


O-564-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3 252 786  BY JUST
ENOUGH PROGRAMME LIMITED IN CLASS 34

AND

IN THE MATTER OF OPPOSITION THERETO BY BEIERSDORF AG

Background and pleadings

1. Just Enough Programme Limited (the applicant), applied to register the trade

mark No 3 252 786



in the UK on 25th August 2017. It was accepted and published in the Trade Marks Journal on 8th September 2017 in respect of the following goods:

Class 34:

Electronic cigarettes; cartridges for electronic cigarettes; liquids for electronic cigarettes; cigarettes containing tobacco substitutes; tobacco substitutes; cigarettes; tobacco; tobacco products; cigarette cases; cigarette boxes.

2. Beiersdorf AG (the opponent) opposes the trade mark on the basis of, amongst others¹, Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark No 9 710 77A NIVEA in Class 03, which it claims has a reputation. In particular the opponent argues that its mark is so well known that the use of NIVEA for any goods or services would lead consumers to believe that there is a connection between those goods and services and the opponent. The opponent's reputation is in respect of skin care, cosmetics and hair care preparations. The later trade mark covers goods in Class 34, including tobacco and cigarettes. The opponent's reputation in the trade mark NIVEA will be damaged if consumers believe that the opponent is using NIVEA for those goods.
3. The applicant filed a counterstatement denying the claims made. Specifically, it accepts that NIVEA is a well known brand within cosmetics in the UK. However, it disagrees that the public would make a connection between the goods for

¹ The opposition also includes claims under Section 3(6) and Section 5(4)(a) of the Act.

which the earlier trade mark is known and those of the application. It claims the opponent has no rights (nor a reputation) in class 34. It ends its counterstatement by declaring that the opponent obviously considers that it has the right to NIVEA in all classes and that this “can’t be right”.

Legislation

4. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

5. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the

public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to

have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Evidence

6. This takes the form of a witness statement, dated 15th March 2018, from Ms Carol Beckmann, the Director of Corporate Business Law Products and Trademarks in the opponent's legal department. Ms Beckmann describes the history of the opponent:
 - the opponent was founded in 1882 in Germany and opened its first office in the UK in 1906 in London.
 - The opponent has used NIVEA extensively and on a number of products since 1922. Exhibit CB2 shows the current range of products on offer. It is noted that these are in the main products in Class 03.
 - The first NIVEA skin cream was launched in the UK in 1922. Advertising of this product dates back to the 1930s until its 1970s adaptation that is still used today. Exhibit CB3 shows the evolution of the Nivea Crème tin as well as the many variants of advertising used for the product.

- In 1922, Nivea was first used on men's products such as shaving soap. The brand then progressed with Nivea for Men launching in the UK in 1998. The reputation of the mark was further promoted with the partnership with the English National Team in 2009 and the partnership with Liverpool football Club in 2015. Exhibit CB4 contains the history of the brand and some of the advertising campaigns associated with it.
- The website www.nivea.co.uk was established in 2001. Nivea has also moved onto social media. Exhibit CB5 contains confirmation of a presence on Facebook and Instagram.
- In 2010 – 2013, the opponent launched an advertising campaign sponsoring the ITV television programme "This Morning". Exhibit CB6 refers. This deal has a media value of £20 million.
- Nivea have also been the official backstage partner of "The Voice" (a British talent show) in 2017 and 2018. Exhibit CB7 is an extract from the Nivea website in support. The programme currently has an audience of approximately 5.5 million viewers each week.
- In 2012, the opponent started working with Cancer Research UK to educate the public with regards to skin care and protection against skin cancer. Nivea is the only sun care brand to partner Cancer Research UK. This involved printed adverts, in-store advertising, leaflets, visiting events to promote safety in the sun and TV advertising. Examples can be seen in Exhibit CB8. Since 2012, the opponent has donated more than £3 million to fund Cancer Research's research into cancer.
- The trade mark NIVEA has become a household name within the UK. It is estimated that products bearing the NIVEA trade mark could be found in 63% of UK households in 2016. Exhibit CB9 is support of this assertion.
- Exhibit CB10 is, according to Ms Beckmann, further evidence of NIVEA's repute. The exhibit contains "The UK and ROI top customers in 2016/2017". It is noted that these include major supermarkets and other retailers such as Tesco, Superdrug, Wilkinson, Sainsbury's, Asda and Boots. The exhibit also contains details of the awards NIVEA has won in the period 2016/2017. These include the Sunday Times Style Beauty Awards, Bella Beauty Awards, InStyle's Best Beauty Buys and Reveal Summer Beauty Awards. It is

noteworthy that the Sunday Times entry chose NIVEA as the best skincare brand. Finally, the exhibit contains details of the No.1 positions held by the various NIVEA products during 2016/2017. These include being the No 1 bodycare brand, the No 1 Male skincare brand and the No 1 sun protection brand (including that aimed at children).

