

In the matter of THE TRADE MARKS ACT 1994

In the matter of UK Trade Mark Application No. 2586969 'JUSTBE' in the name of GAIL BRYDEN

In the matter of Opposition No. 102638 by ULRICH JUSTRICH HOLDING AG

In the matter of the appeal of the Applicant from the decision of Mr C J Bowen dated 25 January 2013

DECISION

1. This is an appeal against a decision of Mr. C J Bowen, the Hearing Officer for the Registrar, dated 25 January 2013, BL O/042/13, in which he upheld an opposition by Ulrich Justrich Holding AG ("UJH") to a trade mark application made by Ms Gail Bryden.
2. The application was made on 27 June 2011 for the following goods and services: Class 3 - Oils and creams for use on the face and body, Class 4 – Candles containing essential oils for burning at home and Class 44 - Massage treatment services. The stylised mark for which registration was sought was:

The logo for 'justbe' is written in a lowercase, cursive script. The letters are connected, with a prominent loop on the 'j' and a long, sweeping tail on the 'e'.

3. UJH opposed the application on the basis of s 5(2)(b) of the 1994 Act, in reliance upon its earlier UK trade mark, No 2245480, which was registered on 6 April 2001, with effect from 14 September 2000, for the following goods in Class 3: Substances for laundry use; cleaning, polishing and scouring preparations, soaps; perfumery,

cosmetics, hair lotions; but not including cotton-wool, cotton-wool balls or cotton buds. UJH's mark is also a stylised mark:



4. Ms Bryden (who acted in person throughout the proceedings below and on the appeal) did not put UJH to proof of use of its mark, but argued in her counter-statement that for a number of reasons there was no likelihood of confusion between the marks.
5. Both parties filed evidence. Neither wished to be heard, but both provided written submissions. Mr Bowen therefore decided the matter on the papers before him. He found that there was a likelihood of confusion in respect of the goods in Class 3 and the services in Class 44 of Ms Bryden's application, but no likelihood of confusion in respect of the goods in Class 4, such that the opposition succeeded in part. Ms Bryden now appeals that decision.

Standard of review

6. This appeal is by way of a review; it is not a rehearing. *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") show that neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision, suffice to justify interference in this sort of appeal. Instead, if I am to uphold the appeal, I need to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef*, para. 28).

This guidance is particularly important when considering appeals which turn on the assessment of the likelihood of confusion. In *Digipos* [2008] R.P.C. 24, Mr Alexander QC held:

“5. It is important at the outset to bear in mind the nature of appeals of this kind. ... As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference. I approach this appeal with that in mind.”

7. Similarly, Floyd J (as he then was) said in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), [2013] E.C.C. 17 which was a similar appeal as to the Hearing Officer's assessment of the similarity of the marks and as to the likelihood of confusion:

“The hearing officer was engaged in a multifactorial assessment which her expertise ideally qualified her to undertake. This is not a fruitful field in which to discover an error of principle. I am unable to see any error of principle in her legal approach, or in the way in which she applied it to the comparison in this case. She reached a conclusion which she was entitled to reach”.

8. The approach which I need to adopt, therefore, is to decide whether there are errors of principle or material errors which amount to “genuine errors of approach” in the Hearing Officer's decision. If so, the decision should be set aside, even if the error relates to the assessment of the likelihood of confusion; if not, even if I would not have reached the same conclusion as the Hearing Officer, the decision should not be set aside.

The basis of the appeal

9. Ms Bryden's Grounds of Appeal in summary raised the following issues:
 - i) The Hearing Officer failed to take into account certain (identified) parts of her evidence;

- ii) The Hearing Officer erred in his assessment of the similarity of the marks;
- iii) Comparison of the marks in use, and as marketed, demonstrated that there was no likelihood of confusion, especially in relation to the Class 44 services;
and
- iv) The Hearing Officer was wrong to discount Ms Bryden's argument that the marks had co-existed on the market without confusion, suggesting that there was no likelihood of confusion.

