

O-448-13

**TRADE MARKS ACT 1994**

**In the matters of application no 2583035**

**by Technopharma Limited**

**to register the trade mark:**

**NEW YORK FAIR & LOVELY**

**and the opposition thereto**

**under no 102865**

**by Unilever Plc and Unilever NV**

**and application no 2346305**

**by Unilever Plc**

**to register the trade mark:**



**and the opposition thereto**

**under no 92847**

**by Technopharma Limited**

**Mr Christian Rowland Buehrlen of Beck Greener appeared on behalf of Technopharma Limited.**

**Ms Angela Fox of RGC Jenkins & Co appeared on behalf of Unilever Plc and Unilever NV.**

**Hearing date: 10 October 2013.**

1) On 28 November 2002 Technopharma Limited (Technopharma) applied to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) to register the trade mark NEW YORK FAIR & LOVELY. As a result of an opposition filed by Unilever NV (NV), the application was refused based upon an earlier Italian trade mark registration. An appeal against the decision was rejected by the Second Board of Appeal. Technopharma converted the application to national applications for the Benelux, Germany, Spain, France and the United Kingdom. The application for conversion was made on 28 March 2011. The United Kingdom application was published on 7 October 2011 with the following specification:

*Toilet preparations; preparations for the care of the skin, scalp and the body; preparations for toning the body; skin cleansers; dermatological preparations and substances; perfume, eau de cologne, toilet water; talcum powder; gels, foam and salts for the bath and the shower; soaps; body deodorants; cosmetics; creams, milks, lotions, gels and powders for the face, the body and the hands; sun care preparations; make-up preparations; aftershaves; shaving foams and creams; preparations for the hair; shampoo; hair lacquers; hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use; dentifrices; anti-perspirants; deodorants for personal use; medicated preparations for the skin and hair.*

The above goods are in classes 3 and 5 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 11 October 2003 Unilever plc (Plc) applied to register the trade mark:



The application was published on 2 July 2004 with the following specification:

*Soaps; cleaning preparations; perfumery; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; hair care preparations; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing*

*preparations; petroleum jelly; 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, facial packs.*

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Technopharma has opposed the registration of Plc's trade mark under section 5(2)(b) of the Trade Marks Act 1994 (the Act), which states:

“(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.”

It relies upon its trade mark application which is the subject of these proceedings. It opposes all of the goods of the application. Technopharma claims that the respective trade marks are visually, phonetically and conceptually similar and that the dominant component of its trade mark is FAIR & LOVELY. It claims that the respective goods are identical or similar.

4) Plc denies the ground of opposition. It claims that the first and most prominent part of Technopharma's trade mark is NEW YORK. Plc claims that its trade mark consists of a combination of wording and a distinctive device and, therefore, the totality of its trade mark is distinguishable from that of Technopharma. It makes no comment on the identity or similarity of the goods.

5) Plc and NV have opposed the registration of Technopharma's trade mark under sections 3(6), 5(4)(a) and 5(2)(b) of the Act. Section 3(6) of the Act states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Section 5(4)(a) of the Act states:

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

6) Plc and NV claim that since 1978 they, or their predecessors in title or companies forming part of the same corporate group, have manufactured and sold a range of skin care products, including skin lightening products and preparations, under the brand name FAIR & LOVELY. They claim that their FAIR & LOVELY products are, and were at the date of the filing of Technopharma's application, one of the world's best-selling brands of skin lightening products and preparations. Plc and NV claim that they have either sold the products directly or through independent distributors in the United Kingdom since 1988. Plc and NV claim that since prior to 28 November 2002, their FAIR & LOVELY products have been sold in soft pink and white packaging (with design modifications over the years) and the words FAIR & LOVELY have been, and continue to be, depicted in a stylised cursive script.

7) Plc and NV claim that Technopharma's trade mark is closely similar to FAIR & LOVELY, “containing indeed the whole of that mark and adding only the non-distinctive geographical identifier, NEW YORK”. They claim that the respective goods are identical or similar to those in relation to which their FAIR & LOVELY trade mark has been used.

8) Plc and NV claim that use of Technopharma's trade mark would be liable to be prevented under the law of passing-off.

9) Plc and NV claim that, as of 28 November 2002, their FAIR & LOVELY “brand” was a well-known trade mark in the United Kingdom within the meaning of section 56(1) of the Act and registration of Technopharma’s trade mark would be contrary to section 5(2)(b) of the Act.

10) Plc and NV claim that the goods of interest to Technopharma are skin lightening products and preparations. They claim that the packaging that Technopharma uses in the United States imitates the soft pink and white colour scheme of their product and that the words FAIR & LOVELY are presented in a stylised cursive script, “reminiscent” of that used by Plc and NV.

11) Plc and NV claim that the market in skin lightening products is a niche one and that it is highly implausible that Technopharma was not aware of Plc and NV’s FAIR & LOVELY brand when it adopted its trade mark. Plc and NV claim that Technopharma intended to “lure in” consumers familiar with Plc and NV’s product and trade dress; thereby profiting from Plc and NV’s substantial reputation. Plc and NV claim that these alleged actions represent an act of bad faith. Plc and NV also claim that Technopharma had no bona fide intention to use its trade mark itself or with its consent for all or any of the goods of the application; consequently, the application was made in bad faith on this basis also. (At the hearing Plc and NV did not rely upon the absence of an intention to use as a stand-alone ground but as part of a claim that the application was made to block Plc and NV’s use of their trade mark. As the application is a conversion, there was no requirement of intention to use and no such intention could be required, as per article 114(2) of the Community Trade Mark Regulation. Decision BL O/093/13 deals with this issue.)

12) In its counterstatement, Technopharma states that its OHIM application was the subject of separate oppositions by Plc and NV. It states that the former opposition was rejected but that the latter opposition was successful on the basis of an earlier Italian right. Technopharma claims that the opposition should be dismissed on grounds of cause of action estoppel, or issue estoppel, or abuse of process, as the application was filed nearly 10 years ago. Technopharma also claims that as Plc and NV had failed to request an extension of time to the opposition period, as per rule 17 of the Trade Marks Rules 2008, the opposition should be dismissed or NV should be dismissed as an opponent. (On form TM7A only Plc was listed as an opponent.) At an interlocutory hearing held on 11 September 2012, the claims of estoppel and abuse of process were dismissed; reasons were given in the official letter of 12 September 2012. At the interlocutory hearing, Technopharma confirmed that the joint opponent issue had abated and that the opposition would be able to continue under section 3(6) of the Act.

13) Technopharma denies all the claims of Plc and NV and put them to proof in respect of the claims.

14) Technopharma claims that the words FAIR & LOVELY on their own are devoid of any distinctive character and have no reputation or goodwill in the absence of added matter. It claims that if a reputation, goodwill or distinctiveness does exist, it is not merely in the words FAIR & LOVELY but in the soft pink and white packaging and stylised cursive script.

15) Technopharma admits that it is in the business of skin lightening products but denies that use of soft white or pink, which are the customers' desired skin colour, constitutes an imitation.

#### *Evidence for Technopharma*

16) This consists of two witness statements made by Michel Maurice Farah, dated 26 May 2005 and 9 January 2013. Mr Farah is a director of Technopharma. He is also a director of the Mitchell Group of Companies which includes Technopharma.

17) Technopharma changed its name from Peter Nailsworth (Pharmaceutical Products) Limited in October 2003.

