

**O-698-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3338153**

**BY EZGO GROUP INC**

**TO REGISTER THE FOLLOWING TRADE MARK:**

The logo for 'MySmile' features the text 'MySmile' in a light blue, sans-serif font. The 'S' in 'Smile' is stylized with a white outline and a light blue fill, resembling a smile. The entire logo is set against a light blue, wavy background that suggests water or a soft smile.

**IN CLASS 3**

**AND**

**OPPOSITION THERETO UNDER NO. 414751**

**BY INTEGRATED DENTAL HOLDINGS LIMITED**

## BACKGROUND AND PLEADINGS

1. On 13 September 2018, EZGO Group Inc (“the applicant”) filed trade mark application number UK00003338153 for the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 21 September 2018, in respect of goods in class 3.

2. Integrated Dental Holdings Limited (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon six United Kingdom trade mark registrations, the pertinent details of which are as follows:

UK00003065413 (series mark)

**Representation:**

(i) MYDENTIST

(ii) MY DENTIST

**Filing date:** 23 July 2014

**Registration date:** 9 October 2015

**Goods and services:** Various in classes 3, 5, 10, 16, 21, 35, 36, 38, 41 and 44.

UK00003070191 (series mark)

**Representation:**

(i) 

(ii) 

**Filing date:** 27 August 2014

**Registration date:** 12 December 2014

**Goods and services:** Various in classes 3, 5, 10, 16, 21, 35, 36, 38, 41 and 44.

UK00003085086 (series mark)

**Representation:**

(i) MY DOCTOR

(ii) MYDOCTOR

**Filing date:** 8 December 2014

**Registration date:** 1 May 2015

**Goods and services:** Various in classes 3, 5, 10, 16, 21, 35, 36, 38, 41 and 44.

UK00003333764

**Representation:**



**Filing date:** 23 August 2018

**Registration date:** 30 November 2018

**Goods and services:** Various in classes 3, 5, 10, 16, 21, 35, 36, 38, 41 and 44.

UK00003060449

**Representation:**



**Filing date:** 18 June 2014

**Registration date:** 12 December 2014

**Goods and services:** Various in classes 3, 5, 10, 16, 21, 35, 36, 38, 41 and 44.

UK00003060452

**Representation:**

MY

**Filing date:** 18 June 2014

**Registration date:** 5 December 2014

**Goods and services:** Various in classes 3, 5, 10, 16, 21, 35, 36, 38, 41 and 44.

3. For the purposes of these proceedings, the opponent relies upon all its registered goods and services. The opponent's marks qualify as earlier marks in accordance with section 6 of the Act. Given their registration dates, they are not subject to the proof of use provisions contained in section 6A of the Act.

4. The opponent's case under section 5(2)(b) is that the applied-for mark is similar to the opponent's earlier marks and is to be registered for identical or similar goods or related services, resulting in a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies a likelihood of confusion due to a lack of similarity between its applied-for mark and any of the opponent's earlier marks.

6. The opponent is represented by Urquhart-Dykes & Lord LLP. The applicant is represented by Trademarkit LLP. Neither party filed evidence. An oral hearing took place before me on 18 September 2019, attended by Alan Fiddes of the opponent's legal representatives. The applicant chose not to attend the oral hearing of this matter, nor did it file written submissions in lieu of attendance.

## **DECISION**

### **Section 5(2)(b)**

7. Section 5(2)(b) of the Act states that:

“A trade mark shall not be registered if because –

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

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

## Relevant law

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

### *The principles*

(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**

9. For the purposes of these proceedings, and for reasons that will become apparent, I will compare the applied-for goods to the opponent's class 3 goods, since I consider this to be the opponent's best case. The opponent has not made any submissions as to why any of its goods or services in the other classes are similar to the applied-for goods. When asked about this at the hearing, Mr Fiddes submitted that the opponent's best case in relation to the goods comparison rests in its class 3 goods.

