

O-314-11

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND  
THE TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION No 851694  
IN THE NAME OF WAALFIN HOLDING SA AND APPLICATION TO EXTEND  
PROTECTION IN THE UK TO THE TRADE MARK**

**BARBARA FARBER**

**IN CLASSES 3,9,14,18 AND 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 71966  
BY NÖLKEN HYGIENE PRODUCTS GmbH**

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**IN THE MATTER OF International Registration No. 851694  
in the name of Waalfin Holding SA and application to extend protection in  
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**IN THE MATTER OF Opposition thereto under No. 71966  
by Nölken Hygiene Products GmbH**

**BACKGROUND AND PLEADINGS**

1. On 12<sup>th</sup> September 2008 the UK was notified by the World Intellectual Property Organisation (hereafter, "WIPO") of international registration 851694, having an international registration date of 3<sup>rd</sup> May 2005, in respect of which it had been designated under the relevant provisions of the Madrid Protocol (hereafter, the "Protocol"). The relevant designation is as follows:

**BARBARA FARBER**

2. The designation stands in the holder's name, Waalfin Holding SA of 17, Rue Beaumont, L-1219 Luxembourg, Luxembourg (hereafter, "Waalfin"), and the following goods only are the subject of this opposition:

**Class 3**

Soaps, perfumery, essential oils, cosmetics, hair lotions.

3. The designation was accepted and advertised for opposition purposes on 6<sup>th</sup> February 2009. On 6<sup>th</sup> May 2009 Nölken Hygiene Products GmbH of Klarenplatz 2, D-53578 Windhagen, Germany (hereafter, "Nölken") filed notice of opposition. The opposition was based solely on the provisions of section 5(2)(b) of the Trade Marks Act 1994 (hereafter, "the Act"). Nölken relied on its own international registration, 832298, the details of which are as follows:



Date of designation in the UK: 26<sup>th</sup> May 2004

Priority date: 11<sup>th</sup> December 2003

Date of international registration: 26<sup>th</sup> May 2004

### **Goods**

#### **Class 3**

Soaps, perfumery, essential oils, cosmetics, in particular skin creams and skin cleansing products, oils, lotions and body powders, cosmetic products for nail care and nail cleaning, nail polish, nail polish remover, makeup removing products; makeup, bath additives, foam baths and shower products not for medical purposes; skin care wipes and skin cleansing wipes impregnated with oils and/or cosmetic lotions, deodorants for personal use, sun tanning preparations; hair lotions, cosmetic hair care products, hair rinses and hair dyeing products; hair styling products, in particular hair gel, hair wax and hair spray, shampoos, cotton sticks for cosmetic purposes, cotton wool pads, cotton wool and/or cellulose pads impregnated with oils and/or lotions for removing makeup; wipes impregnated with cosmetic lotions for removing skin blemishes and for cosmetic skin peeling for removing skin blemishes; dentifrices, mouth care products not for medical purposes.

#### **Class 05:**

Pharmaceutical preparations and sanitary preparations for medical purposes; pharmaceutical skin care and skin cleansing preparations; bath additives for pharmaceutical purposes; sunburn preparations for pharmaceutical purposes; pharmaceutical hair care products; skin care wipes and skin cleansing wipes impregnated with pharmaceutical lotions; wipes impregnated with pharmaceutical lotions for removing skin blemishes.

4. Nölken say the dominant element of the opponent's designation is the word 'BARBARA', being the first word of Waalfin's mark. As this word is identical to the dominant element in its own mark, and given the 'accepted principle' that consumers pay more attention to the beginnings of marks than to their endings, the marks are very similar on a visual and phonetic basis. The marks also share conceptual similarity in that they both make reference to a female name and would be viewed as 'BARBARA' marks. The goods covered by the respective specifications are identical and/or similar. Taking all factors into account there is a likelihood of confusion.
5. Waalfin filed a counterstatement denying the likelihood of confusion. It said the opponent's mark comprises the word 'BARBARA', underlined with the word 'BASIC' appearing underneath in a different font. There is a highly stylised 'N' in the background. Its mark is simply a word mark. The respective marks are thus not visually similar. Given the differences the marks are also phonetically different. In relation to cosmetics, perfumery, soaps etc, consumers are familiar with the names of designers being used as brands and are likely to give more weight to the surname, FARBER. In this regard there are several other 'BARBARA' marks on the CTM register in class 3. These all contain the word 'BARBARA' with some other element which distinguishes them and enables them to co-exist. Taking all factors into account there is no likelihood of confusion.
6. Evidence was filed by both parties which, only insofar as it is factually relevant I shall summarise below.

