

**O/047/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:  
TRADE MARK APPLICATION NO. 3213158 BY GLOBALSOUQ LTD  
TO REGISTER THE FOLLOWING TRADE MARK:**



**AND OPPOSITION THERETO UNDER NO. 409107 BY THE BOOTS COMPANY PLC**

**AND**

**TRADE MARK REGISTRATION NUMBER 3213157  
IN THE NAME OF GLOBALSOUQ LTD FOR THE TRADE MARK:**

**Starry Smiles**

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY UNDER NO. 501673  
BY THE BOOTS COMPANY PLC**

## **Background and pleadings**

1. The first claim in these consolidated proceedings is an application for a declaration of invalidity of a trade mark owned by globalsouq Ltd (“globalsouq”), namely trade mark registration number 3213157 for the trade mark **Starry Smiles**. The application to register the trade mark was made on 16 February 2017 and the mark was registered on 12 May 2017 for “teeth whitening powder” in class 3. The application to invalidate the registration was made by The Boots Company Plc (“Boots”) on 25 May 2017. The invalidation is directed against all of the goods in the registration.

2. The second claim is an opposition to the registration of trade mark number 3213158 for the following trade mark:



The trade mark was applied for on 16 February 2017 by globalsouq and the application was published for opposition purposes on 3 March 2017. The specification was amended after publication and the application is now made for “teeth whitening powder” in class 3. It is opposed by Boots and the opposition is directed against all of the goods in the application.

3. Both the opposition and the invalidation are based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The claims are identical in both. Boots relies upon the following earlier trade marks:

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<sup>1</sup> I note that, in its form TM26(l) (application for a declaration of invalidity), Boots has not ticked the relevant box to indicate the ground which is being relied upon. It is, however, plain from the statement of grounds that Boots’ claim is brought under s. 5(2)(b).

- (i) UK trade mark number 2435807 **SMILE**. The mark was filed on 17 October 2006 and was entered in the register on 22 February 2008. The following goods are relied upon in these proceedings:

Class 3: Dentifrices; denture cleaners; denture polishes; preparations in the form of tablets for cleaning dentures; preparations in the form of powder for cleaning dentures; preparations in the form of paste for cleaning dentures; preparations for cleaning artificial dentures; breath fresheners; mouthwash preparations for oral hygiene purposes; toothpastes.

Class 5: Adhesives for dentures; denture fixative powder; denture fixative paste; denture base materials; breath fresheners; mouthwashes.

Class 10: Dental apparatus and instruments; handles for dental floss; dental tape.

Class 21: Denture baths; denture brushes; dental sticks for personal use; dental floss; dental flow [presumably “floss”] in the form of tape; dental floss in the form of thread; dental flossing aids; containers for toothbrushes; electric toothbrushes; holders for toothbrushes; non-electric toothbrushes.

- (ii) UK trade mark number 2309503 for the following series of two trade marks:



The application to register the series was filed on 31 August 2002 and the marks were entered in the register on 7 February 2003. Boots relies upon all of the goods for which the marks are registered, namely “toothpaste and mouthwash” in class 3 and “toothbrushes and dental floss” in class 21. As nothing turns on the difference in colour, I will refer to the series of marks in the singular.

4. Boots claims that globalsouq’s marks are similar to the earlier trade marks and that the goods are “at the least” similar to the goods upon which Boots relies. Boots claims that there is, as a result, a likelihood of confusion, including a likelihood of association. Given their dates of filing, the above trade marks qualify as earlier marks under s. 6 of the Act. In its pleadings, Boots made a statement that it has used the earlier marks in relation to all of the goods relied upon. This statement is made because the earlier marks are, in theory, subject to the proof of use provisions contained in s. 6A of the Act.

5. Globalsouq filed counterstatements in which it denies the basis of the claims. I note in particular its claims that:

- “the Boots’ [sic] brand of “Smile” [...] has a distinctively different logo and products from Starry Smiles”;
- “Smile” and “Smiles” are non-distinctive and “not unique in relation to dental care products”;
- The parties’ goods reach the market through different channels, with globalsouq’s products being sold on its own website and through Ebay, and Boots’ goods being available in Boots stores and on its own website;
- The packaging used by globalsouq is “distinctive” and/or “distinctively different” compared with that of Boots’ products;
- The goods at issue are not identical and “arguably not even similar”;
- There is “no compelling evidence that the public would be misled or confused”.

