

O/0232/23

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

TRADE MARK REGISTRATION Nos. 3565683 & 3565700
IN THE NAME OF OUCHI TRADING LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARKS:



lifelike reborn

IN CLASS 28

AND



reborn dolls

IN CLASS 28

AND


TWO APPLICATIONS FOR DECLARATIONS OF INVALIDITY
THERE TO UNDER NOS. 504107 & 504108

BY
CHEN YONG ZHOU

BACKGROUND & PLEADINGS

1. These are consolidated invalidation proceedings between OUCHI TRADING LIMITED (“**the registered proprietor**”) and CHEN YONG ZHOU (“**the applicant**”) concerning the following trade mark registrations as shown on the cover page of this decisions:

Trade Mark no.	UK00003565683 ('683)
Trade Mark	 <p>lifelike reborn</p>
Goods Registered	Class 28: Toy furniture; Bath toys; Toy animals; Baby playthings; European style dolls; Toys for dogs; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy cars; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle.
Relevant Dates	Filing date: 09 December 2020
	Date of entry in register: 25 June 2021

Trade Mark no.	UK00003565700 ('700)
Trade Mark	 <p>reborn dolls</p>
Goods Registered7	Class 28: Toy furniture; Bath toys; Toy animals; Baby

	playthings; European style dolls; Toys for dogs; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy cars; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle.
Relevant Dates	Filing date: 09 December 2020
	Date of entry in register: 25 June 2021

2. On 2 September 2021, the applicant filed two applications (nos. 504107 and 504108) to have these trade marks declared invalid under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), which are relevant in invalidation proceedings under Section 47 of the Act. The applications for invalidation concern all the goods for which the contested marks stand registered. The applicant relies upon its UK trade mark registration 3325701 for the word mark:

REBORN

3. The mark was filed on 19 July 2018 and was registered on 26 April 2019 for various goods in Class 28. As shown later in this decision, the applicant relies on a slightly different list of goods for the purposes of each of the applications for invalidation.

The Applicant’s Statement of Grounds

4. In his amended statement of grounds, regarding the application for invalidation no. 504107, the applicant claims that:

“The dominant and distinctive element of the Contested Mark is the word REBORN which is the first verbal element of the mark. This term is identical to the Earlier Mark. The Earlier Mark is incorporated within the Contested Mark in its entirety and maintains an independent and distinctive role within the Contested Mark. The word 'Lifelike' is of low

distinctive character due to its descriptive nature and will likely be overlooked by the average consumer when recalling the Contested Mark.”

In addition, the applicant contends that “[...]in light of the visual, phonetic and conceptual similarity of the marks, the Earlier and Contested Marks are similar to at least an average degree.” I will return to this point later in my decision. He also claims that the proprietor’s goods are identical or similar to the applicant’s.

5. In his amended statement of grounds, regarding the application for invalidation no. 504108, the applicant claims that:

“The dominant and distinctive element of the Contested Mark is the word REBORN. The word dolls is descriptive and non-distinctive and will be overlooked by the relevant consumer. The logo element is a non-distinctive representation of cartoon creatures which will be overlooked by the consumer.”

The applicant concludes by putting forward the claim that the contested marks are highly similar. Also, the applicant contends that the competing goods are identical or similar.

The Registered Proprietor’s Defence

6. The proprietor filed notices of defence in each case.
7. In relation to the application for invalidation no. 504107, the proprietor with its counterstatement denied the opponent’s claims in the following terms:

“[...]”

The registered proprietor denies that there is any likelihood of confusion between the later mark and the earlier mark. In particular, the registered proprietor submits that the two marks are not similar

and would not be confused by consumers, particularly because the English word REBORN lacks distinctiveness and because the common word LIFELIKE REBORN would be seen as descriptive. Also, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the dominant device of a teddy bear will not be ignored. [...]"

Further, in terms of the competing goods, the proprietor claims the following:

"The registered proprietor submits that the following goods of the later trade mark are neither identical or similar to the goods of the earlier trade mark:

Toy furniture; European style dolls; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes.

