

O/614/22

TRADE MARKS ACT 1994

**CONSOLIDATED**  
**PROCEEDINGS**

IN THE MATTER OF APPLICATION NO. UK00003415984  
BY ALEXANDER ROSS HOLDINGS LIMITED  
TO REGISTER THE FOLLOWING MARK:

TRUE TO NATURE

true to nature

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. OP000423051  
BY THE BURT'S BEES PRODUCTS COMPANY

AND

IN THE MATTER OF APPLICATION NO. UK00003470610  
BY THE BURT'S BEES PRODUCTS COMPANY  
TO REGISTER THE FOLLOWING MARK:

TRUE TO NATURE

IN CLASSES 3 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. OP000423310

AND

IN THE MATTER OF APPLICATION NO. UK00003550315  
BY ALEXANDER ROSS HOLDINGS LIMITED  
TO REGISTER THE FOLLOWING MARK:

SCOTTISH FINE SOAPS TRUE TO NATURE

SCOTTISH FINE SOAPS

true to nature

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO  
UNDER OP000425014

## Background and pleadings

Lead case: OP000423051

1. On 23 July 2019, Alexander Ross Holdings Limited (referred to in these consolidated proceedings as “Party B”) applied to register the trade mark shown below (a series of two) - No. UK00003415984 - and the application was published for opposition purposes on 6 November 2020.

TRUE TO NATURE

true to nature

2. The registration is sought for the following goods:

Class 3      Non-medicated toilet preparations; hand wash; face wash; body wash; soap; bath soap; clarifying soap; liquid soap; soap petals; bath preparations; bath elixir; bath salts; bath fizzers; bath powder; bath jelly; bath essence; bathing milk; shower preparations; bath gel; shower gel; preparations for the care of the skin, face, scalp and body; moisturiser; body lotion; body butter; body milk; skin care preparations; body fudge; hand care products; hand and nail cream; oils, creams and lotions for the skin; foot lotion; perfumery; perfumes; fragrances; toilet water; aftershave; cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos; hair shampoo; body shampoo; conditioners; hair lotions; hair colourants; hair styling products; dentifrices; preparations for the care of the mouth and teeth; shaving preparations; pre-shave and aftershave preparations; sun-tanning and sun protection preparations; self-tanning preparations; cosmetics; make-up and make-up removing preparations; cleansers; lip care

preparations; talcum powder; cotton wool; cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks; face masks; facial packs; washing preparations; washing liquids; washing creams; washing lotions; room fragrances; room fragrancing products and preparations; washroom products; washroom hand soap; washroom hand wash; washroom liquid soap; washroom moisturiser; hand cleaning preparations; hand wash for washroom soap dispensers; substances for laundry use; bleaching preparations; cleaning, polishing, scouring and abrasive preparations.

3. The Burt's Bees Products Company (referred to in these consolidated proceedings as "Party A") opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application and is reliant upon the trade mark and the goods detailed below.
4. UK0003399422, filed on 15 May 2019, registered on 13 March 2020.

## BURT'S BEES TRUE TO NATURE

Class 3      Non-medicated toiletry preparations; cosmetic preparations; products and preparations for the face, skin, hair, body and nails; cleaning preparations; bath preparations; lip balms; creams, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and conditioners; perfumes, fragrances, deodorants; shaving preparations; dentifrices; non-medicated balm for

soothing itching, swelling and bruises on babies; non-medicated diaper rash ointments and lotions; baby wipes; baby powder.

5. In its Form TM7 and an accompanying statement of grounds, Party A argues that Party B's mark is similar to its earlier mark and that the competing goods are identical or similar.
6. Party B filed a Form TM8 and a counterstatement denying the claims made.

Second case: OP000423310

7. On 27 February 2020, Party A applied to register the trade mark shown below - No. UK00003470610 - and the application was published for opposition purposes on 20 November 2020.

## TRUE TO NATURE

8. The registration is sought for the following goods and services:

Class 3      Non-medicated toiletry preparations; cosmetic preparations; products and preparations for the face, skin, hair, body and nails; cleaning preparations; bath preparations; lip balms; creams, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and conditioners; perfumes, fragrances, deodorants; shaving preparations; dentifrices; non-medicated balm for soothing itching, swelling and bruises on babies; non-medicated diaper rash ointments and lotions; baby wipes; baby powder.

Class 35      Retail services connected with the sale of medicated and non-medicated preparations for hair, scalp, skin and nails; retail

services connected with the sale of medicated and non-medicated skin care preparations for the face, skin, hair, body and nails; retail services connected with the sale of medicated and non-medicated sunscreen, sun protection, sun care and after sun preparations; retail services connected with the sale of non-medicated toiletry preparations and cosmetics; retail services connected with the sale of medicated and non-medicated lip balms and lip glosses; retail services connected with the sale of medicated and non-medicated soaps, shampoos and conditioners; retail services connected with the sale of perfumes, fragrances, deodorants, body sprays, dentifrices and shaving preparations; retail services connected with the sale of medicated acne preparations and sanitiser lotions; retail services connected with the sale of non-medicated balms, diaper rash ointments and lotions, baby wipes and baby powder.

9. Party B opposes the trade mark on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods and services in the application and is reliant upon the trade mark (a series of two) and the goods detailed below.

10.No. UK00003415984, applied for on 23 July 2019 and published for opposition purposes on 6 November 2020.

