

O/413/20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF
TRADE MARK APPLICATIONS NOS. 3369252 AND 3387255
BY MUNDARE LIMITED**

AND

**OPPOSITIONS THERETO UNDER NOS. 416175 AND 416501
BY MICYS COMPANY S.P.A**

BACKGROUND AND PLEADINGS

1. Mundare Limited (“the applicant”) applied to register trade marks 3369252 and 3387255. The relevant details of both these applications are provided below:

1. UK application number 3369252 (“the First Application”)



Filing date: 23 January 2019

Publication date: 01 February 2019

Class 3: *Baby care products; baby wipes; baby powders; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream.*

Class 5: *Baby foods; milk powder for babies; dietetic substances for babies; baby diapers; babies napkins; babies creams; dietetic preparations for children.*

Class 35: *Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; advisory and consultancy services relating to all of the aforesaid.*

2. UK application number 3387255 (“the Second Application”)

PURA

Filing date: 27 March 2019

Publication date: 05 April 2019

Class 3: *Baby care products (non-medicated); baby wipes; baby powders; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream.*

Class 5: *Baby foods; milk powder for babies; dietetic substances for babies; baby diapers; babies napkins; babies’ creams (medicated); dietetic preparations for children.*

Class 35: *Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, baby foods, milk powder for babies, dietetic substances for babies, baby diapers, babies napkins, babies creams, dietetic preparations for children; advisory and consultancy services relating to all of the aforesaid.*

2. On 1 May 2019 and 4 June 2019 respectively, Micys Company S.P.A (“the opponent”) opposed the applications. The grounds, which are the same for both oppositions, are based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies in both oppositions on its earlier EUTM 5487533 for the mark PUPA, which has a filing date of 21 November 2006 and a registration date of 08 October 2007. The mark is registered for a range of goods in various classes, but the opponent relies only on *soaps; perfumery and cosmetics* (in class 3).

3. The oppositions are directed against all of the goods in class 3 and some of the services in class 35 in the applications.

4. The opponent claims that there is a likelihood of confusion because the parties' respective marks are identical or similar, and the goods and services are identical or similar.

5. The applicant filed counterstatements denying the claims made and putting the opponent to proof of use of its earlier mark.

6. On 28 June 2019 the Registry confirmed that the proceedings were to be consolidated pursuant to Section 62(1)(g) of the Act.

7. Both parties filed evidence. The opponent is represented by Withers & Rogers LLP and the applicant is represented by HGF Limited. A hearing took place before me on 3 April 2020. The applicant was represented by Mr Lee Curtis. The opponent was represented by Ms Marisa Broughton.

PRELIMINARY ISSUE - Request to include additional services after the hearing

8. As can be seen from the specifications, with the exception of two bracketed words, i.e. *(non-medicated)*, which qualify the term "*Baby care products*" (class 3) in the Second Application, the opposed specifications in classes 3 and 35 are identical.

9. As I have said, the oppositions are not directed at all of the services in class 35 specified in the applications. In the opposition to the Second Application the opponent opposes the following services:

Class 35: *Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, babies creams; online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, babies creams; advisory and consultancy services relating to all of the aforesaid.*

10. In the opposition to the First Application the opponent opposes the same services, with the exception of *Retail services in relation to babies creams* and *online retail services in relation to babies creams*, which are not opposed. This was apparently due to a clerical error which was spotted by the opponent's representative after the hearing and was brought to my attention by an e-mail dated 15 July 2020. The e-mail stated that *"the opponent intended to oppose "retail services in relation to babies creams" and "online retail services in relation to babies creams" (hereafter referred to as "the Additional Services") as well and hereby request[ed] that the Additional Services [were] included within the scope of the opposition"*. The points were made that 1) the additional services were identical to other services which had been opposed, i.e. *retail services and online retail services in relation to baby care products*, and therefore the parties' arguments in respect of these services were equally applicable to the additional services; 2) the opponent included the additional services within the scope of the co-pending opposition to the Second Application and 3) in the event that the additional services were not admitted and the oppositions were successful, the opponent would issue invalidity proceedings.

11. I shall return to the opponent's request later.

The opponent's evidence in chief

12. The opponent's evidence in chief consists of a witness statement of Angelo Gatti, accompanied by seven exhibits (AG1-AG7). Mr Gatti is the President and founder of the opponent's company. From Mr Gatti's statement the following facts emerge:

- The opponent was founded in Milan in 1975 and has used the mark PUPA since that date. The opponent uses the mark PUPA in relation to cosmetics, skincare products, perfumery and toiletries, including soaps, deodorants and hair lotions;
- PUPA branded goods are sold in more than 70 countries worldwide including Italy, the UK, France, Poland and Germany. The goods are sold in stores and online through the opponent's website www.pupa.it, as well as through third

parties' websites, including lookfantastic.com, escentual.com and beautyexpert.com;

- Sale figures for PUPA branded products sold in the UK and in the EU are as follows:

	UK € in excess of	Rest of Europe € in excess of
2014	€30,000	€6,000,000
2015	€39,000	€58,000,000
2016	€159,000	€65,000,000
2017	€239,000	€66,000,000
2018	€181,000	€63,000,000
2019	€130,000	€61,000,000

- Expenses on marketing and advertising are as follows:

	Europe
2014	€6,382127
2015	€4,846365
2016	€4,669270
2017	€4,757598
2018	€4,473458
2019	€4,551216

- The opponent uses the mark PUPA on its Instagram and Facebook pages. It has 1.5 million followers;
- The opponent has received a number of awards including Beauty Astir Award Netherlands (2014), Grazia Netherlands (2015), Excellence of the Year TWOJ STYL Poland (2015), Best Beauty Buy Poland (2015) and Elle Beauty Awards Italy (2016).