The Hearing Officer failed to take into account certain parts of the evidence

- 10. Ms Bryden had intimated in her evidence that a number of third parties used other 'Just' marks in relation to cosmetic products. She listed a number of such products in Appendix 11 to her witness statement of 26 April 2012 and referred to certain websites presumably selling or advertising those goods. However she did not exhibit any print-outs of relevant web-pages. The Hearing Officer commented at paragraph 7, and reiterated at paragraph 33, of his decision that as she had not provided copies of the relevant websites this evidence did not assist her.
- 11. On the appeal, Ms Bryden submitted that this meant that he had ignored relevant evidence as to the common use of the word 'Just' in the field of cosmetics. Copies of print-outs were produced for me, but Ms Bryden accepted that she had not filed them for the Hearing Officer, as she had not realised she needed to do so.
- 12. It does not seem to me that the Hearing Officer's dismissal of this element of Ms Bryden's evidence is a material error in his decision. In the first place, it is not for a Hearing Officer to make good substantive defects in a party's evidence, even if that party is unrepresented. Secondly, there is a good reason why a party should exhibit printouts of web-pages, namely that such pages can change almost from day to day and it is important that the parties and the Hearing Officer all consider the same evidence. More importantly, perhaps, even if the Hearing Officer had been prepared

to look at the websites, Ms Bryden's evidence merely stated that "The word 'just' has been adopted by many brand owners, whether registered or unregistered ..." and did not give any further details of the nature, duration or scale of use of any such products. As a result, it cannot be said with any certainty what relevance (if any) such third party brands had to the issues before the Hearing Officer, although Ms Bryden's point was that the word 'just' is in common use in the sector. However, the fact that there may be other registered or unregistered marks including the word 'just' does not, without further evidence, show that UJH's mark could not be raised in opposition to Ms Bryden's application as lacking distinctiveness, etc. I note that in *Digipos*, where the appellant sought to rely upon evidence of numerous other DIGI-prefixed marks on the market, Mr Alexander QC held:

"61 I should say that I am unpersuaded by the appellant's argument that there is no likelihood of confusion *merely* because other marks with a DIGI-prefix were used and co-existed. Co-existence does not, of itself, negate the possibility of confusion. Rather, the existence of the other marks rather shows that the common element relied upon (DIGI-as a prefix) is unlikely to be viewed, in the context of the appellant's marks, as denoting a specific trade origin. There is also reference to another undertaking using the mark DIGI as such which may have pre-dated the respondent's use but, for present purposes, I regard that material as of lesser relevance. What it does show is that the term DIGI, even otherwise than as a prefix, is not unique as a mark but that does not seem to me to be directly relevant to the analysis required under Art.5(2)(b)."

13. The Hearing Officer said at paragraph 33 of his decision that, without details of any other 'just' trade marks, he considered that the word was not descriptive or non-distinctive of UJH's Class 3 goods. That conclusion does not in my view disclose any error of principle or any material error, and as a result the first ground of appeal fails.

The Hearing Officer erred in his assessment of the similarity of the marks

14. Ms Bryden submitted that the Hearing Officer had erred in assessing the aural similarity of the marks, because UJH's mark is pronounced in the German fashion as 'Yoost,' not as the English word 'Just.' It may be that she is right to say that UJH or its agents pronounce the word in that way, but it does not seem to me that the average member of the public in the United Kingdom would be aware that it should be pronounced in that way. It seems to me that the Hearing Officer was right in his assessment of aural similarity in paragraph 35 of the decision.
15. Ms Bryden similarly submitted that the Hearing Officer had not given enough weight to the visual differences between the marks. She wished to rely upon the differences in the get-up used by the parties, as well as the differences between the trade marks as registered. In my view, the Hearing Officer correctly approached the task of comparing the trade marks as registered/sought to be registered, and he clearly considered the visual differences between them. There is no basis for me to interfere with his finding on appeal.
16. Ms Bryden also submitted that the conceptual differences between the parties' respective marks which the Hearing Officer identified in paragraph 36 of his decision should have led him to conclude that there was no likelihood of confusion between them. However, the fact that there is no similarity between marks on one of the three bases of comparison (visual, aural or conceptual) is not always sufficient to prevent a likelihood of confusion arising, because of the way in which the global assessment of the likelihood of confusion must be carried out by the tribunal and the interdependence of the numerous factors to be considered. This was made plain by the CJEU in *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, Case C-342/97, [1999] ECR I-3819; [1999] 2 C.M.L.R. 1343; [2000] FSR 77 where at [29] it held that it is possible that mere aural similarity between trade marks may lead to a likelihood of confusion.
17. Paragraph 39 of the decision below shows the numerous matters weighed up by the Hearing Officer in concluding that there was a likelihood of confusion insofar as the

Class 3 goods and Class 44 services were concerned, and there is nothing in that paragraph which suggests to me that he failed to give proper weight to the lack of conceptual similarity between the marks. This ground of appeal also fails.

