Mr Smart that the dominant and distinctive element is the word SO given that it is at the beginning of the mark (although I accept that this is only a rule of thumb) and that rest of it is simply punctuation which follows



the word. Whilst this adds to the mark, and that (arguably) it may provide the word with context (I will come on to this shortly), it is still the word itself that forms the most important and memorable part of the mark. The other elements of the mark will not, though, be ignored as they are not negligible. In terms of Debonair's other marks, a word follows the "...?" element which will be perceived as the characteristic that is being qualified by the word SO. However, I still consider the most dominant and distinctive element to be the word SO on account of its position and the emphasis given to it by the addition of the dots and the question mark that appear before the characteristic so providing separation. The other elements KISS ME, SUPERSTAR, SINFUL, INSPIRED are still, though, distinctive elements in their own right.

45) In terms of the SO ORGANIC mark, less emphasis is given to SO per se as it is not separated from the word ORGANIC with the dots and question mark as per Debonair's marks. It is, though, at the beginning of the mark and, furthermore, the word ORGANIC is completely descriptive. I agree with Mr Farrand, though, that the word does play some form of qualifying role, the word SO signifying the extent of something, in this case the extent of 'organicness'. The fact that being organic is something that is present or is not (there are unlikely to be degrees of organicness) could be said to give more emphasis to the SO part of the mark. However, I place no real weight on this as the average consumer is unlikely to analyse the mark to that level of detail. Neither component really dominates the other, the mark constituting a single phrase.

46) There is more similarity between SO ORGANIC and SO...? than with the other earlier marks given that the other earlier marks have additional and quite different second words compared to the second word in SO ORGANIC. In terms of this comparison there is a degree of visual similarity on account of both marks having the word SO at the beginning. The differences (the inclusion of "...?" in one and the addition of ORGANIC in the other) are reasonably apparent but I do not consider that this outweighs all visual similarity. I consider there to be only a moderate degree of visual similarity. The visual difference created by the "...?" aspect of the earlier mark is unlikely to form part of its pronunciation. The phonetic comparison is between SO and SO ORGANIC. Given the complete non-distinctive nature of the word ORGANIC, I consider this to mean that there is a moderate to reasonable degree of aural similarity.

47) In terms of concept, Mr Farrand argued that SO...? would be understood as designating the expression "SO WHAT". Whilst I understand the point, it is unclear whether the average consumer will attempt to analyse the mark to such a level so that he or she attaches a particular significance to the word SO beyond it being the word SO. For a conceptual meaning to be relevant it must be one capable of immediate grasp. I am not satisfied that the meaning put forward by Mr Farrand will be immediately grasped. If such an analytical exercise were attempted it seems to me that a variety of meanings could be attached to the

word but normally with the word SO functioning as a question as in: “so?”, “well?”, or even “what?”.

48) In terms of the SO ORGANIC mark, the concept likely to be perceived is as a reference to something that is very organic. Taking the marks in totality there is no real conceptual similarity as the earlier mark does not have the same or similar meaning to SO ORGANIC.

49) In terms of the other earlier marks, similar considerations to that given above apply in terms of the points of similarity. However, the different end word creates a further degree of difference. The net result of all this is that there must only be a low degree of visual and aural similarity and there is still no real conceptual similarity given that the concepts as a whole relate to different characteristics even though the word SO qualifies them all.