13. In support of the witness statement, Mr Gatti submitted various exhibits giving evidence of: webpage print-outs of the opponent's website (in Italian)¹; examples of PUPA branded goods, including shower gels, face cleansers, makeup removers, anti-

¹ Exhibit AG1

perspirant creams, deodorants, make-up products, firming breast enhancer and anticellulite creams²; and webpage print-outs from third party's websites (dated 2015-2019) offering PUPA branded products for sale (with a price in sterling) under the following description of the brand:

Pupa Milano is an Italian brand that started its life in fashion cosmetics before evolving into one of the most exciting skincare treatment innovators in recent years.

They formulate cutting edge products to address the skincare concerns of both the face and the body, utilising innovative active ingredients that sculpt, shape and tone the skin effortlessly.

14. Mr Gatti provides a large number of invoices³ to customers in the EU, including the UK. The invoices, issued between 2014 and 2019, display the mark PUPA. Most of the referenced products are items of make-up.

The evidence also includes:

- Press clippings from 2014, 2016 and 2017 marketing Pupa branded products, including breast firming enhancer creams, fragrances and make-up products⁴;
- Screenshots from the opponent's Instagram and Facebook pages. The images show examples of PUPA branded products including face cleansers, make-up removers, make-up products, scented waters, shower gels, body oils, body creams, body milks and body scrubs⁵;
- Photographs of awards won by the opponent for its PUPA make-up products.

The applicant's evidence

15. The applicant's evidence consists of the witness statement of Suzan Ure. Ms Ure is a trainee trade mark attorney in the employ of HGF Limited, the applicant's representative. Ms Ure says that she gives evidence on the basis of facts and matters

² Exhibit AG2

³ Exhibit AG3

⁴ Exhibits AG4 and AG6

⁵ Exhibit AG5

within her knowledge or based on investigations she conducted on 10 October 2019. Ms Ure filed four documents, namely the following attachments:

- Exhibit SU1: consists of copies of online articles about the use of baby skincare products. They state that adult soaps (and similar products) can irritate baby skin and that *“the golden rule is to look for products that have been formulated specially for babies”*;
- Exhibit SU2: consists of webpage print-outs of various UK retailers’ websites showing that adult beauty products and baby products are sold under different categories;
- Exhibit SU3: consists of photographs from a number of physical retail stores demonstrating that baby care and baby food products are sold separately from soaps and cosmetic goods;
- Exhibit SU4: consists of an extract from the Cambridge English Dictionary showing the definition of the word PUPA as *“an insect in the stage of development after it has been a larva and before it becomes an adult, during which it is contained in and protected by a hard covering and does not move”*.

The opponent’s evidence in reply

16. In response to the applicant’s evidence, the opponent filed evidence in reply. This consists of the witness statement of Mary Louise Broughton accompanied by five exhibits (MLD1 – MLB5). Ms Broughton is a trade mark attorney in the employ of Withers & Rogers LLP, the opponent’s representative.

17. Ms Broughton states that *“adults frequently purchase products targeted at babies for their own use especially if, for example, they have sensitive skin or suffer from skin conditions such as eczema”*. In support of her statement, Ms Broughton filed:

- Exhibit MLB1: consists of a number on online articles which talk about the use of baby products for adult skincare and beauty routines. Examples include use of baby oil and baby wipes to remove make-up, use of baby nappy creams to moisturise and treat acne and use of baby talc to thicken eyelashes. According to Ms Broughton, this evidence attests “*the benefits adults can derive from using a multitude of baby products including baby wipes, baby shampoo and talcum powder*”;
- Exhibit MLB2: consists of extracts from Twitter, all intended to show comments from unidentifiable individuals which indicate that baby products are also used by adults;
- Exhibit MLB3: consists of a webpage print-out of www.boots.com showing that the section marked “baby and child” also contains “pregnancy and maternity” products;
- Exhibit MLB4: consists of webpage print-outs showing mother and baby care products sold under third party brands;
- Exhibit MLB5: consists of an extract from the Collins Online Dictionary showing that the word PUPA is rarely used in English.

18. Ms Broughton’s statement also contains criticisms of the applicant’s evidence as well as submissions. These are all intended to support the argument that baby products are sold alongside products which are targeted at pregnant women and that adults also purchase products targeted at babies and children for their own use.

DECISION

Section 5(2)(b)

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

“5. -(2) 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”.

