

O-417-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2549530  
BY GOSHEN SKINCARE LTD FOR THE SERIES OF TRADE MARKS:**



**GOSHEN SKINCARE**



**GOSHEN SKINCARE**

**AND**

**OPPOSITION THERETO (NO 100914) BY E. TJELLESEN A/S**

## **THE BACKGROUND AND THE PLEADINGS**

1) On 7 June 2010 Goshen Skincare Ltd (“GSL”) applied for the following series of two trade marks for the following goods in class 3:



Baby creams and shampoo, nappy balm, moisturisers, body butters, massage oils and soaps

The application was published in the Trade Marks Journal on 2 July 2010.

2) E. Tjellesen A/S (“ETAS”) opposes the registration of the above application. Its opposition was filed on 2 September 2010 under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The earlier marks/signs relied upon by ETAS consist either of the words GOSH or GOSHA. It should be noted that for earlier marks that have been registered for more than five years as of the date of publication of GSL’s application, there is a requirement to show that they have been genuinely used (otherwise they cannot be relied upon). This is in accordance with section 6A of the Act. The GOSH marks fall into this category; ETAS made a statement that it had used its mark in relation to: soaps, perfumery, essential oils, cosmetics, hair lotions. The GOSHA marks (two are relied upon) do not fall into the proof of use category and, therefore, there is no requirement to prove that they have been used; they may be taken into account for their specifications as registered.

3) GSL filed a counterstatement denying the grounds of opposition. It made detailed comments as to why ETAS’ case should fail. I will come back to its arguments later. GSL did not specifically request that ETAS provide proof of use in relation to its GOSH mark. In the absence of such a request then ETAS’ statement of use should be accepted; the earlier GOSH marks may be taken into account for the goods identified in the statement of use.

4) Both sides filed evidence. The matter then came to be heard before me on 7 October 2011 where ETAS were represented by Mr Martin Krause of Haseltine Lake; Ms Pamela Orji attended the hearing on behalf of GSL.

## **THE EVIDENCE**

### ***ETAS' evidence***

5) ETAS filed two witness statements. The first relates to the use that has been made of its GOSH mark. For reasons that will become apparent, it is not necessary to summarise this evidence. The other witness statement comes from Ms Elizabeth Lowe of Haseltine Lake, the firm which represents ETAS in these proceedings. The evidence includes extracts from the websites of four companies (Bodyshop, Boots, Avon, and a Swedish company called Oriflame) showing that they offer products ranging from traditional make-up, to body and skin care preparations. The Boots results were compiled after searches on the website were undertaken in respect of the terms "make-up", "skin-care" and "body care". The evidence shows that many of the products overlap in more than one area. Also filed were two decisions, one of the Second Board of Appeal of OHIM<sup>1</sup>, the other an OHIM opposition decision. These are filed to support the claim to goods similarity. Whilst the decisions are noted, they are not binding on me. ETAS also filed written submissions which I bear in mind but will not summarise here.

### ***GSL's evidence***

6) The evidence is given by Ms Orji, GSL's director. She refers to GOSHEN being a biblical name and that this is what led to its mark being adopted. Ms Orji provides the results of market research relating to the opposition. It includes side by side comparisons of ETAS' GOSH (as used) mark and GSL's GOSHEN marks. Comparisons are made of how the marks are used on websites and what the respective packaging looks like and comparisons are made between the exact goods of the parties, including marketing strategies etc.

7) Ms Orji refers to a survey that she conducted "to ask people randomly if they were likely to confuse the two marks". There is no methodology set out. There is no explanation of how the participants were selected. The questions were asked on the basis of the compared uses detailed in the preceding paragraph.

8) Evidence is also provided as to the different categorisations of cosmetic products and that certain products are classified as make-up, others as skin care, others as baby products etc. This seems to be from a US based website. The evidence also relates to the differences between organic and non-organic products. Finally, evidence is provided showing other marks on the register that include the letters GOSH including **GO SHOP DIRECT**, **alergoshop** [emphasis added to both] and some marks which have GOSH as a dominant element. The rest of the evidence contains submissions which I bear in mind but will not summarise here.

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<sup>1</sup> OHIM is the office that administers the Community Trade Mark system.