18) Mr Farah states that Technopharma uses the trade mark NEW YORK FAIR & LOVELY in relation to skin care products including soaps, body lotions, face creams, sun blocks, cleansing milks and skin lightening creams. Examples of packaging are exhibited at MMF1; these are for exfoliating soap, skin lightening cream and body clearing milk. There is no indication as to from when the packaging emanates. The packaging states that the products were made in France. The help line telephone number, 1 888 726 6211, does not appear to be a United Kingdom number. The trade mark is used in the following format:



There is no indication on the packaging that the products have been approved for sale in the European Union.

19) Mr Farah states that Technopharma first used the trade mark NEW YORK FAIR & LOVELY in the United Kingdom in mid 2001. He states that the goods are packaged in packaging bearing the trade mark NEW YORK FAIR & LOVELY in the United Kingdom and the vast majority are exported to the USA, to Caribbean countries and to Canada. Mr Farah states that a small quantity are

sold in the United Kingdom. He then states sales of the goods commenced in December 2002, despite earlier stating that the trade mark was first used in mid 2001. Mr Farah states that turnover, as of 26 May 2005, in the United Kingdom was approximately £800 per annum.

20) Mr Farah states that Technopharma spends approximately £2,000 per annum publicising the trade mark in the United Kingdom. He states that this promotional activity mainly consists in attending exhibitions. Mr Farah states that Technopharma's representative attended exhibitions at Alexandra Palace between 27 and 28 May 2001 and 30 and 31 May 2004 (after the latest material date). Mr Farah does not state what the exhibitions were and how many and what goods were exhibited at the exhibition.

21) Mr Farah states that, as of 26 May 2005, the trade mark NEW YORK FAIR & LOVELY was mainly used for goods sold outside of the United Kingdom but that there are plans afoot to increase sales in the United Kingdom.

22) Mr Farah states that NEW YORK FAIR & LOVELY goods are primarily aimed at African-Caribbean women. He gives the retail value of exfoliating soap, skin lightening cream, body cleansing milk, serum, face cream and sun block in the United Kingdom as of 26 May 2005. Mr Farah states that, at 26 May 2005, NEW YORK FAIR & LOVELY products were sold in the United Kingdom in pharmacies, chemist shops, the body care sections in supermarkets and general stores catering to the African-Caribbean community. He does not identify any specific stores.

23) Mr Farah states that he has been in "the business of skin lightening products for over 25 years". He states that such products are very popular in India and that a wide range of these products use the term FAIR in their trade marks. Mr Farah states, at 9 January 2013, that well-known examples are FAIR & HANDSOME, FAIR & FLAWLESS, FAIR & NICE and FAIR & WHITE; exhibit MMF2 relates to this. There is nothing to indicate that any of the material exhibited relates to use or customers in the United Kingdom.

24) Mr Farah notes two decisions of the boards of appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) in which he states it has been held that the words FAIR & LOVELY are entirely descriptive because they relate to skin products that are intended to create a fair complexion.



*Evidence for Plc and NV*

*Witness statement of Stephen Francis Beale of 2 May 2008*

25) Mr Beale is trade mark council for Plc.

26) Mr Beale states that the FAIR & LOVELY product is a skin lightener sold in cream, gel and soap form; it was launched in India in 1978 and sold by Plc's Indian subsidiary, Hindustan Lever. Exhibited at SFB2 is a printout relating to Superbrands in India between 2003 and 2005, FAIR & LOVELY was classified as a Superbrand.

27) Exhibited at SFB4 is a copy of an article dated 2 March 2004 reporting that trading standards officers in London had seized a batch of FAIR & LOVELY FAIRNESS CREAM. The report states that product was labelled for sale in India and that the officers believed that the product was fake.

28) Mr Beale states that many people with immigrant communities know the FAIR & LOVELY products. He gives no evidence for this and this statement must be considered to be mere assertion. Mr Beale states that Hindustan Lever distributes FAIR & LOVELY products via an independent distributor, Ruhi Enterprises Ltd, in London. He states that Ruhi has "regularly" bought FAIR & LOVELY products from Plc for distribution in the United Kingdom. He states that these sales have been in excess of \$100,000 per year. Mr Beale does not give the position as of 28 November 2002. He refers to the goods being bought from Plc rather than from Hindustan Lever. Mr Beale gives details of the distribution of the products to shops in West Croydon, Swansea, Derby and Leicester. Again there is no identification with the dates that are pertinent to these proceedings. Material exhibited at SFB5 and SFB6 all emanates from well after 28 November 2002.

29) Mr Beale gives his view that fair and lovely are descriptive terms in relation to skin care products. Exhibited at SFB8 is a copy of a decision of the Second Board of Appeal of OHIM dated 23 November 2005 in which the Board held:

"In light of the above, the Board considers that the contested decision rightly found the term 'FAIR & LOVELY' to be descriptive of characteristics of the goods applied for and devoid of distinctive character in relation to such goods."

The application, of NV, that was rejected was for a large swathe of goods in class 3.

30) Details of two United Kingdom registrations are exhibited, in which the words FAIR & LOVELY are disclaimed.

31) Mr Beale states that from his experience in the personal care products field and as a consumer, he knows that in the United Kingdom non-medicated cosmetics and skin care products are normally selected visually by customers from self-service displays. Exhibited at SFB10 are photographs taken on 24 April 2008 of cosmetics displays in Boots the Chemists, L'Occitane, The Body Shop and Sainsbury's in Victoria, London.

32) Mr Beale states that cosmetics and skin care products can be inexpensive but can also be expensive. Exhibited at SFB11 is material showing the more expensive items.

33) Mr Beale states that products are now commonly formulated for certain skin or hair types and that this is shown on the packaging. Exhibited at SFB12 is material relating to this. Mr Beale states that the "average consumer of cosmetics now more commonly reads labels to establish, before purchase, whether the product is suitable for the buyer's skin or hair type". This may be the case but Mr Beale has put in no evidence to show the actions of the average consumer; his perception cannot be substituted for that of the average consumer. However, this is not to gainsay that this is likely to be the case.

*Witness statement of Alastair Gray of 9 November 2012*

34) Mr Gray is head of the London office of Cerberus Investigations Limited, an investigation company. In January 2012 Cerberus was instructed to carry out investigations into the use of NEW YORK FAIR & LOVELY by Technopharma. Cerberus was instructed to establish, if possible, the following:

Where and for how long Technopharma has been trading in skin lightening products.

Whether Technopharma has a NEW YORK FAIR & LOVELY range of products and, if so, the full product range, launch date and markets where sold.

Whether and in what capacity a representative of Technopharma attended Afro Hair & Beauty Show exhibitions held at Alexandra Palace from 27 to 28 May 2001 and 30 – 31 May 2004.

35) Mr Gray states that the investigation took place between 10 January 2012 and 15 February 2012.

36) A search for Technopharma Limited was conducted on Creditsafe, a company database which contains information on over 4.4 million United Kingdom companies. Technopharma was listed as non-trading. The directors were listed as Michael Farah and Lucien Chidiac. The company secretary was

listed as MW Douglas and Company Limited. The only listed shareholder was Soap-ex Sarl.

37) Profiles for Mr Farah and Mr Chidiac were interrogated on LinkedIn. Mr Farah describes himself as president of The Mitchell Group. Mr Chidiac describes himself as product development and sourcing manager at Mitchell Group USA LLC. Mr Chidiac also describes himself as being a former managing director of Technopharma NV.

38) A Google Streetview search for Techopharma's trading address at 26 Cranes Park Avenue, Surbiton was carried out. A picture of the property at this address, exhibited at AG3, shows a detached house.

39) A Google search for NEW YORK FAIR & LOVELY was conducted. Mr Gray states that none of the results of the search related to any products under the name NEW YORK FAIR & LOVELY.

