

**BL O-214-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION No. 3253238  
BY HALL & ASSOCIATES (MARKETING) LTD  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 3, 8, 18, 21 & 35:**

**AMERICAN ORIGINALS**

**AND**

**OPPOSITION THERETO (NO. 411986)  
BY UP GLOBAL SOURCING UK LIMITED**

## **Background and pleadings**

1. On 29 August 2017, Hall & Associates (Marketing) Ltd (“the applicant”) applied to register the trade mark **AMERICAN ORIGINALS** for goods and services (which I set out later) in classes 3, 8, 18, 21 and 35. The application was published for opposition purposes on 15 December 2017.

2. Registration of the mark is opposed by UP Global Sourcing UK Limited (“the opponent”) relying on two<sup>1</sup> earlier trade marks:

- i) UK registration 3171364, which is for the trade mark **AMERICAN ORIGINALS** and which is registered for goods in class 11. It was filed on 24 June 2016 and registered on 13 January 2017 in respect of the following class 11 goods:

Appliances for making beverages; machines for making popcorn; machines for making candy floss, fondue and chocolate fondue cooking apparatus; chocolate fountain machines; fondue and chocolate fondue cooking apparatus; electric bread toasters; electric sandwich toasters; electric bread makers; electric ice cream makers; electric cooking pots; ice makers; waffle irons; electric waffle makers; bread makers; electric panini makers; pancake makers; appliances for making hot dogs, appliances for making cakes, appliances for making frozen desserts, appliances for making burgers, appliances for making pies, automatic cocktail mixers; parts and fittings for the aforesaid goods.

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<sup>1</sup> A third mark was initially pleaded (International registration (EU) 1308688) but the opponent withdrew reliance on this mark given that it was refused protection in the EU.

- ii) UK registration 2619640, which is also registered for goods in class 11 (apparatus for cooking; electric kettles; electric cookers). It was filed on 3 May 2012 and registered on 28 December 2012. The mark is depicted below:



3. The above marks are relied upon under sections 5(2)(a) (mark i), 5(2)(b) (mark ii) and 5(3) (both marks) of the Trade Marks Act 1994 (“the Act”). The opponent additionally relies on the following grounds:

- Section 3(1)(b), with the applied for mark claimed to be devoid of any distinctive character because the mark will be perceived as an indication that the relevant goods and services are of a kind originally used, associated with or made in, America;
- Section 3(1)(c), with the applied for mark claimed to consist of an indication as to the kind/characteristics of the goods and services, being of a kind originally created, associated with or made in, America;
- Section 5(4)(a), the claim being that the applied for mark should not be registered as its use in the UK is liable to be prevented under the common law tort of passing-off. It is claimed that the sign **AMERICAN ORIGINALS** has been used in the course of trade since 2012 in relation to goods and services that fall in classes 7, 11 & 35.

4. The applicant filed a notice of defence and counterstatement in which it denied the grounds of opposition and put the opponent to proof of use of their earlier figurative mark (2619640) for all of its registered goods. The request for proof of use is a slight oddity. This is because the earlier mark had been registered for just short of the

required 5 year period for such provisions to bite. Having said that, the request stems from the fact that when the opponent lodged its opposition, it itself indicated that the mark was subject to proof of use. In view of all this, the earlier mark is not subject to the proof of use provisions although, as I will come on to, nothing turns on this.

5. Only the opponent filed evidence, comprising witness statements from Ms Laura West and from Mr Andrew Gossage together with a number of exhibits. The opponent also filed a set of written submissions. On 9 October 2018, an order for confidentiality (to the Registrar, the parties, and their representatives) was made in respect of exhibits AG4, AG6, AG11 and AG14 of Mr Gossage's evidence. I will detail the opponent's evidence when it becomes relevant to do so. The applicant filed no evidence, but it did file a set of written submissions. Neither party requested a hearing. The opponent filed written submissions in lieu of a hearing, the applicant did not.

6. Both parties have been represented throughout the proceedings, the applicant by BRANDED! TM Limited, the opponent by Mathys & Squire LLP.

### **Section 3(1) of the Act**

7. I find it convenient to start with the grounds of opposition under section 3(1) of the Act. The relevant legislation states that the following shall not be registered:

“(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ....

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

8. The pleaded grounds are independent of each other and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c), but still be objectionable under section 3(1)(b) of the Act<sup>2</sup>.

9. There is no evidence before the Tribunal of any use of the applied for mark. Consequently, if I uphold the opposition under section 3(1)(b) and/or (c) there is nothing to show that the mark has acquired a distinctive character as a result of the use made of it. Accordingly, the proviso to section 3(1) set out above does not apply. The date at which these grounds must be assessed is the date of the application for registration, 29 August 2017.

### **Section 3(1)(c)**

10. The case law was summarised by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article

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<sup>2</sup> See *SAT.1 Satelliten Fernsehen GmbH v OHIM*, Case C-329/02 P at [35] and *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) referred to below.

7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 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), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32;

*Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57)...

and

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."



92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

11. The descriptiveness of the mark must be assessed in relation to the goods and services for which registration is sought, which cover a large range of everyday consumer goods and the retail thereof, as follows:

**Class 3:** Toiletries; cosmetics; perfumery; essential oils; skincare preparations; skin cleansers; body creams; body lotions; moisturisers; beauty masks; hand creams; nail care products; cosmetics for nails; cosmetics for use on the hair; hair care preparations; hair care lotions; hair conditioners; hair colouring preparations; hair bleaching products; hair sprays; hair gels; hair lacquer; hair wax; hair styling products; hair straightening products; hair mousses; hair oils; hair treatments; barrier creams; bubble bath; bath preparations; bath lotions; bath bombs; bath creams; bath crystals; soaps; liquid soaps; hair shampoos; bath foams; bath gels; bath additives (non-medicated); hand washes; wipes impregnated with a skin cleanser; toothpaste; body sprays; face and body glitter gels; depilatory products; pumice stones; dentifrices; incense sticks

**Class 8:** Hygienic and beauty implements for humans and animals; manicure and pedicure tools; manicure sets, pedicure sets, nail files, electric nail files; scissors; electric shavers; vibrating blade shavers; parts and fittings for the aforesaid goods

**Class 18:** Luggage; bags; wash bags (not fitted); wash bags for carrying toiletries; wallets and other carriers; cosmetic bags; make up bags.