## **SECTION 5(2)(b)**

9) I will begin by considering the position with respect to the earlier GOSHA mark(s). I do so because even though ETAS claim that its GOSH mark has a reputation (which could increase the likelihood of confusion), the word GOSH has a clear meaning which is not shared by GSL's mark (which is likely to decrease the likelihood of confusion). I consider the strongest earlier mark to be GOSHA.

### **The law**

10) Section 5(2)(b) of the Act reads:

“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.”

11) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

## The average consumer

12) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

13) The goods concerned are not specialist ones and will be purchased by members of the general public. With respect to baby products, the goods will be selected, in most cases, by a parent. Such goods are likely to be selected from a shelf in a supermarket or other store such as a chemist, or their on-line equivalents. The visual similarity/dissimilarity may, therefore, be of slightly more importance. I say slightly because, particularly in the field of certain types of cosmetics, manned counters are often used with the consumer asking for a particular product; aural similarity/dissimilarity will be fully borne in mind. The cost of the goods is, generally speaking, not particularly high. Some goods buck this trend, such as designer perfumes or new innovation face creams. However, this is not always the case and cheaper versions of such products are also available. In view of all this, the degree of consideration utilised by the average consumer will not be higher than the norm. However, it is to be born in mind that the average consumer is still deemed to be reasonably well informed and reasonably circumspect and observant.

## Comparison of goods

14) In terms of the comparison to be made, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

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

15) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

“(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.”

16) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>2</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>. Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play<sup>4</sup> even if there may be other goods within the broader term that are not identical.

17) GSL’s goods are:

Baby creams and shampoo, nappy balm, moisturisers, body butters, massage oils and soaps.

18) ETAS rely on the following goods of its GOSHA earlier marks:

Soaps, perfumery, essential oils, cosmetics, hair lotions

19) Reference was made to the earlier GOSHA marks being registered in respect of the class heading for class 3 (except for the term “deodorants for personal use”) and, as such, it covers all of the goods in the class except for deodorants for personal use. Whilst the issue of class headings (and what they

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<sup>2</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>3</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>4</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

cover) is currently before the CJEU in the *IP TRANSLATOR* case, the fact remains that the specification registered is not the class heading and, therefore, the argument put forward is untenable. Furthermore, ETAS clearly pleaded upfront what goods in its specification it relied upon (as set out above) and it would be wrong to consider any wider claim now.

20) How similar the goods are (if at all), may affect whether there exists a likelihood of confusion. I will therefore go through the goods applied for by GSL term by term (although not necessarily in the order set out above).

### Soaps

21) ETAS' earlier mark also covers soap. **The goods are identical.** GSL accepts this.

### Moisturisers

22) As the name suggests, moisturisers hydrate the skin, be it of the face or the body. ETAS' primary argument relating to goods similarity is based on the term "cosmetics" which it considers broad enough to include moisturisers within its ambit. A cosmetic is a preparation, the purpose of which is to beautify the face or body, in other words to have a positive cosmetic impact on the user. Whilst cosmetics such as lipstick, mascara and eye shadow may be the first and foremost type of goods that come to mind, I do not consider that this is all the term covers. For example, preparations which have the intended effect of reducing wrinkles would be classified as a cosmetic preparation given that it aims to have a cosmetic impact on the appearance of the user; this is another example of a cosmetic. It is noted that in the decision of Mr Justice Neuberger in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* it was held, on the facts of that case, that a dry skin lotion was a cosmetic.

23) Much of Ms Orji's submissions were focused on the actual goods of the parties and that, for example, GSL's goods were natural creams and lotions for moisturising the skin as opposed to ETAS' goods which were products found in the make-up area. Whilst this is noted, I must make an objective assessment of the goods in question rather than an assessment of the parties' current goods and/or marketing methods. To that extent, whilst a moisturiser performs a hydrating role, a purpose of a moisturising function is to improve the appearance of the skin. Bearing in mind my earlier observations regarding the scope of the term cosmetics, I consider that a moisturiser is a form of cosmetic product. **The goods must therefore be identical.**



### Body butters

24) Body butters perform a similar (perhaps even an identical role) to a moisturiser. As such, my previous assessment applies. **The goods are identical, or at least highly similar.**