10. The competing goods are shown in the table below:

<b>Applicant's specification</b>	<b>Opponent's specification</b>
<p>Class 3: Dental bleaching gels; Teeth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Tooth whiteners; Gels for teeth cleaning; Bleaching preparations (decolourants) for cosmetic purposes; Toothpaste; Preparations for dental purposes (dentifrices); Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene (dentifrices); Products for dental hygiene; Cosmetic preparations for cleansing the teeth; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth; Tooth cleaning preparations; Tooth care preparations; Mouthwash; Mouthwashes, not for medical purposes; Non-medicated mouth rinses; Tooth polish; Varnish for teeth; Non-medicated mouth sprays; Breath fresheners.</p>	<p>Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices and mouthwashes: toothpaste; non-medicated oral health care products; mouth rinses; mouth washes; chew sticks; toothpastes and tooth gels; medicated toothpastes; teeth cleaning lotions; oral hygiene preparations; cleaning preparations for the teeth; disclosing tablets for personal use in indicating tartar on teeth; dental bleaches.</p>

11. The General Court confirmed in *Gérard Meric v OHIM*<sup>1</sup> that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

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<sup>1</sup> Case T-133/05

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

12. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:<sup>2</sup>

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

13. I find the following goods (adjacent to one another in the table below) to be identical, in accordance with *Merix*, either because the terms in the applicant’s specification fall within the scope of the terms in the opponent’s specification, or vice versa:

<b>Applicant’s specification</b>	<b>Opponent’s specification</b>
Dental bleaching gels	Dental bleaches
Teeth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Tooth whiteners	Dental bleaches
Gels for teeth cleaning; Toothpaste; Tooth cleaning preparations; Tooth care preparations; Cosmetic preparations for cleansing the teeth	Cleaning preparations for the teeth; toothpastes and tooth gels

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<sup>2</sup> BL O/399/10



Bleaching preparations (decolourants for cosmetic purposes)	Dental bleaches
Preparations for dental purposes (dentifrices); Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth	Oral hygiene preparations
Products for dental hygiene	Non-medicated oral healthcare products
Mouthwash; Mouthwashes, not for medical purposes; Non-medicated mouth rinses	Mouth rinses; mouth washes
Tooth polish; Varnish for teeth	Oral hygiene preparations; non-medicated oral healthcare
Non-medicated mouth sprays; Breath fresheners	Oral hygiene preparations; non-medicated oral healthcare

14. All of the applicant's goods are identical to one or more of the opponent's goods in class 3.

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

15. It is necessary for me to determine who the average consumer is for the goods in question; I must then determine the manner in which the goods are likely to be selected by the average consumer in the course of trade.

16. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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*.<sup>3</sup>

17. 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*,<sup>4</sup> Birss J. described the average consumer in these terms:

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

18. The average consumer of the goods at issue will be either a member of the general public or a member of the dental profession with specific professional knowledge or expertise. Although the price of the goods can vary (some teeth whitening preparations can be quite expensive, whereas some toothpastes are much cheaper, for example), they are not, generally speaking, particularly expensive. The average consumer is likely to consider, for example, the suitability of the goods for their particular dental needs. However, such goods are likely to be purchased fairly frequently by both the general public and professionals. Taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average.

19. The purchase is likely to be predominantly visual: the goods will be self-selected from physical stores, catalogues or websites. However, I do not discount that there may be an aural element with conversations taking place with professionals in a dentistry setting.

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<sup>3</sup> Case C-342/97

<sup>4</sup> [2014] EWHC 439 (Ch)

## Comparison of marks

20. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

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

22. For reasons that will become apparent, I will focus my attention on the opponent’s UK00003065413, UK00003333764, and UK00003060452, but will deal briefly with the remaining earlier marks.

UK00003065413

23. The trade marks to be compared are as follows:

Opponent's UK00003065413	Applied-for mark
<p style="text-align: center;">MYDENTIST MY DENTIST</p>	

24. The opponent claims that its earlier marks are confusingly similar to the applied-for mark to the extent that there is a likelihood of confusion.

25. The applicant makes the following submissions:

“The [Applicant’s] mark consists of the words “MySmile” superimposed on a representation of smiling lips coloured blue. The Opponent’s marks all consist of the word “MY” together with other ordinary words (e.g. MYDENTIST/MY DENTIST), or the word “MY” by itself. When considered as a whole, none of the Opponent’s mark is in any way similar, whether visually, orally, or conceptually, to the contested mark. The only similar element is the word “MY”. All the other elements in the contested mark and the Opponent’s marks are different. The word “MY” is simply a possessive determiner that indicated something belongs to or associated with the speaker. [...] The other elements in the contested mark, namely the word “Smile” and the representation of lips, are distinctive and entirely different from the Opponent’s marks. These elements distinguish the contested mark from the Opponent’s marks.”

26. The applied-for mark consists of the two conjoined words “MySmile”. “MySmile” is written in black in a standard typeface and is superimposed on a figurative device of a pair of pale blue lips. Considering its size and prominent position in the mark, the textual component “MySmile” is the dominant element of the mark, although the lips device still contributes to the overall look and feel of the mark.