**TRUE TO NATURE**

true to nature

Class 3      Non-medicated toilet preparations; hand wash; face wash; body wash; soap; bath soap; clarifying soap; liquid soap; soap petals; bath preparations; bath elixir; bath salts; bath fizzers; bath powder; bath jelly; bath essence; bathing milk; shower preparations; bath gel; shower gel; preparations for the care of

the skin, face, scalp and body; moisturiser; body lotion; body butter; body milk; skin care preparations; body fudge; hand care products; hand and nail cream; oils, creams and lotions for the skin; foot lotion; perfumery; perfumes; fragrances; toilet water; aftershave; cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos; hair shampoo; body shampoo; conditioners; hair lotions; hair colourants; hair styling products; dentifrices; preparations for the care of the mouth and teeth; shaving preparations; pre-shave and aftershave preparations; sun-tanning and sun protection preparations; self-tanning preparations; cosmetics; make-up and make-up removing preparations; cleansers; lip care preparations; talcum powder; cotton wool; cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks; face masks; facial packs; washing preparations; washing liquids; washing creams; washing lotions; room fragrances; room fragrancing products and preparations; washroom products; washroom hand soap; washroom hand wash; washroom liquid soap; washroom moisturiser; hand cleaning preparations; hand wash for washroom soap dispensers; substances for laundry use; bleaching preparations; cleaning, polishing, scouring and abrasive preparations.

11. In its Form TM7 and accompanying statement of grounds, Party B argues that Party A's mark is identical and for identical goods or services, or it is identical and for similar goods or services, or it is similar and for identical or similar goods or services.

12. Party A filed a Form TM8 and a counterstatement denying the claims made.

Third case: OP000425014

13. On 30 October 2020, Party B applied to register the trade mark shown below (a series of two) - No. UK00003550315 - and the application was published for opposition purposes on 19 March 2021.

SCOTTISH FINE SOAPS TRUE TO NATURE

SCOTTISH FINE SOAPS

true to nature

14. Registration is sought for the following goods:

Class 3      Non-medicated toilet preparations; hand wash; face wash; body wash; soap; bath soap; clarifying soap; liquid soap; soap petals; bath preparations; bath elixir; bath salts; bath fizzers; bath powder; bath jelly; bath essence; bathing milk; shower preparations; bath gel; shower gel; preparations for the care of the skin, face, scalp and body; moisturiser; body lotion; body butter; body milk; skin care preparations; body fudge; hand care products; hand and nail cream; oils, creams and lotions for the skin; foot lotion; perfumery; perfumes; fragrances; toilet water; aftershave; cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos; hair shampoo; body shampoo; conditioners; hair lotions; hair colourants; hair styling products; dentifrices; preparations for the care of the mouth and teeth; shaving preparations; pre-shave and aftershave preparations; sun-tanning and sun protection preparations; self-tanning preparations; cosmetics; make-up and make-up removing preparations; cleansers; lip care

preparations; talcum powder; cotton wool; cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks; face masks; facial packs; washing preparations; washing liquids; washing creams; washing lotions; room fragrances; room fragrancing products and preparations; washroom products; washroom hand soap; washroom hand wash; washroom liquid soap; washroom moisturiser; hand cleaning preparations; hand wash for washroom soap dispensers; substances for laundry use; bleaching preparations; cleaning, polishing, scouring and abrasive preparations.

15. Party A opposes the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all of the goods in the application and is reliant upon the trade mark UK0003399422, which is the same mark as set out at paragraph 4 above.

16. In its Form TM7 and an accompanying statement of grounds, Party A argues that Party B’s mark is similar to its earlier mark and that the competing goods are identical or similar.

17. Party B filed a Form TM8 and a counterstatement denying the claims made.

#### The consolidated proceedings

18. On 3 June 2021, cases OP000423051 and OP000423310 were joined together in consolidated proceedings. On 12 August 2021, the third case, OP000425014, was also joined to the proceedings.

19. Party A filed written submissions in relation to cases OP000423051 and OP00023310 on 3 August 2021 and then further submissions in relation to OP000425014 on 17 December 2021.



20. No evidence was filed.

21. No hearing was requested, but both parties filed written submissions in lieu of a hearing.

22. I have carefully considered the submissions when carrying out my analysis and making my decision.

23. Throughout these consolidated proceedings, Party A is represented by HGF Limited and Party B is represented by Murgitroyd & Company.

## **DECISION**

Lead case: OP000423051

24. I shall start with the lead case, namely Opposition no. 423051, as the outcome of this case will affect the outcome of the second case (Opposition no. 423310). This is because the applied for mark in the lead case is the mark that the opponent relies upon in the second case.

25. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

26. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

27. Given its filing date, the trade mark upon which Party A relies qualifies as an earlier trade mark as defined above. Given the date on which it was registered/protected, the earlier mark is not subject to the proof of use provisions in section 6A of the Act.

### **Section 5(2)(b) – case law**

28. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to make reference to the trade mark case-law of EU courts.

29. 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 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 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 the trade marks**

30. 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.”

31. 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.

32. The opponent’s mark (that of Party A) and the applicant’s mark (that of Party B) are shown below:

| Party A’s trade mark       | Party B’s trade mark |
|----------------------------|----------------------|
| BURT’S BEES TRUE TO NATURE | TRUE TO NATURE       |
|                            | true to nature       |

33. Party A’s mark consists of the plain words “BURT’S BEES TRUE TO NATURE” which, as a word mark, could just as easily be rendered as capitalised words, or all lower case. The words themselves are the only things that contribute to the overall impression, but the phrase “BURT’S BEES” is the more dominant and distinctive element within the mark as a whole. This is because (a) the phrase is placed at the beginning of the mark and beginnings of marks are normally more focused upon and (b) it is inherently more distinctive in the context of the goods concerned than the words “TRUE TO NATURE”, since the latter are likely to be seen as a reference to the products using natural ingredients (see below).