40) A number of searches were conducted on the Internet using various websites. Mr Gray states that none of the searches disclosed any hits for NEW YORK FAIR & LOVELY in relation to any cosmetic products.

41) A search was conducted on the media database, HighBeam Research, which, Mr Gray states, covers over 80 million articles, press releases and publications, for NEW YORK FAIR & LOVELY. There were no hits. A search was also made on Ebiquity, an international advertising database. There were no hits from this database either.

42) It was noted that Beauty of New York was a stockist for Technopharma products. A pretext approach to Beauty of New York was made. Mr Gray states that "we" made the pretext approach. He does not identify to whom the "we" relates. A member of staff, who did not give his name, was spoken to. Mr Gray states that "we" posed as a customer for a Technopharma product called NEW YORK FAIR & LOVELY. Mr Gray states that the member of staff said that he had never heard of this product. He said that Beauty of New York sold a range of Technopharma products but that it had never sold a product under the name NEW YORK FAIR & LOVELY; adding, "[t]his is the first request I've ever had for this item".

43) Exhibited at AG5 are details in relation to the registration of NEW YORK FAIR AND LOVELY with the United States Patent and Trademark Office (USPTO). The application was filed on 22 November 2002. The first use anywhere date is given as 1 December 2003; the first use in commerce date is given as 30 November 2005. Examples of the packaging are included; the packaging has been filed as part of the allegation of use with the USPTO. The product is described as being made in Lebanon free zone under licence from Technopharma. An example of the packaging can be seen below:



44) One of the product packaging images filed in support of the United States application displays the telephone number 1 888 726 6211. A pretext call was made to this telephone number. The call was answered by a recorded message in English and Castellano. The call was eventually answered by a customer services representative who did not provide her name. "We" posed as an interested customer based in the United Kingdom but about to travel to the United States on holiday, looking for a product called NEW YORK FAIR & LOVELY. "We" asked if it was stocking the product and where it could be found, either physically or on the Internet. Mr Gray states that the call was put on hold and after a couple of minutes the person returned and stated that the NEW YORK FAIR & LOVELY range was not available in Europe. Mr Gray states that, unprompted, she added that "there is a difference" between NEW YORK FAIR & LOVELY and an unrelated product called FAIR & LOVELY, which was produced by another company. Mr Gray states that the representative said that "we" were probably thinking of the product FAIR & LOVELY and suggested that "we" search on the Internet for it. Mr Gray states that she said that it is produced in India but is also available in the United Kingdom. Mr Gray states that the representative explained that "we" could purchase FAIR & WHITE skin lightening products in the United Kingdom and gave contact details of the official distributors in the United Kingdom. The telephone number provided was 020 300 23694.

45) Mr Gray states that "we" telephoned the number. Each time a call was made there was a voice mail advising that a message should be left. "We" did not leave a message.

46) An Internet search for Mitchell Cosmetics was conducted. The website mitchellcosmetics.com was found. The website was extensively searched but no reference was found to NEW YORK FAIR & LOVELY. A historical website archive for mitchellcostmetics.com was found with archived pages dating from 10 April 2004 to 17 May 2010. All of the available pages were searched but no reference to NEW YORK FAIR & LOVELY was found. There was a reference to a skin lightening product called FAIR & WHITE.

47) A pretext approach was made to Mitchell Cosmetics Distribution on the telephone number +1 305 592 5655; obtained from the website mitchellcosmetics.com. "We" spoke to an employee who identified herself as Vanessa. Again "we" posed as a customer searching for a product called NEW YORK FAIR & LOVELY and asked where it could be found. Mr Gray states that Vanessa explained that she was in charge of the website and product distribution for Mitchell Cosmetics. Mr Gray states that she said that Mitchell did not sell any products under the name NEW YORK FAIR & LOVELY. He states that she suggested that "we" look at another product that Mitchell sold, FAIR & WHITE. Mr Gray states that she also suggested that "we" visit Mitchell's other official websites at fairandwhite.com and mitchellbrands.com or call someone identified as Dominique from Fern Mitchell Group USA LLC on +1 305 381 9890 for more information about the products that Mitchell sells.

48) Mr Gray states that "we" made a pretext call to +1 305 381 9890 and spoke to Dominique. Dominique said that Mitchell did not sell any products under the name NEW YORK FAIR & LOVELY.

49) A search of a historical website archive for fairandwhite.com was conducted, identifying archived website pages dating from 10 January 2003 to 3 February 2011. Mr Gray states that all of the available pages were searched but no references to NEW YORK FAIR & LOVELY were found. An archived page from 2003 refers to FAIR & WHITE.

50) Mr Gray states that thorough and extensive searches were made on the webpage afrohairshow.com but that no reference to Technopharma was found or to any booths or stands operated by Technopharma at the Afro Hair & Beauty Show in 2001 and 2004. (According to the company records exhibited by Mr Gray, prior to 22 October 2003, Technopharma was registered as Peter Nailsworth (Pharmaceutical Products) Limited. Mr Farah also states this in his statement.)

51) Mr Gray states that "we" made a pretext approach to Afro Hair and Beauty on the telephone number 020 7498 1795 and spoke to a member of staff who identified herself as Kadija. Kadija advised that a company called Pak Cosmetics sold Technopharma products. She was not aware of any product called NEW YORK FAIR & LOVELY, nor did she have any information on Technopharma having hosted a booth or a stand at the shows at Alexandra Palace.

52) A search for Pak Cosmetics was conducted, the website pakcosmetics.com was found. It was found that Technopharma products were available at the website but that there were no references to NEW YORK FAIR & LOVELY. Mr Gray states that "we" made a pretext approach to a Pak Cosmetics retail store in Finsbury Park, on 0207 263 2331. "We" asked if a product called NEW YORK FAIR & LOVELY was stocked or if the representative had heard of it. Mr Gray states that the representative did not recognise the name NEW YORK FAIR &

LOVELY and being asked whether the product had been available in the past, the representative said, "No, no. If we sell before, we also sell now". A pretext approach was then made to Pak Cosmetics in Wood Green, on 0208 881 2001. Mr Gray states that the representative said that the store had never sold a product called NEW YORK FAIR & LOVELY and asked if "we" were, in fact, referring to FAIR & LOVELY, which was made by Unilever.

*Witness statement of Grant Robery of 12 November 2012*

53) Mr Robery is the global trade mark counsel of Plc.

54) One of Plc's subsidiaries is Hindustan Unilever Limited (HUL), an Indian undertaking. Mr Robery states that one of HUL's best-selling skin products is the skin lightening range FAIR & LOVELY.

55) Mr Robery comments upon the profile of FAIR & LOVELY in India. He lists the countries to which FAIR & LOVELY products had been exported as of 28 November 2002. The United Kingdom is not one of them. The countries are: the United Arab Emirates, Sri Lanka, Malaysia, Mauritius, Nepal, Ghana, Uganda, Kenya, Australia, Morocco, Singapore, Israel, Turkey, Lebanon, the Maldives and South Africa. According to details exhibited at GR3 exports to the United Kingdom of FAIR & LOVELY products commenced in 2003. No details are given of the amount of sales to the United Kingdom nor as to what products were sold.