27. The opponent's mark (consisting of a series of two marks) consists solely of the words "MY" and "DENTIST", conjoined in one of the marks and separated by a space in the other. Whether the words are conjoined or not does not make a material difference to my comparison since, in either case, the marks will be perceived as two separate words. There are no other elements to add to the overall impression of the opponent's mark, which rests in the words themselves.

28. The similarity between the marks rests in the entire first word "MY". The differences are in (i) the different second word ("DENTIST" versus "Smile") and (ii) the figurative 'lips' device in the applied-for mark, which has no counterpart in the opponent's mark. Overall, I find a low degree of visual similarity between the marks.

29. The first word in each mark ("MY") will be pronounced identically. The second word creates an aural difference (the two-syllable word "DENTIST" versus the one-syllable word "Smile"). The figurative device in the applied-for mark will not be articulated. Overall, I find the marks aurally similar, albeit to only a low degree.

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM*.<sup>5</sup> The assessment must be made from the point of view of the average consumer.



31. The concept of the opponent's mark that will immediately be grasped is a dentist belonging to or associated with someone. The concept of the applied-for mark that will immediately be grasped is a smile belonging to or expressed by a person. Since a dentist is a person whose job is treating people's teeth,<sup>6</sup> and a smile is a person's expression involving their mouth, lips and/or teeth, there is an overlap in the meaning of the marks at issue. I find the marks conceptually similar to a medium degree.

32. I now deal, briefly, with the opponent's UK00003070191, which I refer to as the 'my dentist (stylised)' mark.

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<sup>5</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

<sup>6</sup> Cambridge English Dictionary

Opponent's UK00003070191	Applied-for mark
	

33. The concept of the opponent's UK00003070191 is no different to that of its UK00003065413, neither is the aural comparison. Given the additional elements (the punctuation marks) and the stylisation of the my dentist (stylised) mark, it is no closer, visually, to the applied-for mark than the MYDENTIST word mark, which is a better case for the opponent.

34. I move on to deal, briefly, with the opponent's UK00003085086.

Opponent's UK00003085086	Applied-for mark
<p data-bbox="379 1301 608 1406">MY DOCTOR MYDOCTOR</p>	

35. Since the mark is aurally and visually no more similar to the applied-for mark than the opponent's MYDENTIST word mark, but its concept is further away (i.e. the concept of a smile is more similar to the concept of a dentist than that of a doctor), I do not find this mark to put the opponent in any better a position than its MYDENTIST word mark.

Opponent's UK00003333764	Applied-for mark
	

36. The overall impression of the applied-for mark is as explained at paragraph 26 of this decision.

37. The opponent's mark consists of the word "my" (written in grey) contained within pale pink curly brackets, followed by the word "skin" (written in black). Below the word "skin" are the words "frame your smile", written in pale pink and a smaller font. All textual components of the mark are written in a fairly standard typeface. I consider the words "my skin" to be the dominant elements in the mark, given their size and position. A lesser role is played by the punctuation marks (curly brackets), which I consider act as a border around the word "my". The words "frame your smile" also play a lesser role in the mark given their very small font and pale colour. They are likely to be seen as a slogan by the average consumer.


38. The only visual similarities between the marks are the words "my" and "smile", although the latter of these appears in a different position in each mark (the second word in the applied-for mark as opposed to the smaller fifth word in the earlier mark). All other components of the marks differ. Overall, I find the marks to be visually similar, albeit to only a low degree.

39. I find there to be two possible ways in which the earlier mark will be articulated: either in full, as "my skin frame your smile", or, more likely, shortened to "my skin". Comparing either of these to the applicant's "my smile", I find a low degree of aural similarity.

40. I have already explained the concept of the applied-for mark (someone's smile). Regardless of whether the earlier mark is articulated in full or not, the concept that will be immediately grasped is that of someone's skin. Since skin and smile both refer to the human body (one being an organ, the other being an expression of the mouth), I find there to be some conceptual similarity between the marks, albeit to a low degree.

UK00003060452

41. The trade marks to be compared are as follows:

Opponent's UK00003060452	Applied-for mark
MY	

42. The overall impression of the applied-for mark is as explained at paragraph 26 of this decision. The opponent's mark consists solely of the one word "MY", the overall impression of which rests in the word itself.



43. Again, the similarity between the marks rests in the word "MY". The differences are in the addition of the word "Smile" and the figurative 'lips' device in the applied-for mark, neither of which have a counterpart in the earlier mark. Overall, I find a low degree of visual similarity between the marks.