None of the aforesaid goods are similar in nature. Whilst there might be an overlap in users and may share some trade channels, the goods are not in competition with each other and are not interchangeable or complementary."

I will return to this point later in this decision.

8. In relation to the application for invalidation no. 504108, the proprietor with its counterstatement denied the opponent's claims in the following terms:

"The registered proprietor denies that there is any likelihood of confusion between the later mark and the earlier mark. In particular, the registered proprietor submits that the two marks are not similar and would not be confused by consumers, particularly because the English word REBORN lacks distinctiveness and because the common word REBORN DOLLS would be seen as descriptive. Also, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the

dominant device comprising adjacent caricatured faces of a rabbit and a cat will not be ignored.”

Further, the proprietor denies identity or similarity in relation to the same goods in the same terms as quoted in the preceding paragraph.

Papers Filed and Representation

9. Neither party filed evidence or submissions in these proceedings.
10. In these proceedings, the registered proprietor is represented by IPEY and the applicant by AA Thornton IP LLP.
11. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

12. Section 47 of the Act states that:

“[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

13. The invalidation application is based specifically on Section 5(2)(b) of the Act which states that:

“A trade mark shall not be registered if because-

[...]

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

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

14. Under Section 6(1) of the Act, the applicant’s trade mark clearly qualifies as an earlier trade mark. Further, it had not completed its protection procedure more than five years before the date of the application for invalidation (or the date on which the contested mark was filed), the applicant’s trade mark is not subject to the proof of use provisions contained in Sections 47(2A) – (2E) of the Act.
15. The principles, considered in these applications for invalidity, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):
 - a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
 - b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
 - c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

- d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k) if the association between the marks creates a risk that the public 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 goods at issue

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned [...], 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 complementary.”

17. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(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.”

18. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded

identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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 für 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”.

19. 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 specifications:

“[...] 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.”

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

Invalidation no. 504107 to Registered Marks ‘683

22. The competing goods to be compared are shown in the following table:

Applicant’s Goods re ‘504107	Registered Proprietor’s Goods
Class 28: Artificial Christmas trees; Candle holders for Christmas trees; Carnival masks; Costume masks; Face masks being playthings; Fish hooks; Fishing tackle; Fishing tackle bags; Fishing tackle boxes; Fishing tackle floats; Fishing tackle terminal;	Class 28: Toy furniture; Bath toys; Toy animals; Baby playthings; European style dolls; Toys for dogs; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes; Jigsaw puzzles; Stuffed toys; Masks [playthings];

<p>Fishing tackle terminal tackle; Halloween masks; Hand puppets; Imitation bones being toys for dogs; Jigsaw puzzles; Kits of parts [sold complete] for making toy models; Masks [playthings]; Masks (Theatrical-); Masks (Toy-); Masquerade masks; Motor driven toy animals; Novelty masks; Paper face-masks; Plush stuffed toys; Plush toys; Plush toys with attached comfort blanket; Puppets; Rockets being toy models; Soft toys; Soft toys in the form of animals; Soft toys in the form of elks; Stuffed and plush toys; Stuffed animals [toys]; Stuffed plush toys; Stuffed puppets; Stuffed toy animals; Stuffed toy bears; Stuffed toys; Theatrical masks; Toy and novelty face masks; Toy animals; Toy dogs; Toy masks; Toy model hobby craft kits; Toy model hobbycraft kits; Toy model kits; Toy model theatres in the form of children's theatre sets; Toy model train sets; Toy models; Toy pedal cars; Toy scale models; Toy telescopes; Toys and playthings for pet animals; Toys and playthings for pets; Toys for animals; Toys for birds; Toys for cats; Toys for dogs; Toys for domestic pets; Toys for pet animals; Toys for pets; Toys, games and playthings for pet animals; baby gyms; baby rattles; baby rattles incorporating teething rings; baby swings; clothing for teddy bears; costumes being children's playthings; cuddly toys; fantasy character toys; toy action figures; toy robots; inflatable bath toys; stuffed bean-filled toys; playsets for action figures.</p>	<p>Toy cars; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle.</p>
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23. With his statements of grounds, the applicant contends identity or similarity between the competing goods.