56) The evidence of Mr Robery effectively relates to the position in India. He gives information about the advertising of the products on Indian television. Mr Robery states that Asian television channels are commonly available in the United Kingdom. Exhibited at GR10 is material relating to the availability of Indian television channels in the United Kingdom. This material was downloaded long after the material date. Pages 3 and 4 give details of Zee TV UK. The material shows that Zee TV and Zee Cinema were launched in March 1995 and 2001 respectively. These are United Kingdom channels and there is no reason, or logic, that they would be carrying advertisements for products not sold in the United Kingdom. Plc and NV have given no indication of advertising its Fair & Lovely product on these channels prior to 28 November 2002. Page 9 of the exhibit gives details of Indian television channels available internationally; most of the availability was from after 28 November 2002. ARY Digital is identified as being the first Urdu channel started from the United Kingdom, in 1999. As a United Kingdom based channel its advertising can be expected to be for products available in the United Kingdom. Plc and NV have given no indication of advertising the Fair & Lovely product on this channel. B4U Movies launched in 1999 but there is no indication as to when it first became available in the United Kingdom. There is also no evidence in relation to advertising the FAIR & LOVELY product on the B4U Movies channel in the United Kingdom. Mr Robery has furnished no evidence to show that any advertisements for FAIR & LOVELY

products were seen in the United Kingdom prior to 28 November 2002; or for that matter at any date.

57) Mr Robery asserts that the FAIR & LOVELY brand is well-known to the Indian and Indian sub-continent immigrant communities in the United Kingdom but gives no actual evidence to substantiate this.

58) Mr Robery comments on the FAIR & LOVELY brand being a well-known trade mark in India; Plc and NV need to establish that it was well-known in the United Kingdom as of 28 November 2002. However, the evidence of Mr Robery does establish that as of 28 November 2002, FAIR & LOVELY had a significant reputation in India for skin lightening products.

*Material date(s)*

59) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07, in which the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act. An opponent must establish goodwill at the date of the filing of the application which is being opposed. If the opponent fails to establish this its claim under section 5(4)(a) of the Act must fail.

60) The material dates in relation to the claims under section 3(6) and 5(2)(b) are the dates of application.

*Section 5(4)(a) – passing-off*

61) Mr Robery states that first use in the United Kingdom of the trade mark upon which Plc and NV relies as being in 2003 (exhibit GR3). Ms Fox submitted that there had been parallel imports prior to this; for there to be parallel imports there

would have had to be primary imports. Ms Fox could point to no evidence showing use of the trade mark in relation to sales in the United Kingdom upon which Plc and NV could rely prior to the material date. Plc and NV have filed no evidence to support this claim. There was no evidence of imports by others into the United Kingdom. Ms Fox submitted that goodwill could be inferred. In the face of a claim to first importing the goods in 2003, by Plc and NV, and no other evidence, this would be more invention than inference. She prayed in aid the copy of an article dated 2 March 2004 (SFB4) reporting that trading standards officers in London had seized a batch of FAIR & LOVELY FAIRNESS CREAM. The report states that the product was labelled for sale in India and that the officers believed that the product was fake. This is long after the material date and certainly does not form a basis for inferring goodwill at the material date; especially as it is the evidence of Mr Robery that the first exports of the products was in 2003. (Ms Fox prayed in aid this article in relation to the claim to a well-known trade mark. In relation to this, the submission must be considered to be the wildest of extrapolations. All the article shows is that someone was selling the product; it does not even confirm that it was counterfeit.) Plc and NV have to establish that they had a business in the United Kingdom by reference to FAIR & LOVELY as of 28 November 2002, in order to establish goodwill. Their own evidence is that the business did not begin until after this.

**62) Plc and NV have failed to establish goodwill at the material date. The ground of opposition under section 5(4)(a) of the Act is dismissed.**

*Section 5(2)(b) – likelihood of confusion based on a well-known trade mark*

63) In *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* Arnold J [2008] EWHC 3032(Ch) stated:

“237. Counsel for the Claimants and counsel for the Defendants agreed that the approach to assessing whether a trade mark is well known was correctly stated in my decision sitting as the Appointed Person in *Le Mans Autoparts Ltd's Trade Mark Application* (O/012/05):

"57. In reaching conclusion (b) Mr James referred to paragraph 31 of the Opinion of Advocate General Jacobs in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421. Although it is primarily concerned with Articles 4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between 'marks with a reputation' in Article 4(4)(a) and Article 5(2) of the Directive and well-known marks in the sense used in Article 6*bis* of the Paris Convention for the Protection of Industrial Property. Well-



known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a 'reputation' is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well-known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6*bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a 'reproduction, an imitation, or a translation, liable to create confusion' in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would 'indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use'. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded ever to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Article 5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Article 6*bis* of the Paris Convention are described as 'notorisch bekannt', whereas the marks referred to in Article 4(4)(a) and Article 5(2) are described

simply as 'bekannt'. The two terms in Dutch are similarly 'algemeen bekend' and 'bekend' respectively.

35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms 'notoirement connues', 'notoriamente conocidas', and 'notoriamente conosciuti' in relation to marks referred to in Article 6*bis* of the Paris Convention, and the terms 'jouit d'une renommée', 'goce de renombre', and 'goce di notorietà' in Article 4(4)(a) and Article 5(2) of the Directive.

36. There is also ambiguity in the English version. The term 'well known' in Article 6*bis* of the Paris Convention has a quantitative connotation (the *Concise Oxford Dictionary* defines 'well known' as 'known to many') whereas the term 'reputation' in Article 4(4)(a) and Article 5(2) might arguably involve qualitative criteria. The *Concise Oxford Dictionary* defines reputation as '(1) what is generally said or believed about a person's or thing's character or standing...; (2) the state of being well thought of; distinction; respectability;...(3) credit, fame, or notoriety'. Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the 'reputation' of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.

37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defined, a mark with a 'reputation' need not be as well known as a well-known mark.

58. The Advocate General refers in one of his footnotes to Mostert [*Famous and Well-Known Marks*]. Mostert at 8-17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:

- (i) the degree of recognition of the mark;
- (ii) the extent to which the mark is used and the duration of the use;
- (iii) the extent and duration of advertising and publicity accorded to the mark;
- (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors that may determine the mark's geographical reach locally, regionally and worldwide;

- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

(1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

(iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known."

64) The evidence shows that the trade mark FAIR & LOVELY of Hindustan Lever Limited/Hindustan Unilever Limited had a reputation in India as of 28 November 2002 for skin lightening preparations. As noted above there is nothing to suggest that there was any advertising of the products on television channels based in the United Kingdom which were catering for persons with an ethnic origin from the Indian subcontinent, at the material date. As mentioned above, Ms Fox tried to extrapolate from the article exhibited at SFB4 that the trade mark was well-known at the material date; an extrapolation that is not accepted.

65) It is accepted that there is a large community in the United Kingdom with ethnic origins in the Indian sub-continent. However, this will include persons with their origins in Pakistan, Bangladesh and Sri Lanka, not just India. The potential groups of persons who may wish to use skin lightening creams is very wide, as indicated to some extent in the invoices from Hindustan Lever. The groups will include those with ethnic origins in the Far East, the Middle East, Africa at large, South America and the Caribbean and people from the Roma community. Ms Fox expected it to be accepted that people from the Indian community return to India and so will be aware of products that have a reputation there. There is no evidence as to the frequency of return, this is a bald statement and certainly not something that can be taken on the basis of judicial notice.