### Baby creams

25) Even though for babies (although adults could also use the product) the goods strike me as akin to moisturisers and, for similar reasons, fall within the ambit of cosmetics. **The goods are identical or, even if I am incorrect then I consider such goods to be highly similar to cosmetics.**

### (Baby) shampoo

26) It is unclear whether the construction of the specification limits the shampoo in question to being for babies or whether it is shampoo generally. It could be read both ways. Either way, ETAS have protection in respect of hair lotions. There seems to me to be an obvious point of similarity in terms of nature, method of use and purpose. **The goods are highly similar.**

### Nappy balm

27) Nappy balm is applied to a babies' bottom primarily to sooth skin or to act as a barrier cream. These do not strike me, so obviously, as cosmetics; if they do perform cosmetic functions there is no evidence of this. There is some similarity in that such goods are cream-like and are applied to the body, as are certain cosmetics such as moisturisers and other body lotions/creams. The method of use will be similar, being applied by hand to a particular part of the body. The fact that the term cosmetics would also include within its ambit cosmetic preparations for babies means that the goods may all be used on babies and, even if not found in exactly the same place in its retail setting, they are still likely to be found in reasonably close proximity (all being/including baby care products). **Overall, I consider that there to be a reasonable degree of similarity.**

### Massage oils

28) The earlier mark covers essential oils which are concentrated extracts of plants etc. They are used in aromatherapy and in massage. Whilst such goods are unlikely to be massaged directly into the skin, they are likely to be added to base oil. This could be done during the manufacturing process, or bought separately and combined at home (or by a business). As such, there is a similarity in purpose and in nature (both being oily in nature). There seems to me to be an obvious complementary relationship. **I consider the goods to be highly similar.**

29) In summary, all of GSL's goods (other than nappy balm) are identical or highly similar to goods covered by the earlier mark; nappy balm is, though, still reasonably similar to goods covered by the earlier mark.

**Comparison of the marks**

30) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

ETAS' mark	GSL' mark
GOSHA	

31) ETAS' mark does not separate into distinctive and dominant components. It is a single element mark. GSL's mark is made up of a device element with the words GOSHEN SKINCARE below it. In the non-coloured version the words are larger (in comparison to the device element) than they are in the coloured version. However, the difference in significance is minor. Whichever of the applied for marks are considered it seems to me that both elements are distinctive and both play roughly an equal role in the overall impression of the marks. It should also be noted that the colour in the first mark cannot act as a significant point of difference with the earlier mark given that the earlier mark is not registered with regard to any particular colour<sup>5</sup>.

32) In terms of the visual similarities/differences, the clearest point of difference resides in the addition of a prominent and distinctive device element. There is, though, a similarity on the basis that the verbal element of GSL's mark shares the first four letters of ETAS' earlier mark. The verbal element does, however, have an E rather than an A, an additional N, and an additional word (SKINCARE); it

<sup>5</sup> See to that effect *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08 and, also, the judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch)).

must be acknowledged, though, that the word SKINCARE is totally descriptive and, consequently, this is not a particularly significant difference. I come to the view that the differences do not outweigh all similarities, but that any degree of similarity must be assessed as of only a moderate degree.

33) In terms of aural similarity, the device element (even though it is possible to decipher a letter G) is unlikely to be pronounced. In my view, the marks will be referred to and pronounced as GO-SHUH (or GOSH-UH) and GO-SHUN (or GOSH-UN) SKINCARE (the “e” in GOSHEN and the “a” in GOSHA both having an U sound). There is a possibility that GOSHEN will be pronounced as GO-SHEN, but, even then, I do not consider that this alters the comparison to any significant extent. The addition of the word SKINCARE will do little to assist in differentiation given the descriptive meaning of this word. More focus will be placed on GOSHEN. When this is borne in mind, together with the way in which the marks are likely to be pronounced, I consider there to be a reasonably high degree of aural similarity.

34) In terms of conceptual similarity, for a conceptual meaning to be relevant it must be one capable of immediate grasp<sup>6</sup>. Such assessment must, of course, be made from the perspective of the average consumer. The average consumer cannot be assumed to know the meaning of everything. In the *Chorkee* case (BL O-048-08), Anna Carboni, sitting as the Appointed Person, stated in relation to the word CHEROKEE:

“36. ....By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one’s own personal experience, knowledge and assumptions are more widespread than they are.