**Class 21:** Household or kitchen utensils and containers; cosmetic and toilet utensils and bathroom articles; bottle openers (not of precious metal or coated

therewith); combs; brushes (except paint brushes); hair brushes; cosmetic brushes; cosmetic bags (fitted); shaving brushes; stands for shaving brushes; holders for shaving brushes; articles for cleaning purposes; domestic gloves, gloves for cleaning, gloves for gardening; dust pans; cloths for cleaning purposes; sponges; sponges for scrubbing skin; sponges for children; loofahs; loofahs for household purposes; body scrubbing puffs; toothbrushes; electric and non-electric toothbrushes; wash bags (fitted); soap dishes; soap boxes; soap dispensers; containers for soaps; containers for cosmetics; toothbrush holders; toothbrush containers; glassware, porcelain and earthenware not included in other classes; beakers; flasks and water bottles; plant pots, plant pot covers; plastic buckets; watering devices; watering cans, parts and fittings for the aforesaid.

**Class 35:** Retail services, online retail services and mail order retail services all in connection with the sale of toiletries, cosmetics, perfumery, essential oils, skincare preparations, skin cleansers, body creams, body lotions, moisturisers, beauty masks, hand creams, nail care products, cosmetics for nails, cosmetics for use on the hair, hair care preparations, hair care lotions, hair conditioners, hair colouring preparations, hair bleaching products, hair sprays, hair gels, hair lacquer, hair wax, hair styling products, hair straightening products, hair mousses, hair oils, hair treatments, barrier creams, bubble bath, bath preparations, bath gels, bath lotions, bath foams, bath bombs, bath creams, bath crystals, soaps, liquid soaps, hair shampoos, bath additives (non-medicated), hand washes, wipes impregnated with a skin cleanser, toothpaste, body sprays, face and body glitter gels, depilatory products, pumice stones, dentifrices, hygienic and beauty implements for humans and animals, manicure and pedicure tools, manicure sets, pedicure sets, nail files, electric nail files, scissors, electric shavers, vibrating blade shavers, luggage, bags, wash bags (not fitted), wallets and other carriers, cosmetic bags, make up bags, household or kitchen utensils and containers, cosmetic and toilet utensils and bathroom articles, bottle openers (not of precious metal or coated therewith), combs, brushes (except paint brushes), hair brushes, cosmetic brushes, cosmetic bags

(fitted), shaving brushes, stands for shaving brushes, holders for shaving brushes, articles for cleaning purposes, domestic gloves, gloves for cleaning, gloves for gardening, dust pans, cloths for cleaning purposes, sponges, sponges for scrubbing skin, sponges for children, loofahs, loofahs for household purposes, body scrubbing puffs, toothbrushes, electric and non-electric toothbrushes, wash bags (fitted), wash bags for carrying toiletries, soap dishes, soap boxes, soap dispensers, containers for soaps, containers for cosmetics, toothbrush holders, toothbrush containers, glassware, porcelain and earthenware not included in other classes, beakers, flasks and water bottles, plant pots, plant pot covers, plastic buckets, watering devices, watering cans, parts and fittings for the aforesaid.

12. None of the opponent's evidence touches on the section 3(1) grounds. Indeed, neither sides' written submissions really deal with the issue in any greater detail than the basic pleadings and defence.

13. It is clear and obvious that the word "American" will be understood by the relevant public (both consumers and those in the trade) as having geographical significance. It could indicate that the goods/services have an American origin, or are potentially (for some of the goods) American in style. "Original" (in the singular) is a common English word and has dictionary<sup>3</sup> meanings of:

Present or existing from the beginning; first or earliest;  
Created personally by a particular artist, writer, musician, etc.; not a copy;  
Not dependent on other people's ideas; inventive or novel;  
The earliest form of something, from which copies may be made;  
An eccentric or unusual person.

14. The use of the word ORIGINALS could potentially indicate that the goods are originals, in the sense of being early or first versions of something (or are akin to such

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<sup>3</sup> <https://en.oxforddictionaries.com>

items, a replica of an original). However, the goods at issue do not strike me as the type of goods where originality in this sense is a relevant characteristic. The word could, potentially, send a message of authenticity, but this in my view would be nothing more than being of an allusive significance especially in relation to the goods (and services) the subject of the application. In terms of the capacity of the mark (and the use of the word ORIGINALS) to be taken as indicating original (in the sense of novel), or created personally (as a one-off, for example) then, again, the goods (and services) at issue do not strike me as ones where such a characteristic is particularly relevant.

15. All of the above reduces the capacity of the mark (as a whole) to be perceived as a description of a characteristic of the goods and services. In my view, the combination AMERICAN ORIGINALS, absent evidence to the contrary, is not language likely to be perceived as a descriptor of the goods and services at issue. I do not consider that the objection under section 3(1)(c) is made out. The ground of opposition under section 3(1)(c) is rejected.

### **Section 3(1)(b) of the Act**

16. Section 3(1)(b) prevents the registration of marks which are devoid of distinctive character. The principles to be applied were summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 *P Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 *P Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 *P KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 *P Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 *P OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

17. The opponent submits that consumers will fail to see the applied for mark as distinguishing the goods/services of a single undertaking and will instead perceive the mark as an indication that the relevant goods are of a kind originally used, associated

with or made in America or will believe the goods to be both American and original designed products.