20. The mark upon which the opponent relies qualifies as an earlier mark because it was applied for at an earlier date than the applicant's marks pursuant to Section 6 of the Act. The mark completed its registration process more than 5 years before the filing date of the applications in issue in these proceedings and it is subject to proof of use.

Proof of use

21. The relevant statutory provisions are as follows⁶:

“6A Raising of relative grounds in opposition proceedings in case of non-use:

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

⁶ As amended by “The 2018 Regulations” which came into force on 14 January 2019.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

[...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the

purposes of this section as if it were registered only in respect of those goods or services.”

22. Section 100 of the Act is also relevant. It reads:

“100. 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.”

23. The onus is upon the opponent to prove that the earlier mark has been put to genuine use within the EU during the relevant periods. The relevant periods in the oppositions at issue are 24 January 2014 to 23 January 2019 (in the opposition to the First Application) and 28 March 2014 to 27 March 2019 (in the opposition to the Second Application).

Genuine use: assessment

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].⁷


⁷ See also *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 and *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52

25. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. 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.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

26. In the five-year period 2014-2019, the opponent's turnover was €379 million (in the EU) and €588,000 (in the UK) under and by reference to the mark PUPA. The marketing and promotional efforts of the opponent have also been significant, with around €30 million being spent (in the EU) in the same period. Although the turnover figures are not apportioned among all the goods upon which the opponent relies, i.e. *soaps; perfumery and cosmetics*, the evidence includes a large number of invoices dated within the relevant periods, together with samples bearing the sign PUPA directly on the products. It is possible to see from the invoices that most of the goods sold are items of make-up, but there are also examples of other goods being sold. Further, the advertising and promotional material clearly indicates that the goods made available under the mark PUPA comprise goods other than items of make-up. Although the samples of labelling and the invoices show use of the mark PUPA in the stylised version  , the stylisation does not alter the distinctive character of the word mark⁸ and there are numerous examples of use of PUPA as a word mark.

27. At the hearing Ms Broughton asked me to ignore the evidence which concerned make-up products. She argued that, even disregarding that evidence, the opponent has made use of the mark in relation to, inter alia, “*shower gels, breast enhancer creams, anti-cellulite creams, moisturisers, body scrubs, body oils, toning oils and scented water*” and that such use constitutes genuine use in relation to the goods for which the mark is registered and upon which the opponent relies, i.e. *soaps; perfumery and cosmetics*.

28. Mr Curtis urged me not to take a relaxed approach to the assessment of genuine use. He argued that PUPA is a make-up brand and that if one leaves out the evidence relating to make-up, the conclusion is that proof of genuine use of the mark has not been furnished. He contended that *shower gels* and *soaps* are different categories of products and use of the mark on *shower gels* should not be taken to prove use in relation to *soaps*. Likewise, use in relation to *scented water* should not be taken to prove use in relation to *perfumery*.

⁸ *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

29. I have gone through the bundle of invoices filed by Mr Gatti. Whilst most of them cover purchases of make-up products (which Ms Broughton has asked me to disregard), there are several invoices listing other goods. These include: 10 invoices⁹ for the sale of a total of 8,451 units of breast enhancer cream (amounting to approximately €71,000); 7 invoices¹⁰ for the sale of 1,530 units of massage creams and anti-cellulite preparations including anti-cellulite creams, anti-cellulite mud and anti-cellulite concentrates (amounting to approximately €4,700); 8 invoices¹¹ for the sale of 1,488 units of salt scrub (amounting to approximately €6,500); 9 invoices¹² for the sale of 2,550 units of shower gel (amounting to approximately €6,200); 7 invoices¹³ for the sale of 1,815 units of scented water (amounting to approximately €5,200). The goods were sold to customers in the UK, Poland and Germany and the sales took place relatively continuously over a period of 5 years (which corresponds to the 5-year relevant periods).

30. Even if I accept that the invoices at issue constitute a sample of all the invoices, selected at random, there is no way to ascertain the total level of sale per category of goods. Nevertheless, I find that whilst the sales evidenced by the invoices are not particularly high for the products at issue, they are sufficient to establish that there was real commercial exploitation of the mark in the course of trade, taking into account the duration and frequency of the use. Further, the opponent has spent a significant sum of money, i.e. over €30 million, in promoting the mark in the EU during the relevant periods and the clippings and pictures of labels indicate that the goods were present on the market in an actual and consistent manner.

31. Consequently, my conclusion is that, **even disregarding the evidence relating to make-up**, the opponent has established genuine use of the earlier mark.

