

O-126-18

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NO 3186263

**IN THE NAME OF IMAX GROUP LIMITED AND
OPPOSITION THERETO (UNDER NO. 408196) BY**

BENZO INTERNATIONAL LTD.

&

TRADE MARK APPLICATION NO 3185584

**IN THE NAME OF BENZO INTERNATIONAL LTD.
AND OPPOSITION THERETO (UNDER NO. 408753) BY**

IMAX GROUP LIMITED

BACKGROUND

1) This dispute concerns two consolidated trade mark oppositions. The parties to the dispute are iMax Group Limited ('iMax') and Benzo International Ltd. ('Benzo Intl').

2) On 18 September 2016, iMax applied to register **BENTO** as a trade mark in respect of 'cosmetics' in class 03 and 'bags for cosmetics' in class 18. The application was published in the Trade Marks Journal on 07 October 2016 for opposition purposes. Benzo Intl claims that iMax's application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). Benzo Intl relies upon its trade mark application, filed on 14 September 2016 and published on 09 December 2016, for the word **BENZO**. That mark was applied for in relation to various goods and services in classes 3, 14, 26 and 38. However, only the goods in class 03 are relied upon in support of the claim under section 5(2)(b). Those goods are 'Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps'.

3) In response to the above opposition, iMax opposed Benzo Intl's abovementioned application for **BENZO**. The opposition was initially directed against all of the goods and services of the application but is now directed only against the goods in class 03.¹ iMax relies on four earlier registered marks under section 5(2)(b) of the Act. I need only set out the details of one of those marks here, given that, at the hearing, Mr Mills confirmed that it represents iMax's strongest case. That mark is **My Beauty Bento** which was applied for on 09 June 2016 and entered in the register on 23 September 2016 in respect of 'cosmetics' in class 03.

4) Both parties filed a counterstatement in defence of their respective trade mark applications denying the other's claim of a likelihood of confusion under section 5(2)(b) of the Act.

¹ As confirmed by Mr Mills at the hearing.

5) Neither party filed evidence. A hearing took place before me on 25 January 2018. iMax was represented by Mr Stephen Mills. Benzo Intl did not attend the hearing or file written submissions in lieu.

6) At the hearing, Mr Mills requested leave to add a further ground of opposition against the mark **BENZO** in class 03 under section 3(6) of the Act. In support that request, Mr Mills had, two days prior to the hearing, furnished information which he stated shows that the sole director of Benzo Intl is Mr Michael Gleissner. Mr Mills explained that his investigations had unearthed a pattern of behaviour by companies of which Mr Gleissner is a director which shows that Benzo Intl has no bona fide intention of using the mark applied for in trade and the company has therefore applied for that mark in bad faith. Mr Mills explained that he was not aware of this pattern of behaviour when the opposition was originally filed and that is why the 3(6) ground was not pleaded upfront.

7) I provisionally allowed Mr Mills' request to add the ground under section 3(6). However, I explained that it could not be considered at the hearing because the other party had not had an opportunity to respond to that claim. In the circumstances, I explained to Mr Mills that the hearing would proceed and I would hear his submissions on the existing respective 5(2)(b) grounds only, before issuing a decision solely on those grounds. In the event that I find iMax's opposition to the **BENZO** mark succeeds under section 5(2)(b), there will be no need to also consider the 3(6) claim. In the event that iMax's opposition fails under section 5(2)(b), the claim under section 3(6) will be dealt with as separate proceedings under rule 62(1)(h) of The Trade Marks Rules 2008 and I will issue further directions in this regard.

DECISION

8) Turning then to consider the existing respective grounds under section 5(2)(b), it is appropriate to begin by considering iMax's opposition to Benzo Intl's application for the mark **BENZO**. This is because, if that opposition succeeds, the basis of Benzo Intl's opposition to the mark **BENZO** will fall away.

9) iMax's earlier mark, **My Beauty Bento**, is an earlier mark in accordance with section 6 of the Act and, as it had not been registered for more than five years before the publication date of Benzo Intl's mark **BENZO**, it is not subject to the proof of use requirements, as per section 6A of the Act.