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the

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<sup>6</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.”

35) In terms of the word GOSHA, this has no meaning. The average consumer will perceive it as an invented word. In terms of the applied for marks, whilst the device element can be analyzed and it could be seen as a leaf with a tail surrounding a stylized letter G, this will only be seen following analysis, it is not something that would be immediately grasped. In relation to the words GOSHEN SKINCARE, GOSHEN is, as a matter of fact, a word relating to a biblical land. It may also be a geographical name of certain places in the US. Whilst Mr Krause accepted that this was the case, he did not accept that the word GOSHEN would be known by the average consumer. Ms Orji argued to the contrary, suggesting that it was a generally well-known word. The caution expressed by Ms Carboni in *CHEROKEE* applies in this case. The word GOSHEN does not seem to me to be the type of word that would be generally known. It is not used in common parlance and even members of the public with a more religious background may not generally refer to GOSHEN. There is no evidence to the contrary. It cannot be accepted that the average consumer in the UK will know of the word GOSHEN. The net effect of this is that neither mark has any conceptual meaning capable of immediate grasp, with a consequence that there is neither conceptual similarity nor dissimilarity.

### **The distinctiveness of the earlier GOSHA mark**

36) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). There has been no use of the GOSHA mark so I have only the inherent characteristics of it to consider. From this perspective, GOSHA, as already observed, will be perceived by the average consumer as an invented word. It is the type of mark entitled to a high degree of distinctive character.

### **Likelihood of confusion**

37) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

38) It is noted that much of Ms Orji's submissions focused on the actual marketplace, highlighting ETAS' marketing methods, locations in the retail environment, goods sold, in comparison to those of GSL. Examples of the mark on packaging have been provided. Whilst this is all noted, the test to be applied, as Mr Krause submitted, is a notional one. I must consider notional and fair use of the respective marks for the respective goods (as applied for by GSL and as registered by ETAS), setting aside marketing methods etc. Much of the submissions also focused on GOSH rather than GOSHA. All of these criticisms follow through to the random survey Ms Orji conducted. In relation to the other marks on the register which contain similar letters are not relevant because they do not show the position in the marketplace; many are also very different trade marks from the marks at issue here.

39) I have found the marks to be visually similar but only to a moderate degree, aurally similar to a reasonably high degree, with no conceptual similarity or difference. With the exception of nappy balm, I have found the goods to be identical or highly similar, but nappy balm is still reasonably similar to goods contained within the earlier mark. I have found the earlier mark to possess a high degree of inherent distinctive character. Imperfect recollection must also be borne in mind given that marks are rarely seen side by side. The imperfect recollection of them in the mind of the average consumer is something to bear in mind. This is particularly so in this case given that the goods are not highly considered purchases and given that neither mark has a concept. The latter point is relevant because if neither mark has a concept then the mark has a greater capacity to be imperfectly recalled because there is no conceptual trigger for the average consumer to rely on. Whilst the device element of the applied for mark is borne in mind (and the absence of any form of device in the earlier GOSHA mark) and that this may mean that the average consumer would not directly mistake one mark for the other, the imperfect recollection of the verbal elements may nevertheless lead to the average consumer still believing that the goods come from the same or an economically related undertaking. This is all the more likely given the high degree of inherent distinctiveness of the earlier mark and the identical/close relationship between the goods. For all these reasons I conclude that there is a likelihood of confusion in respect of identical/highly similar goods. I extend this finding to nappy balm as, even though such goods may have differing purposes, the products in question (in comparison to cosmetics which could include cosmetic preparations for babies) are still reasonably similar and weighing all the relevant factors the average consumer is likely to believe that the respective products are from the same economic source. The opposition succeeds under this ground.

40) Given my earlier comments about GOSHA being the strongest earlier mark, there is no need to consider the other mark and the other ground of opposition. ETAS will be in no better position.

## **COSTS**

41) ETAS has been successful and is entitled to a contribution towards its costs. I hereby order Goshen Skincare Ltd to pay E. Tjellesen A/S the sum of £1500. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement*  
£300

*Opposition fee*  
£200

*Filing evidence and considering GSL's evidence*  
£500

*Attending the hearing*  
£500

42) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 25<sup>th</sup> day of November 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**