⁹ Invoices dated 4.02.2014; 4.12.2015; 26.01.2016; 9.02.2016; 30.01.2017; 15.12.2017; 21.03.2018; 26.04.2018; 5.10.2018; 30.11.2018; 30.01.2019

¹⁰ Invoices dated 4.12.2015; 2.11.2016; 15.12.2017; 21.03.2018; 5.10.2018; 30.11.2018;

¹¹ Invoices dated 4.12.2014; 18.05.2015; 9.02.2016; 2.11.2016; 30.01.2017; 15.12.2017; 21.03.2018; 30.11.2018; 30.01.2019

¹² Invoices dated 18.05.2015; 28.05.2015; 9.02.2016; 16.03.2017; 15.12.2017; 2.11.2016; 321.03.2018; 30.01.2019; 19.03.2019

¹³ Invoices dated 28.04.2015; 18.05.2015; 9.02.2016; 2.11.2016; 15.12.2017; 31.03.2018; 30.11.2018

Fair specification

32. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

33. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

34. In respect of the opponent's *cosmetics*, I consider that, once the evidence relating to make-up is left out of the picture, the sales of breast enhancer creams, massage creams and anti-cellulite creams do not entitle the opponent to rely on the registered term *cosmetics*, this would be too wide a term. In my view, the average consumer would describe the use made as limited to a sub-category of *cosmetics*, namely *body creams for cosmetic use*¹⁴.

35. In relation to the sale of *shower gels*, Mr Curtis wrote to me on 6 April 2020 (after the hearing) asking for an additional case¹⁵ to be considered in support of the claim that soap does not encompass shower gel. Ms Broughton objected, first, because the submissions was late and, second, because, she maintained, shower gels and soaps are identical goods. She also filed a dictionary definition of the word "shower gel", which, as Mr Curtis correctly pointed out, is late evidence. I have considered the

¹⁴ Some of the invoices refer to 'moisturizing tinted cream', but I consider that type of product fall within the category of make-up products

¹⁵ BL-O-722-18

additional material filed, but I do not think it is necessary for me to deal with it. First, regardless of the case mentioned by Mr Curtis, I am of the opinion that soaps and shower gels are not identical, simply because the term *soaps* is a broad term which includes not only goods for personal care but also goods aimed at washing and cleaning objects or laundry for domestic use¹⁶. With regards to whether use of the mark on shower gel would be use in relation to a sub-category of the goods to which the opponent's registration relates, I think the question should be answered in the affirmative, and I come to the same conclusion as Ms Broughton, but in a different way. Given that the opponent's shower gels are marketed, inter alia, on the basis that they have a cosmetic purpose, e.g. anti-water retention properties¹⁷, revitalising the skin and restoring hydration¹⁸, and include ingredients designed to improve the appearance of the body, they would fall within (and are a sub-category of) the registered term *cosmetics*¹⁹, similar to *salt scrubs*²⁰, which are also cosmetic preparations for the body. Albeit the sales of shower gels and salt scrubs (as extrapolated from the invoices) are modest, taking into account the marketing efforts and the degree of diversification of the opponent's cosmetic products, they are sufficient to establish that the mark has been genuinely used for those goods.

36. As regards the sale of scented water, Ms Broughton conceded that these goods do not provide the opponent with a strongest case, compared to the other goods for which use has been claimed.

37. Taking of all the above into account, a fair description of the goods offered under the mark is:

Class 3: *body creams for cosmetic use; body scrubs [cosmetics]; cosmetics products for the shower, namely shower gels.*

¹⁶ *AVEDA CORPORATION v DABUR INDIA LIMITED*, [2013] EWHC 589 (Ch)

¹⁷ Exhibit AG2, page 20

¹⁸ Exhibit AG5, pages 195 and 197

¹⁹ The TM Class database also contains the term *cosmetics products for the shower* and *cosmetic preparations for bath and shower*. This corroborates the view that shower gels can also be classified as cosmetics.

²⁰ TM Class contains the term *Body scrub [cosmetic]*

Section 5(2) – case law

38. 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.

(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 impression 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 greater 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

39. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

40. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

41. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

42. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated:

“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”.

43. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

44. The goods and services to be compared are as follows:

The applicant’s goods and services	The opponent’s goods (after proof of use)
<p>The First Application</p> <p>Class 3: <i>Baby care products; baby wipes; baby powders; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream.</i></p> <p>Class 35: <i>Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream; online retail services in relation to baby care</i></p>	<p>Class 3: <i>body creams for cosmetic use; body scrubs [cosmetics]; cosmetics products for the shower, namely shower gels.</i></p>

products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream; advisory and consultancy services relating to all of the aforesaid.

The Second Application

Class 3: *Baby care products (non-medicated); baby wipes; baby powders; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream.*

Class 35: *Retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, babies creams; online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, babies creams; advisory and consultancy services relating to all of the aforesaid.*

45. The main points of Ms Broughton's submissions can be put thus: namely:

- 1) that the applicant's baby products and one of the opponent's most popular products, i.e. breast enhancer cream, are both aimed at new mothers;

- 2) that baby products can be used by adults and are also sold alongside and in conjunction with products aimed at adults, especially new and expectant mothers;
- 3) that the limitation in the applicant's specification to products specifically designed for babies does not prevent the application of the principle outlined in *Meric*. In this connection, Ms Broughton said that the opponent's *shower gels* are identical to the contested *baby care products* and *baby bubble bath*, that the contested *baby care products* and *baby lotion* are identical to the opponent's *body creams* and that *baby oil; baby wipes; baby powders; baby shampoo; baby conditioner and baby sun cream* are similar goods.