### Comparison of the goods

50) The goods the subject of the opposition are:

**Class 3:** Soaps, essential oils, cosmetics, deodorants, toiletries, beauty products; bleach and bleaching preparations included in Class 3; perfumes, colognes, fragrances, eau de toilette; hair lotions; dentifrices, toothpaste; preparations for the body, hair, scalp, skin, eyes and nails; makeup; lipstick, lip gloss, lip balms, lip liner, lip colour, lip contour, nail care preparations; nail enamel, nail colour; foundation, face powder, blush; mascara, eyeliner, eye shadow; moisturising creams, lotions, cleansers, serums and toners, facial masks, face creams; body creams; talc; anti perspirants; body lotions; creams; emulsions; hair care products, shampoo, conditioner, hair gel, hair colour, hair mousse; eye makeup; depilatories; cotton sticks for cosmetic purposes; pumice stones; cosmetics and skin care products, namely, foundation, concealer, mascara, eye shadow, eye and/or brow liners, lipstick, lip liner, lip balm, face powder, bronzer, blusher, moisturisers, make-up remover; non-medicated body powder; bath gel, bath oils, bath salts, bath beads, and bath fizzies; scented room fragrances, incense sticks, potpourri and sachets; all being organic.

**Class 25:** Clothing, footwear and headgear; clothing for babies and children; footwear for babies and children; headgear for babies and children; all being organic.

51) In terms of the class 3 goods, Sol concedes that they are either identical or similar. However, it is clear from the case-law that there is interdependency between the various factors and, therefore, it is incumbent upon me to identify which goods are identical and which goods are similar (and the degree of that similarity). In doing so I bear in mind the guidance set out in the case-law<sup>9</sup>. The SO...? mark is to be considered on the basis of:

Perfumes; fragrances; body lotions; toilet waters; deodorants for personal use; body sprays.

52) Whilst the specifications of some of the other earlier marks may be wider than this, I consider Debonair's best case to lie with the above goods, particularly when its family of marks argument (which must be tied to the use made of the marks rather than what they are registered for) and its enhanced degree of distinctiveness is factored in. To that extent, the following of Sol's goods are considered to be identical:

Category A: Deodorants, toiletries, beauty products; perfumes, colognes, fragrances, eau de toilette; preparations for the body, skin, moisturising creams, lotions, cleansers, serums and toners, body creams; body lotions; creams; emulsions; skin care products, namely, moisturisers; all being organic

The above goods are either identically worded or represent an equivalent product (e.g. emulsions and serums could be a lotion type substance applied to the body). Other terms (e.g. beauty products & toiletries) are simply wide terms that would include within their ambit Debonair's goods; identical goods must be considered to be in play in view of this<sup>10</sup>.

53) The following goods are highly similar

Category B: Facial masks, face creams; anti perspirants; non-medicated body powder

Facial masks and creams and body powder provide a similar purpose to body lotions, are likely to be sold in close proximity to each other, likely to be used by the same users etc. Anti-perspirants are highly similar to deodorants and body spray, they serve a very similar purpose, the method of use is identical, the goods are competitive and will be located in very close proximity to each other.

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<sup>9</sup> See, for example, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer and British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281. Also, in terms of understanding what constitutes a complementary relationship see *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06.

<sup>10</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-133/05 ("Gérard Meric").

54) The following goods are reasonably similar:

Category C: Cosmetics; preparations for eyes and nails; makeup; lipstick, lip gloss, lip balms, lip liner, lip colour, lip contour, nail care preparations; nail enamel, nail colour; foundation, face powder, blush; mascara, eyeliner, eye shadow; eye makeup; cosmetics and skin care products, namely, foundation, concealer, mascara, eye shadow, eye and/or brow liners, lipstick, lip liner, lip balm, face powder, bronzer, blusher, make-up remover

Category D: Soaps, talc; bath gel, bath oils, bath salts, bath beads, and bath fizzies; essential oils,

All of the above goods are (or could be) used for personal care and/or beautification of the person. They, therefore, serve a similar purpose to those of the earlier mark and are likely to be sold in reasonably close proximity to each other.

55) The following goods are similar to a moderate degree:

Category E: Bleach and bleaching preparations included in Class 3; hair lotions; hair care products, shampoo, conditioner, hair gel, hair colour, hair mousse; preparations for hair, scalp

Category F: Cotton sticks for cosmetic purposes; pumice stones; depilatories

All of the above goods are similar to the extent that they will form part of a person's beautification process. They are only moderately similar as they are distinct things for the hair and the scalp or are particular pieces of beautification paraphernalia. They are unlikely to be sold in as close a proximity to the other goods I have so far assessed.