18. As stated earlier, this ground has independent effect to section 3(1)(c) of the Act. However, I note that the pleading is based largely on the same rationale with the same (or very similar) claim as to how the consumer will perceive the mark. It is therefore logical for my findings to follow through. However, I should say for the record that I have fully considered whether the ground should nevertheless apply irrespective of my finding under section 3(1)(c). I come to the view that it should not. Whilst the mark clearly sends a message of Americanism, it does not do so in a way that would also prevent it from indicating the trade origin of the goods and services. The ground under section 3(1)(b) of the Act is also rejected.

#### **5(2)(a) and 5(2)(b) of the Act**

19. The legislation reads:

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

(a) it is identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected,

(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.”

20. The following principles are gleaned from the judgments 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 likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- 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;
- the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 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;
- nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- 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;

- a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- 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;
- mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- 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;
- 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.

21. The opponent's word mark is the closest mark in terms of similarity. I will, consequently, begin my assessment based on this earlier mark, the relevant ground being section 5(2)(a).

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

22. All relevant factors relating to the goods should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union ("the 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.”

23. Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.”

24. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships

that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

25. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as “complementary” and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited [LOVE]* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

26. I also remind myself of the guidance given by the courts on the correct interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

“... 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”.

27. The earlier mark is registered for the following goods:

Class 11: Appliances for making beverages; machines for making popcorn; machines for making candy floss, fondue and chocolate fondue cooking apparatus; chocolate fountain machines; fondue and chocolate fondue cooking apparatus; electric bread toasters; electric sandwich toasters; electric bread makers; electric ice cream makers; electric cooking pots; ice makers; waffle irons; electric waffle makers; bread makers; electric panini makers; pancake makers; appliances for making hot dogs, appliances for making cakes, appliances for making frozen desserts, appliances for making burgers, appliances for making pies, automatic cocktail mixers; parts and fittings for the aforesaid goods.

28. As can be seen, the goods comprise various types of cooking and beverage making appliances. I will make the comparison with reference to the various classes for which the applicant seeks registration.

#### The applicant's class 3 goods

29. Registration is sought in relation to:

Toiletries; cosmetics; perfumery; essential oils; skincare preparations; skin cleansers; body creams; body lotions; moisturisers; beauty masks; hand creams; nail care products; cosmetics for nails; cosmetics for use on the hair; hair care preparations; hair care lotions; hair conditioners; hair colouring preparations; hair bleaching products; hair sprays; hair gels; hair lacquer; hair wax; hair styling products; hair straightening products; hair mousses; hair oils; hair treatments; barrier creams; bubble bath; bath preparations; bath lotions; bath bombs; bath creams; bath crystals; soaps; liquid soaps; hair shampoos; bath foams; bath gels; bath additives (non-medicated); hand washes; wipes impregnated with a skin cleanser; toothpaste; body sprays; face and body glitter gels; depilatory products; pumice stones; dentifrices; incense sticks.

30. In general terms, the applicant's goods cover toiletries, cosmetics, perfumes, dentifrices, and other items for beauty and personal care. The opponent submits that there is a low degree of similarity with their goods (it accepts that this is a lower degree of similarity than some of the other applied for goods). However, I find that there is none. The purpose of the goods is very different. The nature of the goods is very different. The methods of use are very different. The goods do not compete, nor are they complementary. Any overlap in users is a very superficial point because the users are simply members of the general public. The same applies to the trade channels, in that whilst they could all be sold in, for example, a supermarket, they are not sold in close proximity to each other. Therefore, the evidence provided by Ms West showing a number of retailers who stock a wide range of, on the face of it, very different goods is not compelling. The class 3 goods are not similar to the goods of the earlier mark.

The applicant's class 8 goods

31. Registration is sought in relation to:

Hygienic and beauty implements for humans and animals; manicure and pedicure tools; manicure sets, pedicure sets, nail files, electric nail files; scissors; electric shavers; vibrating blade shavers; parts and fittings for the aforesaid goods.

32. In its written submissions, the opponent states that items such as hygienic and beauty implements, electric nail files etc. are types of electrical hand-held tools and thus similar to its goods in class 11, some of which could also be electrical and hand-held. I, again, disagree. This added factor is too general and does little to bring the purpose, nature and methods of use closer, nor do the goods compete or are complementary to one another. The same points in relation to users and channels of trade made above apply here also. The class 8 goods are not similar to the goods of the earlier mark.

The applicant's class 18 goods

33. Registration is sought in relation to:

Luggage; bags; wash bags (not fitted); wash bags for carrying toiletries; wallets and other carriers; cosmetic bags; make up bags.

34. As per the class 3 & 8 goods, the same rationale applies. There is no greater prospect for finding similarity. The class 18 goods are not similar to the goods of the earlier mark.

The applicant's class 21 goods

35. Registration is sought in relation to:

Household or kitchen utensils and containers; cosmetic and toilet utensils and bathroom articles; bottle openers (not of precious metal or coated therewith); combs; brushes (except paint brushes); hair brushes; cosmetic brushes; cosmetic bags (fitted); shaving brushes; stands for shaving brushes; holders for shaving brushes; articles for cleaning purposes; domestic gloves, gloves for cleaning, gloves for gardening; dust pans; cloths for cleaning purposes; sponges; sponges for scrubbing skin; sponges for children; loofahs; loofahs for household purposes; body scrubbing puffs; toothbrushes; electric and non-electric toothbrushes; wash bags (fitted); soap dishes; soap boxes; soap dispensers; containers for soaps; containers for cosmetics; toothbrush holders; toothbrush containers; glassware, porcelain and earthenware not included in other classes; beakers; flasks and water bottles; plant pots, plant pot covers; plastic buckets; watering devices; watering cans, parts and fittings for the aforesaid.