46. Mr Curtis reiterated at the hearing that the goods involved are not identical and that the goods and trade channels are different.

47. I reject Ms Broughton's argument that the goods are identical. To begin with, shower gels are by definition goods designed for use in the shower. They are unlikely to be used when washing a baby as the cleaning routine for very young children normally involves the use of bath (not shower) products. Further, there is no evidence that baby care products include shower gels or that it is particularly recommended to use shower gels for infants. In this connection, Ms Broughton referred in her skeleton arguments to exhibit MLB4 (at pages 104 and 115) arguing that it provides "*examples of [third party] baby and adult shower gels*". However, the evidence at page 115 shows a "*Mother Bath and Shower Gel*" which is described as a product designed for expecting mothers, not for babies. The evidence at page 104 shows one example of "*Baby Bee Shampoo and Body Wash*". I am not persuaded by this evidence either: first it is not clear whether body wash and shower gel are the same thing, second, it is only one example and does not establish that shower gel is a type of baby care product. Consequently, the goods are not identical. Likewise, the opponent's *body creams* are cosmetic products intended to improve the aesthetics of the body and cannot be assimilated to the applicant's baby care products. I will now go on to consider the question of whether the goods are similar.

Class 3

48. **Baby wipes.** *Baby wipes* are disposable tissues intended for use in cleaning children, especially during nappy changes²¹. The closest clash I can see is with the earlier *cosmetics products for the shower, namely shower gels*. Although baby wipes can also be used by adults for quickly cleaning their skin, for example, when travelling, and may serve a purpose similar to that of the opponent's goods, i.e. cleaning, the goods are not interchangeable and are not in competition with each other; their uses, physical nature and methods of use are different. Baby wipes are not specifically intended to be used with shower gels and there is nothing to suggest that baby wipes and shower gels are often sold under the same mark, so there is no complementarity involved. As regards the channels of trade, the applicant's evidence confirms my experience that items of baby care are sold separately from cosmetic and toiletry products (where the opponent's goods would be placed) and are not always displayed on the same shelf or side by side. In this connection, although it was suggested that the earlier *shower gels* could include goods for use by expecting mothers²² (which would be sold together with the applicant's baby products), I consider that such argument is precluded by the opponent's own evidence; that evidence, clearly shows that the opponent's target market is cosmetics, and there is no suggestion that the applicant sells (or intends to sell) "mother and baby care products". Finally, I do not understand how Ms Broughton's evidence that baby care products are also purchased by adults for their own use may create any similarity with the opponent's goods, over and above the fact that their users may be the same (which is, *per se*, too general a fact to create a similarity in a trade mark sense). **Overall, I am not satisfied that there is any similarity between the goods in issue.** As some degree of similarity is required for there to be a likelihood of confusion, the opposition must fail in respect of these goods²³.

49. **Baby powders.** *Baby powder* is a product similar to talcum powder and used on baby skin to help it stay dry. **For reasons similar to those outlined in the preceding paragraph, I consider these goods to be dissimilar.** As some degree of similarity

²¹ See *Oxford English Dictionary*

²² See Exhibit MLB4

²³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

is required for there to be a likelihood of confusion, the opposition must fail in respect of these goods²⁴.

50. ***Baby shampoo; baby conditioner.*** *Baby shampoo* and *baby conditioner* are products specially formulated for use on babies' hair. These goods as well as the opponent's *cosmetics products for the shower, namely shower gels*, serve the same purposes of personal hygiene. However, even accepting that some adults may use baby products, 1) the average consumer would not use baby shampoo (or baby conditioner) as a shower gel (especially if one considers that the earlier *shower gels* have some characteristics of cosmetics) or vice versa, and 2) it has not been demonstrated that consumers generally expect producers of shower gels to also to sell baby shampoo and conditioner under the same mark or vice versa. All in all, it seems to me that whilst the physical nature and purpose of the goods is similar, they have different uses, are unlikely to be sold in close proximity to each other and are neither competitive nor complementary. **I consider the goods to be similar to a medium degree.**

51. ***Baby bubble bath.*** *Baby bubble bath* is a bath preparation used for bathing babies and infants. Similarly to what I said in the preceding paragraph, the goods are used for personal hygiene and have a similar purpose. Even if the similarity is slightly more pronounced here because the goods are meant to be used to wash the body, they still have different uses and are still unlikely to be sold in close proximity to each other. **I consider the goods to be similar to a medium degree.**

52. ***Baby suncream.*** *Baby suncream* is used on babies and infants to protect them from the sun. The closest clash I can see is with the opponent's *body creams for cosmetic use*. The competing goods have the same physical nature and method of use. However, their specific purpose is different, the earlier goods being intended to improve the appearance of the body, the later goods being intended to protect baby skin from the sun. Finally, the goods are neither competitive nor complementary and are unlikely to be sold in close proximity to each other. **I consider the goods to be similar to a low degree.**

