

BLO/292/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3273758
BY TINYYO LIMITED FOR THE TRADE MARK**

KOVIRA

IN CLASSES 3, 8 AND 21

AND

**THE OPPOSITION THERETO UNDER NUMBER 411929
BY
COVIRAN, S.C.A.**

Background

1. On 28 November 2017, Tinyyo Limited (“the applicant”) filed trade mark application number 3273758, for the mark KOVIRA, in respect of the following goods:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices; body cleaning and beauty care preparations; make-up for the face and body; soaps for body care; bath preparations; deodorants for body care; skin, eye care and nail preparations; hair removal and shaving preparations; hair preparations and treatments.

Class 8: Hand tools and implements; manicure and pedicure tools; nail clippers; nail scissors; nail files; nail buffers; hairdressing scissors; hair styling appliances; hair clippers for personal use; hair removing tweezers.

Class 21: Cosmetic brushes; cosmetic sponges; cosmetic utensils; cosmetic applicators; cosmetic powder compacts; holders for cosmetics; make-up removing appliances.

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 22 December 2017. Coviran, S.C.A. (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the following two earlier trade mark registrations:

(i) European Trade Mark (“EUTM”) 8958381

Colours Claimed/Indication: Red Pantone Warm Red C, green Pantone 334 C.



Class 3: *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.*

Class 6: *Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.*

Class 8: *Hand tools and implements (hand operated); cutlery; side arms; razors.*

Class 9: *Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission and reproduction of sound or images; magnetic data carriers, recording and optical discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing apparatus and computers; fire-extinguishing apparatus.*

Class 11: *Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.*

Class 16: *Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); materials for packaging (not included in other classes); printers' type; printing blocks, publications.*

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; materials for cleaning purposes; steelwool; unworked or semi-*

worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 24: Textiles and textile goods, not included in other classes; bed and table covers.

Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes, eggs, milk and milk products; edible oils and fats.

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; raising substances for baking; baking powder; salt, mustard; vinegar, sauces, (condiments), spices, ice.

Class 31: Agricultural, horticultural and forestry products and grains, not included in other classes; live animals, fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33: Alcoholic beverages (except beers).

Class 34: Tobacco; cigars; cigarettes; cigarillos; cigarette holders; smoking pipes; cigar cutters; cigar cases and tobacco jars, not of precious metal; tobacco humidors, not of precious metal; lighters, not of precious metal; matches.

Class 39: Transport services; packaging and storage of goods; travel arrangement.

Class 43: Services provided by establishments whose aim is to prepare food and drink for consumption.

Date of filing: 16 March 2010; completion of registration procedure: 11 June 2011.

(ii) EUTM 15429335



Colours claimed: Red; green.

Class 16: *Paper; Paperboard; Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging; Printers' type; Printing blocks, publications.*

Class 35: *Advertising; Business management; Business administration; Office functions; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of paints, colorants and anti-corrosive preparations, industrial oils and greases, fuels and illuminants, preparations and substances for laundry use, cleaning preparations, soaps, household goods, cleaning goods, perfumery and cosmetics, and perfumes; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of cosmetics, hair lotions, dentifrices, make-up preparations, make-up removing preparations, shaving preparations, air fresheners, fragrances for clothing, candles, incense, air freshening and purifying goods and accessories, sanitary preparations, and materials for dressings; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of pharmaceuticals and veterinary preparations, preparations for destroying vermin, fungicides, herbicides, preservatives for leather (waxes), creams for leather, hand tools and implements (hand-operated), cutlery, side arms, knives and razors; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of optical goods, jewellery, horological and chronometric instruments, jewellery cases or boxes of precious metal, parts and fittings for watches and clocks,*

keyrings, trunks and travelling bags, umbrellas and parasols, walking sticks, pocket wallets, purses, handbags, backpacks, wheeled bags, travel bags, beach bags, school satchels, and cases for toiletries; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of leatherware, furniture, mirrors, picture frames, bed covers, table covers, sheets, household linen, table linen not of paper, bath linen, clothing, footwear, headgear, clothes hangers, garment covers, glasses and other containers, decanters, tableware, teapots, vases, stew-pans, dishes, and corkscrews; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of coasters, stoppers, bottle racks, ironmongery, small items of metal hardware, building materials, tools, paints, enamels, lacquers, paintings, lighting and decorations, DIY and gardening articles, photographic and optical apparatus and instruments, and apparatus for recording, transmission, reproduction or processing of sound or images; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of magnetic, digital or optical data carriers, optical or recording discs, calculating machines, data processing equipment, computers, computer software, computer peripherals, computers, hi-fi systems, portable digital audio players, televisions, electric cells, batteries, and childcare articles; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of household electric appliances, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and air conditioning purposes, electric fans for personal use, apparatus and machines for purifying air or water, stationery, artists' materials, paintbrushes, paper, boxes of cardboard or paper, and albums; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of maps, books, periodicals, leaflets, calendars, writing implements, drawings, drawing implements, adhesives, insulating materials, pocket handkerchiefs of paper, face towels of paper, table linen of paper, toilet paper, nappies of paper or cellulose, refuse bags (of paper or plastic), toilet paper dispensers, and toilet brushes; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of articles for cleaning purposes, household or kitchen utensils and containers, combs and sponges, brushes, hand-operated cleaning instruments, refuse bins, toilet utensils or cases, artificial flowers, natural plants and flowers, trees, and shrubs; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of haberdashery, games and playthings, toy masks, costumes, model vehicles, playthings for household pets,