66) As Mr Buehrlen submitted that it can be inferred that, in order to support their case of owning a well-known trade mark, Plc and NV would have conducted a search of articles in the print media or on the Internet. If such a search had not been conducted it is difficult to see how the articles exhibited at SFB4 and SFB5 would have been discovered. The latter exhibit is from an article posted on a website for students in Manchester on 24 October 2005 in relation to skin lightening creams; where reference is made to FAIR & LOVELY and what the

writer considers a highly offensive advertisement in relation to it. An extensive search for matter relating to Technopharma's product was also made by Cerberus Investigations Limited. Despite all of the resources of Plc and NV it has not managed to adduce any references to the FAIR & LOVELY product from the United Kingdom prior to 28 November 2002. In 2002 social media were not flourishing, however, the Internet was mature and so if FAIR & LOVELY were well-known in the United Kingdom it could be expected to see references to it in United Kingdom media. Cerberus conducted investigations using special databases to trace references to Technopharma's products; Plc and NV would equally have had access to such databases. If the trade mark was well-known in the United Kingdom one would expect evidence showing references to it in the United Kingdom.

67) There is no evidence from which the conclusion can be drawn that FAIR & LOVELY was a well-known trade mark in the United Kingdom by reference to either the trade or the relevant public at the material date. It cannot be inferred that the trade mark was well-known at the material date to even those from the ethnic Indian community; which only represents part of the potential customer base in the United Kingdom for skin lightening products. (It is noted that in *McDonald's Corporation v Joburgers Drive-Inn Restaurant (PTY)* in the Supreme Court of South Africa Case No. 547/95, 1996, it was held that a trade mark could be well-known on the basis of a particular ethnic group of the population. However, this case was based on the effects of the apartheid system and a constant refrain of the Court of Justice of the European Union (CJEU) is that it necessary to consider the average consumer for the goods and services. The average consumer of skin lightening products is not formed by just persons of an Indian ethnic origin, as noted above.)

68) Mr Buehrlen submitted that if the trade mark upon which Plc and NV rely was considered to be well-known at the material date, it could not assist Plc and NV as the owner of the trade mark was Hindustan Unilever Limited/Hindustan Lever not Plc and NV. An opponent has to be the owner of the trade mark upon which it relies for the purposes of section 5(2) of the Act (Trade Marks (Relative Grounds) Order 2007). It is considered that there is merit in Mr Buehrlen's submission that neither Plc nor NV were owners of the trade mark that had a reputation in India and that the only party that could rely upon the use in India and on the trade mark being well-known in the United Kingdom is Hindustan Unilever Limited/Hindustan Lever. However, the various undertakings are closely linked and if anything turned upon this issue it would be captious not to allow Hindustan Unilever Limited/Hindustan Lever to be joined to the proceedings. However, as Plc and NV have failed to establish that the trade mark was well-known at the material date, nothing turns upon this.

**69) Plc and NV have failed to establish that as of 28 November 2002, FAIR & LOVELY was a well-known trade mark for skin lightening, or any other, products in the United Kingdom, consequently, their ground of opposition under section 5(2)(b) must be dismissed.**

*Section 3(6) of the Act – bad faith*

70) In *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) Arnold J considered the general principles relating to filing an application in bad faith:

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C-529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at

[51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin,



without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48).”

In *Malaysia Dairy Industries Pte Ltd v Ankenævnet for Patenter og Varemærker* Case C-320/12 the CJEU stated

“1. Article 4(4)(g) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the concept of ‘bad faith’, within the meaning of that provision, is an autonomous concept of European Union law which must be given a uniform interpretation in the European Union.

2. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that, in order to permit the conclusion that the person making the application for registration of a trade mark is acting in bad faith within the meaning of that provision, it is necessary to take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration. The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.

3. Article 4(4)(g) of Directive 2008/95 must be interpreted as meaning that it does not allow Member States to introduce a system of specific protection of foreign marks which differs from the system established by that provision and which is based on the fact that the person making the application for registration of a mark knew or should have known of a foreign mark.”

In *Boxing Brands Limited v Sports Direct International Plc and others* [2013] EWHC 2200 (Ch) Birss J stated:

“79. Mr Purvis also referred to the recent decision of the CJEU in *Malaysia Dairy v Ankenævnet for Patenter og Varemærker* Case C-320/12 [27 June 2013]. In this case the court held that when considering the overall assessment in relation to the bad faith ground, “*the fact the applicant knows or should know that a third party is using such a sign is not sufficient in itself to permit the conclusion that that applicant is acting in bad faith. Consideration must, in addition, be given to the applicant’s intention at the time when he files the application for registration of a mark, a subjective factor which must be determined by reference to the objective circumstances of the particular case.*” This must be right. If a business person decides entirely independently that they are going to register a

given trade mark for a particular set of goods, the fact that they might happen to find out that someone else is also interested in the same thing cannot necessarily put them in a worse position. The issue will be highly sensitive to the circumstances.”

*The evidence of Mr Farah*

71) Mr Farah was cross-examined. He was asked about his knowledge of the FAIR & LOVELY brand:

“Q. Did you know about it in 2002 when this application was filed?

A. I don't recollect precisely knowing about it the same way that I do today, but I was probably aware of it; yes.”

Mr Farah then appeared to resile from this position:

A. I stated that I may have been aware about the mark **FAIR & LOVELY** or I may have heard of it but I don't recollect with distinction today whether I knew about it or not.

He then pulled what might be described as a rabbit out of the hat:

“Whilst we were defending it and spending a lot of money defending it, our licensor was parallelling the product into the United States. So, on one occasion, after we had been in court and I was walking with my associate on Broadway, we saw a store selling leather goods called NEW YORK FAIR & LOVELY. We joked it. We said, "Wouldn't that be funny if we actually" ----“

This explanation for the name had not been put forward before. If this were the reason for the genesis of the trade mark, it would be expected that this would have been put forward in the pleadings and/or evidence of Technopharma. It was not. Even if there is such a store in New York, this does not mean that this gave birth to the trade mark in the mind of Mr Farah. The rabbit pulling appears to be an attempt to further resile from the first position; knowledge of the trade mark FAIR & LOVELY.

72) Technopharma has given 3 different dates of first use of the trade mark outside of the United States. Mr Buehrlen submitted that the date given to the USPTO was not by Mr Farah but by a lawyer acting for Technopharma and so this could be the cause of the discrepancy. It is to be assumed that the lawyer will have been acting upon the direct instruction of Technopharma; he would not have been pulling a date out of the air.

73) There are significant problems in the evidence of Mr Gray. The repetition of the first person plural indicates that large parts of the evidence are hearsay. No contemporaneous records of conversations have been adduced. Mr Gray was called for cross-examination but did not attend so he could not be questioned on

his witness statement. Questions may have asked about what had been excluded from his statement as well as what had been included. The decision that Mr Gray should appear to be cross-examined was made at a case management conference held on 25 April 2013. At the same case management conference it was decided that Mr Farah would attend for cross-examination in October. Mr Farah is resident in the United States of America and it was stated that he would be in the United Kingdom at the beginning of October 2013 for business. On 17 May 2013 Technopharma advised that Mr Farah would be available for cross-examination on 10 October 2013. On 22 August 2013 Plc and NV advised that Mr Gray would not be available for cross examination on 10 October 2013; nearly 4 months after the case management conference. It is to be assumed that Mr Gray would have been advised that he should be available for cross-examination in October, immediately after the case management conference. As it was, taking into account that Mr Farah would be travelling from the United States of America, and the length of delay of Plc and NV advising of his non-availability; it was not appropriate to vacate the date of the hearing.

74) Despite the failings in the evidence of Mr Gray and his failure to attend for cross-examination, his witness statement does carry some weight as none of the statements made in it have been subject to evidential rebuttal. Technopharma could have requested to file evidence to challenge the statements in the witness statement in relation to the absence of evidence of use of Technopharma's trade mark.