34. Party B’s mark is a series of two. The first in the series consists of the plain words “TRUE TO NATURE”, the only things that contribute to the overall

impression and none of the words are any more dominant than the other. The second in the series consists of the same words, but in all lower case and slightly stylised typeface. Having said that, the words themselves in the second of the series overwhelmingly dominate the overall impression, the stylistic aspects making a very minor contribution.

35. Visually, Party B's three-word series of two mark is incorporated in Party A's mark as its last three words. Party A's mark begins with the two additional words "BURT'S BEES", words which are absent from Party B's mark. I find the respective marks to be of medium similarity visually.

36. Aurally, Party A's mark begins as "BURTZ BEEZ" and is then phonetically identical to Party B's "TROO TUH NAYCHUR". I find the marks to be aurally similar to a medium degree.

37. Conceptually, Party A's mark begins as "BURT'S BEES" – bees that belong to Burt. This concept is absent from Party B's mark. Party A's mark is then conceptually identical to Party B's insofar as both marks contain the identical words "TRUE TO NATURE", meaning in line with the laws or principles of the natural world – natural. The presence of Party A's "BURT'S BEES" does not alter the conceptual meaning of the latter phrase "TRUE TO NATURE". I find the marks to be conceptually similar to a medium degree.

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

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of

other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

39. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

40. The phrase “BURT’S BEES TRUE TO NATURE” is not descriptive of the goods for which the mark is registered. It is, however, laudatory to the extent that there is a reference to being true to nature, implying that naturalness is a property of Party A’s products. While “BURT’S BEES” is quite an unusual and therefore distinctive phrase, none of the words in the earlier mark are invented. I find the earlier mark to be inherently distinctive to a medium degree.

41. I bear in mind that the degree of distinctiveness of the earlier mark is only likely to be significant to the extent that it relates to the point of commonality between the marks<sup>1</sup>. In this case, it is the phrase “TRUE TO NATURE” that is

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<sup>1</sup> See, *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

common to both marks, and I consider that phrase alone to be of a low level of distinctiveness.

### **Comparison of the goods**

42. When making the comparison, all relevant factors relating to the goods 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 of its judgment 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.”

43. 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.

44. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

45. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

“...the applicable principles of interpretation are as follows:

- (1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

46. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“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 for 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.”

47. 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 Office for Harmonization in the Internal Market* (Trade Marks and Designs) (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 the responsibility for those goods lies with the same undertaking.”

48. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services*

*for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

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

While on the other hand:

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

49. The goods in question are as below:

| <b>Party A's goods</b>   | <b>Party B's goods</b>   |
|--|--|
| <p><u>Class 3</u><br/>           Non-medicated toiletry preparations; cosmetic preparations; products and preparations for the face, skin, hair, body and nails; cleaning preparations; bath preparations; lip balms; creams, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and</p> | <p><u>Class 3</u><br/>           Non-medicated toilet preparations; hand wash; face wash; body wash; soap; bath soap; clarifying soap; liquid soap; soap petals; bath preparations; bath elixir; bath salts; bath fizzers; bath powder; bath jelly; bath essence; bathing milk; shower preparations; bath gel; shower gel; preparations for the care of the skin, face, scalp and body; moisturiser; body lotion; body butter; body milk; skin care preparations; body fudge; hand care products; hand and</p> |

conditioners; perfumes, fragrances, deodorants; shaving preparations; dentifrices; non-medicated balm for soothing itching, swelling and bruises on babies; non-medicated diaper rash ointments and lotions; baby wipes; baby powder.

nail cream; oils, creams and lotions for the skin; foot lotion; perfumery; perfumes; fragrances; toilet water; aftershave; cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos; hair shampoo; body shampoo; conditioners; hair lotions; hair colourants; hair styling products; dentifrices; preparations for the care of the mouth and teeth; shaving preparations; pre-shave and aftershave preparations; sun-tanning and sun protection preparations; self-tanning preparations; cosmetics; make-up and make-up removing preparations; cleansers; lip care preparations; talcum powder; cotton wool; cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks; face masks; facial packs; washing preparations; washing liquids; washing creams; washing lotions; room fragrances; room fragrancing products and preparations; washroom products; washroom hand soap; washroom hand wash; washroom liquid soap; washroom moisturiser; hand cleaning preparations; hand wash for washroom soap

|  |  |
|--|--|
|  | dispensers; substances for laundry use; bleaching preparations; cleaning, polishing, scouring and abrasive preparations. |
|--|--|

50. Party B's "non-medicated toilet preparations" are identical to Party A's "non-medicated toilet preparations".

51. Party B's "bath preparations" are identical to Party A's "bath preparations".

52. Party B's "preparations for the care of the skin, face ... and body" are identical to Party A's "products and preparations for the face, skin, ... , body".

53. Party B's "preparations for the care of the ... hair" is identical to Party A's "products and preparations for the ... hair ...".