decorations for Christmas trees, party favours, sporting articles, tents, carpets, rugs, mats and matting, smokers' articles, matches, lighters, and musical instruments and accessories therefor; Retailing in shops, wholesaling, sale via catalogue and sale via global computer networks of all kinds of foodstuffs and beverages; Dissemination of advertising matter and direct mail advertising; Advertising, including promotions; Commercial and business management assistance, including customer services; Exhibitions for commercial or advertising purposes; Sales promotion for others; Public relations services; Import and export services; Services provided by a franchiser, namely assistance in the operation and management of commercial companies; Business administration for franchises in connection with retailing in shops.

Class 39: *Transport; Package and storage of goods; Travel arrangement.*

Date of filing: 12 May 2016; completion of registration procedure: 8 December 2016.

3. The opponent claims that the marks are similar and that the parties' goods and services are identical and similar, leading to a likelihood of confusion under section 5(2)(b) of the Act.

4. The applicant filed a defence and counterstatement, denying all the grounds and putting the opponent to proof of use of EUTM 8958381.

5. The opponent is professionally represented by Page, White & Farrer whilst the applicant is professionally represented by K A Fransz Legal Services. The opponent filed evidence and both sides filed written submissions. Neither party chose to be heard but both filed written submissions in lieu of a hearing.

Relevant dates

6. The opponent's earlier EUTM 8958381 had been registered for more than five years on the date on which the contested application was published. It is, therefore, subject to the proof of use provisions under section 6A of the Act, and the applicant has requested such proof. The opponent has made a statement that it has made

genuine use of the mark in relation to all the goods and services for which its mark is registered. As these proceedings commenced prior to 14 January 2019, when the Trade Mark Regulations 2018 came into force¹, the relevant period for proof of use purposes is the five years prior to and ending on the date of publication of the contested application: 23 December 2012 to 22 December 2017. The relevant date for the purposes of sections 5(2)(b) is the date the application was filed: 28 November 2017.

Opponent's evidence

7. At a case management conference ("CMC") held on 4 October 2018, I allowed the opponent an extension of one week to file its evidence. The opponent's representative informed me that the evidence consisted of invoices and a two-page witness statement. I directed that no further time would be allowed. The evidence was received on 11 October 2018 (the extended deadline). It consisted of a short witness statement from Carlos Martínez Castilla, the opponent's Legal Counsel, with five exhibits, and evidence from James Cornish, from the opponent's professional representatives. The combined evidence vastly exceeded the 300-page limit set out in Tribunal Practice Notice ("TPN") 1/2015 and no permission had been sought to exceed the limit, either at the CMC or in writing.

8. The evidence of James Cornish made an obvious point, that supermarkets sell their own-branded products. The Tribunal directed that the evidence of James Cornish would be disregarded. Exhibit CM4 (to Mr Castilla's witness statement) was the largest exhibit and was unpaginated, contrary to TPN 5/2008. It consisted of copies from a Spanish brochure of grocery items. The Tribunal directed that only the first 100 pages of this exhibit would be admitted and that it must be paginated within seven days, taking the view that allowing the opponent time to bring its evidence to under 300 pages, or to request permission to file evidence over the limit, effectively circumvented my decision to allow the opponent one final week to file its evidence. In relation to Exhibits CM1, CM2 and CM3, the Tribunal directed that, owing to the lack of translation thereof, consideration of these exhibits would be limited to those

¹ SI 2018/825.

items for which the opponent had provided a translation in Mr Castilla’s witness statement, plus any obvious items (e.g. “pastas” and “cereales”). The parties were given an opportunity to comment or object to these directions, but none were received. The opponent re-filed the first 100 pages of Exhibit CM4 on 22 October 2018, paginated.

