

O-061-14

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL TRADE MARK REGISTRATION NO 1 134
075**

IN THE NAME OF ADNAN AKAT

TO PROTECT IN CLASS 03 THE TRADE MARK:



OSSION +

AND

**OPPOSITION THERETO UNDER NO 72486
BY HENKEL AG & CO KGaA**

Background and pleadings

1. Adnan Akat (the applicant) applied to protect International Trade Mark 1 134



075 in the UK on 15th February 2012. It was accepted and published in the Trade Marks Journal on 30th November 2012 in respect of Bleaching and cleaning preparations; perfumery; cosmetics; soaps; dentifrices; abrasives (abrasive cloths, abrasive papers, pumice stones, pastes); shining and maintenance preparations (preparations for leather, vinyl, metal, wood etc.) (terms considered too vague by the International Bureau - rule 13.2.b) of the Common Regulations) in class 03.

2. Henkel AG & Co KGaA (the opponent) partially opposes the trade mark on the basis of Section 5(2) (b) of the Trade Marks Act 1994 (the Act). This is on



the basis of its earlier International Trade Mark 734 835 protected in the UK on 14th February 2003. The following goods are relied upon in this opposition: Cosmetics, preparations for treating, washing, dyeing, bleaching, styling and perming hair, soaps in class 03. The following goods of the application are under attack: bleaching and cleaning preparations; cosmetics; soaps.

3. The opponent argues that the respective goods are either identical or similar and the marks are globally similar, particularly visually. Further, as the goods are purchased visually rather than orally and bearing in mind the concept of imperfect recollection, confusion is highly likely.
4. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade mark relied upon.
5. Only the opponent filed evidence in these proceedings, together with written submissions, the latter of which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Likelihood of confusion – Section 5(2) (b)

6. The relevant parts of section 5 of the Act read as follows:

“(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”.

7. The leading authorities in this ground are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C- 334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) 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; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

O-061-14

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

PROOF OF USE

8. An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

9. The opponent relies on its International Trade Mark 734 835. This is an earlier trade mark within the meaning of section 6(1) of the Act. The applicant has requested the opponent prove use of its mark and, given the interplay between the date of registration of this earlier mark and the date the application was published, the provisions of section 6A of the Act are relevant.

10. Section 6A of the Act reads:

“(1) This section applies where –

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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

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

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

O-061-14

- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or
- (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

11. Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

12. In reaching a conclusion on this point, the relevant period for present purposes is the five year period ending with the date of publication of the application for registration i.e. 1st December 2007 to 30th November 2012.

13. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

- (b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

14. The guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, in relation to determining what constitutes a fair specification is also useful, namely:

“Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view the task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use”.

15. In *Animal Trade Mark* [2004] FSR 19, Jacob J held:

“The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White’s brilliant and memorable example of a narrow specification) “three-holed razor blades imported from Venezuela” is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say “razor blades” or just “razors”. Thus the

“fair description” is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”). A lot depends on the nature of the goods—are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

16. Also of relevance are the comments of the General Court in *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03 where it said:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

17. Finally, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10 Mr Geoffrey Hobbs Q.C., sitting as the appointed person, stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification

should accord with the perceptions of the average consumer of the goods or services concerned.”

The Opponent's Evidence

18. This is a witness statement from Mr Joachim Renner, who is corporate trade mark counsel for the opponent. The following information is contained therein:

- The earlier trade mark was first used in the UK in 2000 and has been used extensively since this date. Turnover figures are as follows: £1,988,888 in 2009, £2,291,627 in 2010, £2,300,217 in 2011 and £1,890,776 in 2012.
- Advertising figures are also provided: £20,440 in 2008, £1,545 in 2009, £45,827 in 2010, £9,545 in 2011 and £500 in 2012.
- Exhibit JR1 is a copy of promotional activity from March 2004, April 2005, June 2006 and October 2006.
- Exhibit JR2 is a photograph of the earlier trade mark used in respect of a hairspray.
- Exhibit JR3 is a review of the 2010 press launch for the earlier trade mark.
- Exhibit JR4 is a press release dated 13 February 2012 relating to the Your Hair Product Awards in 2012. It is noted that a product bearing the earlier trade mark won the styling award for best curls.
- Exhibit JR5 is information from the opponent's website relating to its product range bearing the earlier trade mark.
- Mr Renner also informs that the opponent attends the Essential Looks Roadshow (a trade show) in the UK held in March and September every year and products sold under the earlier trade mark have been shown at this trade show every year since 2000.