44. The first word in each mark ("MY") will be pronounced identically. The word "Smile" in the applied-for mark creates an aural difference. The figurative device in the applied-for mark will not be articulated. Overall, I find a medium degree of aural similarity between the marks.



45. The word “MY” is a possessive determiner, usually used before a noun to refer to possession of that noun. Despite being used by itself, the average consumer will most likely grasp the concept of the mark as the ordinary meaning of the word “MY”. However, given that “MY” is such a short word, there is a possibility that the mark may be understood as the two separate letters “M” and “Y”, meaning some consumers will not perceive the word “MY”. If the same word, “MY”, is perceived in both marks, there will be some degree of conceptual similarity. However, the addition of the word “smile” generates a clear conceptual difference from the use of the determiner “MY” alone, such that any conceptual similarity is very low.

46. I move on to deal, briefly, with the opponent’s UK00003060449, which I refer to as the ‘my (stylised)’ mark.

Opponent’s UK00003060449	Applied-for mark
	

47. The concept of the opponent’s UK00003060449 is no different to that of its UK00003060452, neither is the aural comparison. Given the additional elements (the punctuation marks) and the stylisation of the my (stylised) mark, it is no closer, visually, to the applied-for mark than the MY word mark, which is a better case for the opponent.

**Distinctive character of the earlier marks**

48. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark/s, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

49. The opponent has not filed any evidence, so I am unable to determine whether the marks have been used at a sufficient level to have enhanced their distinctive character. Consequently, I have only the inherent distinctiveness of the marks to consider. Since I have found them to be the most similar marks to the applied-for mark, I will focus my attention on the earlier marks UK00003065413, UK00003333764 and UK00003060452.

UK00003065413

MYDENTIST/MY DENTIST

50. The trade marks manual provides some guidance on the use of marks containing the word “MY”, the relevant parts of which read as follows:

## **“My and my first**

Use of the word ‘My’ in combination with other personalised descriptive words in relation to services which can be tailored to suit the needs of an individual are likely to be objectionable, for example:

‘MY PERSONAL TRAINER’ – for training services ‘MY PERSONAL BANKER’ – for financial services ‘MY WEDDING PLANNER’ – for planning services.

However, in respect of goods, the use of ‘My’ may be acceptable as they are less likely to be personalised. Take the example ‘MY BOOK SHELF’. The shelf is only likely to be personalised by the user after purchase, with their unique selection of books, not be personalised by the producer of the furniture itself.

...”

51. Although in the current case it is the goods and not the services that are relevant, I find that dental hygiene goods can be tailored to suit the needs of an individual, meaning the opponent’s MY DENTIST (series) mark could be considered as falling within the realms of personalised descriptive words. However, the work manual is, of course, just a guide. Although I bear it in mind, it is not binding on me. In any case, these proceedings are not based on absolute grounds – this is a relative grounds opposition. However, the perception of the average consumer of the marks in question is an important factor, as is the role that elements may play within a mark, including whether a word(s) plays purely a descriptive or non-distinctive role.

52. I find that the average consumer will notice the relevance of the words “MY DENTIST” in relation to dental hygiene goods. “DENTIST”, in particular, is allusive, if not descriptive, of the goods at issue. The purpose of a trade mark is to distinguish the goods of one undertaking from those of another trader. This cannot be achieved if the average consumer cannot see past the descriptive message that the mark gives. It seems to me that the words “MY DENTIST” are at least close to failing to serve as an indication of trade origin of any one individual trader in relation to the goods at issue. With this in mind, and since an existing registered trade mark must be afforded some

distinctive character,<sup>7</sup> I find the earlier mark UK00003065413 to have a very low degree of distinctive character.

UK00003333764



53. The words “my skin frame your smile”, which are not descriptive for, or allusive of, the goods at issue, with the added stylisation affords the mark with an average degree of distinctive character.

UK00003060452

MY

54. The word “MY” is a very common dictionary word. It is a possessive determiner that can be used in front of any noun to show possession of that noun.<sup>8</sup> Using “MY” on any goods or services simply suggests that those goods or services belong to the user. Alternatively, some consumers will perceive the mark as the two separate letters “M” and “Y”. In either case, since an existing registered trade mark must be afforded some distinctive character,<sup>9</sup> I find the earlier mark to have a very low degree of distinctive character.