56) The following goods are similar to only a low degree:

Category G: Dentifrices, toothpaste;

Category H: Scented room fragrances, incense sticks, potpourri and sachets

The category G goods are more about personal hygiene than beautification. They are unlikely to be sold in particularly close proximity to the goods of the earlier mark. Similarity is though conceded – however bearing the above factors in mind, I must conclude that any similarity is of only a low degree. The same applies (to an even starker degree) to room fragrances etc. Whilst they fragrance, as do the goods of the earlier mark, they are distinct and separate products. They are

unlikely to be sold in close proximity to each other. They are neither competitive nor complementary. The goods must be considered to be similar to only a low degree.

57) In relation to the class 25 goods, Debonair has a registration in class 25 which includes clothing, footwear and headgear at large. Consequently, all of the goods sought by Sol must be considered as identical.

#### Conclusions on the likelihood of confusion

58) It is clear that all the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

59) I have found the marks to be similar but only to a low or moderate degree. Some of the goods are identical, others are similar to lesser (and various) degrees. The earlier marks do, though, constitute a family of trade marks in respect of certain goods in class 3 and the use made of them increases their distinctiveness so that they are distinctive to a reasonably high degree. The family of marks is, though, based on a common element of "SO...?" rather than SO per se. The family of marks argument certainly puts Debonair in its strongest position. I intend to consider its opposition on this basis in the first instance.

60) In terms of the identical goods in class 3, the argument is that the SO ORGANIC name will simply be seen as another extension of the SO...? family of marks in relation to the same goods for which the SO...? family of marks has been used. The SO ORGANIC name does not, however, have the "...?" element which is common to the family of marks. That being said, I must bear in mind the concept of imperfect recollection and it is my view that this militates against the "...?" from serving as a significant distinguishing element. As stated earlier, the earlier marks' dominant and distinctive element is the word SO per se and the family of marks are likely to be recalled as the SO family of marks. They will be remembered as SO alone or SO plus some characteristic which is being qualified. Even if the difference is spotted and recalled then this could easily be put down to a slightly different form of branding but still being part of the same family of marks from the same undertaking. Whilst there may be no conceptual similarity per se between the earlier marks and SO ORGANIC, the concept of a number of the family members is that of a particular characteristic being qualified by the word SO, this lends further support to the proposition that SO ORGANIC will be seen as a further family member as it falls into a similar construction, albeit without the ...?.

61) There is also the argument that the ORGANIC message in SO ORGANIC is a different type of message than that given by the family of marks which has a more youthful approach (SO...? KISS ME, SO...? SUPERSTAR) etc. Whilst this is noted, I see no reason why the family of marks should be limited in this way. Some of its marks (SO...? INSPIRED for example) do not send such a message. In any event, I see no reason why an organic type message would contrast that strongly with the types of use demonstrated with the family of marks. All things considered, my finding is that the SO ORGANIC mark will be perceived as part of Debonair's family of trade marks when used in relation to identical goods in class 3. There is a likelihood of confusion.

62) I turn to consider the position in respect of the other goods the subject of the opposition. I have no hesitation in extending the above finding to those goods I found to be highly similar. The similarity of the goods to those for which the family of marks has been used is so great that the same conclusion will be made by the average consumer. There is a likelihood of confusion. In relation to those goods in categories C, D, E & F, the degree of similarity is less, being similar to a reasonable degree (C & D) or to a moderate degree (E & F). Although the goods similarity is less, they are all still goods used for the beautification of a person and will form part of a personal beauty care regime. Whilst the goods are not those for which the family of marks is known, the existence of a family of marks in a clearly related area, the use of which gives the earlier marks a reasonably high degree of distinctiveness, leads me to conclude that there is a likelihood of confusion. The SO ORGANIC products will be believed to be part of Debonair's family of marks albeit in respect of related products. There is a likelihood of confusion.