²⁴ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

53. ***Baby oil; baby lotion.*** *Baby oil* and *baby lotion* are products used to moisturize and clean baby skin. The closest clash I can see is with the opponent's *body creams for cosmetic use*. The goods have a similar physical nature and method of use, but they have a different intended use. The goods are not complementary, although I accept that there may be an element of competition between them, to the extent that baby oils could be used by adults as a massage oil to improve skin's appearance. Whilst the opponent's breast firming cream is marketed as addressing, amongst others, problems related pregnancy and breastfeeding (as well as weight loss and the ageing process)²⁵, the evidence does not establish that it is marketed as a product specially designed for pregnant women and new mothers, so it would not be found in close proximity to the opponent's goods. **I consider the goods to be similar to a medium degree.**

54. ***Baby care products*** and ***Baby care products (non-medicated)***. The goods in relation to which I found the highest degree of similarity, i.e. medium, are baby bubble bath, baby oil and baby lotion. To the extent that *baby care products* and *baby care products (non-medicated)* encompass *baby bubble bath, baby oil and baby lotion*, **they are also similar to a medium degree.**

Class 35

55. Ms Broughton argued that the contested retail services are similar to a low degree to the opponent's goods.

56. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, 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.

57. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

²⁵ Exhibit AG4

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

58. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*²⁶, and *Assembled Investments (Proprietary) Ltd v. OHIM*²⁷, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*²⁸, 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;

²⁶ Case C-411/13P

²⁷ Case T-105/05, at paragraphs [30] to [35] of the judgment

²⁸ Case C-398/07P

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).

59. The goods that are the subject of the applicant's *retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, babies creams; online retail services in relation to baby care products, baby wipes, baby powders, baby oil, baby shampoo, baby conditioner, baby bubble bath, baby lotion, baby suncream, babies creams*; are not identical to the goods in relation to which the opponent has established genuine use, i.e. *body creams for cosmetic use; body scrubs [cosmetics]; cosmetics products for the shower, namely shower gels*. According to the above case law, this does not necessarily mean that the goods and services at issue are dissimilar. However, the degree of similarity between the opponent's goods and the goods to which the applicant's retail services are associated, i.e. low and medium, is, in my view, not sufficiently pronounced to conceive the existence of a degree of similarity between the goods and services. In her skeleton argument Ms Broughton referred me to a case²⁹ whereby the GC found that the BoA had erred in finding that the degree of similarity between retail services of goods identical to the same goods covered by the earlier mark was only low. First the case is not on all fours with the comparison at issue, insofar as the goods at issue in these proceedings are not identical, but only similar to a low and medium degree; and second, that judgment does not imply that the goods and services at issue are similar. As regards the contested *advisory and consultancy services relating to all of the aforesaid*, I understand these services to be business to business services, used by other types of providers of retail services to improve their own businesses, so I cannot detect any similarity between these services and the opponent's goods. **Consequently, my conclusion is that there is no similarity between the applicant's services in class 35 and the opponent's goods.** As some

²⁹ *Grupo Osborne, SA v OHIM*, Case T-390/16

degree of similarity is required for there to be a likelihood of confusion, the opposition must fail in respect of these services³⁰. Accordingly, I do not need to deal with the opponent's request to amend the pleadings as set out at paragraph 10.

Average consumer and the nature of the purchasing act

60. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

61. Mr Curtis did not make any specific submissions on the average consumer or the nature of the purchasing process for the goods in issue. Ms Broughton submitted that the purchasing process will primarily be a visual one and that the goods will likely be selected with a level of attention varying from low to average.

62. The average consumer for the goods at issue, namely *baby care products; baby care products (non-medicated); baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion; baby suncream*, include parents and those caring for babies and young children. I agree with Ms Broughton that the goods will be selected visually from the shelves of a retail outlet or from an online equivalent, but not to the extent that aural considerations can be ignored. Although in general, consumers are

³⁰ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA


particularly attentive when selecting products for babies, the goods at issue are still relatively commonplace goods which are bought quite regularly and have a moderate price. Consequently, the degree of attention of the average consumer will be average.

Comparison of the marks

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

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

64. 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 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. The respective trade marks are shown below:

The applicant's marks	The opponent's mark
 <p data-bbox="204 683 512 719">(the First Application)</p> <p data-bbox="204 792 296 826">PURA</p> <p data-bbox="204 846 560 882">(the Second Application)</p>	<p data-bbox="810 304 900 338">PUPA</p>

Comparison between the First Application and the opponent's mark

65. The opponent's mark consists of the single word 'PUPA' and it is, therefore, self-evidently the dominant and distinctive element of the mark.

66. The First Application consists of the words 'pura', 'one pull, one wipe'. The word 'pura' is written in a dark grey cursive font and is set out in a white circle, in the middle of the mark. The white circle itself is surrounded by two light grey outer circles, the larger of which is interrupted at two diagonal points. The word 'pura' and the circular elements of the mark are incorporated within a grey square. The grey square contains two small rings on the top hand side and is, itself, surrounded by a white square within which the words 'one pull, one wipe' appear in very small lower-case characters in the bottom part of the mark. All of these elements are then contained within a light grey square frame.