24. As quoted in the beginning of this decision, in its counterstatement, the registered proprietor explicitly denies similarity or identity but only for part of the competing goods, namely “*Toy furniture; European style dolls; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes*”. In this regard, it is noted that the proprietor without putting forward a blanket denial for the competing specifications, is deemed to have accepted the applicant’s contentions in relation to the rest of the competing terms.¹ However, even for those goods where similarity has not been denied, I will need to assess the degree of similarity between the goods.

Toy animals; Toys for dogs; Puppets; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle

25. The above terms are identical to the applicant’s, as they are identically worded.

European style dolls; Dolls for playing; Talking dolls; Dolls

26. There is similarity between the registered goods and the applicant’s “*toy action figures; fantasy character toys; stuffed toys*”. The trade channels for between the competing goods coincide as they would be sold in toy shops (retail or online) potentially in close proximity from each other. They are similar in nature (potentially of the same material) and they have the same purpose and method of use. They also have the same users, namely children. However, I do not consider that they are complementary. They

¹ Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

“The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a “blank” defence would lead to the whole of the Claimant’s case being admitted.”

are in competition in that the purchaser might choose one over the other. The goods are highly similar.

Dolls' clothes

27. The contested goods are clothes for doll's. I consider these to be similar to the opponent's "*Clothing for teddy bears*" goods. They may share the same nature and will serve the same purpose, i.e. clothing for toys/playthings. Also, the users, method of use, and trade channels will overlap. I do not consider that there is a degree of complementarity or competition between the goods. I find the goods to be similar to between a medium to high degree.

Toy furniture

28. The contested term relates to toys resembling furniture. The closest comparable term from the opponent's specification is "*soft toys*". The competing goods may share the same nature and purpose, method of use, users. The competing goods may share the same trade channels sold in the same retail shops. Although there could be a degree of competition, I do not consider the goods to be complementary. I find the competing goods to be similar to between a medium to high degree.

Bath toys

29. The contested term is a broad term that would cover the opponent's "*Inflatable bath toys*". Thus, I consider the competing goods to be *Merix* identical. If I am wrong in my finding that the goods are identical then, taking into account the nature, purpose, users, methods of use, distribution channels of the goods, and competition, they will be highly similar.

Baby playthings

30. The competing goods cover a wide range of baby toys. In this respect, the opponent's goods "*Baby rattles*" will be encompassed by the broad term "*baby playthings*". In this regard, I find the competing goods to be identical as per *Meric* or else highly similar.

Toy cars

31. The contested term is broad enough to cover the opponent's goods "*toy pedal cars*". Therefore, I find the respective goods to be *Meric* identical. If I am wrong in my finding that the goods are identical then, taking into account the nature, purpose, users, methods of use, distribution channels of the goods, and competition, they will be highly similar.

Invalidation no. 504108 to Registered Marks '700

32. The competing goods to be compared are shown in the following table:

Applicant's Goods re '504108	Registered Proprietor's Goods
Class 28: Artificial Christmas trees; Candle holders for Christmas trees; Carnival masks; Costume masks; Face masks being playthings; Fish hooks; Fishing tackle; Fishing tackle bags; Fishing tackle boxes; Fishing tackle floats; Fishing tackle terminal; Fishing tackle terminal tackle; Halloween masks; Hand puppets; Imitation bones being toys for dogs; Jigsaw puzzles; Kits of parts [sold complete] for making toy models; Masks [playthings]; Masks (Theatrical -); Masks (Toy-); Masquerade masks; Motor driven toy animals; Novelty masks; Paper face-masks; Plush stuffed toys; Plush toys; Plush toys with attached comfort blanket; Puppets; Rockets being toy models; Soft toys; Soft toys in the form of animals; Soft toys in the form of elks; Stuffed and	Class 28: Toy furniture; Bath toys; Toy animals; Baby playthings; European style dolls; Toys for dogs; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy cars; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle.