54. Party B's "shaving preparations" and Party A's "shaving preparations are identical.

55. Party B's "dentifrices" are identical to Party A's "dentifrices".

56. Party B's "cosmetics" and "make-up ..." are identical to Party A's "cosmetic preparations".

57. Party B's "bath elixir", "bath salts", "bath fizzers", "bath powder", "bath jelly", "bath essence" and "bathing milk" are *Merici* identical to Party A's "bath preparations" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

58. Party B's "bath gel" and "shower gel" are *Merici* identical to Party A's "... gels ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

59. Party B's "shampoos", "hair shampoo", "conditioners", "hair lotions", "hair colourants" and "hair styling products" are *Meric* identical to Party A's "products and preparations for the ... hair ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
60. Party B's "body wash", "body shampoo", "body lotion", "body butter", "body milk", "body fudge" "massage preparations" and "talcum powder" are *Meric* identical to Party A's "products and preparations for the ... body ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
61. Party B's "beauty masks", "face masks" and "facial packs" are *Meric* identical to Party A's "products and preparations for the face ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
62. Party B's "washing creams" are *Meric* identical to Party A's "creams ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
63. Party B's "washroom products" are *Meric* identical to Party A's "non-medicated toiletry preparations" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
64. Party B's "substances for laundry use" and "bleaching preparations" are *Meric* identical to Party A's "cleaning preparations" in that in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
65. Party B's "cleaning, polishing, scouring and abrasive preparations" are *Meric* identical to Party A's "cleaning preparations" in that the goods designated by the earlier mark are included in a more general category, designated by the trade mark application.

66. Party B's "pre-shave and aftershave preparations" are *Merici* identical to Party A's "shaving preparations" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
67. Party B's "lip care preparations" is *Merici* identical to Party A's "lip balms" in that the goods designated by the earlier mark are included in a more general category, designated by the trade mark application.
68. Party B's "moisturiser", "skin care preparations", "oils, creams and lotions for the skin", "sun-tanning and sun protection preparations", "self-tanning preparations", "washing lotions", "washroom moisturiser" and "cleansers" are *Merici* identical to Party A's "products and preparations for the ... skin ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
69. Party B's "... nail cream" is *Merici* identical to Party A's "products and preparations for the ... nails" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
70. Party B's "preparations for the care of the mouth and teeth" are *Merici* identical to Party A's "dentifrices" in that the goods designated by the earlier mark are included in a more general category, designated by the trade mark application.
71. Party B's "perfumery", "perfumes", "fragrances", "toilet water", "aftershave", "cologne", "aromatherapy products", "deodorants and antiperspirants", "room fragrances" and "room fragrancing products and preparations" are *Merici* identical to Party A's "perfumes, fragrances, deodorants" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

72. Party B's "hand care products", "hand ... cream" and "foot lotion" are *Meric* identical to Party A's products and preparations for the ... body ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
73. Party B's "hand wash", "face wash", "soap", "bath soap", "clarifying soap", "liquid soap", "soap petals", "shower preparations", "washing preparations", "washing liquids", "washroom hand soap", "washroom hand wash", "washroom liquid soap" "hand cleaning preparations" and "hand wash for washroom soap dispensers" are identical, or at least highly similar, to Party A's "... soaps ...".
74. I compare Party B's "preparations for the ... scalp ..." and "preparations for the care of the scalp ..." with Party A's "products and preparations for the ... hair ...". The two goods share the same user group – members of the general public, and will be very similar in nature, taking the form of a liquid or gel. While they target different parts of the body – the scalp and the hair, both are intended for use on the head and would be used in the same way – being applied by hand and used with water. Both goods would be sold through the same trade channels – chemists and supermarkets. They are not complementary. They could, however, be in competition in that a consumer may consider hair preparations which they would see as having the secondary effect of benefiting the scalp, and vice versa. Overall, I find the respective goods to be highly similar.
75. I compare Party B's "essential oils" to Party A's "products and preparations for the ... body ...". The goods share the same user group – members of the general public, are similar in nature and method of use and share the common of purpose of being applied to the body. However, essential oils can also be burnt to create a relaxing or stimulating smell. The respective goods would be sold through the same trade channels – chemists and supermarkets. They are not complementary. They could be in competition to a degree in that the customer may choose between a general product for application to the body that feels pleasant and essential oils that claim to



produce specific benefits when applied to the body. Overall, I find the respective goods to be highly similar.

76. I compare Party B's "... make-up removing preparations" "cotton wool", "cotton sticks", "cosmetic pads, tissues or wipes" and "pre-moistened or impregnated cleansing pads, tissues or wipes" with Party A's "cosmetic preparations". The respective goods share the same user group – members of the general public. They differ in nature and specific purpose in that Party A's goods are used for make-up itself, whereas Party B's goods are paraphernalia used for removing make-up. However, they share the same broad purpose in that they are both make-up-related. The respective goods would be sold through the same trade channels – chemists and supermarkets. They are not in competition, but there is complementarity. The one is important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking. Overall, I find the respective goods to be of medium similarity.

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

77. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services 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."

78. Toiletries and cosmetics can vary in price such that they could fall within the category of an impulse buy. However, they can also be expensive such that the average consumer, a member of the general public, would give significant thought to the attributes of the product before making a purchase. Overall, the average consumer would pay a medium level of attention during the purchasing process.

79. The average consumer would generally purchase the contested goods at chemists or supermarkets and would select them directly from the shelves. As such, this would be a wholly visual process. However, there will be occasions where the products are particularly expensive and will be stocked behind a counter, requiring the services of a shop assistant. In this scenario, verbal considerations will play a part, but visual considerations will still predominate.