6. I also note that globalsouq indicated in its counterstatements that proof of use was not required. As a consequence, Boots may rely upon all of the goods it has identified.

7. Boots has been represented throughout by its Group Intellectual Property Department. Globalsouq was not initially represented but is now represented by Fry Heath & Spence LLP. Only Boots filed evidence; both parties filed submissions during the evidence rounds. Whilst neither party asked to be heard, Boots filed written submissions in lieu of attendance at a hearing. I will bear all of the parties' submissions in mind and refer to them, as necessary, below.

### **Preliminary issue**

8. Globalsouq has made a number of comments both in its counterstatements and in its submissions regarding the actual products which are sold by the parties, their packaging and their marketing. It is necessary to explain why, as a matter of law, those factors will play no part in this decision. In the absence of a request for evidence of use, the comparison must be made on the basis of notional use of the marks across the full width of the specifications. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

9. This approach has recently been endorsed by the Court of Appeal in *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84).

10. As far as globalsouq's use of the applied-for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the CJEU stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. There is no evidence before me of globalsouq's use of its marks and, in any event, it is clear from the case law cited above that my assessment must take into account only the marks (and their specification) and any potential conflict with the earlier trade mark. Any differences between the goods provided by the parties, or differences in their trading styles, are irrelevant unless those differences are apparent from the applied-for and registered marks.

### **Evidence**

11. The opponent's evidence consists of the witness statement of Katie Smith, the opponent's trade mark attorney, with two exhibits. Exhibit KS1 consists of prints from the UK register of the opponent's earlier marks. It adds nothing.

12. Exhibit KS2 is a print from oxforddictionaries.com showing a definition of the word "smile", which is described as "[form] one's features into a pleased, kind, or amused expression, typically with the corners of the mouth turned up and the front teeth exposed".

### **Decision**

13. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

[...]

(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”.

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The principles are:

(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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.



15. I will begin by considering the actions based on Boots' earlier trade mark registration 2435807 for the word "SMILE", as this represents Boots' best case. If the opposition fails in relation this mark, it will also fail in relation to the other, less similar, mark.

### **Comparison of goods and services**

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment:

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

17. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd*, [1996] R.P.C. 281 (the *Treat* case), where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. Boots has not explained in any detail the extent to which the goods in globalsouq's specifications are similar to those of the earlier marks, simply claiming that:

"[...] all of the goods in class 3 as claimed by [globalsouq] are similar to all of the dental related products claimed by [Boots'] earlier rights in classes 3, 5 and 21. For example, [globalsouq's] "*teeth whitening powders*" are at the very least similar, if not identical, to goods such as toothpaste and mouthwashes that are readily used to whiten the teeth".<sup>2</sup>

19. Globalsouq submits there is no similarity between the goods. It considers that "preparations in the form of powder for cleaning dentures" and "toothpastes" in class 3 of Boots' registrations are the closest goods to those covered by its own marks. It acknowledges that there may be "some overlap" in users and trade channels but argues that the nature and purpose of the respective goods are different, because teeth whitening powders are used to whiten teeth, whilst toothpastes and denture cleaning powders and mouthwashes are for cleaning teeth and/or freshening breath. It claims that Boots' products do not contain chemical agents to change the colour of teeth and that Boots' goods are bought for health purposes rather than the cosmetic purposes for which globalsouq's goods are purchased. It further claims that there are differences in both the frequency and method of the application.

20. For the reasons I explained at paragraphs 8-10, above, the comparison must be made not on the basis of the products actually sold by the parties but on the notional use across the respective specifications. Globalsouq's specifications read "teeth

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<sup>2</sup> Submissions in lieu, p. 5.

whitening powder”. Boots’ word-only “SMILE” mark includes in its specification the term “dentifrices”. In my view, this represents Boots’ best case. The *Oxford English Dictionary* defines “dentifrices” as “a paste or powder for cleaning the teeth”.<sup>3</sup> These goods, therefore, have the same nature as globalsouq’s “teeth whitening powder”. There is an overlap in purpose as, notwithstanding globalsouq’s comments regarding bleaching, both cleaning and whitening can be said to involve the removal of stains. The users and channels of trade are identical. I note globalsouq’s claim that the goods are used differently. However, there is no evidence to show how the goods at issue are used and it seems to me that both could require application to the teeth and rinsing off in an identical way. I consider that the goods are highly similar, if not identical.