9. Mr Castilla’s witness statement is dated 10 September 2018. He states that the opponent is a retail cooperative with a long history, having begun trading in Granada (Spain) in 1961. Mr Castilla states that, at the date of his witness statement, the opponent owned more than 3,221 supermarkets, mainly in Spain and Portugal. At the end of 2017, the opponent enjoyed 6.3% annual sales growth and revenue was €1.34 billion.

10. Exhibits CM1 to CM3 are invoices in Spanish. Exhibit CM4 comprises Spanish brochures showing typical supermarket goods. Exhibit CM5 comprises press releases concerning the opponent’s stores in the EU. Mr Castilla provides the following translation of some of the terms appearing in the exhibits:

Spanish	English
Plato	Dish
Vaso	Glass
Tenedor	Fork
Cuchara	Spoon

11. Exhibit CM1 comprises four invoices, described by Mr Castilla in a table, replicated below:

Date	Invoice No.	Total (€)	The invoices show sales of COVIRAN in relation to a range of own-branded products, including:
16/01/2015	FV-01030350	4,341.33	“Plato Postre Coviran 17cm 25 u.” “Plato Hondo Coviran 22cm 10 u” “Vaso Blanco Coviran 100 cc 50 u”

			"Vaso Translucido Coviran 250ml 50 u"
24/2/2015	FV-01138077	8,596.86	"Plato Postre Coviran 17cm 25 u." "Plato Hondo Coviran 22cm 10 u" "Tenedor Blanco Coviran 25 u."
6/5/2015	FV-01353199	10,966.28	"Cuchara Moca Coviran 25 U"
19/5/2015	FV-01395493	5,757.21	"Plato Hondo Coviran 22cm 10 u" "Plato Postre Coviran 17cm 25 u."

12. The first invoice, FV-01030350, is seven pages long and shows a long list of goods. The top of the invoice shows EUTM 8958381. Only a small portion of the goods listed include the word "COVIRAN", such as those identified in the table by Mr Castilla. I have noted others, such as LECHE SEMI BOTELLA COVIRAN 1L and CERVEZA CON ALCOHOL COVIRAN. From my own knowledge, these goods are milk and beer, respectively. However, for reasons which will become clear, it is only necessary to identify goods falling in classes 3, 8 and 21. Apart from the goods identified by Mr Castilla, I cannot see any others, which would appear to fall in these classes, specifically marked as COVIRAN. There are many goods listed without COVIRAN, and some of them carry well-known third-party marks, such as NIVEA, NESTLE, HEINEKEN and PEPSI.

13. The position is similar in relation to the other three invoices contained in Exhibit CM1. I note that FV-01353199 contains a listing, for example, for ROLLO COCINA 3 CAPAS COVIRAN 3 u, JABON DE MANOS ALMENDRA COVIRAN 500 ml, SUAVIZANTE TALCO CONCENT COVURAN 54DOSIS; however, I do not know what these entries mean and Mr Castilla does not explain them. An exception to this is contained in invoice FV-01395493 (not highlighted by Mr Castilla) which contains an entry for DETERGENTE GEL COVIRAN 2 L 22 DOSIS, which I assume is detergent.

14. Mr Castilla provides tables in relation to the invoices comprising Exhibits CM2 and CM3. Again, the only items he has highlighted are COVIRAN items beginning with the words PLATO, VASO, TENEDOR and CUCHARA. The amounts given by

Mr Castilla in his tables are for the total invoice amount, for all the goods in the invoices.

15. As explained earlier in this decision, Exhibit CM4 has been limited to the first hundred pages of the exhibit as originally filed. The pages comprise copies of the opponent's brochures from 2015. The opponent has not highlighted any part of this exhibit as demonstrating use of EUTM 8958381. As far as goods identifiable as falling into classes 3, 8 and 21 are concerned, there are pictures of class 3 goods with trade marks such as COLGATE and ARIEL, but none with the earlier mark. There are pictures of cosmetics cases, but there is no reference to the earlier mark; in fact, the trade marks appear to be VON VOYAGE and MARKWINS (page 7). Page 8 shows a picture of a bottle bearing the words "GEL Aloe Vera" which appears to bear the mark, but I do not know what the goods are. Page 46 refers to COVIRAN champú, but it is not possible to see the mark:



16. Exhibit CM5 relates to the performance of the opponent as a retailer. The earlier mark which is subject to proof of use does not cover retailing. The other earlier mark covers retailing but is not subject to proof of use. Since the opponent says on page 3 of in its written submissions in lieu of a hearing that it does not seek to claim an enhanced level of distinctive character for its earlier marks, the relevance of this exhibit is unclear.