### **Likelihood of confusion**

80. Confusion can be direct or indirect. 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 undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 trade marks may be offset by a greater degree of similarity between the respective goods or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make

direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

81. Earlier in this decision I found that the goods are similar to a degree ranging from identical to medium. Party A's mark is of a medium level of inherent distinctive character, with the point of commonality between the marks being of a low level of distinctiveness. The average consumer of the parties' goods will be a member of the public who will pay a medium degree of attention. Verbal factors will not play a part in most purchases. However, there will be occasions where products are particularly expensive and will be stocked behind a counter and here verbal considerations will play a part, but with visual considerations still predominating.

82. I have found the parties' marks to be of medium similarity visually, aurally and conceptually.

83. Given that Party A's mark consists of the plain words "BURT'S BEES TRUE TO NATURE" and Party B's mark is a series of two – the plain words "TRUE TO NATURE" (and the same words in slightly stylised all-lower-case form), the average consumer will clearly see the differences between the marks because the differentiating verbal element "BURT'S BEES" makes Party A's mark much longer and is placed at the beginning of the mark. They will notice that Party A's mark includes the phrase "BURT'S BEES" which is absent from Party B's mark and consequently there is no likelihood of direct confusion in this case.

84. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

85. When considering the respective marks, the average consumer will see “BURT’S BEES TRUE TO NATURE” and “TRUE TO NATURE” (the stylised version of Party B’s mark not having a bearing on how the mark is considered). Party A’s mark contains two distinct phrases – “BURT’S BEES” and “TRUE TO NATURE” – which operate as separate units even though there is no punctuation between them. The average consumer would see the mark as “BURT’S BEES” plus “TRUE TO NATURE” and therefore the phrase “TRUE TO NATURE”, which is common to both marks, performs an independent distinctive role within Party A’s mark.

86. Given that Party A’s mark contains two distinct phrases, the average consumer will focus on the first phrase which is the most distinctive of the two phrases – “BURT’S BEES” – and will see the second, lowly distinctive phrase – “TRUE TO NATURE” – as a strapline which is laudatory of Burt’s Bees products. Although the phrase “TRUE TO NATURE” performs an independent distinctive role, its role is secondary to the distinctive element “BURT’S BEES” serving to describe what is a characteristic of Burt’s Bees products. As such, the average consumer will see that second phrase as saying that Burt’s Bees products are “true to nature”, that they are made in accordance with the laws or principles of the natural world or from natural ingredients. Consequently, the average consumer when confronted with the standalone trade mark “TRUE TO NATURE” will view its use for the shared

goods such as cosmetics and toiletries as coincidence rather than indicative of an economic connection. I conclude that there is no likelihood of indirect confusion in this case.

## **CONCLUSION**

87. The opposition has failed. Subject to appeal, the application will proceed to registration.

## **DECISION**

### Second case: OP000423310

88. Because the opposition in the lead case failed, the opponent in this second case can rely upon the mark that was subject to the opposition in the lead case. The opponent's mark – No. UK00003415984 – is a valid earlier mark for the purposes of this second case.

89. Sections 5(1), 5(2)(a) and 5(2)(b) read as follows:

- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- (2) A trade mark shall not be registered if because—
  - (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
  - (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.

90. Given its filing date, the trade mark application upon which Party B relies in this case qualifies as an earlier trade mark as defined in the Act.

### Comparison of the trade marks

91. The opponent's (Party B's) and the applicant's (Party A's) marks are shown below.

| Party A's trade mark | Party B's trade mark |
|----------------------|----------------------|
| TRUE TO NATURE       | TRUE TO NATURE       |
|                      | true to nature       |

92. As it is a prerequisite of sections 5(1) and 5(2)(a) that the marks be identical, I will begin by assessing whether they are identical within the meaning of the Act and case law.

93. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ('CJEU') held that:

"54 ... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

94. Party A's word mark "TRUE TO NATURE", is identical to the word only version of Party B's mark.

95. The figurative version of Party B’s mark is in all lower case and slightly stylised typeface. Considering that point, I refer to Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14:

“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks ... A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

96. Bearing the above in mind, these two marks are identical.

**Distinctive character of the earlier mark**

97. The phrase “TRUE TO NATURE” is laudatory of the goods for which the mark is registered. It is seen as a selling point for cosmetics and toiletries to be made in a natural way or from natural ingredients. I find Party B’s mark to be inherently distinctive to a low degree, the mark being identical to Party A’s mark.

**Comparison of the goods and services**

98. The goods and services in question are below:

| Party A’s goods and services  | Party B’s goods   |
|---|---|
| <u>Class 3</u><br>Non-medicated toiletry preparations; cosmetic preparations; products and preparations for the face, skin, hair, | Non-medicated toilet preparations; hand wash; face wash; body wash; soap; bath soap; clarifying soap; liquid soap; soap petals; bath preparations; bath |

|  |   |
|--|---|
| <p>body and nails; cleaning preparations; bath preparations; lip balms; creams, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and conditioners; perfumes, fragrances, deodorants; shaving preparations; dentifrices; non-medicated balm for soothing itching, swelling and bruises on babies; non-medicated diaper rash ointments and lotions; baby wipes; baby powder.</p> | <p>elixir; bath salts; bath fizzers; bath powder; bath jelly; bath essence; bathing milk; shower preparations; bath gel; shower gel; preparations for the care of the skin, face, scalp and body; moisturiser; body lotion; body butter; body milk; skin care preparations; body fudge; hand care products; hand and nail cream; oils, creams and lotions for the skin; foot lotion; perfumery; perfumes; fragrances; toilet water; aftershave; cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos; hair shampoo; body shampoo; conditioners; hair lotions; hair colourants; hair styling products; dentifrices; preparations for the care of the mouth and teeth; shaving preparations; pre-shave and aftershave preparations; sun-tanning and sun protection preparations; self-tanning preparations; cosmetics; make-up and make-up removing preparations; cleansers; lip care preparations; talcum powder; cotton wool; cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks; face masks; facial packs; washing</p> |
|--|---|