Comparison of the marks in use, and as marketed, demonstrated that there was no likelihood of confusion, especially in relation to the Class 44 services

18. Ms Bryden submitted that the Hearing Officer had been wrong to find that the differences in the ways in which the parties' marks are used and marketed demonstrated that there was no likelihood of confusion, especially in relation to the Class 44 services. She relied upon the price differentials between the products, and upon the manner in which she told me that UJH sells its products, as showing that the parties' respective cosmetics in Class 3 were sufficiently different as not to be likely to be confused. She also relied upon the care with which the average consumer chooses cosmetic/skincare products as tending to avoid confusion. As to this last point, the Hearing Officer considered carefully the level of attention which the average consumer would apply to Class 3 purchases in paragraphs 14-16 of his decision, and found that at least a reasonable degree of care would be used.
19. However, there was a distinct lack of evidence before the Hearing Officer as to how UJH had used its mark in the UK prior to the relevant date; UJH's evidence as to its past use was either undated or related to periods after the relevant date, perhaps because it had not been put to proof of use. Moreover, Ms Bryden's submission relates, at best, to the past use by the parties of their trade marks, not to the breadth of the trade mark specifications, which is what the Hearing Officer had to look at. For the same reason, the *Schuh* passing off case to which Ms Bryden referred me does not help her in this context.
20. It seems to me that the Hearing Officer was right to find at paragraph 44 of his decision that the Class 3 goods for which Ms Bryden sought registration were identical to the Class 3 goods in UJH's registration, and in the circumstances, as he took into account the numerous factors set out in paragraph 39 of his decision, it does not seem to me that Ms Bryden's point shows any error of principle or material

error in the Hearing Officer's conclusion that there is a likelihood of confusion between the parties' respective Class 3 goods.

21. As to the Class 44 services, Ms Bryden submitted that the average consumer would be the professional masseur or therapist providing the massage treatment services, who would not be confused as to the products to be used upon his or her clients. However, whilst some consumers of those services may indeed be such professionals, other relevant consumers are the recipients of the massage treatment services. The Hearing Officer considered such average consumers in paragraphs 15 and 42 of his decision, and it does not seem to me that there is any error of principle or material error in his analysis, or in his finding that there was a likelihood of confusion between the marks in relation to the Class 44 services.

The Hearing Officer was wrong to discount Ms Bryden's argument that the marks had co-existed on the market without confusion, suggesting that there was no likelihood of confusion.

22. Lastly, Ms Bryden submitted that the Hearing Officer had failed to give sufficient weight to the fact that the parties had used their marks in parallel in the United Kingdom for some years without evidence of any confusion having arisen, casting doubt on his finding that there was a likelihood of confusion.
23. The Hearing Officer dealt with this point at paragraph 45 of his decision. Ms Bryden had traded using her mark for about 2 years prior to the date of her trade mark application. The Hearing Officer noted that her evidence showed a "relatively low level of turnover achieved" by such trade, in a limited geographical area, and concluded that the evidence "falls a long way short of allowing me to conclude that by the date of her application for registration, the average consumer had become exposed to the competing trade marks to such an extent that they are able to distinguish between them."
24. It seems to me that the Hearing Officer approached this point as suggesting that this was a case of honest concurrent use, in which both marks had established distinctiveness, as in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2012]

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EWCA Civ 880; [2012] 3 All E.R. 1405; [2013] R.P.C. 12; [2012] E.T.M.R. 48 CA at [23] and [33] following Case C-482/09, 22 September 2011, [2011] ECR I-08701. If so, his conclusion in that regard does not disclose any error.

25. I think it possible that the Hearing Officer misunderstood Ms Bryden's argument in this regard, which may instead have been (as it was on the appeal) that use of the marks in parallel on the market had not, in the past, led to any confusion, such that there could not be said to be a likelihood of confusion. However, even if the Hearing Officer had approached the point in this way, I do not consider that his decision would have changed. He had no reliable evidence before him as to the nature, extent etc of UJH's UK trading prior to the relevant date, which would have enabled him to conclude that there was parallel trading without confusion, sufficient to counter his views as to the likelihood of confusion on the basis of notional fair use of the marks.
26. For all these reasons, the appeal fails. Costs should follow the event, and I order Ms Bryden to pay a contribution towards UJH's costs of £1000, to be paid (given the Christmas holidays) within 28 days of today, together with the £800 ordered to be paid by the Hearing Officer.

Amanda Michaels

The Appointed Person
9 December 2013

Ms Gail Bryden, the applicant/appellant, appeared in person

Mr Steven Wake of Forresters appeared on behalf of the opponent/respondent.