10) Section 5(2)(b) of the Act provides that:

“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.”

11) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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

(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.

Comparison of goods

12) The respective goods are:

iMax's goods	Benzo Intl's goods
Class 03: Cosmetics	Class 03: Perfumery; essential oils; cosmetics; make-up; eye-make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

13) I note that Benzo Intl has conceded that all of its goods, with the exception of 'essential oils', fall within iMax's 'cosmetics' and therefore those goods are identical.²

14) In relation to 'essential oils' I bear in mind that, in the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

"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".

15) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

² Paragraph 12 of the counterstatement refers.

- 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.

16) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

17) I also note that in *La Mer v OHIM*³ the General Court stated:

"110. As regards the assessment of the similarity of the goods in question, it must be stated, as the Board of Appeal correctly noted in paragraph 33 of the contested decision, that 'cosmetics' in the Community trade mark application include 'cosmetics of a marine product base', so that they are identical.

³ T-418/03

111. So far as concerns 'soaps, perfumery, essential oils, hair lotions, dentifrices, toiletries' in the Community trade mark application, it should be stated that they share hygiene and cosmetic properties. The cosmetic products of the earlier mark may also be used for hygiene purposes. As was stated in paragraphs 77 to 84 above, soaps and bath additives are used not only for cleaning the skin but also for making the skin more beautiful and claim therefore to have cosmetic properties. On that point, in paragraph 33 of the contested decision the Board of Appeal correctly noted that beautification is not obtained only by the use of traditional means, such as make-up or other cosmetics, but also through the use of products which, although they may be hygienic, serve beauty purposes as well: for example, soap that is composed in a manner whereby there is only a minimum of skin dehydration, thus leading to a more beautiful skin ...

112. Moreover, those products may be sold in the same sales outlets and be directed at an identical category of consumers. In addition, quite often the manufacturers of those products are the same.

...

114. The Board of Appeal was therefore right to take the view, in paragraph 33 of the contested decision, that 'soaps, perfumery, essential oils, hair lotions, dentifrices, toiletries' under the Community trade mark and 'cosmetics of a marine product base' under the earlier mark are very similar." (my emphasis)

18) Having regard for the above case law and bearing in mind, in particular, the likely shared channels of trade, the goods being aimed at the same users and their shared intended purpose and similar nature, I find that there is a medium degree of similarity between iMax's 'cosmetics' and Benzo Intl's 'essential oils'.

Average consumer and the purchasing process

19) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

20) The average consumer of the goods at issue is the general public. They may be accessed in a variety of ways including both online and in bricks-and-mortar establishments. I would expect the selection to be primarily a visual one but the aural aspect is also borne in mind given that the goods may be the subject of discussions with sales assistants/advisors. The cost of the goods is likely to vary. The consumer may take into account factors such as scent, colour, texture, ingredients, suitability for skin-type etc. Generally speaking, I would expect a normal level of attention to be paid by the average consumer during the purchase.

Comparison of marks

21) 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. 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.”

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

My Beauty Bento v BENZO

22) The overall impression of BENZO lies solely in that word. Turning to My Beauty Bento, I find that, of the three words in the mark, Bento has the greatest weight in the overall impression. This is due to two factors. Firstly, Bento does not naturally combine with the first two words of the mark to form a unit with a readily understandable meaning. Secondly, although it is the beginning of a mark that tends to have the greater impact on the perception, this is not an immutable rule; each case must be considered on its merits. Bento has greater distinctiveness than the words ‘My Beauty’ in relation to the relevant goods such that it is the former that is likely to attract the greater degree of attention. The combination of these factors is such that Bento is likely to have the greatest impact on the consumer’s perception despite its positioning at the end of the mark.

23) Visually, the words Bento and BENZO are highly similar given that, despite the different appearance of the letters ‘t’ and ‘z’, the other four letters in those words are identical and presented in the same order. However, the presence/absence of ‘My

Beauty' is a clear point of visual difference between the marks. Overall, I find a moderate degree of visual similarity.