67. Where a mark is composed of word and figurative elements the former are, in principle, more distinctive than the latter. In this case 1) the figurative elements of the mark are not particularly fanciful; 2) the word 'pura' occupies a prominent position in the mark due to the use of large and stylised letters; 3) the term 'pura' is not a dictionary word and is inherently the most distinctive word element of the mark; 4) the

expression 'one pull, one wipe' is less distinctive than the word 'pura' taking into account its position and smaller size. In connection to (4), although the word 'pura' is likely to be seen and remembered as the main brand and the expression 'one pull, one wipe' is likely to be understood as secondary element, the average consumer is unlikely to perceive the latter as descriptive in relation to the goods at issue, namely *baby care products; baby oil; baby shampoo; baby conditioner; baby bubble bath; baby lotion and baby suncream*. That would be correct in relation to baby wipes, but I found that baby wipes are dissimilar to the earlier goods. Overall, I consider that the word 'pura' is the most distinctive and dominant element of the mark, with the figurative elements and the words 'one pull, one wipe' contributing to the overall impression to a lesser extent.

Visual similarity

68. Mr Curtis argued that the marks are visually different. Although he accepted that there is only one letter difference between 'pura' and 'PUPA', he argued that *"that is significant from a visual point of view given the fact both [marks] are [short marks]"*. Ms Broughton said that there is a moderate degree of visual similarity between the marks owing to the presence of the word 'pura' in the applied for mark, which is similar to the word 'PUPA' in the opponent's mark.

69. The words 'pura' and 'PUPA' coincide in the first, second and fourth letter, but differ in the third letter, which is a 'r' in the applied for mark and a 'P' in the opponent's mark. Further, the presence of the graphic elements (including the gradation of colour) and the expression 'one pull, one wipe' in the applied for mark means that it differs significantly from the earlier mark, which consists solely of the word 'PUPA'. In my view, the combination of all of the verbal and figurative elements in the applicant's mark, give the applied for mark a different overall impression. Based on their overall impression, **I find that the marks are visually different**. Even considering that the word 'PUPA' might be presented using lower-case letters³¹, it would not increase materially the overall similarity between the marks, given my finding that the visual

³¹ *Yango Trade Mark*, BL-420/18

dissimilarity of the marks at issue is not based primarily on the stylised font used to present the word element 'pura'.

Aural similarity

70. Ms Broughton said that if the strapline 'one pull, one wipe' in the applied for mark is articulated, the comparison being between 'pura one pull, one wipe' on the one hand, and 'PUPA', on the other, the marks are phonetically similar to a low degree. She also noted that since the dominant element of the mark is the word 'pura', the words 'one pull, one wipe' are unlikely to be spoken, in which case, she said, the marks would be phonetically similar to a moderate degree.

71. Mr Curtis said that the marks are phonetically different. He stated: *"The Opponent's [mark] and the Applicant's [marks] sound different. The 'pu' element is lost within the pronunciation of 'pura', whereas it is emphasised in PUPA. The 'pa' element also is clearly heard in PUPA, which does not exist at all in PURA. The respective [marks] have different syllable structures, with the [mark] forming the subject of [the First Application] being more complex with the inclusion of the additional word 'one pull, one wipe'".*

72. As the words 'one pull, one wipe' will not be understood as descriptive for the goods in question, it is likely that they will be remembered and spoken, in which case **the marks are aurally similar to a low degree**. Alternatively, if the applied for mark is referred to as, simply, 'pura', I agree with Ms Broughton that the marks are similar to a moderate (medium) degree. Neither party filed evidence about how the marks are pronounced. In my view, the most likely pronunciation of 'pura' will be PURE-AH. 'PUPA' is an Italian brand and although Mr Curtis has argued that the word 'PUPA' is an English word which describes an insect, I think that most consumers will not be familiar with it (or its meaning). Since the word 'PUPA' will be seen as invented, there is no conventional pronunciation. Although it is likely that the average consumer will attempt to articulate 'PUPA' in a number of ways, the most likely pronunciation is, in my view, PYOO-PAE ('pyoo' being pronounced like pupil) or as PUHP-PAE ('puhp' being pronounced like pup).

Conceptual similarity

73. Mr Curtis submitted that 'pura' strongly alludes to the English word 'pure' and that the average consumer will come to recognise the concept of purity in the word 'pura'. Ms Broughton submitted that the average consumer will not attribute any meaning to either 'PUPA' or 'pura'.

74. I agree with Mr Curtis. Despite being an invented word, 'pura' is so similar to the common English word 'pure' that is likely to be assimilated to it. The more so, since 'pura' is also the phonetic equivalent of the comparative form 'purer'. Further, the nature of the goods in relation to which the mark is used, reinforces the perception of the word 'pura' as referring to the concept of purity, because there is a symbolic association between baby care products and the notion of goods which are pure, in the sense that are "*clean and free from harmful substances*³²". In addition, the figurative elements of the mark evoke the image of drops and waves that propagate outside an expanding circle of fluid; this is likely to trigger the concept of water, making the association between the word 'pura' and the concept of 'purity' even more apparent. Finally, some consumers might also perceive a link between the concept of water conveyed by the figurative elements of the mark and the strapline 'one pull, one wipe' to the extent that wipes are products impregnated with water. With regard to the opponent's mark, I have already said that the word 'PUPA' will not be recognised as having a specific meaning by the average consumer in the UK. **The marks are conceptually different.**

Comparison between the opponent's mark and the Second Application

75. The applicant's mark consists of the single word 'PURA' and it is, therefore, self-evidently the dominant and distinctive element of the mark.