75) The claims of Mr Farah in relation to use in the United Kingdom, which have a complete lack of substantiation, sit ill at ease with his statements regarding the primary market of Technopharma, African Americans. As the primary market is for African Americans, it seems odd that, according to Mr Farah and the evidence to the USPTO, the first use in the United Kingdom was in mid 2001 and the first use in the United States of America was not until 30 November 2005. It is also to be taken into account that Technopharma advised the USPTO that the first use anywhere was 1 December 2003; two years after the date claimed in Mr Farah's statement; although, Mr Farah also stated that sales commenced in December 2002.

76) Taking into account these various inconsistencies both in his evidence and in his cross-examination and the rabbit out of a hat, the evidence of Mr Farah must be viewed with a good deal of circumspection.

77) Taking these factors into account, it is held that at the date of the filing of Technopharma's application, Mr Farah, who is a controlling mind of Technopharma, knew of the use of FAIR & LOVELY by Hindustan Unilever Limited/Hindustan Lever in relation to skin lightening creams and, taking into account his long experience and expertise in the field, if with African Americans, he knew that it was a highly successful brand in India.

78) Ms Fox submitted:

“It filed this application knowing that it would block Unilever from the market and with the intention of getting some kind of financial gain out of it, either by trading on the back of Unilever's reputation amongst consumers who knew the **FAIR & LOVELY** brand, and profiting from that confusion, or by possibly leveraging a settlement out of Unilever, thereby getting Unilever to pay for the rights.”

In relation to this, there are two points. Firstly, it is not the pleaded case that Technopharma applied for the registration of the trade mark in order to obtain a settlement from Plc and NV; even though Plc and NV amended the section 3 ground by the addition of the further element of an absence of intention to use. The basis of the claim was “that it deliberately sought to obtain a legal monopoly in a mark whose use it intended to manipulate in order to lure in consumers familiar with the Opponents’ product and trade dress, thereby profiting from the Opponents’ substantial international reputation and consumer confusion”. Technopharma can only defend itself against what has been pleaded. If Plc and NV wanted to expand the basis of its claim under section 3(6) of the Act, it should have requested to amend the ground. As is stated by rote, section 3(6) of the Act is a serious ground and, consequently, it is of particular importance that a party knows of the basis of the claim. Secondly, there is not a shred of evidence to support the attack upon this basis. Ms Fox submitted that there was similar fact evidence in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Alexir Packaging Limited* [1999] ETMR 912. Ms Fox stated that Mitchell International Pharmaceuticals Ltd is one of the Mitchell Group of Companies, of which Mr Farah is a director and which is linked to Technopharma. This was not denied by Mr Buehrlen. In *Mitchell International Pharmaceuticals Ltd*, Mitchell used a trade mark in the United States which was owned in the United Kingdom by Beautimatic. Mitchell was aware of Beautimatic’s ownership of the trade mark. There is no indication in the judgment that Mitchell sought to “leverage” a settlement from Beautimatic; it is not possible, therefore, to see, in relation to this particular aspect of the (unpleaded) claim that there is similar fact evidence. However, it does show that the Mitchell Group has previously used a trade mark in one jurisdiction that is owned by another party in a different jurisdiction. (It is noted that Neuberger J stated:

“where there is no evidence of Beautimatic having suffered damage, and it is by no means obvious on the facts as established that Beautimatic will have suffered damage.”)

(Mr Buehrlen submitted that the “leverage” submission was flawed as Plc owned United Kingdom registrations. However, there is no evidence that Technopharma knew of these registrations at the date of application and so that would not gainsay the submission of Ms Fox if it had been pleaded and if there were some substantiation to it.)

79) The basis of the pleaded case is that Technopharma applied to register its trade mark in “order to lure in consumers familiar with the Opponents’ product and trade dress, thereby profiting from the Opponents’ substantial international reputation and consumer confusion”. (The action in *Beautimatic* was not brought upon this basis; the facts of the case are very different.) It is also claimed that there was a lack of intention to use.

80) Plc and NV have made claims in relation to the get-up of the packaging of the products of Technopharma. Neither the colours nor the fonts used in the examples of packaging of Technopharma are identical to the get-up of the products which have been shown in the exhibits of Plc and NV. The get-up emphasises the New York association with images evoking the city. The respective get-ups would not induce the average consumers to make even an association between the products. Ms Fox considered that there is significance that in the small print of some of the packaging exhibited at AG5 that there is use of Fair & Lovely NY and NY Fair & Lovely; that this is indicative of the intentions of Technopharma. Mr Buehrlen’s view of the matter that this form of use is simply an effect of the limited space that was available on the side of the packaging. Mr Buehrlen’s view is the more reasonable; a great deal of significance cannot be derived from this use on the side of packaging.

81) Mr Farah knew of the use of FAIR & LOVELY by Hindustan Unilever Limited for skin lightening products in India at the time of making the application. Owing to Mr Farah’s experience in skin lightening products, he would have known of the success of the products in India and of their exports to other countries. However, as the CJEU has stated:

**“The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.”**

82) Despite the failings in the evidence of Mr Gray and his failure to appear for cross-examination, it can be accepted that Technopharma has not used its trade mark in the United Kingdom, despite the statements of Mr Farah. There are too many inconsistencies in the statements of Mr Farah and no substantiation of his claims through exhibited material. As mentioned above, Technopharma has not challenged what is in the statement of Mr Gray by way of evidence. The lack of intention to use in this case does not turn upon section 32(3) of the Act but on the claim that this was a blocking action to stop the use of the trade mark of Plc. The absence of use cannot be seen as an equivalent to an absence of an intention to use. It is often commercially prudent to await the registration of a trade mark before it is used. Although in this case Mr Farah has claimed to have used the trade mark but not substantiated the claim.

83) The claim that the application was made without an intention to use is in conflict with the claim that the application was made to trade off the reputation of Plc and NV. Plc and NV are arguing two conflicting cases; one based on an intention to use and one based on a lack of intention to use.

84) Although Plc and NV have established that Technopharma has not used its trade mark, they have not established that there was no intention to use at the date of the filing of the application, which is the basis of the claim that the application was made as a blocking action to Plc and NV.

85) Technopharma knew of the use of Hindustan's trade mark in India. Owing to Mr Farah's experience in the field, it is likely that Technopharma knew of the sales outside of India. Plc and NV have not established that at 28 November 2002 Plc/NV/Hindustan Unilever Ltd's trade mark was well-known in the United Kingdom. However, owing to the substantial size of those with an ethnic origin from India living in the United Kingdom, it is reasonable to infer that a part of this particular population would be aware of the trade mark's use in India, that part which returned to India sometimes. More importantly it is reasonable to infer that Technopharma considered members of this community in the United Kingdom would know of the trade mark, whether this was the case or not. As Mr Farah, in his second statement, states that he accepts that the words FAIR & LOVELY are non-distinctive for the products; it is difficult to understand why he would choose such words if they did not have some other significance. If the words FAIR & LOVELY are non-distinctive, the addition of NEW YORK is not going to create a memorable trade mark. The intention of Technopharma was to trade off the reputation of the Plc/NV/Hindustan Unilever Ltd trade mark on the basis that part of the target population would know of the FAIR & LOVELY brand in India.

86) The state of knowledge of Technopharma as of 28 November 2002 has been established. It has been decided that Technopharma wanted to trade off the presumed knowledge of the Plc/NV/Hindustan Unilever Ltd trade mark in the United Kingdom. This was not a matter of a business deciding entirely independently that it is going to register a trade mark and then finding out that someone else is interested in the trade mark. It is a business trying to benefit from the reputation of another business that it perceives will exist in the United Kingdom. This falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.