|   |   |
|---|---|
|   | <p>preparations; washing liquids; washing creams; washing lotions; room fragrances; room fragrancing products and preparations; washroom products; washroom hand soap; washroom hand wash; washroom liquid soap; washroom moisturiser; hand cleaning preparations; hand wash for washroom soap dispensers; substances for laundry use; bleaching preparations; cleaning, polishing, scouring and abrasive preparations.</p> |
| <p><u>Class 35</u><br/>Retail services connected with the sale of medicated and non-medicated preparations for hair, scalp, skin and nails; retail services connected with the sale of medicated and non-medicated skin care preparations for the face, skin, hair, body and nails; retail services connected with the sale of medicated and non-medicated sunscreen, sun protection, sun care and after sun preparations; retail services connected with the sale of non-medicated toiletry preparations and cosmetics; retail services connected with the sale of medicated and non-medicated lip balms and lip glosses; retail services connected with the sale of medicated and non-medicated soaps, shampoos and conditioners; retail services</p> |   |

|  |  |
|--|--|
| connected with the sale of perfumes, fragrances, deodorants, body sprays, dentifrices and shaving preparations; retail services connected with the sale of medicated acne preparations and sanitiser lotions; retail services connected with the sale of non-medicated balms, diaper rash ointments and lotions, baby wipes and baby powder. |  |
|--|--|

### Class 3

99. Party A's "non-medicated toiletry preparations" are identical to Party B's "non-medicated toiletry preparations".
100. Party A's "cosmetic preparations" are identical to Party B's "cosmetics".
101. Party A's "products and preparations for the face, skin ... body ..." are identical to Party B's "preparations for the care of the skin, face ... and body".
102. Party A's "bath preparations" are identical to Party B's "bath preparations".
103. Party A's "... soaps ..." are identical to Party B's "soap".
104. Party A's "... conditioners" are identical to Party B's "conditioners".
105. Party A's "shaving preparations" are identical to Party B's "shaving preparations".
106. Party A's "dentifrices" are identical to Party B's "dentifrices".
107. Party A's "... moisturisers ..." are identical to Party B's "moisturiser".

108. Party A's "products and preparations for the ... hair ..." are *Meric* identical to Party B's "preparations for the care of the scalp and hair" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
109. Party A's "products and preparations for ... nails" are *Meric* identical to Party B's "... nail cream" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
110. Party A's "cleaning preparations" are *Meric* identical to Party B's "cleaning, polishing, scouring and abrasive preparations" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
111. Party A's "lip balms" are *Meric* identical to Party B's "lip care preparations" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
112. Party A's "creams ..." are *Meric* identical to Party B's "... creams ... for the skin" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
113. Party A's "... oils ..." are *Meric* identical to Party B's "oils ... for the skin" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
114. Party A's "... powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks ..." are *Meric* identical to Party B's "bath preparations" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.

115. Party A's "... gels ..." are *Merici* identical to Party B's "bath gel" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
116. Party A's "... lotions ..." are *Merici* identical to Party B's "... lotions for the skin" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
117. Party A's "perfumes, fragrances, deodorants" is *Merici* identical to Party B's "perfumes" in that the goods designated by the earlier mark are included in a more general category designated by the trade mark application.
118. Party A's "non-medicated balm for soothing itching, swelling and bruises on babies" and "non-medicated diaper rash ointments and lotions" are *Merici* identical to Party B's "preparations for the care of the skin ..." in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
119. Party A's "baby wipes ..." are *Merici* identical to Party B's "tissues or wipes" in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
120. Party A's "... baby powder" is highly similar to Party B's "talcum powder".

### Class 35

121. In my analysis of Party A's retail services, I am reminded of *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, where the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

122. Party A's "retail services connected with the sale of non-medicated toiletry preparations and cosmetics" are of medium similarity with Party B's "Non-medicated toilet preparations" and "cosmetics". The goods referred to are identical and there would be complementarity between Party A's services and Party B's goods.
123. Party A's "retail services connected with the sale of medicated and non-medicated soaps, shampoos and conditioners" are of medium similarity with Party B's "soap", "shampoos" and "conditioners". The goods referred to are identical and there would be complementarity between Party A's services and Party B's goods.
124. Party A's "retail services connected with the sale of perfumes, fragrances, deodorants, body sprays, dentifrices and shaving preparations" are of medium similarity with Party B's "perfumes", "fragrances", "deodorants and antiperspirants", "dentifrices" and "shaving preparations". The goods referred to are either identical or *Merix* identical and there would be complementarity between Party A's services and Party B's goods.
125. Party A's "retail services connected with the sale of medicated and non-medicated preparations for hair, scalp, skin and nails" are of medium similarity by comparison with Party B's "preparations for the care of the scalp and hair". The goods referred to are *Merix* identical and there would be complementarity between Party A's services Party B's goods.
126. Party A's "retail services connected with the sale of medicated and non-medicated skin care preparations for the face, skin, hair, body and nails" are of medium similarity with Party B's "preparations for the care of the "skin, face ... body". The goods referred to are *Merix* identical and there would be complementarity between Party A's services and Party B's goods.