### **The average consumer and the nature of the purchasing act**

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

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<sup>3</sup>[http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m\\_en\\_gb0216810?rskey=eSmnMA&result=1](http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0216810?rskey=eSmnMA&result=1) [accessed 3 January 2018].

22. Given my finding regarding the similarity between “teeth whitening powder” and “dentifrices”, the relevant average consumer is the consumer of those goods. The parties have not commented in any detail on the identity of the average consumer. The goods at issue are general consumer items which are likely to be purchased by members of the general public. They are likely to be purchased following a visual inspection of the goods on shelves in retail premises such as supermarkets and chemists’ shops, as well as their online equivalents. I do not discount that there may be an aural component but the purchase is likely to be primarily visual.

23. The goods at issue are likely to be the subject of, if not everyday, then reasonably frequent purchase. They are not, in general, particularly expensive items, though the average consumer is likely to take into account whether, for example, the product is suitable for sensitive teeth or whether it contains fluoride. I consider that an average level of attention, not materially higher or lower than the norm, will be paid to the selection of the goods.

### **Comparison of trade marks**

24. It is clear from *Sabel* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

25. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

26. Boots submits that the marks at issue are visually very similar, and phonetically and conceptually similar to Boots' earlier trade mark. I note in particular Boots' submission that "the depiction of the lips and teeth in [globalsouq's device mark] is not striking, and nor is it uncommon in respect of the amended goods covered by their application".<sup>4</sup> I also note Boots' contention that "Smile" plays an independent distinctive role in globalsouq's trade marks.

27. Globalsouq submits that there is an "extremely low" level of visual similarity between the parties' marks, whilst there is a low level of aural and conceptual similarity. It submits that "the word SMILE *per se* plays only a weak role" in the overall impression of the marks.<sup>5</sup>

28. Boots' mark consists of the word "SMILE", presented in capital letters. The overall impression and the distinctiveness of the mark are contained in that word.

(i) Trade mark number 3213157

"Starry Smiles"

29. Globalsouq's word mark consists of the words "Starry Smiles", presented in title case. Neither word dominates the other, each having an equal impact in the overall impression.

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<sup>4</sup> Submissions in lieu, p. 3.

<sup>5</sup> Submissions, p. 4.

30. There is some similarity between the respective marks as they both contain the words “SMILE”/“Smile”. There is, however, also a clear difference, due to the presence of the word “Starry” at the beginning of globalsouq’s mark. The marks are visually and aurally similar to a medium degree. Conceptually, the earlier mark has the clear, known concept of a smile. Whilst the later marks share the reference to a smile, the notion of a “starry smile” in globalsouq’s marks is somewhat odd and is, in my view, most likely to lead the average consumer to imagine a sparkling or, possibly, celebrity-white smile. The marks are conceptually similar to a medium degree.

(ii) Application number 3213158



31. Globalsouq’s device mark contains a number of elements. There is a stylised representation of a pair of lips, in red and turned upwards at the corners. Teeth are shown between the lips. On the teeth are short grey lines, arranged in circles, which give the impression of the teeth sparkling. Underneath the device are the words “Starry Smiles”, in title case, in a slightly stylised dark blue font. At the top right of the word “Smiles” is a small, dark blue device, with a circle in the centre and lines radiating out, which resembles a star. Given their relative size and positioning, I consider that the device of a smiling mouth on the one hand and the words “Starry Smiles” on the other will make a roughly equal contribution to the overall impression. The device of a star, in blue, plays only a weak role.

32. There is some visual similarity between this mark and the earlier mark due to the shared presence of the word “SMILE”/“Smiles”. However, globalsouq’s mark also contains a significant device element, as well as the word “Starry”, neither of which have any counterpart in the earlier mark. I consider that there is a low degree of visual similarity between the marks. Similar considerations apply to the aural comparison but,

as the device element in globalsouq's mark will not be articulated, the marks are aurally similar to a medium degree. Notwithstanding the presence of a device, I do not consider that the conceptual position is materially different than in relation to the word-only mark, as the device merely reinforces the meaning conveyed by the words. The marks are conceptually similar to a medium degree.