63) In terms of class 3, that leaves categories G & H which I have assessed as being of only a low degree of similarity. This is where I consider the line needs to be drawn. The goods, whilst possessing a degree of similarity, are quite distinct from the type of goods for which the family of marks has been used. I do not consider it likely that the average consumer will perceive SO ORGANIC to be part of the family of marks when use on these goods is considered. The difference in goods represents too great a step (when the differences between the marks, and the use that has been made of the earlier marks, is borne in mind) for such a perception to arise. There is no likelihood of confusion.

64) For the sake of completeness, I have considered whether Debonair is in a better position in respect of categories G & H when considering the fact that some of the earlier marks (those with additional words) include wide terms such as toiletries which would include goods such as toothpaste. Whilst this point is borne in mind, and whilst on an individually considered basis some of the earlier marks cover identical goods, the degree of similarity between the respective marks is low and, furthermore, the family of marks and the increased distinctiveness does not relate to such goods. I do not consider that Debonair is any better position. There is still no likelihood of confusion.

65) That leaves the class 25 goods. I have found the goods to be identical. The earlier mark SO...? represents Debonair's best case. I have already stated that the family of marks exists only in class 3 so I do not see how this can help in terms of the opposition against class 25. There is no similarity between class 3 & class 25, none has been claimed. The enhanced degree of distinctiveness of the earlier mark also only applies in class 3. Despite the identity between the goods, I consider that the qualifying effect that SO has on the word ORGANIC means that the moderate degree of visual similarity, the reasonable degree of aural similarity (which is less important when considering items of clothing) and there being no real conceptual similarity as a whole, will be put down to co-incidence and not to economic connection. There is no likelihood of confusion.

Summary of findings under section 5(2)(b)

66) There is a likelihood of confusion in respect of:

**Class 3:** Soaps, essential oils, cosmetics, deodorants, toiletries, beauty products; bleach and bleaching preparations included in Class 3; perfumes, colognes, fragrances, eau de toilette; hair lotions; preparations for the body, hair, scalp, skin, eyes and nails; makeup; lipstick, lip gloss, lip balms, lip liner, lip colour, lip contour, nail care preparations; nail enamel, nail colour; foundation, face powder, blush; mascara, eyeliner, eye shadow; moisturising creams, lotions, cleansers, serums and toners, facial masks, face creams; body creams; talc; anti perspirants; body lotions; creams; emulsions; hair care products, shampoo, conditioner, hair gel, hair colour, hair mousse; eye makeup; depilatories; cotton sticks for cosmetic purposes; pumice stones; cosmetics and skin care products, namely, foundation, concealer, mascara, eye shadow, eye and/or brow liners, lipstick, lip liner, lip balm, face powder, bronzer, blusher, moisturisers, make-up remover; non-medicated body powder; bath gel, bath oils, bath salts, bath beads, and bath fizzies; all being organic.

67) But there is no likelihood of confusion in respect of:

**Class 3:** Dentifrices, toothpaste; scented room fragrances, incense sticks, potpourri and sachets; all being organic.

**Class 25:** Clothing, footwear and headgear; clothing for babies and children; footwear for babies and children; headgear for babies and children; all being organic.