### **Likelihood of confusion**

55. The factors assessed so far have a degree of interdependency (*Canon*); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel*). However, there is no scientific formula to apply. It is a matter of

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<sup>7</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

<sup>8</sup> [www.dictionary.cambridge.org](http://www.dictionary.cambridge.org)

<sup>9</sup> *Formula One Licensing BV v OHIM*, Case C-196/11P

considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

56. Firstly, I am minded to deal with an issue that arose during the hearing. Mr Fiddes made several references to the opponent's "family of marks". As I explained to Mr Fiddes, a family of marks claim was not pleaded in the TM7, nor was any evidence filed in support of such a claim. In *Il Ponte Finanziaria SpA v OHIM*,<sup>10</sup> the CJEU stated, at paragraph 64:

"...Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market."

57. Without evidence, it is not possible for me to determine that the earlier marks relied upon are present on the market and, subsequently, that they form a family of marks. Consequently, I will not consider a family of marks argument in determining whether there is a likelihood of confusion.

58. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertaking being the same or related).

59. I am of the view that there are sufficient differences between the applied-for mark and all of the earlier marks relied upon to avoid them being mistakenly recalled as each other. Even for the marks I have found to be most similar to the applied-for mark, the highest degree of similarity is a medium degree of conceptual similarity (for mark 3065413) and a medium degree of aural similarity (for mark 3060452), otherwise the marks are only similar to a low degree. I have considered the interdependency of factors and that the goods are identical, but conclude that this does not offset the low degree of similarity between the marks. I have also found the marks 3065413 and

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<sup>10</sup> Case C-234/06

3060452 to have a very low degree of distinctive character, and the mark 3333764 only an average degree. The average consumer will also pay an average degree of attention to the purchase of the goods. Overall, I do not consider there to be a likelihood of direct confusion.

60. I go on now to consider indirect confusion. This was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>11</sup>

“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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

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

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

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<sup>11</sup> BL O/375/10

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

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

61. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>12</sup>

62. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common elements of the marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

63. I accept Mr Fiddes’ submission that the first (or only) word element in the respective marks is the word “MY”. As a general rule, the beginnings of word marks make more of an impression than the endings. However, this is not always the case.<sup>13</sup> The contested mark is not, of course, a word mark, but a composite mark in which the figurative elements will strike the user at the same time as the word elements. Additionally, whilst the general rule about the beginnings of word marks making more of an impact on consumers than the ends makes perfect sense when the mark is a word such as MUNDICOR,<sup>14</sup> it has less weight where the common word element is a very common word like “MY”.

64. Mr Fiddes submitted at the hearing that the opponent’s case is that the “common element” is the word “MY”, and is the reason why people would identify the identical (or very similar) goods and services with the opponent. My Fiddes further submitted

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<sup>12</sup> See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

<sup>13</sup> See, for example, the judgment of the General Court in *CureVac GmbH v OHIM*, case T-80-08

<sup>14</sup> To cite an example from the caselaw of the General Court: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

that the identical element (MY) used with associated terminology and a descriptive device element would lead to confusion. I pause here to note that this submission amounts to a claim to a very powerful monopoly in the use of MY followed by descriptive terms in marks for goods in class 3. As Arnold J. noted in *Whyte and Mackay*:<sup>15</sup>

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

65. I also bear in mind the guidance of Mr James Mellor QC, sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*:<sup>16</sup>

“81.4. Fourth, I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

66. I am not satisfied that any mark containing “MY” followed by a word associated with goods in class 3 would be regarded by the average consumer as originating from the same, or an economically linked, undertaking.

67. It is also necessary to give some weight to the elements of the applied-for mark which distinguish it from the earlier marks: the blue ‘lips’ device. The average consumer is likely to attach weight to this element in circumstances where the word elements of the mark are somewhat non-distinctive in respect of the relevant goods and are therefore unreliable, by themselves, to identify the specific trade source of the goods; the figurative difference of the device in the applied-for mark thus takes on a greater significance for the average consumer than it might otherwise.<sup>17</sup>

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<sup>15</sup> [2015] EWHC 1271 (Ch)

<sup>16</sup> BL O/547/17

<sup>17</sup> See *Nicoventures Holdings Limited v The London Vape Company Ltd*: [2017] EWHC 3393 (Ch)



68. Considering all the relevant factors, I do not find there to be a likelihood of indirect confusion.

## **CONCLUSION**

69. There is no likelihood of confusion. The opposition has failed and the application may proceed to registration.

## **COSTS**

70. As the applicant has been successful, it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, I award costs to the applicant on the following basis:

Considering the other side’s statement and preparing a counterstatement:	£200
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<b>Total:</b>	<b>£200</b>
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71. I order Integrated Dental Holdings Limited to pay EZGO Group Inc the sum of **£200**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of November 2019**

**Emily Venables**  
**For the Registrar**