### **Distinctive character of the earlier trade marks**

33. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)".

34. Globalsouq submits that:

"the word "smile" alone is commonly used by third parties in respect of toothpastes and is not associated with a particular source.

[...] with regard to the inherent characteristics of BOOTS's registration, they contain a word that is at least indirectly descriptive of toothpastes/powders because clean teeth are likely to cause a user to smile".

35. Boots submits that its earlier mark is "inherently distinctive, since [it] not in any way allude[s] to the relevant goods". It also claims that the distinctiveness of its mark has been enhanced through use. However, although Boots filed evidence, it did not file any evidence which shows the use that has been made of its mark. In the absence of any such evidence, Boots' claim to enhanced distinctiveness is dismissed.

36. Turning to the inherent position, invented words usually have the highest degree of inherent distinctive character whilst words which are descriptive of the goods and services relied upon normally have the lowest. The judgment of the CJEU in *Formula One Licensing BV v OHIM* Case C-196/11P indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character. The dictionary word "SMILE" is highly allusive in relation to the goods at issue, which are concerned with maintaining or improving one's smile, among other things. I consider that the earlier mark has a low degree of inherent distinctive character.



## **Likelihood of confusion**

37. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering them from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct (the average consumer mistaking one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related).

38. Indirect confusion was described in the following terms by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

39. It is clear that the categories identified by Mr Purvis are illustrative not exhaustive (see *N.V. Sumatra Tobacco Trading Co. v TCBAT International Co. Ltd* O/005/18 at [34]-[35]).

40. I also remind myself of Mr Purvis’s comments, again while sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, where he pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said

in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it”.<sup>6</sup>

41. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask “in what does the distinctive character of the earlier mark lie?”. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

#### Trade mark registration 3213157

42. Globalsouq’s word-only trade mark is visually, aurally and conceptually similar to the earlier mark to a medium degree. However, the point of similarity between the marks rests in an element which has only a low level of distinctiveness. The goods at issue are highly similar and are bought with an average level of attention. Bearing in mind all of the competing factors, I do not consider that there is a likelihood of confusion, whether direct or indirect. The relative novelty of the concept evoked by the combination “Starry Smiles” is sufficiently unusual to distinguish the later mark from the earlier mark’s single word “SMILE”, which is low in distinctive character. In particular, the unusual combination means that globalsouq’s mark will not be perceived as a natural brand extension of the earlier mark. Even if the average consumer does become aware of both products, given the low distinctive character of the common element, the similarity between the marks is likely to be attributed to coincidence rather than economic connection. There is no likelihood of confusion.

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<sup>6</sup> This proposition was recently approved in *Nicoventures Holding Limited v The London Vape Company Limited* [2017] EWHC 3393 (Ch) at [23].

## Application 3213158

43. This device mark is visually similar to the earlier mark to a low degree, and the marks are aurally and conceptually similar to a medium degree. However, as with the registered mark, above, the point of similarity is in an element low in distinctiveness. Moreover, there is a lower degree of visual similarity between these marks, though I accept that the device is not particularly distinctive. Nonetheless, for the same reasons as given above, I do not consider that there is a likelihood of confusion, whether direct or indirect.

44. For the record, my findings would have been the same if I had found the goods to be identical.

### **Conclusion**

45. Both the opposition and the invalidation have failed.

### **Final remarks**

46. I have not judged it necessary to consider Boots' remaining trade mark, as it is less similar to globalsouq's marks than the mark I have considered and offers no stronger a position in respect of the goods for which it is registered. Boots' case would not be materially improved were I to consider the actions based on a less similar mark and I decline to do so.

### **Costs**

47. As globalsouq has been successful it is entitled to a contribution towards its costs. It was unrepresented in the initial stages and the award is reduced accordingly. Although Boots filed evidence, it was very light and will have taken very little time to consider.

Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using that TPN as a guide but bearing in mind my comments, above, I award costs to globalsouq on the following basis:

Preparing a statement and  
considering the other side’s statement (x2):      £200

Considering the other party’s evidence  
and preparing submissions:                              £300

Total:    £500

48. I order The Boots Company plc to pay globalsouq Ltd the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 22<sup>nd</sup> day of January 2018**

**Heather Harrison  
For the Registrar  
The Comptroller-General**