36. Given the range of goods covered by the above specification, it is necessary to break this down further. I begin by considering:

cosmetic and toilet utensils and bathroom articles; combs; hair brushes; cosmetic brushes; cosmetic bags (fitted); shaving brushes; stands for shaving brushes; holders for shaving brushes; sponges for scrubbing skin; sponges for children; loofahs; loofahs for household purposes; body scrubbing puffs; toothbrushes; electric and non-electric toothbrushes; wash bags (fitted); containers for cosmetics; toothbrush holders; toothbrush containers; plant pots, plant pot covers; plastic buckets; watering devices; watering cans, parts and fittings for the aforesaid; gloves for gardening;

37. I find these goods not similar to the goods of the earlier mark for similar reasons given in relation to the goods in classes 3, 8 and 18.

38. I next consider:

Brushes (except paint brushes); articles for cleaning purposes; domestic gloves, gloves for cleaning, dust pans; cloths for cleaning purposes; sponges; soap dishes; soap boxes; soap dispensers; containers for soaps;

39. The opponent has said little by way of submission beyond its claim that there is a low degree of similarity. I, again, consider there to be none. Whilst some of these goods could be used in a kitchen environment for, for example, cleaning purposes, they are still very different in terms of purpose, nature and methods of use. The goods still do not compete or are complementary to one another. These goods are not similar.

40. Finally, in class 21, I consider:

Household or kitchen utensils and containers; bottle openers (not of precious metal or coated therewith); glassware, porcelain and earthenware not included in other classes; beakers; flasks and water bottles.

41. The opponent's position with regard to the above goods is that they, like the goods of the earlier mark, are used for the preparation, presentation and storage of food and beverages. It states that the above goods could include the non-electric versions of the goods of the earlier mark and that this increases the similarity in terms of, for example, the channels of trade.

42. I think there is some force in these submissions, at least in relation to some of the above. Household/kitchen utensils are used in the preparation of food/beverages. The goods would include manual equivalents or alternatives such as, for example, non-electric popcorn makers, manual ice cream makers, non-electric cooking pots. This means that there is similarity of purpose, some similarity in nature and methods of use, and the trade channels could well overlap. The goods may also compete. I consider there to be a medium degree of similarity.

43. In relation to containers, some of the goods of the earlier mark include items which have a container (often for storage/consumption) built in, such as ice cream makers,

beverage makers (which would include smoothie), cocktail makers etc. This creates a degree of similarity, although in my view only of a low level. The similarity rests in a partial overlap in nature and purpose, a likely closer link in channels of trade, and a degree of complementarity. The same applies to “glassware, porcelain and earthenware not included in other classes; beakers; flasks and water bottles” for similar reasons. I do not, though, extend the finding to bottle openers as any link with the earlier goods is more tenuous.

#### The applicant’s class 35 services

44. The applicant’s specification covers retail services, online retail services and mail order retail services in connection with all of the goods set out in their class 3, 8, 18 and 21 specifications.

45. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

46. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services compared with goods. He said that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the



opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

47. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>4</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>5</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>6</sup>, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

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<sup>4</sup> Case C-411/13P

<sup>5</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>6</sup> Case C-398/07P

48. Bearing in mind the above guidance, my view is that there is no similarity between the retail of the class 3, 8 and 18 goods listed in the class 35 specification with the earlier class 11 goods. There is, though, some, albeit low, level of similarity with the retail of the class 21 goods I have found to be similar to the earlier class 11 goods. Whilst it is possible that the retail services connected with the sale of goods I have found to be not similar to the goods of the earlier mark could be found to be similar to the goods of the earlier mark, I am not satisfied that there is a sufficiently pronounced link between them to so find.

#### Summary of the goods and services comparison

49. In summary, I therefore find that, in comparison to the opponent's class 11 goods, there is no similarity with any of the applied for goods in classes 3, 8 & 18. In relation to the applied for class 21 goods, there is no similarity in relation to:

Cosmetic and toilet utensils and bathroom articles; combs; hair brushes; cosmetic brushes; cosmetic bags (fitted); shaving brushes; stands for shaving brushes; holders for shaving brushes; sponges for scrubbing skin; sponges for children; loofahs; loofahs for household purposes; body scrubbing puffs; toothbrushes; electric and non-electric toothbrushes; wash bags (fitted); containers for cosmetics; toothbrush holders; toothbrush containers; plant pots, plant pot covers; plastic buckets; watering devices; watering cans, parts and fittings for the aforesaid; gloves for gardening; brushes (except paint brushes); articles for cleaning purposes; domestic gloves, gloves for cleaning, dust pans; cloths for cleaning purposes; sponges; soap dishes; soap boxes; soap dispensers; containers for soaps; bottle openers (not of precious metal or coated therewith);

but there is a medium degree of similarity in relation to:

Household or kitchen utensils

and a low degree of similarity in relation to:

Household or kitchen containers; glassware, porcelain and earthenware not included in other classes; beakers; flasks and water bottles.

50. There is also a low level of similarity with the applied for “[r]etail services, online retail services and mail order retail services all in connection with the sale of...[the goods in the preceding paragraph found to be similar] but not in relation to anything else.

51. Where I have found no similarity between the applicant’s goods and services and the opponent’s goods there can be no likelihood of confusion<sup>7</sup>. I will, therefore, make no further mention of them in this part of my decision.

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

52. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

53. 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

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<sup>7</sup> See the Court of Appeal decision in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 at paragraph 49.

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.”

54. The competing goods, for the most part, will be purchased by members of the general public. I do not, though, discount that sometimes the goods will be purchased for business purposes.