127. Party A's "retail services connected with the sale of medicated and non-medicated sunscreen, sun protection, sun care and after sun preparations" are of medium similarity with Party B's "... sun protection preparations". The goods referred to are *Merix* identical and there would be complementarity between Party A's services and Party B's goods.
128. Party A's "retail services connected with the sale of medicated and non-medicated lip balms and lip glosses" are of medium similarity with Party B's "lip care preparations". The goods referred to are *Merix* identical and there would be complementarity between Party A's services and Party B's goods.
129. Party A's "retail services connected with the sale of medicated acne preparations and sanitiser lotions" and "retail services connected with the sale of non-medicated balms, diaper rash ointments and lotions ..." are of medium similarity with Party B's "preparations for the care of the skin ...". The goods referred to are *Merix* identical and there would be complementarity between Party A's services and Party B's goods.
130. Party A's "retail services connected with the sale of ... baby wipes ..." are of medium similarity with Party B's "tissues or wipes". The goods referred to are *Merix* identical and there would be complementarity between Party A's services and Party B's goods.
131. Party A's "retail services connected with the sale of ... baby powder" are of medium similarity with Party B's "talcum powder". The goods referred to are highly similar and there would be complementarity between Party A's services and Party B's goods.

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

132. For the goods in Class 3, the same considerations apply as those set out in paragraphs 78-79.

133. As for the retail services of toiletries and cosmetics, the average consumer will have in mind factors such breadth of goods stocked, location, opening times and so on. I would, therefore, expect them to also pay a medium degree of attention when selecting the retail services at issue.

134. Visual factors will play the most important role in the average consumer's search for and selection of the retail services at issue, although I do not entirely rule out verbal factors in seeking out such services.

### **Likelihood of confusion**

135. Earlier in this decision I found that the goods are similar to a degree ranging from identical to medium. Party B's mark is of a low level of inherent distinctive character. The average consumer of the contested goods and retail services will be a member of the public who will pay a medium degree of attention, with verbal factors predominating.

136. I have found the respective marks to be identical. Given that the goods and services at issue range from identical to a medium degree of similarity, I conclude that there is a likelihood of direct confusion in this case.

### **CONCLUSION**

137. The opposition has succeeded in full. Subject to appeal, the application will be refused.

### **DECISION**

Third case: OP000425014

138. Given its filing date, the trade mark upon which Party A relies qualifies as an earlier trade mark as defined in the Act. Given the date on which it

was registered/protected, the earlier mark is not subject to the proof of use provisions in section 6A of the Act.

### Comparison of the trade marks

139. The opponent's (Party A's) and the applicant's (Party B's) marks are shown below.

| Party A's trade mark       | Party B's trade mark                         |
|----------------------------|--|
| BURT'S BEES TRUE TO NATURE | SCOTTISH FINE SOAPS TRUE TO NATURE           |
|                            | <b>SCOTTISH FINE SOAPS</b><br>true to nature |

140. In terms of the overall impression formed by Party A's mark, I refer to my comments set out above at paragraph 33.

141. Party B's mark is a series of two. The first in the series consists of the plain words "SCOTTISH FINE SOAPS TRUE TO NATURE", the only things that contribute to the overall impression, but the phrase "SCOTTISH FINE SOAPS" is the more dominant and distinctive element within the mark as a whole. This is because the beginnings of marks are normally more focused upon than their endings. I think the principle applies in this case despite the fact that neither "SCOTTISH FINE SOAPS" nor "TRUE TO NATURE" are particularly distinctive phrases. The second in the series consists of the same words, but with the first phrase "SCOTTISH FINE SOAPS" being in slightly stylised block capitals above the all-lower-case phrase "TRUE TO NATURE", the latter phrase being slightly stylised. The words themselves dominate the



overall impression in the second series of the two, the format and the stylistic aspects making a minor contribution.

142. Visually, the marks share the same three-word phrase “TRUE TO NATURE” as the latter parts of their marks. They differ in that Party A’s mark begins as “BURT’S BEES” and Party B’s mark begins as “SCOTTISH FINE SOAPS”. I find the respective marks to be of medium similarity visually.

143. Aurally, Party A’s mark begins as “BURTZ BEEZ” while Party B’s mark begins as “SKOTTISH FINE SOPES”. The marks end phonetically identically as “TROO TUH NAYCHUR”. I find the marks to be aurally similar to a medium degree.

144. Conceptually, Party A’s mark begins as “BURT’S BEES” – bees that belong to Burt. Party A’s mark begins “SCOTTISH FINE SOAPS” – high quality soap that is characteristic of the soap produced in Scotland/made in Scotland. Both marks end with the phrase “TRUE TO NATURE”, meaning in line with the laws or principles of the natural world - natural. Given the conceptual differences at the beginning of the marks, I find the marks to be conceptually similar to a low degree.

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

145. The same analysis applies as for paragraphs 40-41.

### **Comparison of the goods**

146. The goods in question are as below:

| <b>Party A’s goods</b>  | <b>Party B’s goods</b>   |
|---|--|
| <u>Class 3</u><br>Non-medicated toiletry preparations;<br>cosmetic preparations; products and | <u>Class 3</u><br>Non-medicated toilet preparations; hand<br>wash; face wash; body wash; soap; |