<p>plush toys; Stuffed animals [toys]; Stuffed plush toys; Stuffed puppets; Stuffed toy animals; Stuffed toy bears; Stuffed toys; Theatrical masks; Toy and novelty face masks; Toy animals; Toy dogs; Toy masks; Toy model hobby craft kits; Toy model hobbycraft kits; Toy model kits; Toy model theatres in the form of children's theatre sets; Toy model train sets; Toy models; Toy pedal cars; Toy scale models; Toy telescopes; Toys and playthings for pet animals; Toys and playthings for pets; Toys for animals; Toys for birds; Toys for cats; Toys for dogs; Toys for domestic pets; Toys for pet animals; Toys for pets; Toys, games and playthings for pet animals; baby gyms; baby rattles; baby rattles incorporating teething rings; baby swings; clothing for teddy bears; costumes being children's playthings; cuddly toys; fantasy character toys; toy action figures; toy robots, inflatable bath toys.</p>	
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33. As mentioned in the beginning of this decision, the opponent claims identity and similarity between the contested goods.
34. On the other hand, the applicant denies any identity/similarity but only for part of the goods, i.e. *“Toy furniture; European style dolls ; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes.”* Again, in this instance, it is noted that the proprietor without putting forward a blanket denial for the competing specifications, is deemed to have accepted the applicant’s contentions in relation to the rest of the competing terms.²

² Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states:

“The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets

However, even for those goods where similarity has not been denied, I will need to assess the degree of similarity between the goods.

Toy animals; Toys for dogs; Puppets; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle

35. The above terms are identical to the applicant's, as they are identically worded.
36. For the rest of the contested terms, namely "*Dolls' clothes; Toy furniture; Bath toys; Baby playthings; Toy cars; European style dolls; Dolls for playing; Talking dolls; Dolls*", I adopt the same findings made at paragraphs 26-31 above.

Average Consumer and the Purchasing Act

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

"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 word 'average' denotes that the person

out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a "blank" defence would lead to the whole of the Claimant's case being admitted."

is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

38. The Class 28 goods at issue cover largely toys aimed at children, animal toys, and a range of other items, including artificial Christmas trees, candle holders for Christmas trees, fish hooks and fishing tackle. The average consumer of the goods will be a member of the general public. In relation to the goods aiming children, it is more likely that adults would be making the purchase given the age group that plays with toys. Such goods can be selected from stores, including specialist ones, brochures, catalogues, and online. In retail premises, the goods will be displayed on shelves, where they will be viewed and self-selected by consumers. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment. The average consumer will pay an average degree of attention, or less for low-cost toys/items.


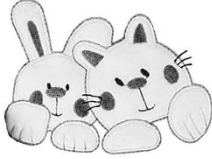
Comparison of Trade Marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not 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.”

40. 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.

41. The marks to be compared are:

Applicant's Mark	Proprietor's Marks
<p style="text-align: center;">REBORN</p>	<p style="text-align: center;"><u>'683 Mark</u></p>  <p style="text-align: center;">lifelike reborn</p>
	<p style="text-align: center;"><u>'700 Mark</u></p>  <p style="text-align: center;">reborn dolls</p>

Invalidation no. 504107 to Registered Mark '683

Overall Impression

42. The applicant's mark is the single worded mark "REBORN" presented in upper case and standard typeface. Registration of a word mark protects the word itself.³ The overall impression of the mark lies in the word itself.
43. In relation to the proprietor's mark '683 mark, it consists of both word and figurative elements. At the centre of the mark, there is a prominent device, which is a grayscale drawing of a teddy bear (toy). Underneath it, there are the word elements "lifelike reborn", presented in bold and lowercase and in a standard typeface. I note that the proprietor contends that: "*[t]he later mark would be seen by the average consumer an extremely distinctive device of a teddy bear above the descriptive phrase "lifelike reborn" which would be seen as phrase describing an attribute of the goods and not as an indication of trade origin.*" I do not entirely agree with the proprietor's approach regarding the distinctiveness of the mark. It is my view that the device will be highly allusive for toys. Also, in the absence of evidence, I do not accept that both word elements will be descriptive. In more detail, the first word element, "lifelike", will be seen as having a descriptive quality, for example, a lifelike version of the goods, as opposed to the word "reborn", which will be the most distinctive element in the mark, indicating trade origin. Nevertheless, as a rule of thumb, I consider that more attention is paid to the beginnings of marks.⁴ Moreover, I also note that the eye will be drawn to the verbal elements of the mark as the average consumer more easily refers to marks by the word(s) than by describing a figurative element.⁵ For the above reasons, both the device and the verbal