19. In considering the evidence filed, it is true that some documents such as the copies of pages from the opponent's website are not dated or are dated outside of the relevant period. However, the information contained in the evidence as a whole provides sufficient indications as to the period of use. It is also true that the opponent did not file invoices but the witness statement provides information regarding turnover figures and advertising spend. Taking the evidence as a whole, the various pieces of evidence considered in combination with each other provide sufficient indications to conclude that the earlier trade mark has been put to genuine use in the UK during the relevant period.

20. However, the evidence filed by the opponent does not show genuine use of the trade mark in connection with all the goods covered by the earlier trade mark. If the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

21. In the present case the evidence filed by the opponent shows genuine use of the trade mark in connection with the following goods namely:

“Preparations for styling hair”

22. Thus, in examining the opposition only the above mentioned goods will be taken into consideration.

Comparison of goods

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

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

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

“(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

24. The earlier goods are:

Class 03:

“Preparations for styling hair”

The contested goods are:

Class 03

“Bleaching and cleaning preparations; cosmetics; soaps”

25. In respect of the contested *bleaching and cleaning preparations*, it is clear that there is some overlap as the later term is very broad and can include hair products which bleach and/or clean the hair. These are considered to be highly similar to the earlier goods, as they all aim to improve and/or alter the appearance of the hair. However it is also clear that the later term will include items which are neither identical nor similar to the earlier terms for example bleaching and cleaning preparations for household use. This issue will be considered further below¹. Where there is an overlap however, the goods are considered to be highly similar.

26. The contested *cosmetics* is a broad term which can encompass a large variety of items which all have a key purpose in common, namely to beautify, alter or otherwise improve the appearance of the user. The same is true of the earlier goods. They can also be the same or similar in nature as they can be available in cream, powder, spray or other liquid format. Their method of application can also therefore be the same or similar (albeit one being in respect of face and body and the other, hair). Trade channels can also coincide and they are also likely to be sold in the same establishments or in the same aisles of a particular establishment, for example, a supermarket. Bearing in mind all of the aforesaid, they are considered to be highly similar.

27. In respect of the contested *soaps*, it is considered that the core purpose of such products is to clean the body and achieve and maintain acceptable standards of hygiene. This differs from the earlier goods, the purpose of which has already been described above. The trade channels may coincide and they may be sold in the same general area as one another, albeit in different aisles. There is therefore a degree of similarity between them, though this is pitched as being on the low side.



Comparison of marks

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind

¹ See TPN 1/2012 (trade marks) Partial Refusal

their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

29. The respective trade marks are:

	
<p>Earlier trade mark</p>	<p>Contested trade mark</p>

30. Visually, it is noted that each of the verbal elements contained within the marks start with the letters “OS” and end with the + symbol. Further that they are each contained within similar get up. There are also differences, namely the length of the verbal elements (4 letters and 6 letters respectively) which does have an impact and that the + symbol is presented within its own circle in the earlier trade mark. It is accepted that the get up present is fairly banal and that + symbols are not particularly striking or distinctive. However, taking all matters into the round, the similarities are such that there is considered to be a similar overall visual impression created here. The degree of visual similarity is considered to be moderate.

31. Aurally, the matter is somewhat different: three syllables versus four and so the lengthening has a more prominent impact here. The beginnings of each of the marks will be pronounced identically as each are the letters “OS”. However, the differing syllable sounds quite different: “IS” as opposed to “SION”. There is considered to only be a very low degree of aural similarity.

32. Conceptually, neither of the signs has any particular meaning and are each likely to be perceived as invented terms. There is neither conceptual similarity nor dissimilarity, the position is neutral.

Distinctive and dominant components

33. In respect of each of the trade marks here, the get up and device elements present are, as already stated, fairly banal (though as also already stated, this does not mean they do not have a visual impact). However, in the light of this banality, it is considered that it is the word elements of each of the marks that comprise their respective dominant components as they catch the eye first. Further, the words are likely to be perceived as invented and so are distinctive. Having said all that, the remaining elements are not negligible and so the correct comparison to be made is in respect of the trade marks as a whole.
34. Bearing in mind all of the aforesaid, the trade marks are considered to be similar, particularly visually. The degree of overall similarity is pitched as being moderate.