|   |   |
|---|---|
| <p>preparations for the face, skin, hair, body and nails; cleaning preparations; bath preparations; lip balms; creams, oils, soaps, powders, milk baths, emollient baths, fragranced baths, moisturizing baths, non-medicated milk soaks, non-medicated emollient soaks, non-medicated fragranced soaks, non-medicated moisturizing soaks, moisturizers, gels, lotions, and conditioners; perfumes, fragrances, deodorants; shaving preparations; dentifrices; non-medicated balm for soothing itching, swelling and bruises on babies; non-medicated diaper rash ointments and lotions; baby wipes; baby powder.</p> | <p>bath soap; clarifying soap; liquid soap; soap petals; bath preparations; bath elixir; bath salts; bath fizzers; bath powder; bath jelly; bath essence; bathing milk; shower preparations; bath gel; shower gel; preparations for the care of the skin, face, scalp and body; moisturiser; body lotion; body butter; body milk; skin care preparations; body fudge; hand care products; hand and nail cream; oils, creams and lotions for the skin; foot lotion; perfumery; perfumes; fragrances; toilet water; aftershave; cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos; hair shampoo; body shampoo; conditioners; hair lotions; hair colourants; hair styling products; dentifrices; preparations for the care of the mouth and teeth; shaving preparations; pre-shave and aftershave preparations; sun-tanning and sun protection preparations; self-tanning preparations; cosmetics; make-up and make-up removing preparations; cleansers; lip care preparations; talcum powder; cotton wool; cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing</p> |
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|  |   |
|--|---|
|  | <p>pads, tissues or wipes; beauty masks; face masks; facial packs; washing preparations; washing liquids; washing creams; washing lotions; room fragrances; room fragrancing products and preparations; washroom products; washroom hand soap; washroom hand wash; washroom liquid soap; washroom moisturiser; hand cleaning preparations; hand wash for washroom soap dispensers; substances for laundry use; bleaching preparations; cleaning, polishing, scouring and abrasive preparations.</p> |
|--|---|

147. In respect of the goods comparison, the same analysis applies as was carried out in the goods comparison under lead case OP000423051. This results in the same findings of similarity ranging from identical to medium.

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

148. The same analysis applies as for paragraphs 78-79.

**Likelihood of confusion**

149. Earlier in this decision I found that the goods are similar to a degree ranging from identical to medium. Party A's mark is of a medium level of inherent distinctive character, with the point of commonality between the marks being of a low level of distinctiveness. The average consumer of the parties' goods will be a member of the public who will pay a medium degree of attention. Verbal factors will not play a part in most purchases. However, there will be occasions where products are particularly expensive and will

be stocked behind a counter and here verbal considerations will play a part, but with visual considerations still predominating.

150. I have found the parties' marks to be of medium similarity visually and aurally and to be conceptually similar to a low degree.

151. Given that Party A's mark consists of the plain words "BURT'S BEES TRUE TO NATURE" and Party B's mark is a series of two consisting of the words "SCOTTISH FINE SOAPS TRUE TO NATURE", the first two and three words in the respective marks are clearly different and the average consumer will clearly see the differences between them. They will notice that Party A's mark includes the phrase "BURT'S BEES" which is absent from Party B's mark and Party B's mark contains the phrase "SCOTTISH FINE SOAPS" which is absent from Party A's mark. There is no likelihood of direct confusion in this case.

152. It now falls to me to consider the likelihood of indirect confusion. When considering the respective marks, the average consumer will see the words "BURT'S BEES TRUE TO NATURE" and "SCOTTISH FINE SOAPS TRUE TO NATURE". Party A's mark contains two distinct phrases – "BURT'S BEES" and "TRUE TO NATURE" – which operate as separate units even though there is no punctuation between them. The same applies to the phrases "SCOTTISH FINE SOAPS" and "TRUE TO NATURE" in the word version of Party B's mark. In the figurative version, the demarcation between "SCOTTISH FINE SOAPS" and "TRUE TO NATURE" is even clearer.

153. Even allowing for the level of identity/similarity of the goods involved, the average consumer will not think that there is an economic connection between the two marks. They will see two different marks. First, they will see Party A's mark as that of the Burt's Bees company which includes a laudatory description of its products – that they are true to nature, made in accordance with the laws or principles of the natural world or from natural ingredients. Second, they will see Party B's mark as that of the Scottish Fine Soaps company which includes a laudatory description of its products – that they are

true to nature, made in accordance with the laws or principles of the natural world or from natural ingredients.

154. I conclude that there no likelihood of indirect confusion in this case.

## **CONCLUSION**

155. The opposition has failed. Subject to appeal, the application will proceed to registration.

## **OVERALL CONCLUSION**

156. In the lead case, OP000423051, the opposition has failed. Subject to appeal, the application will proceed to registration.

157. In the second case, OP000423310, the opposition has succeeded in full. Subject to appeal, the application will be refused.

158. In the third case, OP000425014, the opposition has failed. Subject to appeal, the application will proceed to registration.

## **COSTS**

159. Given the outcome of the three cases in question, Party B has been successful in these consolidated proceedings, and I award costs accordingly.

160. My costs award will, however, reflect the fact that Party B cancelled a Case Management Conference (CMC) at very short notice during these proceedings and that Party A asked in its submissions that it be compensated for this. The CMC was cancelled on the morning it was due to take place and Party A had already prepared for the CMC at that point.

161. In line with Annex A of Tribunal Practice Notice 2 of 2016, I award costs to Party B as below.

|  |       |
|--|-------|
| Preparing statements and considering<br>the other side's statements: | £600  |
| Preparation of submissions:  | £400  |
| Official fees:   | £100  |
| Party A's preparation for a cancelled CMC:                           | -£250 |
| Total:   | £850  |

162. I order The Burt's Bees Products Company to pay Alexander Ross Holdings Limited £850. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 20<sup>th</sup> day of July 2022**

**JOHN WILLIAMS  
For the Registrar**