³ See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

⁴ *El Corte Inglés, SA v OHIM (MUNDICOR)*, Cases T-183/02 and T-184/02, paragraphs 81-83.

⁵ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

elements “lifelike reborn” make a roughly equal contribution to the overall impression.

Visual comparison

44. Visually, the competing marks share the common element “REBORN”. Thus, the common presence of the same word creates a strong point of similarity. There are, though, various visual differences between the marks. I bear in mind that the beginnings of words tend to have more impact than the ends.⁶ In particular, the proprietor’s mark consists of two word elements, “lifelike reborn”, and there is no counterpart of the first word element ‘lifelike’ in the applicant’s mark. Another point of visual difference is the presence/absence of the prominent teddy bear device in the competing marks. Taking into account the above factors, including the overall impression of the competing marks, I find that the degree of visual similarity falls somewhere between low and medium.

Aural comparison

45. The applicant’s mark is a two-syllable word which will be articulated as “REE-BAWRN”. The proprietor’s mark contains two verbal elements, which will be pronounced as “LYF-LYK REE-BAWRN”. The competing marks share the common verbal element “REE-BAWRN”. However, there is no phonetic counterpart for the word element “LYF-LYK” in the applicant’s mark. Further, I do not consider that the average consumer will attempt to articulate the figurative element of the proprietor’s mark. I find that there is a medium degree of aural similarity.

⁶ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Conceptual comparison

46. The applicant claims that:

“Conceptually, the Earlier and Contested Marks are identical. Reborn means to be born again, to be regenerated or revived and will be understood as such by the average consumer. The addition of the word LIFELIKE to the Contested Mark merely seeks to describe a characteristic of the relevant goods, namely they are very realistic. It is likely the average consumer would view the Contested Mark as a sub-range.”

47. The proprietor contends that:

“1.2.4. The earlier mark would be seen as comprising the English word REBORN, meaning born again, or the acts of regenerating, reviving or bringing something back to life or activity e.g. "my toy pedal car was reborn after I painted it" or "I felt reborn after playing with my inflatable bath toy".

See the following link:

<https://www.merriam-webster.com/dictionary/reborn>

1.2.5. Also, evidence will be provided at a later stage of the proceedings that REBORN is a term of the art widely used to describe a kind of life-like toy doll and associated goods.

1.2.6. The later mark would be seen by the average consumer as an extremely distinctive device of a teddy bear above the descriptive phrase "lifelike reborn" which would be seen as a phrase describing an attribute of the goods and not as an indication of trade origin. The meaning of the word reborn is explained above in relation to the earlier mark and the preceding word lifelike simply conveys the message that the goods are regenerated, revived or brought back to life in a lifelike manner or to appear lifelike. Also, evidence will be provided at a later

stage of the proceedings that the phrase LIFELIKE REBORN is a term widely used in relation to life-like toy dolls and associated goods.”

48. The word “REBORN” in the applicant’s mark is a well-known dictionary word that the average consumer will understand immediately, conveying the concept of being born again. Although the proprietor claims that the term “REBORN” is descriptive, I disagree. This is because, in this case, and in the absence of the evidence the proprietor said it would file, I conclude that the word “REBORN” is used as a metaphor with no element of the goods being described as such. As a result, it is my view that the applicant’s mark will not be conceptualised “as an attribute of the goods”, as per the proprietor’s contentions. Such a claim goes one step further in the conceptualisation process, which requires intellectual analysis or time to reflect on the mark.