Decision

17. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of

the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18. The onus is on the opponent, as the proprietor of the earlier mark, to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. In *Awareness Limited v Plymouth City Council*, O/236/13 Mr Daniel Alexander QC, sitting as the Appointed Person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself². As will be apparent from my summary of the evidence, there is next to nothing in the way of explanation, narrative or commentary in Mr Castilla’s witness statement. The only goods which Mr Castilla has picked out in his evidence are dishes/plates, glasses, forks and spoons. There is no particularisation of any other goods (or services) throughout some 370 invoice and brochure pages. There is no breakdown of turnover for these, or any other goods. There is no translation or explanation of the abbreviations used in the invoice column headings so it is impossible to ascertain the level of sales in relation to plates, glasses, forks and spoons. There are no pictures of these in the brochure pages. There are no translations of the COVIRAN goods I have listed in paragraph 13 of this decision, so I do not know what these are. The only entry I can guess at is DETERGENTE GEL COVIRAN 2 I 22 DOSIS: presumably, a detergent of some description. However, I do not know what sort of product this is (e.g. whether for laundry or washing dishes), nor the level of sales. There are no pictures of it, so I do not know what the mark

² Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, General Court (“GC”).

looks like which appears on the goods. I can surmise that it is the mark relied upon because this is what appears on the top of the invoices. Even so, this single invoice entry, with no turnover and no explanation as to how many units were sold then or at any other time in the relevant period, is not enough to sustain a claim to genuine use for goods in class 3, even just for detergent (of whatever description). Mr Castilla has provided 269 pages of invoices, with around 40 items per page but has highlighted only 45 items out of approximately 10,760 items as being relevant to the opponent's proof of genuine use. It is not for the Tribunal to trawl through 10,760 items looking for COVIRAN items for the opponent (and then trying to ascertain what they are), when it is the opponent which is best placed to know in relation to what goods it has used its mark and whether they are relevant to the issues to be decided.

21. Nor is it any answer, as submitted by the opponent, that the applicant has not challenged its evidence. There is a difference between not believing evidence and the burden of proving sufficiency, which falls to the opponent. In *Multisys*³, Mr Alexander, sitting as the Appointed Person said:

“17. Key does not dispute the correctness of these principles or criticise the Hearing Officer for applying them. Instead, relying on the decision of Richard Arnold QC, Appointed Person, in *Pan World Brands v. Tripp (Pan World)* [2008] RPC 2, Key submits that if evidence is given about goodwill which is not obviously incredible and is unchallenged by countervailing evidence or by cross-examination, it is not open to the Hearing Officer to reject it. Key refers to Tribunal Practice Note TPN 5/2007 which is to similar effect. Key submits that this is the position here and that the Hearing Officer was therefore wrong to have concluded that Key's goodwill was insufficient to found a s.5(4)(a) attack. It is therefore necessary first to consider what *Pan World* was and was not saying.

18. In *Pan World*, the Appointed Person said that, although documentary records of use were not required, mere assertion of use of a mark by a witness did not constitute evidence sufficient to defeat an application for

³ BL O/410/11

revocation for non-use (see [31]). He did not regard a tribunal evaluating the evidence as bound to accept everything said by a witness without analysing what it amounts to. He pointed out at [37] that Hearing Officers were entitled to assess evidence critically and referred to the observations of Wilberforce J in *NODOZ Trade Mark* [1962] RPC 1 at 7:

“...in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established.”

19. *Pan World* and *NODOZ* were applications for revocation for non-use. The approach to use is not the same as in a s.5(4)(a) case. As Floyd J said in *Minimax*, it is possible for a party to have made no real use of a mark for a period of five years but to retain goodwill sufficient to support a passing off action. Conversely, use sufficient to prevent revocation for non-use may be insufficient to found a case of passing off.

20. However, the approach to evaluation of evidence of use is similar: the less extensive the evidence of use relied on, the more solid it must be. The Registrar is not obliged to accept – and in some circumstances may be obliged to reject – a conclusory assertion by a witness that it has a given goodwill at the relevant date or that the use by a third party of a similar mark would amount to misrepresentation, when the material relied upon in support does not bear that out.

21. That point was also made by Laddie J in *DIXY FRIED CHICKEN TM* [2003] EWHC 2902 (Ch) and, more recently, in *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32, Geoffrey Hobbs QC, Appointed Person, said at [38]:

“...it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish.”

22. Overall, the adequacy of evidence falls to be assessed by reference to the Lord Mansfield's aphorism from *Blatch v. Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v. Glenhaven Financial Services Ltd* [2002] UKHL 22 [2203] 1 AC 32 and in *CLUB SAIL*:

“...all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.”