87) It is noted that the trade mark is NEW YORK FAIR & LOVELY and not FAIR & LOVELY but owing to the fame of New York, the attention of the average consumer is going to fall on the second element and it is considered that this is what Technopharma expected and, indeed, hoped. It is also noted that the specification is not limited to skin lightening products. However, taking into account the proximity of the other goods to such cosmetic products and the

tendency for product expansion under cosmetic brands; nothing turns upon this. The application was made in bad faith.

**88) The application is to be refused under section 3(6) of the Act.**

*The opposition of Technopharma to the registration of Plc's trade mark.*

89) In the event that the above finding is overturned on appeal, the opposition under section 5(2)(b) of the Act brought by Technopharma will be considered.

90) There is no dispute that the respective goods are identical or similar.

91) The purchase of the respective goods is likely to be from the shelf of a shop or over the Internet. Consequently, visual similarity will be of greater importance than aural similarity. The respective goods could be of low or high cost. It is likely that a reasonable degree of attention will be made in the purchase of most of the goods as the prospective customer will wish to be aware of such things as the scent of products, the properties of the products and whether there may be any contraindications, owing to allergy. The average consumer for the respective goods is the public at large.

92) The trade marks to be compared are:

**NEW YORK FAIR & LOVELY**



93) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>1</sup>. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>2</sup>; in relation to this the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97 stated:

“27. In order to assess the degree of similarity between the marks concerned, the national court must determine the degree of visual, aural or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.”

There cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The

average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>iii</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>iv</sup>. It is not always the case that the first element of a trade mark is of greater importance than later elements in considering similarity<sup>v</sup>.

94) Mr Farah has stated in his second witness statement that the words FAIR & LOVELY are “entirely descriptive because the marks relate to skin products that are intended to create a fair complexion”. Mr Farah goes on to state that he agrees with paragraphs 6 and 7 of the statement of Mr Beale. At the end of paragraph 7 Mr Beale states:

“The descriptive words FAIR & LOVELY are the only shared element between Unilever’s Mark and the Opponent’s Mark. The mere commonality of such descriptive words in the marks at issue does not create the impression that the sources of the goods are the same or linked.”

Despite this statement of Mr Farah the opposition has not been withdrawn. It is also to be noted that Plc and NV have opposed the registration of Technopharma’s application on the basis that there is a likelihood of confusion. Ms Fox had sought the deconsolidation of the cases as she did not want what was pleaded in one case to affect the other. Even if the cases had been deconsolidated, it can be assumed that Technopharma would have referred to the apparently contradictory positions of Plc and NV. In these circumstances the issues will be considered in the normal fashion; with the admissions and contradictions put to one side.

95) In considering the trade mark of Technopharma there is no presumption of distinctiveness as per *Formula One Licensing BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-196/11P* as that judgment relates to the presumption of validity of registered and protected national trade marks. The trade mark upon which Technopharma relies is neither registered nor protected in the United Kingdom.

96) The pink background and the device of two female heads, one darker than the other, in Unilever trade mark will be viewed by the average consumer as background, decoration and, in relation to skin lightening products, description. If these components have any distinctiveness, it is of a most limited nature.

97) New York will be seen as an indication of geographical origin. It is common practice for undertakings to identify their products by reference to geographical locations; especially those that might be seen as having attractive force, eg



London, Paris, Rome and New York. It is not a distinctive component of Technopharma's trade mark.

98) The decision of the Second Board of Appeal has been exhibited in relation to the non-distinctiveness of the words FAIR & LOVELY in which it was held that the words were descriptive of characteristics of the goods and devoid of distinctive character in relation to goods in class 3.

99) The words FAIR & LOVELY, in relation to the goods under consideration, might advise the consumer of the purpose of the goods; to make the user fair and lovely. However, this is a somewhat unusual combination of words and seems rather archaic. These words, despite the findings of the Second Board of Appeal, are considered to have a very limited degree of distinctiveness. In the context of both trade marks, these words are the most distinctive elements and in terms of position, length and the characteristics of the other elements, are the most dominant elements of the trade marks.

100) The respective trade marks are aurally and conceptually identical in respect of the FAIR & LOVELY component and highly similar visually.

101) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>vi</sup>. The respective goods are identical or highly similar. The GC in *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-505/11* stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal's taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”<sup>vii</sup>

However, as the GC held in *Meda Pharma GmbH & Co KG c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) les affaires jointes T-492/09 et T-147/10*, where goods are identical it is not essential, in order to exclude the likelihood of confusion, that there is a large difference between the trade marks being compared:

“50 La requérante soutient que, en cas d'identité de produits, il est nécessaire, pour exclure tout risque de confusion, que les signes présentent une plus grande différence que dans une situation où l'écart entre les produits est important. Or, dans les circonstances de l'espèce où

l'identité des produits n'est pas contestée, la chambre de recours aurait dû conclure au risque de confusion, à l'instar de ce qui a été considéré dans la décision R 734/2008-1 de la première chambre de recours de l'OHMI, du 14 septembre 2009 (Alleris et Allernil). Selon la requérante, plusieurs décisions de l'OHMI démontrent que les décisions attaquées s'écartent de la pratique décisionnelle de l'OHMI, ce qui viole les principes d'égalité et de non-discrimination.

51 Il ressort de la jurisprudence que l'OHMI est tenu d'exercer ses compétences en conformité avec les principes généraux du droit de l'Union. Si, eu égard aux principes d'égalité de traitement et de bonne administration, l'OHMI doit prendre en considération les décisions déjà prises sur des demandes similaires et s'interroger avec une attention particulière sur le point de savoir s'il y a lieu ou non de décider dans le même sens, l'application de ces principes doit toutefois être conciliée avec le respect du principe de légalité. Au demeurant, pour des raisons de sécurité juridique et, précisément, de bonne administration, l'examen de toute demande d'enregistrement doit être strict et complet afin d'éviter que des marques ne soient enregistrées de manière induue. C'est ainsi qu'un tel examen doit avoir lieu dans chaque cas concret. En effet, l'enregistrement d'un signe en tant que marque dépend de critères spécifiques, applicables dans le cadre des circonstances factuelles du cas d'espèce, destinés à vérifier si le signe en cause ne relève pas d'un motif de refus [voir, en ce sens, arrêt de la Cour du 10 mars 2011, *Agencja Wydawnicza Technopol/OHMI*, C-51/10 P, non encore publié au Recueil, points 73 à 77, et la jurisprudence citée, et arrêt du Tribunal du 22 novembre 2011, *LG Electronics/OHMI (DIRECT DRIVE)*, T-561/10, non publié au Recueil, point 31).

52 Or il apparaît que, dans la présente affaire, la chambre de recours a correctement pris en compte les circonstances de l'espèce. À cet égard, elle a, à juste titre, constaté l'identité des produits concernés en l'espèce, elle a aussi retenu une similitude très faible des signes en cause sur les plans phonétique et visuel et une impossibilité de comparaison de ces mêmes signes sur le plan conceptuel, comme il ressort des points 40, 41 et 46 ci-dessus. Dès lors, comme le soutient à juste titre l'OHMI, l'identité entre les produits désignés est compensée par un très faible degré de similitude entre les signes en cause et la chambre de recours a pu conclure à bon droit à l'absence de tout risque de confusion, d'autant que le degré d'attention du public est accru et qu'il n'est pas démontré que la marque antérieure présente un caractère distinctif élevé."