49. The verbal elements “lifelike reborn” in the proprietor’s mark are dictionary words that the average consumer in the UK will readily understand. Both parties made contentions as to the descriptiveness of the terms. However, in the absence of evidence, I will rely on the ordinary and literal meaning of the words. The verbal element “lifelike” will be construed as something made to look real, and the word “reborn” will have the same meaning described in the previous paragraph. Together these words will be conceptualised as something that was brought to life to look real. The competing marks overlap in the concept stemming from the word ‘reborn’. However, they differ in the absence/presence of the word “lifelike”, which has a descriptive quality. Further, while introducing a conceptual difference, the teddy bear device will be conceptualised as such, alluding to the registered toy goods as noted previously in this decision. Taking into account all the above, including the overall impressions, I find that the degree of conceptual similarity falls between low and medium.

Invalidation no. 504108 to Registered Mark '700

Overall Impression

50. I adopt the same finding at paragraph 39 above, namely the overall impression of the applicant's mark lies in the word "REBORN" itself.
51. The proprietor's '700 mark is a composite mark containing both figurative and verbal elements. The prominent figurative element comprises a grayscale drawing of two animal figures, namely a cat and a rabbit, positioned at the centre of the mark. The verbal elements "reborn dolls" are placed underneath the device and appear in bold, lower case, and standard typeface. The first word element, "reborn", will be the most distinctive element of the mark, with the second word element, "dolls", being descriptive of some of the goods. For the same reasons delineated previously, both the verbal and the figurative elements make a roughly equal contribution to the overall impression.

Visual comparison

52. The proprietor's mark incorporates the whole of the applicant's mark, "reborn", comprising the first word element of the mark. I, again, bear in mind here as a rule of thumb that the beginnings of words tend to have more impact than the ends. Points of visual difference arise from the presence of the prominent device and the additional second word element, "dolls", in the proprietor's mark. Taking all the factors into account, including the overall impression, I find that the degree of visual similarity falls somewhere between low and medium.

Aural comparison

53. As shown above in this decision, the earlier mark will be pronounced as "REE-BAWRN". The first word element, "REE-BAWRN", in the proprietor's mark will be identically pronounced as in the applicant's mark. However, the second word element, "DOLZ", in the proprietor's mark introduces a

phonetic difference. In addition, I do not consider that the average consumer will attempt to articulate the figurative element of the proprietor's mark in this instance. Therefore, I find that the degree of aural similarity falls somewhere between medium to high.

Conceptual comparison

54. The applicant claims that:

[...] The word dolls is descriptive and non-distinctive and will be overlooked by the relevant consumer. The logo element is a non-distinctive representation of cartoon creatures which will be overlooked by the consumer.

[...]

Conceptually, the Earlier and Contested Marks are highly similar. The Contested Mark is likely to be viewed by the average consumer as a range of dolls offered under the client's REBORN brand.

55. The proprietor contends the following:

"1.2.6. The later mark would be seen by the average consumer an extremely distinctive device comprising adjacent caricatured faces of a rabbit and a cat disposed above the descriptive phrase "reborn dolls" which would be seen as phrase describing an attribute of the goods and not as an indication of trade origin. The meaning of the word reborn is explained above in relation to the earlier mark and the subsequent word dolls simply conveys the message that the goods are connected with dolls: it is common for brands of toy dolls to have other goods that share the same brand, with the goods either being accessories for the dolls or having their own commercial existence. Also, evidence will be provided at a later stage of the proceedings that the phrase REBORN DOLLS is a term widely used in relation to life-like toy dolls and associated goods."