#### **Holder's evidence**

7. This takes the form of a witness statement dated 24<sup>th</sup> March 2011 from Jennifer Hitchcock, a trade mark attorney acting for Waalfin. Most of this is submission, but exhibit JJH1 comprises a print out of marks on the CTM register containing the word 'BARBARA'.
8. There is also a witness statement dated 24<sup>th</sup> March 2011 from Mr Gert van Noord, director of Waalfin. He says the trade mark 'BARBARA FARBER' has been used in relation to fashion products. Exhibit 1 shows the mark in use in respect of childrens' clothing, including for babies and, specifically, female wear. This exhibit also includes a list of UK customers comprising 72 names spanning the country. The pages of this exhibit are apparently taken from internal company catalogues and magazines.
9. He sets out the sales figures in the UK during the period Summer 2005 – Winter 2009. These are set out in Euros and contain sales to wholesalers and retailers. I will not set out these figures exhaustively, but simply provide several snapshots over this period. In Summer 2005, overall

sales amounted to 322,001 Euros. In Winter 2007, the figure was 349,423 Euros. In Summer 2009, 292,271 Euros and in Winter 2009, 270,365 Euros.

10. Mr van Noord says this use prior to the designation date shows the respective marks have co-existed without instances of confusion.

**Opponent's evidence in reply.**

11. For the record there are two witness statements, one from Edward Carstairs and the other from Alasdair MacQuarrie, both from the firm of attorneys acting for Nölken. Both witness statements however are simply critique of Waalfin's evidence rather than evidence of fact, except that Mr MacQuarrie exhibits the UK register record of 832298. Of course I shall take their submissions into account in my analysis below.

**DECISION**

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

12. The opposition is founded upon section 5(2) (b) of the Act. This reads:

“(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.”

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

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

14. By virtue of the Act and The Trade Marks (International Registration) Order 2008 (as amended) (hereafter, “the Order”) Nölken's mark is a protected international trade mark (UK). Protection of this mark was within

5 years of the publication of the subject designation, and accordingly, the earlier mark is not subject to proof of use requirements.

15. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a

composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.

### ***The average consumer***

16. The average consumer for both parties' products will be the soaps and cosmetics purchasing general public. There will thus be complete overlap as far as the identities of these respective average consumers are concerned. Nölken's products in class 5 are of a pharmaceutical nature but I will not focus further on these as, plainly, its best case rests in the goods covered in class 3.

17. The respective products are of an everyday nature and although purchased with some degree of circumspection (especially items like expensive perfume), things like soap and hair products, being less expensive and perhaps more routinely purchased, will not command the highest degree of circumspection.

18. I will factor these observations into my final analysis of likelihood of confusion.

### **Comparison of goods**

19. The respective goods are as follows:


Nölken's goods	Waalfin's goods
<p><b>Class 3</b></p> <p>Soaps, perfumery, essential oils, cosmetics, in particular skin creams and skin cleansing products, oils, lotions and body powders, cosmetic products for nail care and nail cleaning, nail polish, nail polish remover, makeup removing products; makeup, bath additives, foam baths and shower products not for medical purposes; skin care wipes and skin cleansing wipes impregnated with oils and/or cosmetic lotions, deodorants for personal use, sun tanning preparations; hair lotions, cosmetic hair care products, hair rinses and hair dyeing products; hair styling products, in particular hair gel, hair wax and hair spray, shampoos, cotton sticks for cosmetic purposes, cotton wool pads, cotton wool and/or cellulose pads impregnated with oils and/or lotions for removing makeup; wipes impregnated with cosmetic lotions for removing skin blemishes and for cosmetic skin peeling for removing skin blemishes; dentifrices, mouth care products not for medical purposes.</p>	<p><b>Class 3</b></p> <p>Soaps, perfumery, essential oils, cosmetics, hair lotions.</p>

20. Self evidently, the respective goods are identical. All the goods specified by Waalfin are included in Nölken's specification.



## Comparison of marks

21. The respective marks are as below:

Nölken's mark	Waalfin's mark
	BARBARA FARBER

22. Visually, Nölken's mark comprises the centrally dominant word, or rather, name, 'BARBARA', in upper and lower case and non-stylised script. Below this, in smaller letters, is the word 'BASIC' in plain, upper case. Both these verbal elements are set against a background of a stylised letter 'N'. Waalfin's mark comprises the two names, 'BARBARA' and 'FARBER'. It will be assumed by the average UK consumer that the first is a forename and the second the surname. Both marks therefore share the same visual element, being the name 'BARBARA' but that is the extent of the similarity. Taking the similarities and dissimilarities into account, I find that visually the marks are similar to a moderate degree.