## **The other grounds of opposition**

68) Debonair also opposes under sections 5(3) & 5(4)(a) of the Act. In respect of section 5(4)(a) then the position is not materially different to the analysis I have made under section 5(2) where I have factored in the use made of the marks and the existence of a family of marks. If there is no likelihood of confusion based on this use then I do not see how Debonair is in any better position to argue that there would be a misrepresentation. The only difference in assessment could come in class 25 given that such goods are not similar to the goods for which the use of the earlier mark has been made. Whilst no common field of activity is required under section 5(4)(a), I do not consider that the use of the family of marks for class 3 goods would result in the belief that clothing products bearing SO ORGANIC would be perceived as those of Debonair (or its licensee). I consider that Debonair would still succeed and fail to the same extent. In relation to section 5(3), even accepting that the SO...? mark and its family of marks would have enjoyed a reputation, Debonair would also have to establish that a link<sup>11</sup> would be made between the respective marks bearing in mind the respective goods. Where the opposition failed under section 5(2) (as per paragraph 64) it is considered that the differences between the goods (where a reputation exists) and the marks results, after considering all the relevant factors, in a finding that a link would not be made. The ground of opposition would, therefore, fail in relation to such goods. In view of this, I do not intend to probe these grounds in any greater level of detail.

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<sup>11</sup> In terms of the link, in *Adidas-Salomon*, the ECJ stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

and in *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) the ECJ provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.



**Costs**

69) Both parties have achieved a measure of success. In the circumstances, I do not intend to favour either of them with an award of costs.

**Dated this 31 day of May 2011**

**Oliver Morris  
For the Registrar  
The Comptroller-General**

## ANNEX

| Earlier mark & grounds relied upon  | Relevant dates   | Specification   |
|---|--|---|
| <p>CTM 485078 for the mark:</p> <p>SO...?</p> <p>Opposition against only the class 3 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; s. S5(3)</p> | <p><b>Filing date:</b><br/>07 March 1997</p> <p><b>Registration date:</b><br/>26 February 2001</p> | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toilet preparations; preparations for use in the shower and the bath; all being non-medicated; perfumes; fragrances; aftershaves, creams, gels, and lotions; cosmetics; eau de cologne; toilet waters; hair styling products; anti-perspirants; deodorants for personal use;</p> |
| <p>UK registration 2482729 for the mark:</p> <p>SO...?</p> <p>Opposition against only the class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p>  | <p><b>Filing date:</b><br/>18 March 2008</p> <p><b>Registration date:</b><br/>01 August 2008</p>   | <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p>   |
| <p>UK registration 2408599 for the mark:</p> <p>SO...? SUPERSTAR</p> <p>Opposition against only the class 3 goods outlined in paragraph 1.</p>                                | <p><b>Filing date:</b><br/>08 December 2005</p> <p><b>Registration date:</b><br/>02 June 2006</p>  | <p><b>Class 3:</b> Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; preparations for the care of the skin, body and</p>   |

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| <p>Grounds pleaded:<br/>s. 5(2)(b)</p>  |   | <p>hair; deodorants; talcs; preparations for use in the bath; fragrance sachets; body lotion; shower gel; shimmer lotions, all included in Class 3.</p>   |
| <p>CTM 5530993 for the mark:<br/><br/>SO...? SENSUAL<br/><br/>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.<br/><br/>Grounds pleaded:<br/>s. 5(2)(b)</p> | <p><b>Filing date:</b><br/>07 December 2006<br/><br/><b>Registration date:</b><br/>15 November 2007</p> | <p><b>The following goods of the earlier mark are relied upon.</b><br/><br/><b>Class 03:</b> Hair care preparations; perfumery; perfumed body spray; eau de toilette; cosmetics; personal care deodorants; body lotion; shower gel.<br/><br/><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p> |
| <p>CTM 3952033 for the mark:<br/><br/>SO...? SEXY<br/><br/>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.<br/><br/>Grounds pleaded:<br/>s. 5(2)(b)</p>    | <p><b>Filing date:</b><br/>20 July 2004<br/><br/><b>Registration date:</b><br/>22 November 2005</p>     | <p><b>The following goods of the earlier mark are relied upon.</b><br/><br/><b>Class 03:</b> Toiletries; hair care preparations; perfumery; cosmetics; deodorants; fragrance sachets; body lotion; shower gel; shimmer lotions.<br/><br/><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p>     |
| <p>CTM 4330221 for the mark:</p>  | <p><b>Filing date:</b><br/>03 March 2005</p>  | <p><b>The following goods of the earlier mark are</b></p>   |