56. The first word element, “reborn”, which is also the common element between the competing marks, will be construed as having the same meaning delineated previously in this decision (paragraph 48). The second word element, “dolls”, is a commonplace word that will be understood as descriptive of some of the goods. Together these words would potentially convey the meaning of dolls brought to life. The figurative element, in this instance, will be conceptualised as the drawings of a cat and a rabbit. Despite the differences emanating from the presence/absence of the word element “dolls” and the device element, I find that the degree of conceptual similarity falls between low and medium.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

58. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
59. The applicant has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the applicant’s mark to consider. The applicant’s mark is the ordinary and dictionary word “REBORN” with the meaning identified earlier in this decision. As the mark is comprised of one plain word, its distinctiveness lies in the word itself. The earlier mark has no real suggestive or allusive significance in relation to the goods for which it is registered. I find that the degree of inherent distinctiveness will be medium.

LIKELIHOOD OF CONFUSION

60. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁷ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

⁷ See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁸

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
62. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.C., sitting as the Appointed Person, explained that:

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

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark

⁸ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.⁹

63. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

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

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there

⁹ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

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

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

64. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
65. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of

a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

66. Earlier in this decision I have concluded that:

- the goods at issue range from identical to between a medium to high degree of similarity;
- the average consumer is a member of the general public. The level of attention paid will be average, or less for low-cost goods. The selection process is predominantly visual without discounting aural considerations;
- re proprietor's mark '683 and the applicant's mark: the degree of visual similarity falls somewhere between low and medium, aurally similar to a medium degree, and the degree of conceptual similarity falls somewhere between low and medium;
- re proprietor's mark '700 and the applicant's mark: they are visually similar to between a low and medium, the degree of aural similarity falls somewhere between medium to high, and the degree of conceptual similarity falls between low and medium;
- the earlier mark is inherently distinctive to a medium degree.

Registered mark '683

67. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion even for identical goods. Notwithstanding the principle of imperfect recollection, the average consumer would not overlook the presence/absence of the prominent teddy bear device and potentially the additional word element "lifelike" by virtue of their position and size in the proprietor's mark. Therefore, the average consumer will not mistakenly recall or misremember the competing marks as each other.
68. Nevertheless, I consider the marks would be indirectly confused. Having identified that the marks are different, the consumers will assume that the respective marks originate from the same or economically linked undertakings. This is because the common word element, "REBORN/reborn", will have an independent distinctive role within the contested mark that will lead the average consumer to confuse the marks. While noticing the highly allusive teddy bear device in the proprietor's mark, the average consumer may consider the proprietor's mark to be a brand extension or a sub-brand of the applicant's with the addition of a device and a descriptive word element ("lifelike"). In these circumstances, having carried out the global assessment required, I find that the average consumer would assume a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings. This finding extends to the goods for which I found any degree of similarity.

Registered mark '700

69. Weighing up all the factors, I am satisfied that there is no likelihood of direct confusion for identical goods. Similarly, in this case, there are sufficient differences between the marks to guard against the average consumer mistaking one mark for the other, even where the goods are identical. I find that there is no likelihood of direct confusion.

70. Turning to indirect confusion, there is a likelihood of indirect confusion for the respective identical goods. In particular, while the average consumer will identify the difference in the marks, they will recognise the shared word element “REBORN/reborn”, which has an independent distinctive role and is the first verbal element in the contested mark. Bearing in mind my assessment of the overall impression and the role each element plays within the marks as wholes, when coming across the respective marks, I find that the average consumer will consider that the same provider is responsible for the goods and that the registered mark could be a brand extension or a sub-brand, succeeded by a descriptive (for some goods) or informative word element, namely “dolls”, along with a device. Therefore, I find that the average consumer would assume a commercial association between the parties, believing that the respective goods come from the same or economically linked undertakings. This finding extends to the goods for which I found any degree of similarity.

OUTCOME

71. Both of the applications for invalidation have been successful in full. **The registered trade marks are declared invalid, subject to an appeal against this decision, with effect from 9 December 2020 for all the goods for which they are registered, and the registrations will be cancelled.**

COSTS

72. The applicant has been successful and is entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official opposition fees	£400
Filing applications for invalidation and considering the counterstatement	£400
Total	£800

73. I, therefore, order OUCHI TRADING LIMITED to pay CHEN YONG ZHOU the sum of £800. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of March 2023

Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General