22. As said earlier, the opponent was warned by the Tribunal that the only evidence that would be considered would be that for which Mr Castilla had provided translations (as in paragraph 10 of this decision) and for terms which are obvious, such as pastas and cereals. The opponent chose not to reply or contest that direction, so accepts that it has run the risk that items which are potentially important to this decision will not be considered. The Tribunal's arbitrary limit of Exhibit CM4 to the first hundred pages (and this still took the entirety of the opponent's evidence to well over the 300-page limit) was entirely down to the opponent's failure, having secured an extension of time, to get its evidence in order. The consequence of its approach to filing evidence is that it has failed to discharge the burden of proof because its evidence fails to show genuine use of the mark in relation to the goods (and the services of this particular earlier mark). The opponent cannot rely upon EUTM 8958381. The remainder of this decision concerns the likelihood of confusion between the other earlier mark and the application.

Section 5(2)(b) of the Act

23. 5(2)(b) of the Act states:

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

(a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

25. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

26. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06, the GC stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

27. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

28. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

29. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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."

30. The goods and services to be compared are shown in the table below.

Earlier mark	Application
<p><i>Class 16: Paper; Paperboard; Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paint brushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging; Printers' type; Printing blocks, publications.</i></p> <p><i>Class 35: Advertising; Business management; Business administration; Office functions; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of paints, colorants and anti-corrosive preparations, industrial oils and greases, fuels and illuminants, preparations and substances for laundry use, cleaning</i></p>	<p><i>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices; body cleaning and beauty care preparations; make-up for the face and body; soaps for body care; bath preparations; deodorants for body care; skin, eye care and nail preparations; hair removal and shaving preparations; hair preparations and treatments.</i></p> <p><i>Class 8: Hand tools and implements; manicure and pedicure tools; nail clippers; nail scissors; nail files; nail buffers; hairdressing scissors; hair styling appliances; hair clippers for personal</i></p>

<p><i>preparations, soaps, household goods, cleaning goods, perfumery and cosmetics, and perfumes; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of cosmetics, hair lotions, dentifrices, make-up preparations, make-up removing preparations, shaving preparations, air fresheners, fragrances for clothing, candles, incense, air freshening and purifying goods and accessories, sanitary preparations, and materials for dressings; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of pharmaceuticals and veterinary preparations, preparations for destroying vermin, fungicides, herbicides, preservatives for leather (waxes), creams for leather, hand tools and implements (hand-operated), cutlery, side arms, knives and razors; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of optical goods, jewellery, horological and chronometric instruments, jewellery cases or boxes of precious metal, parts and fittings for watches and clocks, keyrings, trunks and travelling bags, umbrellas and parasols, walking sticks, pocket wallets, purses, handbags, backpacks, wheeled bags, travel bags, beach bags, school satchels, and cases</i></p>	<p><i>use; hair removing tweezers.</i></p> <p><i>Class 21: Cosmetic brushes; cosmetic sponges; cosmetic utensils; cosmetic applicators; cosmetic powder compacts; holders for cosmetics; make-up removing appliances.</i></p>
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for toiletries; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of leatherware, furniture, mirrors, picture frames, bed covers, table covers, sheets, household linen, table linen not of paper, bath linen, clothing, footwear, headgear, clothes hangers, garment covers, glasses and other containers, decanters, tableware, teapots, vases, stew-pans, dishes, and corkscrews; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of coasters, stoppers, bottle racks, ironmongery, small items of metal hardware, building materials, tools, paints, enamels, lacquers, paintings, lighting and decorations, DIY and gardening articles, photographic and optical apparatus and instruments, and apparatus for recording, transmission, reproduction or processing of sound or images; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of magnetic, digital or optical data carriers, optical or recording discs, calculating machines, data processing equipment, computers, computer software, computer peripherals, computers, hi-fi systems, portable digital audio players, televisions, electric cells, batteries, and childcare articles; Retailing in shops, wholesaling,

and sale via catalogues and via global computer networks of household electric appliances, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and air conditioning purposes, electric fans for personal use, apparatus and machines for purifying air or water, stationery, artists' materials, paintbrushes, paper, boxes of cardboard or paper, and albums; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of maps, books, periodicals, leaflets, calendars, writing implements, drawings, drawing implements, adhesives, insulating materials, pocket handkerchiefs of paper, face towels of paper, table linen of paper, toilet paper, nappies of paper or cellulose, refuse bags (of paper or plastic), toilet paper dispensers, and toilet brushes; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of articles for cleaning purposes, household or kitchen utensils and containers, combs and sponges, brushes, hand-operated cleaning instruments, refuse bins, toilet utensils or cases, artificial flowers, natural plants and flowers, trees, and shrubs; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of haberdashery,