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| <p>SO...? SINFUL</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; s. 5(3)</p> <p>The s. 5(3) ground is not pleaded in respect of the class 25 goods</p>                                     | <p><b>Registration date:</b><br/>18 April 2006</p>  | <p><b>relied upon.</b></p> <p><b>Class 03:</b> Toiletries; hair care preparations; perfumery; cosmetics; deodorants; fragrance sachets; body lotion; shower gel; shimmer lotions.</p> <p><b>Class 25:</b> Clothing, footwear, headgear; T-shirts; caps.</p>   |
| <p>CTM 5099635 for the mark:</p> <p>SO...? SUPERSTAR</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; s. 5(3)</p> <p>The s. 5(3) ground is not pleaded in respect of the class 25 goods</p> | <p><b>Filing date:</b><br/>26 May 2006</p> <p><b>Registration date:</b><br/>27 April 2007</p>               | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Hair care preparations; perfumery; perfumed body spray; eau de toilette; cosmetics; personal care deodorants; body lotion; shower gel.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p> |
| <p>UK registration 2259592 for the mark:</p> <p>SO...? KISS ME</p> <p>Opposition against only the class 3 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p>   | <p><b>Filing date:</b><br/>31 January 2001</p> <p><b>Registration date:</b><br/>06 August 2004</p>          | <p><b>Class 03:</b> Toiletries; hair care products; perfumery; cosmetics; deodorants.</p>   |
| <p>International registration 825679 for the mark:</p> <p>SO...? WHAT</p>   | <p><b>Date of international registration:</b><br/>13 November 2003</p> <p><b>Date of designation in</b></p> | <p><b>Class 03:</b> Toiletry articles; hair care products; perfumery, cosmetics, deodorants, fragrances in sachets;</p>   |

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| <p>Opposition against only the class 3 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p>   | <p><b>UK:</b><br/>13 November 2003</p>  | <p>body lotions; shower gels; scintillating lotions</p>   |
| <p>UK registration 2374586 for the mark:</p> <p>SO...? WILD</p> <p>Opposition against only the class 3 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p> | <p><b>Filing date:</b><br/>01 October 2004</p> <p><b>Registration date:</b><br/>11 March 2005</p>     | <p><b>Class 03:</b> Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; preparations for the care of the skin, body and hair; deodorants; talcs; preparations for use in the bath; fragrance sachets; body lotion; shower gel; shimmer lotion, all included in Class 3</p> |
| <p>CTM 4630406 for the mark:</p> <p>SO...? CHIC</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p>   | <p><b>Filing date:</b><br/>05 September 2005</p> <p><b>Registration date:</b><br/>09 January 2008</p> | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toiletries; perfumery; cosmetics; deodorants; fragrance sachets; body lotion; shower gel; shimmer lotions; not including shaving cosmetics.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; t-shirts; caps.</p>                  |
| <p>CTM 3188109 for the mark:</p> <p>SO...? CONNECTED</p> <p>Opposition against the class 3 &amp; class 25 goods</p>  | <p><b>Filing date:</b><br/>09 May 2003</p> <p><b>Registration date:</b><br/>17 September 2004</p>     | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toiletries; hair care products; perfumery; cosmetics; deodorants.</p>  |