55. The cost of the goods will vary from, for example, a low-cost kitchen utensil to a more expensive piece of electrical kitchen equipment. However, the average consumer will still wish to ensure that the goods meet their requirements as to type, size or design, or that the retail service provider covers the products they are seeking to buy. Consequently, and whilst there will be a degree of variance depending on exactly what is involved, at least an average degree of attention will be paid by the average consumer to the selection of the goods and services. It could be argued that trade purchasers are likely to pay a higher than average level of attention, however, in my view I do not consider that they will do so to a materially higher extent.

56. The goods are sold through various types of retail stores and their online/mail order equivalents, routinely via self-selection. This suggest that the visual impact of the marks will take on more significance. I will not, though, ignore the aural aspect completely because advice may, for example, be sought from a shop assistant particularly for electrical equipment. The retail services will largely be selected online or a decision taken to visit a particular physical store, with the mark encountered on signage and publicity material, both physically and online. This, again, suggests that the marks will be encountered largely via visual means, but I again do not rule out aural exposure to the marks, such as word of mouth recommendations.

### **Comparison of the marks**

57. The marks are identical, both consisting purely of word marks comprising of the words **AMERICAN ORIGINALS**.

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

58. 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).”

59. Earlier in this decision I found the applicant’s mark to be neither descriptive or devoid of any distinctive character in relation to the goods and services for which registration is sought. Although the goods of the earlier mark are not the same, I consider the same rationale to apply in relation to the earlier mark and the goods for which it is registered. That said, I did say earlier that the (applicant’s) mark is suggestive of Americanism, which I also consider to apply to the earlier mark. Whilst I would not go so far to say that the earlier mark is weak in inherent distinctiveness, its distinctiveness nevertheless lies at the more modest end of the spectrum. In making this finding that there is some inherent distinctiveness in the mark, I have been conscious that the earlier mark was only accepted upon the basis of acquired distinctiveness, however, regardless of this fact, I do not consider that this prevents the finding I have made.

60. The opponent has, though, filed evidence of use, which may enhance the distinctiveness of the mark. The evidence in relation to the use made of the mark comes from Mr Gossage, who, after explaining the background to the opponent company, moves on to discuss the use made of the mark. It is at this point that I record

that from the exhibits provided, the mark is used predominantly in a particular form (or a close variation), as set out below:



61. The above mark has been used in the UK since 2010. Confidential exhibit AG4 contains sales data. I will not record the details in this decision, but I have noted them. Mr Gossage notes in his witness statement that sales have reached in excess of £500k per annum “often substantially more”. Some of the years (which go up to 2016) do go beyond the £500k level, but in my view, and whilst they are not insignificant, the level of sales is not something I would characterise as being self-evidently significant or substantial in the relevant market. There is nothing in the evidence to show any relevant market share that dispels my take on this.

62. Confidential exhibit AG6 contains a list of the opponent’s top 10 customers, which includes Argos, Tesco, Amazon and Asda. Evidence is then provided showing the size of such entities including the number of stores (Tesco and Asda) have in the UK. However, there is no evidence about how many such stores actually stocked the opponent’s goods and, if they did, what impact they had in store. Based on the sales made to the likes of Tesco and Asda it would be a stretch to find that there was much of an impact. Although there is a paucity of evidence in relation to some of these customers, there is evidence in the form of Argos catalogues in which the opponent’s goods have featured (AG9); it is added that in 2013 18 million catalogues were circulated in the UK. There is also a trade catalogue for the opponent’s goods (AG8) although there is no evidence as to the circulation of this. Various invoices are also provided in confidential exhibit AG14 to various of its customers dating between 2010-2016. Mr Gossage states that even if not specifically mentioned, the goods invoiced are goods sold under the opponent’s mark.

63. Beyond what I have already set out, there is little by way of traditional advertising (although I also note the archive website prints in AG13), but there are some articles about the opponent's goods which have featured on a number of websites. Four are mentioned, two of which Mr Gossage states have visitor numbers of 97k and 220k respectively (graziadaily.co.uk and takeabreak.co.uk), however, there is no evidence about the number of people who actually viewed the articles themselves.

64. In the sales figures there is no breakdown of product type. However, what can be seen from the various exhibits (including the invoices) is that the mark has been used in relation to a range of electric food/beverage preparation appliances including: a hotdog toaster, a cakepop maker (a cakepop appears to be a small cake), a popcorn maker, ice cream maker, chocolate fondue makers, waffle makers, slushy makers, cupcake makers, dessert makers, cocktail makers, burger makers, family pie makers and an ice cone machine. The difficulty that arises is what proportion of goods have been sold. From looking at the evidence as whole, the goods that appear to have been sold most often are items such as the popcorn maker, the ice-cream maker, the popcake/cupcake maker, the waffle maker and the fondue maker.

65. In relation to the evidence filed, I finally note that exhibit AG16 contains two witness statements from people in the trade filed for the purpose of other proceedings. I do not intend to summarise what they say in their statements but I note that they would associate the opponent's brand with the opponent, and no other business.

66. Having considered the evidence as a whole, I am not overly convinced about the significance the use made will have had on the average consumer. The sales figures are not particularly significant, and there is nothing to show market share. Whilst the goods have been stocked by some major players, there is nothing to show in how many stores or what impact the stocking of the goods will have had. Although the goods have been included in a number of Argos catalogues, it does not follow that everyone who has looked at such a catalogue will have encountered the mark. There is some (limited) media coverage of the goods sold under the mark but nothing else in terms of formal advertising. There is nothing to show how many people encountered

the mark in the media articles. The evidence from people in the trade does not greatly assist. The use made will not, in my view, have enhanced the distinctive character of the earlier mark from the perspective of the average consumer of the goods at issue.

### **Likelihood of Confusion**

67. 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 the various factors 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]).