24) Aurally, My Beauty Bento consists of five syllables whereas BENZO consists of just two syllables. Bearing in mind that the two syllables of BENZO are, in my view, highly similar to those in Bento, but also having regard for the presence/absence of the three syllables of My Beauty, I find a moderate degree of aural similarity between the marks as wholes.

25) Conceptually, I find that BENZO is likely to be perceived as an invented word by the average consumer. As to My Beauty Bento, these three words do not naturally combine to form a conceptual unit with a meaning that is capable of being grasped immediately. Whilst the words 'My Beauty' will be immediately perceived as referring to personal beauty, I find that the following word, Bento, is likely to be perceived as an invented one with no meaning. Considering the marks overall, there is a conceptual difference between them owing to the presence/absence of My Beauty but this is not a distinctive difference in the context of the goods at issue (which are intended to be used for beautification purposes).

Distinctive character of the earlier mark

26) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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-0000, 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).”

27) There is no evidence before me and so I have only the inherent degree of distinctiveness of the earlier mark to consider. I have already expressed views on the meaning and distinctiveness of My Beauty Bento and its constituent parts. Bearing these in mind, I find that the mark, as a whole, is inherently distinctive to a high degree and that that degree of distinctiveness stems primarily from the presence of, what is likely to be perceived as, the invented word Bento within the mark.

Likelihood of confusion

28) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

29) In this instant case, it also appropriate to bear in mind the judgments of Arnold J. in *Aveda Corporation v Dabur India Limited*⁴ and *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*⁵. Arnold J. considered the impact of the CJEU's judgment in *Bimbo*⁶ on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

⁴ [2013] EWHC 589 (Ch)

⁵ [2015] EWHC 1271 (Ch)

⁶

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

30) The marks, as a whole, share only a moderate degree of visual and aural similarity. However, the conceptual difference between the marks is a non-distinctive one. Furthermore, Bento has distinctive significance independently of the mark as a whole; it does not combine with the words My Beauty to form a unit with a meaning that differs to the meaning of Bento alone. Bento, like Benzo, will be perceived as an invented word and those two words are visually and aurally highly similar. Bearing these factors in mind, together with the identity/medium degree of similarity between the respective goods and the high degree of inherent distinctiveness of the earlier mark (a degree of distinctiveness which stems primarily from the word Bento) I find that an average consumer paying a normal level of attention, and whilst perceiving the marks as wholes, is likely to be confused, through imperfect recollection of the Bento/Benzo elements, into believing that the respective goods emanate from the same or linked undertaking(s). In other words, there is a likelihood of indirect confusion. **iMax’s ground of opposition under section 5(2)(b) succeeds.**

31) The consequence of my finding above is that Benzo Intl cannot rely upon its BENZO mark in its opposition against iMax’s application to register BENTO. That opposition therefore falls away.

OUTCOME

32) Trade mark application number 3186263 for the mark BENTO may proceed to registration.

33) Trade mark application number 3185584 for the mark BENZO is refused in respect of the goods in class 03. It may proceed to registration only in respect of the goods and services in classes 14, 26 and 38.

COSTS

34) I max's opposition against Benzo Intl's application in class 03 has succeeded; Benzo Intl's opposition to I max's application has failed. I consider that iMax is entitled to a contribution towards the costs it has incurred in these proceedings. Although Mr Mills appeared for iMax at the hearing as a litigant in person, iMax had, prior to that point, had legal representation. Bearing this in mind, and using the guidance in Tribunal Practice Notice 2/2016, I award iMax costs on the following basis:

Preparing a statement and considering the other side's statement x 2	£400
Official fee (Form TM7)	£100
Preparing for and attending the hearing	£100
Total:	£600

35) I order Benzo International Ltd to pay iMax Group Limited the sum of **£600**. 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 26th day of February 2018

**Beverley Hedley
For the Registrar,
the Comptroller-General**