23. Phonetically, Nölken's mark will be pronounced 'BAR – BRA BASE-ICK'. The background letter 'N' will not be enunciated. It is also, given its relatively small size and the fact the word, 'BASIC' may, to the average consumer, comprise a 'secondary indicator' of the particular range, sub-brand or just a description, very plausible that the word 'BASIC' may not even be enunciated at all. Waalfin's mark will be enunciated 'BAR-BRA FAR-BER'. 'Barbara' is an instantly recognisable female name in the UK although I have no evidence on exactly how common it is. It is likely the name will be enunciated in full rather than shortened to just 'BARBARA'. In this respect, although as I have said I have no evidence on exactly how common the name 'BARBARA' is, I suspect it is more common than the surname 'FARBER' and for that reason alone, a consumer is likely to opt to enunciate the full name when, for example, placing an aural order. In that way, there will be no doubt as to what is being ordered. Taking the similarities and dissimilarities into account I find that phonetically the marks are similar to a more than moderate degree.

24. By conceptual comparison, the authorities mean the semantic references and allusions conveyed by the respective marks. Inasmuch as either mark will convey any 'concept', it will be that of a personal name. The name 'Barbara' is, as I have said, a well-known female forename. 'Farber' is not, in my experience, an especially popular or well-known surname, but in the context of its usage, following the name 'BARBARA' it will undoubtedly be viewed as a surname. It is likely the name 'BARBARA FARBER', as a whole, will be assumed to be the designer or person responsible for the goods being sold under the mark. The same may or may not be true of Nölken's mark; as it is only the single forename 'BARBARA', the average consumer may assume the name has been chosen for reasons other than it is the personal name of the designer or some other person connected with the products.
25. Insofar then, as both parties' marks contain the female forename, 'BARBARA', the respective marks will share the same 'concept', but this is to ignore the effect of the marks *as totalities*, which convey different impressions of, on the one hand, a full name and, on the other hand, a forename. I therefore find the respective marks to be conceptually similar to only a low degree.

### **Overall similarity of marks**

26. Whilst there is other matter in Nölken's mark, the distinctive and dominant element will be taken to be the name 'BARBARA'. The word 'BASIC' is much smaller and will only have the impact suggested by me above in para 23 above. Despite its size, the background 'N' will similarly not be seen as the distinctive, dominant element in Nölken's mark as it is in the background and used almost decoratively. Accordingly, the name 'BARBARA' will present as the most immediately distinctive and dominant element.
27. The CJEU has given some guidance on the question of approaching the comparison of names, where one mark is the full name and the other mark is just the surname. Case C-51/09P *Barbara Becker v Harman International Industries Inc and OHIM ("Becker")* is worth quoting at length:

35. In the present case, having repeated all of the rules set out in paragraphs 30 to 33 of this judgment, the General Court held essentially, in its assessment of the conceptual similarity of the marks at issue, first, that, as consumers in part of the European Union generally attribute greater distinctiveness to the surname than to the forename in word signs, the component 'Becker' in the mark applied for was likely to have attributed to it a stronger distinctive character than

the component 'Barbara'; second, that the fact that Ms Becker is famous in Germany had no effect on the similarity of the marks at issue since they refer to the same surname and the component 'Barbara' is merely a forename and, third, that the component 'Becker' retained an independent distinctive role in the composite mark because it would be perceived as a surname.

36. Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname 'Becker' which the Board of Appeal noted is common.

37. Account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known, since that factor may obviously influence the perception of the mark by the relevant public.

38. Furthermore, it must be held that, in a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.

39. Moreover, as the Advocate General pointed out in essence, in point 59 of his Opinion, the grounds relied on by the General Court in order to conclude that the marks at issue are conceptually similar, if they were held to be consistent with Article 8(1)(b) of Regulation No 40/94, would result in acknowledging that any surname which constitutes an earlier mark could be effectively relied on to oppose registration of a mark composed of a first name and that surname, even though, for example, the surname was common or the addition of the first name would have an effect, from a conceptual point of view, on the perception by the relevant public of the composite mark.

40. It follows from all the foregoing that the General Court erred in law in basing its assessment of the conceptual similarity of the marks on general considerations taken from the case-law without analysing all the relevant factors specific to the case, in disregard of the requirement of an overall assessment of the likelihood of confusion, taking account of all factors relevant to the circumstances of the case, and based on the overall impression produced by the marks at issue."