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| <p>outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p>  |   | <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p>  |
| <p>CTM 3188091 for the mark:</p> <p>SO...? DESIRABLE</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; s.(5(3)</p> <p>The s. 5(3) ground is not pleaded in respect of the class 25 goods</p> | <p><b>Filing date:</b><br/>09 May 2003</p> <p><b>Registration date:</b><br/>13 October 2004</p> | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toiletries; hair care products; perfumery; cosmetics; deodorants.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p> |
| <p>CTM 3188083 for the mark:</p> <p>SO...? INSPIRED</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b)</p>  | <p><b>Filing date:</b><br/>09 May 2003</p> <p><b>Registration date:</b><br/>16 June 2004</p>    | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toiletries; hair care products; perfumery; cosmetics; deodorants.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p> |
| <p>CTM 2335511 for the mark:</p> <p>SO...? KISS ME</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; 5(3)</p>  | <p><b>Filing date:</b><br/>31 July 2001</p> <p><b>Registration date:</b><br/>27 May 2005</p>    | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toiletries; hair care products; perfumery; cosmetics; deodorants.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; t-shirts; caps.</p> |

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| <p>The s. 5(3) ground is not pleaded in respect of the class 25 goods.</p>   |   |   |
| <p>CTM 5814942 for the mark:</p> <p>SO...? LUXURIOUS</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; 5(3)</p> | <p><b>Filing date:</b><br/>05 April 2007</p> <p><b>Registration date:</b><br/>13 March 2008</p>   | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Hair care preparations; perfumery; perfumed body spray; eau de toilette; cosmetics; personal care deodorants; body lotion; shower gel.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p> |
| <p>CTM 3188117 for the mark:</p> <p>SO...? THERE</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; 5(3)</p>     | <p><b>Filing date:</b><br/>09 May 2003</p> <p><b>Registration date:</b><br/>16 June 2004</p>      | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b>Toiletries; hair care products; perfumery; cosmetics; deodorants.</p> <p><b>Class 25:</b> Clothing; footwear; headgear; T-shirts; caps.</p>   |
| <p>CTM 4246311 for the mark</p> <p>SO...? WILD</p> <p>Opposition against the class 3 &amp; class 25 goods outlined in paragraph 1.</p> <p>Grounds pleaded:<br/>s. 5(2)(b) &amp; 5(3)</p>       | <p><b>Filing date:</b><br/>19 January 2005</p> <p><b>Registration date:</b><br/>03 April 2006</p> | <p><b>The following goods of the earlier mark are relied upon.</b></p> <p><b>Class 03:</b> Toiletries, hair care products, perfumery, cosmetics, deodorants, fragrance sachets, body lotions, shower gel, shimmer lotions.</p> <p><b>Class 25:</b> Clothing, footwear, headgear, T-</p>                     |

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|---|--|---|
|   |  | shirts, caps.   |
| <p>UK registration 2286577 for the mark:</p> <p>SO...? ONE</p> <p>Opposition against only the class 3 goods outlined in paragraph 1.</p> <p>Grounds pleaded: s. 5(2)(b)</p> | <p><b>Filing date:</b><br/>26 November 2001</p> <p><b>Registration date:</b><br/>15 April 2005</p> | <p><b>Class 03:</b> Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; non-medicated toilet preparations; preparations for the care of the skin, body and hair; deodorants; talcum powders; preparations for use in the bath; all included in Class 3; but not including any of the aforesaid goods for sale or for use in the professional hair care market, hairdressers or beauty salons.</p> |

**Under section 5(4)(a), use is claimed to have commenced in the UK in 1994 and that the goodwill of the business is associated with the following signs:**

**SO...?**  
**SO CHILLED**  
**SO COSMETICS**  
**SO...? DESIRABLE**  
**SO...? ETERNAL**  
**SO...? EXCITING**  
**SO HIM**  
**SO...? INSPIRED**  
**SO...? INTO THE NIGHT**  
**SO...? KISS ME ALL OVER**  
**SO MAX**  
**SO...? ON THE BEACH**  
**SO...? ON THE WILD SIDE**  
**SO...? SHOP TO YOU DROP**  
**SO...? SINFUL**  
**SO...? SUPERSTAR**  
**SO...? KISS ME**  
**SO...? WHAT**  
**SO...? WILD**  
**SO...? WITH A TWIST**