³² See *Collins Online English Dictionary*

Visual similarity

76. From a visual perspective, the marks are of identical length, each is made up of four letters with three of those letters being shared in the same order. The only difference is in the third letter of the marks, which is a 'R' in the application and a 'P' in the opponent's mark. Even considering that 'PURA' and 'PUPA' are both short words and it is often said that small differences are more noticeable when they occur in short words, **the marks are visually similar to a high degree.**

Aural similarity

77. I have already said that **the words 'PURA' and 'PUPA' are aurally similar to a medium degree.**

Conceptual similarity

78. Similarly to my conclusion at paragraph 74, when looked at through the eyes of the average consumer of baby care products, I find that the applicant's mark will be readily assimilated to the word 'pure' even in the absence of any other elements in the mark, with the result that the impact of the 'R' in the applicant's mark is not lost in the overall impression of the respective marks. **The marks are conceptually different.**

Distinctive character of the earlier trade mark

79. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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)."

80. In her skeleton arguments, Ms Broughton submitted that the earlier mark is of medium/high degree of distinctiveness. She made no reference to the mark having acquired enhanced distinctiveness because of the use made. Whilst there have been some sales in the UK, the quantum of use demonstrated is clearly insufficient to show that the mark has acquired an enhanced level of distinctive character through use in the UK.

81. The earlier mark consists of the single word PUPA. As I have already said, the UK public is likely to perceived PUPA as an invented word with no meaning and, as such, it has a high degree of inherent distinctive character.

Likelihood of confusion

82. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between

marks and must instead rely upon the imperfect picture of them he has retained in his mind.

83. Confusion can be direct or indirect³³. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertaking being the same or related.

84. I have found the parties' goods to vary from dissimilar to similar to a medium degree. I have identified the average consumer to be a parent and those caring for babies and young children, who will purchase the goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the earlier mark to have a high degree of inherent distinctive character.

85. I have found the First Application and the opponent's mark to be visually different, aurally similar to (at best) a medium degree and conceptually different. Bearing these factors in mind, I find that there is no possibility of direct confusion. The medium degree of aural similarity is, on balance, offset by the overall impression of visual dissimilarity, particularly taking into account that the goods will be selected visually. As regards indirect confusion, even if the verbal elements 'pura' and 'PUPA' are, in themselves, similar to a high degree, the presence of the figurative elements and the words 'one pull, one wipe' must also be taken into account, together with the nature of the goods in the context of which the applicant's mark will be used - which, I have said, will reinforce the perception of 'pura' as a word linked to the concept of purity – and the degree of similarity with the opponent's goods. In such circumstances, even factoring in imperfect recollection, I think it is highly unlikely that the average consumer will misremember the earlier mark 'PUPA' and confuse it with the element 'pura' in the applicant's mark, so that to conclude that there is a connection in the course of trade.

There is no likelihood of confusion.

³³ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

86. Moving on to the other mark, I have found the Second Application and the opponent's mark to be visually similar to a high degree, aurally similar to a medium degree and conceptually different. Notwithstanding the existence of a high degree of visual similarity between the marks PURA and PUPA, one has to consider the degree of similarity of the goods involved, as well as the conceptual associations that the use of the marks on the relevant goods is likely to trigger. In this connection, I have found that even in the absence of any other elements in the applicant's mark, when the mark PURA is encountered in the context of on baby care products, it will bring to mind the word 'pure' and the concept of purity, whereas the earlier mark PUPA will be perceived by most consumers as an invented word with no meaning. According to the case-law, conceptual differences between two signs are capable of counteracting visual and phonetic similarities between them if at least one of those signs has a clear and specific meaning for the relevant public, so that that public is capable of grasping it immediately³⁴. In my view that is the case here. The differences in the goods and the conceptual perception of the applicant's mark will reinforce the impact created by the difference in one letter in the middle of the mark. I believe that that impact is sufficient to avoid direct confusion by imperfect recollection of the earlier mark. Having found that the average consumer will not directly confuse the marks, I cannot see how there can be any indirect confusion. **There is no likelihood of confusion.**

CONCLUSION

87. The oppositions have failed, and the applicant's marks may proceed to registration.

COSTS

88. The applicant has been successful and is entitled to a contribution towards its costs. I assess these as follows:

£400 towards the cost of completing and filing the defences;

£500 towards the cost of filing evidence and considering the other party's evidence;

£700 towards the cost of the hearing, including the preparation of a skeleton argument.

³⁴ *Ruiz-Picasso and Others v OHIM*, C-361/04 P, EU:C:2006:25, paragraph 20

89. I order Micys Company S.P.A to pay Mundare Limited the sum of £1,600. This to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 1st day of September 2020

T Perks

For the Registrar,

the Comptroller-General