28. The CJEU tells courts and tribunals to take account of the fact, for example, that the surname involved may be common or, to the contrary, unusual, as this is a question relevant to the distinctiveness of the mark containing the surname. Also, the CJEU asks courts to take account of the fact that the person requesting his first name and surname to be registered is well known, as that fact may also affect the perception of the public. Finally, the CJEU notes that a surname in a composite mark does not necessarily retain an independent role in a combined forename and surname mark solely by virtue of being perceived as a surname. All these observations are relevant to the case before me even though I recognise that this case engages marks having a shared *forename* rather than surname.
29. Unsurprisingly, Nölken asks me, in effect, to skew my analysis of distinctiveness and dominant elements of the respective marks towards the forename, 'BARBARA'. Both marks, it says, are 'BARBARA' marks. 'BARBARA' is the distinctive, dominant 'element' in Waalfin's mark, for no other reason than that it comes before 'FARBER' and in the application of what it terms an accepted trade mark 'principle' (namely, that consumers pay more attention to the first elements of marks than the later one(s)), the word 'BARBARA' must be dominant.
30. I reject this as being far too forensic and prescriptive an approach. The simple fact is that the mark 'BARBARA FARBER' will be seen as a personal name; 'BARBARA' qualifies 'FARBER' and 'FARBER' qualifies 'BARBARA'; the two names sit together as a whole<sup>1</sup>. We are not talking here about a two 'word' or 'element' mark, but what the average consumer would perceive as a single sign: a personal name.
31. That does not mean to say my analysis simply ignores the distinctiveness of each of the names contained in 'BARBARA FARBER' separately. Such an approach would fly in the face of the *Becker* case above. Account needs to be taken of the fact that, to the average UK consumer, the name 'BARBARA' will be more common and better known than the surname 'FARBER'. FARBER is therefore a more distinctive name to a UK consumer. This, of course, is not shared with Nölken's mark at all.
32. Taking all these factors into consideration, I find that, overall, the respective marks only share a low level of similarity.

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<sup>1</sup> The same point being made at Para 26 of *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40

### ***Likelihood of confusion***

33. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK of course being the prime example.
34. The earlier mark is the name, 'BARBARA', with the other verbal element 'BASIC', against a background of the letter 'N'. Plainly such a mark is distinctive in relation to the goods of the designation. Yet its distinctive, dominant element is a recognisable and common female forename and so I would not classify it as having by any means the highest level of distinctiveness. Instead, I find that it is inherently distinctive to a moderate degree. There is no evidence of Nölken's use of its mark in the UK and so I cannot say its inherent distinctiveness has been enhanced through use.
35. At this point I need to remind myself of my various findings and bring them together in a global assessment taking, of course, into account, the doctrine of imperfect recollection, namely that consumers rarely have the opportunity to compare marks side by side.
36. I have found that the respective goods are identical. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process to involve some, but not usually the highest degree of circumspection. Finally, I have found the respective marks to share a low level of similarity overall. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in one parties favour, it inevitably wins. All factors must be weighed in the evaluation of likelihood of confusion.
37. Taking all the factors into account, but in this case especially the analysis of the similarity of marks overall, I find there is no likelihood of confusion.
38. I should clarify that the fact there has been no instances of actual confusion is not a factor that has weighed in my overall finding. Alan Steinfield QC, sitting as a deputy judge of the High Court, in *Fiorelli Trade Mark* [2007] RPC 18 ("*Fiorelli*") gave weight to an absence of confusion in the marketplace. However, this should be tempered by a number of decisions which express caution about the circumstances in which it is appropriate to give these factors weight. Millet LJ in the Court of Appeal case in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291, says:

“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.”

39. I have not been persuaded this is a *Fiorelli* scenario, as plainly in that case, the respective marks operated in close proximity to each other in the same market place, so to speak. There is no evidence that prior to the relevant date, these respective marks have operated in close proximity, let alone any proximity at all and so on that basis, I have do not feel that parallel or concurrent usage without confusion is a factor in this case.

40. In any event of course I have nevertheless found the opposition to have failed in its totality.

### **Costs**

41. Waalfin is successful and is entitled to a contribution towards its costs. I take account of the fact that that the decision has been reached without a hearing taking place. In the circumstances I award Waalfin Holding S.A the sum of £700 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering Notice of Opposition and statement - £ 200  
Preparing and filing counterstatement - £200  
Filing evidence, submissions and considering evidence of Nölken –  
£300

Total £700

42. I order Nölken Hygiene Products GmbH to pay Waalfin Holding SA the sum of £700. The sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 08 day of September 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**