Distinctiveness of the earlier trade mark

35. The opponent has made no claim as to reputation in its earlier trade mark, though it has filed evidence of use. In respect of this evidence, it is noted that promotion of the earlier mark has been somewhat limited and the sales figures provided lacks context in respect of the hair styling market as a whole. Consequently it cannot be found that the earlier mark's distinctiveness has been increased through use.
36. As such, its distinctiveness can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00). It is noted that the goods in question are a variety of hair styling products, for which the earlier trade mark has no meaning in respect of the relevant consumer. Further, that such a consumer is highly likely to perceive OSIS as an invented term. Taking into account the invented nature of the word and the get-up the earlier trade mark enjoys a reasonable degree of inherent distinctiveness. It is not considered to be able to be bestowed any higher degree than reasonable as without reputation, an invented word has no hook for memory in the eyes of the consumer and so distinctiveness becomes, relatively speaking, more limited.

Average consumer and the purchasing act

37. The case-law informs that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).
38. The goods in question are those which are usually self- selected from shelves. As such, they are likely to be predominantly purchased visually.

However, some cosmetics can be found behind a counter and so will be requested orally. The level of attention one would expect to be displayed will vary as within products of this nature some will be purchased frequently and will be relatively cheap others may be purchased less frequently and be more expensive. In this regard, the following guidance is helpful: *Adelphoi Limited v DC Comics (a general partnership)* BL O/440/13 where Professor Annand said:

“21. As for the services, e.g., broadcasting, whilst I agree with Mr. Malynicz that the average consumer would include business consumers or professionals as well as the general public, the likelihood of confusion must be assessed in relation to the part of the public whose attention is lower (see e.g., Case T-448/11, *Golden Balls Ltd v. OHIM*, 16 September 2013, para. 26), although in any event, the Hearing Officer relied on an average consumer (reasonably well informed and reasonably circumspect and observant) paying an average level of attention (para. 41).”

39. So the consideration must be based on the scenario for the cheapest goods and the consequent effect upon the purchasing process.

40. It is considered that the type of purchasing circumstance that will occur most often will be in respect of the cheaper products purchased more frequently. In such a circumstance, the level of attention expected to be displayed will be fairly low. At the very least it will not be more than moderate.

Global assessment

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

42. The matter will be considered in respect of the goods found to be highly similar first of all. As already found, these are goods which will be predominantly visually purchased. On a visual comparison, the marks have been found to be moderately similar as a result of all the respective features of each of the marks in combination, with a low to moderate degree of similarity overall. It is this combination of features which, it is considered, become crucial when bearing in mind the notion of imperfect recollection and the fact that consumers rarely have the opportunity to view trade marks side by side and instead rely upon an imperfect picture of them. In respect of highly similar goods, purchased predominantly visually and with a degree of attention at the lower side of moderate, it is considered that all these factors

interact. The impact being that it is considered that, on balance, the consumer of these goods will be unable to accurately distinguish between these marks and so confusion between them is considered to be likely to occur.

43. In respect of the contested *soaps*, it is noted that these are similar only to a relatively low degree. This degree of similarity is viewed to have an impact on the overall degree of confusion, such that it is considered to be unlikely. The opposition fails in this respect.
44. Further, in respect of the contested *bleaching and cleaning preparations*, it is clear that the opposition succeeds in respect of highly similar goods included within this term (the example used is bleaching and cleaning preparations for hair). However, it cannot succeed in respect of products included within the term that are clearly not similar (the example used is bleaching and cleaning preparations for household use). Therefore in line with the contents of "TPN1/2012 (trade marks) Partial Refusal", the applicant is therefore permitted one month from the date of this decision to submit an alternative term to the Tribunal. A supplementary decision will then be issued. Should no alternative term be submitted, the opposition will succeed against the entire term *bleaching and cleaning preparations*.

COSTS

45. The opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £750 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £300

Filing evidence and submissions - £250

Total - £750

46. I therefore order Adnan Akat to pay Henkel AG & Co KGaA the sum of £750. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful. It should be noted that the appeal period for this substantive decision will be concurrent with that of the supplementary decision.

O-061-14

Dated this 5th day of February 2014

Louise White

For the Registrar,
The Comptroller-General