<p><i>games and playthings, toy masks, costumes, model vehicles, playthings for household pets, decorations for Christmas trees, party favours, sporting articles, tents, carpets, rugs, mats and matting, smokers' articles, matches, lighters, and musical instruments and accessories therefor; Retailing in shops, wholesaling, sale via catalogue and sale via global computer networks of all kinds of foodstuffs and beverages; Dissemination of advertising matter and direct mail advertising; Advertising, including promotions; Commercial and business management assistance, including customer services; Exhibitions for commercial or advertising purposes; Sales promotion for others; Public relations services; Import and export services; Services provided by a franchiser, namely assistance in the operation and management of commercial companies; Business administration for franchises in connection with retailing in shops.</i></p> <p><i>Class 39: Transport; Package and storage of goods; Travel arrangement.</i></p>	
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31. In *Oakley, Inc v OHIM*, Case T-116/06, the GC 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.

32. In *Tony Van Gulck v Wasabi Frog Ltd* (“*Miss Boo*”), BL O/391/14, Mr Geoffrey Hobbs, sitting as the Appointed Person, cautioned that “selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35”. The objective of retail services, as set out in *Oakley*, “includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction” and “those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered for sale.” On the basis of the European courts’ judgments in *Sanco SA v OHIM*⁴, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁵, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*⁶, 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).

⁴ Case C-411/13P

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

⁶ Case C-398/07P

33. I take from these authorities that, in comparing retail services against goods, there may be some similarity based upon complementarity and shared trade channels; the goods do not have to be identical to the subject goods of the retail service; and, that the level of similarity may be weak depending on the presence or absence of the other *Canon* factors.

34. There are no submissions from the opponent as to why its goods in class 16 are similar to the applicant's goods. It is not evident to me that there is any similarity. As the opponent has provided no assistance in relation to what is clearly not an obvious point, I find that there is no similarity between its class 16 goods and the applicant's goods.

35. The applicant's goods are self-evidently different in nature to retail services. The intended purpose of the goods is, broadly, for cleaning, for creating an effect or performing a task, and for use in relation to cosmetics. The intended purpose of retail services is to encourage the sale of various goods, which means that the purpose of the goods/services is different. The goods are not in competition with the services and their method of use also differs.

36. As said above, the intended purpose of the opponent's retail services is to encourage the sale of various goods, including the following goods, as set out in the opponent's specification:

- *Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of preparations and substances for laundry use, cleaning preparations, soaps, household goods, cleaning goods, perfumery and cosmetics, and perfumes; Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of cosmetics, hair lotions, dentifrices, make-up preparations, make-up removing preparations, shaving preparations;*

- *Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of hand tools and implements (hand-operated);*
- *Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of cases for toiletries;*
- *Retailing in shops, wholesaling, and sale via catalogues and via global computer networks of combs and sponges, brushes, toilet utensils or cases.*

37. I find that the opponent's retail services are complementary to the applicant's goods because the applicant's goods are (amongst others) specified as the subject of the retail services, either individually or as part of a larger group, such as retailing of hand tools and implements. The goods are indispensable to the retail services relating to them. In addition to the complementary relationship between the goods and the retailing thereof, there is an overlap in the trade channels through which the goods and services reach the average consumer. I find that there is a medium degree of similarity between the applicant's goods and the opponent's retail services which I have listed above.

The average consumer and the purchasing process

38. 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. The parties' goods and services are all aimed at the general public. Some will be inexpensive and frequently purchased (low-cost toiletries, for example). The purchase will be overwhelmingly visual, although I do not ignore the potential for an aural aspect to the purchasing process; for example, department stores commonly provide assistance when purchasing cosmetics. On the whole, a normal degree of attention will be paid to the purchase.


Comparison of marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

40. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

41. The marks to be compared are:

Opponent's mark	Applicant's mark
	KOVIRA

42. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited*, Case C-252/12, the CJEU held that:

“2. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision.

3. Article 9(1)(b) and (c) of Regulation No 207/2009 must be interpreted as meaning that the fact that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign is relevant to the global assessment of the likelihood of confusion and unfair advantage for the purposes of that provision.”

43. The Court of Appeal has stated on two occasions following the CJEU’s judgment in *Specsavers*, (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter).⁷ Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour. However, it is not appropriate to notionally apply complex colour arrangements to a mark registered in black and white. This is because it is necessary to evaluate the likelihood of confusion on the basis of normal and fair use of the marks, and applying complex colour arrangements to a mark registered, or proposed to be registered, without colour would not represent normal and fair use of the mark.