102) As the GC held in *Meda Pharma GmbH & Co KG* it is necessary to take into account such factors as the distinctiveness of the earlier trade mark and the degree of attention of the relevant public; the more distinctive the earlier trade mark the greater the likelihood of confusion<sup>viii</sup>. In *The European Limited v The*

*Economist Newspaper Ltd* [1998] FSR 283 Millett LJ commented upon the corollary of this:

“The more distinctive the earlier mark, the greater will be the likelihood of confusion. The converse, of course, follows. The more descriptive and the less distinctive the major feature of the mark, the less the likelihood of confusion.”

However, in relation to the limited distinctiveness of an earlier trade mark the judgment of the CJEU in *L’Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P* is pertinent:

“45 The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

103) The average consumer will be faced with two trade marks in which FAIR & LOVELY are dominant components for identical goods. The NEW YORK element of the trade mark of Technopharma will be seen as a geographical qualifier and will not change the essential perception of the trade mark. It is difficult to see how the coincidence of the FAIR & LOVELY component of the trade marks would not give rise to confusion; especially taking into account the very limited effect that the other components of Unilever’s trade mark would have upon the perception of the average consumer. If it had not been found that the application of Technopharma was to be refused on the basis of section 3(6) of the Act; the application of Unilever would have been refused under section 5(2)(b) of the Act.

## ***Overall outcome***

**104) The application of Technopharma is to be refused. The application of Unilever may progress to registration.**

### *Costs*

105) Mr Farah stated that he had come to London specifically to be cross-examined at the hearing. However, at the case management conference of 25 April 2013, Mr Buehrlen requested that the cross-examination should take place in October as Mr Farah would be on business in London then. This was followed up with a letter on 17 May 2013 from Mr Buehrlen stating that Mr Farah would be available for cross-examination on 10 October 2013. The date of the hearing was the result of Mr Buehrlen's statement about the availability of Mr Farah and when he would be in London for business. Consequently, if Technopharma had been successful, no expenses would have been granted in respect of Mr Farah's attendance other than any costs in relation to travel in London to the office of the Intellectual Property Office.

106) Mr Buehrlen submitted that Technopharma was having to face effectively the same attack that it faced before OHIM. It was held at the interlocutory hearing no estoppel arose in relation to the opposition by Plc and NV and there was no abuse of process. The opposition before OHIM could not consider a claim of bad faith, as this is an absolute ground. Mr Buehrlen also referred to Technopharma's application now having taken 10 years. This is hardly the fault of Plc and NV. Technopharma chose to contest the opposition before OHIM and subsequently, chose to convert its application. There is nothing in the actions of Plc and NV which, if Technopharma had been successful, would have warranted an award of costs outwith the scale.

107) In relation to the case management conference, as Ms Fox submitted, each party had some success and so no award of costs is made in relation to this.

108) Ms Fox submitted that Plc and NV should receive costs outwith the scale:

“Technopharma repeatedly failed to copy Unilever's representatives in its correspondence with the IPO, causing us to have to contact the IPO repeatedly to ask for copies. It pursued weak objections at the interlocutory hearing, at which the IPO's preliminary view was upheld. It forced Unilever to incur costs in preparing argument for that interlocutory hearing on points which Technopharma then dropped at the outset of that hearing. It created unnecessary costs by making a manifestly groundless request for cross-examination of two of Unilever's witnesses, Mr. Beale and Mr. Robery, at the CMC in April. In relation to that, in case the issue arises, my recollection is that the request for cross-examination was in relation to inconsistencies in the evidence. I believe it was suggested that

when the inconsistencies were pointed out to be irrelevant to the substance of the case, my friend said, "There are other inconsistencies." When asked what they were, and he said that it would take too long to go through the witness statement. That was not, we think, simply acceptable.

Ultimately, Technopharma forced Unilever to incur costs at this main hearing in Opposition 92846, despite Technopharma's only witness, Mr. Farah, a director of the company, admitting in evidence that he no longer regarded those marks as even being in conflict.

The conduct of Technopharma and its attorneys throughout these proceedings has been marked by the pursuit of trivial, weak and irrelevant points, and by a persistent failure to abide by the normal procedural rules that parties normally respect in these proceedings, all of which has resulted in Unilever incurring unnecessary costs in these proceedings."

109) In relation to the costs of attending the main hearing; this was inevitable as Plc and NV had requested to cross-examine Mr Farah. If Technopharma had withdrawn its opposition, the opposition of Plc and NV would still have needed to be decided and Mr Farah would still, no doubt, have been cross-examined. It is also to be noted that Plc and NV, in relation to the distinctiveness of FAIR & LOVELY, were approbating in one case and reprobating in the other.

110) There is nothing in the behaviour of Technopharma that merits an award outwith the costs.

111) In *West t/a Eastenders v Fuller Smith Turner PLC* [2003] EWCA Civ 429 Pumfrey J, sitting in the Court of Appeal, decided that, in awarding costs, the success in relation to separate grounds and the evidence adduced in relation to those grounds should be taken into account. Plc and NV's opposition failed in relation to sections 5(2)(b) and 5(4)(a). On the evidence furnished, the case under section 5(4)(a) was hopeless and the claim in relation to a well-known trade mark little better. Much of the evidence of Plc and NV had no little or no bearing upon the outcome of the case. It was ill focused. The evidence of Mr Gray was poorly presented, with the regular presence of the first person plural pronoun and Mr Gray did not present himself for cross-examination. Taking these factors into account, it is considered appropriate that, despite being overall successful, the costs payable to Plc and NV should be limited to a contribution towards the interlocutory hearing, of £300, and the opposition fee of £200.

**112) Technopharma Limited is ordered to pay Unilever plc and Unilever NV the sum of £500. This sum is to 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 7<sup>th</sup> day of November 2013**

**David Landau  
For the Registrar  
the Comptroller-General**

<sup>i</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>ii</sup> *Sabel BV v Puma AG* Case C-251/95.

<sup>iii</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

<sup>iv</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>v</sup> See for instance: *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07 and *CureVac GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-80/08.

<sup>vi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97.

<sup>vii</sup> In *Fon Wireless Ltd c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* l'affaire T-283/11 the GC stated :

« 67 Il convient de rappeler que le risque de confusion doit être apprécié globalement, selon la perception que le public pertinent a des signes et des produits ou des services en cause, et en tenant compte de tous les facteurs pertinents en l'espèce, notamment de l'interdépendance entre la similitude des signes et celle des produits ou des services désignés (voir arrêt GIORGIO BEVERLY HILLS, précité, points 30 à 33, et la jurisprudence citée). Ainsi, un faible degré de similitude entre les produits ou les services désignés peut être compensé par un degré élevé de similitude entre les marques, et inversement [arrêt de la Cour du 29 septembre 1998, Canon, C-39/97, Rec. p. I-5507, point 17, et arrêt VENADO avec cadre e.a., précité, point 74].

68 En l'espèce, comme indiqué au point 39 ci-dessus, il y a lieu de confirmer le constat de la chambre de recours selon lequel les produits et les services désignés par les marques antérieures et par la marque demandée sont hautement similaires s'agissant des produits relevant de la classe 9, et identiques s'agissant des services relevant de la classe 38.

69 Ce constat implique, conformément à la jurisprudence citée au point 67 ci-dessus, que le degré de différence entre les marques en conflit doit être élevé pour éviter un risque de confusion. Or, ainsi qu'il ressort du point 62 ci-dessus, il existe un degré de similitude visuelle et phonétique élevé et un certain degré de similitude conceptuelle entre les marques en conflit. »

<sup>viii</sup> *Sabel BV v Puma AG* Case C-251/95.

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