68. The opponent argues that use of an identical mark is likely to prompt confusion, even where there is low similarity between some of the goods/services because the interdependence principle will apply. The applicant denies that there is any similarity and states they are primarily interested in non-electrical goods

69. Although the goods/services are, in some case, only low in similarity to the goods of the earlier mark, the marks are identical. Although the earlier mark is not the strongest in terms of distinctiveness, it is distinctive enough to cause the average consumer (whether a member of the general public or the trade) to believe that the goods/services I have found to have some similarity, to be the responsibility of the same (or related) undertaking. They will assume that they are further goods offered by the same undertaking, or a direct retail service for those goods. There is a likelihood of confusion in relation to the similar goods and services under section 5(2)(a).

70. In relation to the figurative mark, I provide here only a high level finding. This is because I consider that the opponent will only succeed to the same extent. This is because:



- Whilst the earlier mark is registered for cooking apparatus at large, which is arguably wider than the cooking related goods of the word mark, I do not consider that there is any greater prospect for finding similarity with the goods/services I have thus far found not to be similar.
- The mark is further away in terms of similarity, but still close enough to find confusion in relation to the goods found to be similar.

### **Section 5(4)(a)**

71. Section 5(4)(a) of the Act reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

72. It is settled law that for a successful finding under the law of passing-off, three factors must be present: i) goodwill, ii) misrepresentation and, iii) damage.

### **Relevant date**

73. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”.

74. In view of the above, the opponent must establish that it had a protectable goodwill at the date when the contested trade mark application was filed (29 August 2017). The applicant has not provided any evidence showing that it has used the mark earlier than this, so it is not necessary to consider the position at an earlier date.

### **Goodwill**

75. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), where the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

76. The opponent claims goodwill in respect of:

**Class 7:**

*Food and beverage processing and preparation machines and apparatus; parts and fittings for the aforesaid goods.*

**Class 11:**

*Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; domestic, household and electrical appliances for heating, cooking and refrigerating food and drink; household and electrical appliances for heating, cooking and refrigerating food and drink for use in connection with parties; appliances for heating food, for cooling food and for making beverages; machines for making popcorn; machines for making candy floss, fondue and chocolate fondue cooking apparatus; chocolate fountain machines; fondue and chocolate fondue cooking apparatus; slow cookers; electric pressure cookers; electric bread toasters; electric kettles; deep fat fryers; electric sandwich toasters; electric bread makers; electric ice cream makers; electric food steamers; electric cooking pots; ice makers; waffle irons; electric pans; egg cookers; electric fires; fires;*

*fireplaces; gas fires; oil fired heaters; oil filled radiators; heaters; storage heaters; electric heaters; convector heaters; gas fired heaters; portable heaters; heated towel rails; electric towel warmers; heated towel drying rails; clothes dryers; clothes drying installations; hot water bottles; electric blankets; electric waffle makers; food defrosting trays and platters; food warming and defrosting devices; bread makers; oil-free electric fryers; electric deep fryers; electric egg poachers; electric soup makers; electric panini makers; pancake makers; spas; foot spas; spa devices for baths; hairdryers; ovens; cookers; grills; parts and fittings for the aforesaid goods*

**Class 35:**

*Retail, online retail, wholesale and mail order services in connection with the sale of food and beverage processing and preparation machines and apparatus, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, domestic, household and electrical appliances for heating, cooking and refrigerating food and drink, household and electrical appliances for heating, cooking and refrigerating food and drink for use in connection with parties, appliances for heating food, for cooling food and for making beverages, machines for making popcorn, machines for*

*making candy floss, fondue and chocolate fondue cooking apparatus, chocolate fountain machines, fondue and chocolate fondue cooking apparatus, slow cookers, electric pressure cookers, electric bread toasters, electric kettles, deep fat fryers, electric sandwich toasters, electric bread makers, electric ice cream makers, electric food steamers, electric cooking pots, ice makers, waffle irons, electric pans, egg cookers, electric fires, fires, fireplaces, gas fires, oil fired heaters, oil filled radiators, heaters, storage heaters, electric heaters, convector heaters, gas fired heaters, portable heaters, heated towel rails, electric towel warmers, heated towel drying rails, clothes dryers, clothes drying installations, hot water bottles, electric blankets, electric waffle makers, food defrosting trays and platters, food warming and defrosting devices, bread makers, oil-free electric fryers, electric deep fryers, electric egg poachers, electric soup makers, electric panini makers, pancake makers, spas, foot spas, spa devices for baths, hairdryers, ovens, cookers, grills and parts and fittings for the aforesaid goods*

77. Based on my review of the evidence, the above claim is untenable. At most, any goodwill the opponent has created is in the field of small electrical appliances for food preparation, of the like described earlier. I say at the most because there is a gap in the evidence as no sales figures from 2017 are provided. Having said that, there is nothing to suggest that the opponent stopped trading under the mark. Even if it did, it is unlikely that the goodwill would have extinguished in the short period of time leading to the relevant date. I find the requisite goodwill.

### **Misrepresentation**

78. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is: “is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product].” The necessity for a substantial number is brought out

also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

79. It is often the case that a finding under section 5(2) in relation to confusion follows through to section 5(4)(a) in assessing whether there is a relevant misrepresentation, although there can sometimes be differences, as I will come on to. In my view, it follows that in relation to the goods/services I found to be similar and for which I held a likelihood of confusion, I find, for the same reasons, that a misrepresentation will also occur.

80. However, there is one important difference in the assessment I make here. That is, unlike the requirement under section 5(2) for the goods/services to be similar, there is no requirement in a claim for passing-off for what is often termed a common field of activity. Therefore, an opponent could potentially succeed under section 5(4)(a) even though it may have failed under section 5(2) for want of a similarity in the goods/services. It is therefore important that I consider the other goods/services applied for and whether a relevant misrepresentation will occur in relation to them.