⁷ See paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294 and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at paragraph 47

44. The '55' element on the earlier mark comprises a complex colour arrangement; however, it is only the COVIRAN element which has any similar counterpart in the applicant's mark. It is limited to green on the EUTM register. The applicant's mark is in black and white and so, notionally, covers colour. The opponent's COVIRAN element does not comprise a complex colour arrangement and so, bearing in mind the authorities, the fact that the earlier mark is limited to colour does not have a bearing on the assessment of similarity (and confusion) between the marks. This is because, notionally, the applicant's mark covers use in green.

45. The applicant's mark consists of KOVIRA, which is the sole element in which the overall impression of the mark resides. The earlier mark is more complex. The stylised 55 is the largest element and is positioned at the top of the mark, so can be said to be the most dominant of the three main components (55, años juntos and COVIRAN). Whilst 'años juntos' is not negligible, it is smaller and less eye-catching than the 55 and COVIRAN. As a result, 'años juntos' carries less weight in the overall impression than the other two main elements. With regard to COVIRAN, whilst not as large as the 55, and whilst positioned at the base of the mark, it is, nevertheless, in thick, bold capitals and is almost equal to the 55 in its contribution to the overall impression of the mark. The red dot over the I of COVIRAN carries little weight, being understood as the dot of an 'i' (despite the word being presented as capital letters).

46. The only point of convergence between the marks is COVIRAN/KOVIRA. These elements are visually similar to a good degree because of the common letter sequence: OVIRA. However, there are other visual elements in the earlier mark. Taking these into account, because marks must be considered as wholes, there is a low degree of overall visual similarity between them.

47. The marks are aurally similar to a low or high degree, depending on whether the average consumer would articulate 55 and años juntos. If they do not, the marks are similar to a high degree because the C and K would sound identical (in English). The only aural difference would be the end letter N; the three syllables would sound almost identical.

48. There is no conceptual similarity between the marks. COVIRAN and KOVIRA are invented words with no concept. The 55 and años juntos do not have any counterparts in the applicant's mark. (I am aware that años means years; I do not know the meaning of juntos, although the opponent submits that años juntos means years together.)

Distinctive character of the earlier mark

49. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁸ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

⁸ Case C-342/97

50. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. There is no use shown in the evidence of the mark upon which the opponent may rely (EUTM 15429335). The opponent is not entitled to claim an enhanced level of distinctive character. That being the case, I have only the inherent distinctiveness of the earlier marks to consider.

51. The earlier mark is comprised of several elements. There is only one point of similarity between the marks. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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

52. The similar element is COVIRAN. This is an invented word. It is highly distinctive because it does not describe, allude to or evoke any characteristics of any of the services covered by the earlier mark.

Likelihood of confusion

53. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that there is a medium degree of similarity between the parties' goods and services.

54. The applicant appears to take the view in its written submissions that the parties' trade channels are different, the opponent's evidence indicating that it is a physical store, the applicant's current trade being an online business. The applicant also points out that the opponent has not filed evidence in relation to online retail services. In short, it did not have to because its earlier mark EUTM 15429335 is not subject to proof of use. This means that the opponent has notional cover for all the class 35 services in its specification and can rely on them all without having to file evidence. The opponent has cover for retail services provided in shops, wholesaling and sale via catalogues and global computer networks. Furthermore, it may decide to sell goods online, as well as in shops (a common feature of UK supermarket business). This point is illustrated in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06 P, in which the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

55. That being the case, notionally the trade channels are shared (as found earlier in this decision).

56. I agree with the applicant that the visual perception is more important for the parties' goods and services than the aural perception because these are everyday consumer goods and services which will be, for the most part, self-selected and perceived visually on shop signage, websites and in brochures. The visual perception of the marks includes the elements additional to the similar element (COVIRAN/KOVIRA). These, in particular the large and complex 55, lead me to conclude that the visual differences will mitigate the risk that the average consumer might mistake the whole of the earlier mark for the applicant's mark, even taking into account the effects of imperfect recollection.

57. However, although average consumers may not be directly confused, I must also consider whether they may be *indirectly* confused, which also constitutes a likelihood of confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

58. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion.