7. Ms Beckmann's witness statement contains numerous submissions. The following are worth highlighting:

- The registration of the attacked trade mark would have a serious detrimental effect on the opponent's earlier brand. The earlier brand is recognised as promoting personal beauty and skin care. The opponent promotes NIVEA together with Cancer Research UK to educate the public on skin care safety and actively helps in research into cancer. The only word in the attacked trade mark is NIVEA but it has been filed for goods in class 34, including cigarettes. The use of NIVEA for such goods would be in complete contrast to the reputation of the opponent's earlier brand which is synonymous with skincare and personal health.
- The opponent is likely to suffer damages in sales if consumers believe that the opponent has expanded into the tobacco industry; further its goodwill will be diluted and its distinctiveness in the UK.

Reputation

8. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

9. Having considered the evidence filed, it is clear that the earlier trade mark enjoys a significant reputation in respect of cosmetics, specifically skincare products (including sun tanning preparations) and shaving cream.

The Link

10. Having considered that NIVEA enjoys a reputation, I now go on to consider whether or not the average consumer will make a link between the earlier trade mark and the attacked trade mark. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public


The strength of the earlier mark's reputation

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

11. In assessing the similarity of the signs, I take into account the following guidance in Case C-408/01, *Addidas-Salomon*, where the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

12. The earlier trade mark is NIVEA. The later trade mark is . Though there is a visual difference in respect of the circular swirl present in the later trade mark, the word element is virtually visually identical. Aurally, the marks are identical. Conceptually NIVEA will be seen as an invented word and so any impact is neutral. The marks are considered to be highly similar.

13. It has already been established that the earlier trade mark enjoys a reputation. The strength of its reputation is significant. Indeed, the applicant itself agrees that NIVEA is well known within the cosmetics field.

14. As to distinctiveness, NIVEA is an invented term and so has, prima facie, a high degree of inherent distinctiveness. The use made of NIVEA will have further enhanced this inherent degree. The earlier trade mark therefore enjoys the very highest degree of distinctiveness.

15. It is true that there is a not insignificant gap between the respective goods of the parties in these proceedings: skincare versus smokers' articles. However, bearing in mind all of the other factors to consider, all of which weigh heavily in the opponent's favour for the reasons already given, it is considered inevitable that a consumer, upon seeing the later trade mark, will immediately bring to mind the earlier trade mark. A link therefore, is clearly established.

Damage

16. In *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant's argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude

prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

17. It is noted that the opponent has made various claims under Section 5(3). I will focus upon its claim as regards detriment to the repute of its earlier trade mark. In this regard, I bear in mind the following guidance from the L’Oreal v Belure decision included above, namely at paragraph 40 which outlines that detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark.
18. In its evidence the opponent has outlined the history of its brand. It has always been known for products which help with beautification and care of the body, together with protection of the skin via its sun tanning preparations. Notably, its strong association with Cancer Research UK in respect of a campaign focussing upon the effects of skin cancer. This campaign clearly aims to educate and inform the public as regards suitable preventative measures and the products provided under the NIVEA brand to achieve this.
19. The later goods are cigarettes, tobacco and other smoking related goods and paraphernalia (including alternatives to smoking). They will be perceived as being harmful to health (albeit to varying degrees) and at least some of the goods are proven to be directly cancer causing. Bearing in mind the reputation of NIVEA in respect of care of the body and skin, together with its close relationship with a leading Cancer charity, it is considered clear that any potential linking of the NIVEA brand with smoking related goods and accessories (and even alternative products thereto) are likely to have a detrimental effect on NIVEA as a brand. This claim under Section 5(3) is considered to be clearly made out and so succeeds in its entirety.

Final Remarks

20. As the opposition is successful in its entirety based upon this ground, there is no need to consider the remaining grounds as they are not considered to materially improve the opponent's position.

COSTS

21. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1250 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Notice of opposition and accompanying statement (plus official fees) - £500

Preparation of Evidence - £750

TOTAL - £1250

22. I therefore order Just Enough Programme Limited to pay Beiersdorf AG the sum of £1250. The above sum should 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 11th day of September 2018

Louise White

For the Registrar,

The Comptroller-General