81. In making this consideration I bear in mind that although a common field of activity is not required, the closeness of the parties' goods and services is still an important factor. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. confirmed that:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business...”

What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties. The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration ‘...whether there

is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant'..."

82. The strength of the opponent's goodwill is also a relevant factor. In *Teleworks Limited v Teleworks Group Plc* [2001] WL 395220 Mr Christopher Floyd QC sitting as a Deputy Judge of the Chancery Division stated:

"5...Thus if a claimant has at the relevant date only a modest business in one or two lines of goods, he can still succeed in a passing off action against a company selling the other goods. It all depends on whether the evidence establishes that purchasers would be led into the belief that the defendant company was now selling these new goods. An extreme example is *Lego v Lego M Lemelstrich* [1983] FSR 155 where the maker of plastic toy bricks restrained the use of its name on garden sprinklers. If the strength of the claimant's reputation is great enough to induce the relevant belief in purchasers in the circumstances of the trade in question, then the claimant's goodwill is protected in fields which it has not yet entered, and which it may not have the slightest intention of entering."

83. In my view the, the opponent's goodwill is fairly modest in relation to a business associated with a limited range of appliances. The sign relied upon is not greatly distinctive either. Therefore, notwithstanding that the applicant seeks to register words which are identical to words associated with its goodwill, I have no hesitation in concluding that there would be no misrepresentation in relation to the applied for class 3, 8 and 18 goods, or the retail thereof, and make the same finding in relation to the following goods (and their retail) in class 21:

Cosmetic and toilet utensils and bathroom articles; combs; hair brushes; cosmetic brushes; cosmetic bags (fitted); shaving brushes; stands for shaving brushes; holders for shaving brushes; sponges for scrubbing skin; sponges for children; loofahs; loofahs for household purposes; body scrubbing puffs;

toothbrushes; electric and non-electric toothbrushes; wash bags (fitted); containers for cosmetics; toothbrush holders; toothbrush containers; plant pots, plant pot covers; plastic buckets; watering devices; watering cans, parts and fittings for the aforesaid; gloves for gardening;

84. In relation to:

Brushes (except paint brushes); articles for cleaning purposes; domestic gloves, gloves for cleaning, dust pans; cloths for cleaning purposes; sponges; soap dishes; soap boxes; soap dispensers; containers for soaps; bottle openers (not of precious metal or coated therewith),

85. I accept that there is greater potential for such items to be sold for use in a kitchen environment, which arguably closes the distance (somewhat) between them and the goods associated with the opponent's goodwill. However, the respective goods are still quite different in purpose and are unlikely to be sold in close proximity to each other, especially in the case of: domestic gloves, gloves for cleaning, dust pans; soap dishes; soap boxes; soap dispensers; containers for soaps; bottle openers (not of precious metal or coated therewith). Bearing this in mind, and the points made already about the strength of the goodwill, I conclude that misrepresentation is not likely here. However, in relation to: brushes (except paint brushes)<sup>8</sup>; articles for cleaning purposes; cloths for cleaning purposes; sponges (and their retail), there is greater room for argument. Such goods could be used to clean the appliances, are for kitchen use and could also be sold in closer proximity. Similar rationale applies to their retail. Therefore, whilst an evenly balanced decision, I conclude that a misrepresentation is likely here.

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<sup>8</sup> Which include cleaning brushes and therefore require distinct consideration to the applied for hair brushes and toothbrushes.

## Damage

86. In *Harrods Limited V Harrodian School Limited* [1996] Millett L.J. described the requirements for damage in passing-off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the Lego case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation.”

87. In *Ewing v Buttercup Margarine Ltd* (1917) 34 R.P.C. 232 Warrington L.J. said:

“To induce the belief that my business is a branch of another man's business may do that other man damage in all kinds of ways. The quality of the goods I sell; the kind of business I do; the credit or otherwise which I might enjoy. All those things may immensely injure the other man, who is assumed wrongly to be associated with me.”

88. I am satisfied that damage of the type described above is relevant here.



## **Outcome under section 5(4)(a)**

89. In addition to the goods and services for which the opposition succeeded under section 5(2) of the Act, the opposition succeeds under section 5(4)(a) in relation to:

**Class 21:** Brushes (except paint brushes); articles for cleaning purposes; cloths for cleaning purposes; sponges.

**Class 35:** Retail services, online retail services and mail order retail services all in connection with the sale of brushes (except paint brushes); articles for cleaning purposes; cloths for cleaning purposes; sponges

## **Section 5(3)**

90. Section 5(3) of the Act is as follows:

“(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 (EU) 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.”

91. The relevant case law can be found in the following judgments of the CJEU: Case C375/97, *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*).

92. The conditions of section 5(3) are cumulative. The first task, though, it to consider whether the earlier mark has achieved a level of knowledge amongst a significant part of the relevant public. I have found thus far that the opponent's use of the sign AMERICAN ORIGINALS will have created a protectable goodwill, but that it was not enough to enhance the distinctive character of the earlier mark from the perspective of the average consumer. Such contrasting findings are permissible given the differing legal tests at play. A different legal test applies here. In my view, the hurdle for reputation is not cleared. Even though some judges have expressed a view that the

requirement is not a great one, the level of use shown here is simply not enough to hold that a significant part of the relevant public will know of the mark. The use made is simply not sufficient, particularly when one bears in mind that the mark has not been advertised extensively. This means that the 5(3) claim fails at the first hurdle. However, even if I were wrong on this assessment, I still consider that the claim would have failed for the following reasons:

- Given that the reputation would be weak, the distinctiveness of the mark modest, and that the goods and services (beyond those for which the other grounds have failed) are not similar (even if they could all be used in a household) that would not be enough to bring the earlier mark to mind.
- Even if a link was made, I see no reason why any form of advantage would flow to the owner of the applied for mark due to this link. The opponent says that the advantage is due to the instant recognition of the mark, but I do not see how this makes it easier for the applicant to market its goods.
- Even if some form of minor advantage was found, there is no reason to conclude that this was an unfair advantage, there is, for example, no evidence that the applicant has intended to take advantage of the earlier mark's reputation.
- Further, I see no reason why the earlier mark would be less capable of indicating the origin of its goods, or for there to be some form of economic effect with regards to its consumers.