59. As said earlier, COVIRAN is highly distinctive. It is also separated in meaning from the rest of the earlier mark, because the combination 55 años juntos COVIRAN does not form a unit with a meaning, as a whole. COVIRAN is an invented word. It sits on its own in the earlier mark, with no conceptual connection to the rest of the mark. It has the impression of a house mark. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

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

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

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

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

60. As pointed out by Arnold J, the principle established in *Medion v Thomson* extends to the situation where the composite mark contains an element which is similar to the earlier mark. In an earlier judgment, Arnold J considered the marks AVEDA and DABUR UVEDA and said:

“48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion. Accordingly, it is necessary for me to consider the matter afresh. Having regard to the matters set out in paragraph 39 above, I think there can be little doubt that the average consumer who was familiar with AVEDA beauty products would be likely to be confused by the use of DABUR AVEDA in relation to identical goods. In particular, there would be a strong likelihood that the average consumer would think that it indicated some connection between DABUR and AVEDA. In my judgment it makes little difference that the second word in the composite mark is UVEDA rather than AVEDA. As the hearing officer rightly accepted, UVEDA is both visually and aurally very close to AVEDA. The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear. Thus it is likely that some consumers would misread or mishear UVEDA as AVEDA. (Indeed, not only did the hearing officer himself write AVEDA instead of UVEDA at [43], but also the Intellectual Property Office's database of past decisions currently records the contested mark as being "Dabur AVEDA".)”

61. In the present case, COVIRAN has an independent distinctive role in the earlier mark. COVIRAN and KOVIRA are not identical, but they do not have to be, as set

out in *Whyte and Mackay* and *Aveda*. The COVIRAN and KOVIRA elements are similar visually and aurally, and they will be seen as invented words with no counteracting concept, making these elements more prone to imperfect recollection. As said above, I do not think that the marks will be mistaken for one another. However, all factors in the analysis considered, there is a likelihood of indirect confusion because there is sufficient risk that the average consumer, while noting the extra elements, will nevertheless perceive the COVIRAN element in the manner of a house mark and it is that element which is likely to be imperfectly recalled, as a house mark. Given that the opponent's services cover the retailing of the goods covered by the applicant's mark, and that the level of attention is no higher than normal for everyday goods, the consequence of such a perception is that the average consumer will conclude that the goods and services emanate from economically linked undertakings or the same undertaking using a variation on its brand.

Outcome

62. The opposition succeeds in full. The application is refused.

Costs

63. The opponent has been successful and, ordinarily, would be entitled to a contribution towards the costs of the proceedings, based upon the scale of costs published in Tribunal Practice Notice 2/2016. It will be apparent from my analysis of the opponent's evidence that it was ill-prepared and unfocussed. It took me a disproportionate amount of time to go through it, also a burdensome task for the applicant. The evidence has made no difference to the outcome of this decision. I will not award the opponent any costs in relation to the preparation of its evidence.

64. Furthermore, the opponent's pleadings were also unfocussed and burdensome. Bearing in mind that the application covered goods in classes 3, 8 and 21 (classes that were also covered by one of the earlier marks), the statement of grounds contained the following:

“The Applicants’ mark covers goods that are identical and similar to the goods and services in the Opponent’s registered marks. Without prejudice to the generality of the foregoing, the Opponent’s mark No. 8958381 covers a wide list of class 3, 8 and 21 items, which are identical or similar goods, sold through the same channels of trade, for the same purpose, directed at the same consumers, as the Applicant’s classes 3, 8 and 21 goods, or they are complementary goods.”

65. It is clear from this paragraph what the opponent really thought its case was. Its two sets of written submissions dealt only with classes 3, 8, 21 and 35; however, at no time did it withdraw its reliance on classes 6, 9, 11, 16, 24, 29, 30, 31, 32, 33, 34, 39 or 43. Further, the opponent made a statement of use in relation to all the goods, signed by a statement of truth. Even if it had shown genuine use for all of its goods, it would have been of no benefit to the opponent other than in relation to goods in classes 3, 8 and 21: it is a mystery how any of the opponent’s other goods and services upon which it relies could be considered similar to the goods of the application.

66. Pleadings should not be ‘general’. Their purpose is to set out the party’s legal case with sufficient clarity so that the other side can make an informed decision about whether to defend its trade mark, and in which respects. The nature of the pleadings would have caused extra work for the applicant, even if simply to compare the specifications to realise that there was no similarity between its goods and the goods and services in the opponent’s classes, other than classes 3, 8, 21 and 35. It is assumed that the opponent believes its claim to be true because the notice of opposition includes a statement of truth. Therefore, to preserve its position, the applicant would have had to go through all the specifications and the evidence.

67. It is the opponent’s role to hone its pleadings to those where it can, at the very least, put forward an arguable case. If it cannot meet this very basic requirement then the goods and/or services should not be included in the pleading. The fact that it was silent about the majority of its goods and services in its two sets of

submissions shows that it could not meet this very basic requirement. In the circumstances, I make no award for costs.

Dated this 29th day of May 2019

**Judi Pike
For the Registrar,
the Comptroller-General**