93. The claim under section 5(3) fails.

### **Conclusion**

94. The opposition fails for, and the mark may proceed to registration, in respect of:

**Class 3:** Toiletries; cosmetics; perfumery; essential oils; skincare preparations; skin cleansers; body creams; body lotions; moisturisers; beauty masks; hand creams; nail care products; cosmetics for nails; cosmetics for use on the hair; hair care preparations; hair care lotions; hair conditioners; hair colouring preparations; hair bleaching products; hair sprays; hair gels; hair lacquer; hair wax; hair styling products; hair straightening products; hair mousses; hair oils; hair treatments; barrier creams; bubble bath; bath preparations; bath lotions; bath bombs; bath creams; bath crystals; soaps; liquid soaps; hair shampoos; bath foams; bath gels; bath additives (non-medicated); hand washes; wipes impregnated with a skin cleanser; toothpaste; body sprays; face and body glitter gels; depilatory products; pumice stones; dentifrices; incense sticks

**Class 8:** Hygienic and beauty implements for humans and animals; manicure and pedicure tools; manicure sets, pedicure sets, nail files, electric nail files; scissors; electric shavers; vibrating blade shavers; parts and fittings for the aforesaid goods

**Class 18:** Luggage; bags; wash bags (not fitted); wash bags for carrying toiletries; wallets and other carriers; cosmetic bags; make up bags.

**Class 21:** Cosmetic and toilet utensils and bathroom articles; bottle openers (not of precious metal or coated therewith); combs; hair brushes; cosmetic brushes; cosmetic bags (fitted); shaving brushes; stands for shaving brushes; holders for shaving brushes; domestic gloves, gloves for cleaning, gloves for gardening; dust pans; sponges for scrubbing skin; sponges for children; loofahs; loofahs for household purposes; body scrubbing puffs; toothbrushes; electric and non-electric toothbrushes; wash bags (fitted); soap dishes; soap boxes; soap dispensers; containers for soaps; containers for cosmetics; toothbrush holders; toothbrush containers; plant pots, plant pot covers; plastic buckets; watering devices; watering cans, parts and fittings for the aforesaid.

**Class 35:** Retail services, online retail services and mail order retail services all in connection with the sale of toiletries, cosmetics, perfumery, essential oils, skincare preparations, skin cleansers, body creams, body lotions, moisturisers, beauty masks, hand creams, nail care products, cosmetics for nails, cosmetics for use on the hair, hair care preparations, hair care lotions, hair conditioners, hair colouring preparations, hair bleaching products, hair sprays, hair gels, hair lacquer, hair wax, hair styling products, hair straightening products, hair mousses, hair oils, hair treatments, barrier creams, bubble bath, bath preparations, bath gels, bath lotions, bath foams, bath bombs, bath creams, bath crystals, soaps, liquid soaps, hair shampoos, bath additives (non-medicated), hand washes, wipes impregnated with a skin cleanser, toothpaste, body sprays, face and body glitter gels, depilatory products, pumice stones, dentifrices, hygienic and beauty implements for humans and animals, manicure and pedicure tools, manicure sets, pedicure sets, nail files, electric nail files, scissors, electric shavers, vibrating blade shavers, luggage, bags, wash bags (not fitted), wallets and other carriers, cosmetic bags, make up bags, cosmetic and toilet utensils and bathroom articles, bottle openers (not of precious metal or coated therewith), combs, hair brushes, cosmetic brushes, cosmetic bags (fitted), shaving brushes, stands for shaving brushes, holders for shaving brushes, domestic gloves, gloves for cleaning, gloves for gardening, dust pans, sponges for scrubbing skin, sponges for children, loofahs, loofahs for household purposes, body scrubbing puffs, toothbrushes, electric and non-electric toothbrushes, wash bags (fitted), wash bags for carrying toiletries, soap dishes, soap boxes, soap dispensers, containers for soaps, containers for cosmetics, toothbrush holders, toothbrush containers, plant pots, plant pot covers, plastic buckets, watering devices, watering cans, parts and fittings for the aforesaid.

but the opposition succeeds for, and the application will be refused registration, in respect of:

**Class 21:** Household or kitchen utensils and containers; brushes (except paint brushes); articles for cleaning purposes; cloths for cleaning purposes; sponges; glassware, porcelain and earthenware not included in other classes; beakers; flasks and water bottles

**Class 35:** Retail services, online retail services and mail order retail services all in connection with the sale of household or kitchen utensils and containers, brushes (except paint brushes), articles for cleaning purposes, cloths for cleaning purposes, sponges, glassware, porcelain and earthenware not included in other classes, beakers, flasks and water bottles; parts and fittings for the aforesaid.

### **Costs**

95. The applicant has retained more than it has lost. It is entitled to an award of costs, albeit reduced to reflect the partial nature of the success. I bear in mind the relevant scale contained in Tribunal Practice Note 2/2016, and award costs to the applicant as follows:

Considering the statement of case and preparing a counterstatement: £200

Considering the opponent's evidence and filing written submissions: £500

Total: £700

96. I order UP Global Sourcing UK Limited to pay Hall & Associates (Marketing) Ltd the sum of £700. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**26<sup>th</sup> April 2019**

**Oliver Morris**

**For the Registrar**