

O-220-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2562512
BY AVON PRODUCTS INC.
TO REGISTER THE TRADE MARK**

Pure O₂

**IN CLASS 3
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 101853 BY
O2 HOLDINGS LIMITED**

BACKGROUND

1) On 27 October 2010 Avon Products Inc. (hereinafter the applicant) applied to register the trade mark shown above in respect of the following goods in Class 3:

“Non-medicated toilet preparations; toiletries; skin care preparations; skin moisturizers; body and beauty care preparations; powders, creams and lotions, all for the face, hands and body; soaps; shower and bath preparations; beauty masks; talcum powder; nail polish; nail polish remover; enamels for manicure; false nails; adhesives for cosmetic purposes; cosmetics; eye makeup remover, eye shadow, eye liner, mascara, lipstick, lip liner, lipgloss; make-up foundation; blusher; tissues impregnated with cosmetic lotions; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; preparations for cleaning, moisturising, colouring and styling the hair; preparations for cleaning the teeth; shaving and aftershave preparations; perfumes, fragrance, toilet waters, eau de colognes; deodorants and anti-perspirants for personal use; essential oils (cosmetic); all the aforesaid being alone, in combination and/or in gift sets comprised of some or all of these items.”

2) The application was examined and accepted, and subsequently published for opposition purposes on 4 February 2011 in Trade Marks Journal No.6873.

3) On 28 April 2011 O2 Holdings Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended. The following is a summary of the statement of grounds and the correspondence surrounding it.

- a) The opponent is the proprietor of the trade marks shown in Annex A. For each earlier mark relied upon under Section 5(2)(b) the opponent has to provide various details. In answer to the question “1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?” the opponent has replied “All” as opposed to the option of selecting “some” and then specifying those selected. In the space where it states “Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g. why you consider the respective marks or goods and/or services to be similar?” the answer provided was to see the attached statement of grounds. Here the opponent initially, and in the first amended statement only made mention to Class 3 goods being identical or very similar, although still maintaining its opposition in respect of the other goods and services for which its marks were registered.
- b) The applicant wrote to the Registry on 4 January 2013 seeking clarification of the 5(2)(b) opposition. It stated that “It seems beyond question that many of the goods and services designated by these marks are totally dissimilar to the Applicant’s goods and that, pursuant to the IPO Tribunal Practice Notice (TPN) No.4 of 2000, the grounds of opposition as they currently stand are untenable and should not have been admitted”. The Registry agreed and sought an

amended statement of grounds. The opponent then submitted an amended statement of grounds, dated 29 April 2013, which expanded the goods it explicitly stated were similar, although overall reducing the number of classes of goods and services slightly. It stated:

“Moreover, the Class 3 goods covered by the subject application are identical to the goods and services covered by the earlier rights owned by the Opponent. These class 3 goods are also at least very similar to the other goods and services owned by the opponent within their earlier rights, namely the goods and services detailed in Classes 5, 9, 16, 35, 36, 41, 43, 44 and 45.”

- c) The applicant again wrote to the Registry, on 6 June 2013 stating that the amended statement of grounds was not adequately particularised in relation to the ground of opposition under Section 5(2)(b), and again referring to TPN 4/2000.
- d) As the parties were involved in settlement negotiations which they both hoped would resolve the issue the Registry replied:

“It is considered that the statement of case is acceptable in its present form, however prior to the hearing/decision on this matter, the opponent will be required to provide a full and detailed breakdown of which goods/services they consider are identical/similar and the reasons why. If this omits a large number of classes or goods/services or proves spurious, the Hearing Officer will take this into consideration when applying costs.”

- e) In January 2014 the negotiations broke down and, on 4 March 2014, a hearing was requested. The opponent was requested, on 10 March 2014 to provide a detailed breakdown of which goods and services covered by the earlier marks the opponent believed were identical or similar to the goods applied for and the reasons why. The response was as follows:

“1) Any coverage in class 3 in relation to the opponents earlier rights relates either to identical or very similar goods on the basis that they are all cosmetic, perfume or cleaning preparations.

2) Many of the opponent’s rights cover “retail services... relating to bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumes, essential oils, cosmetics, hair lotions, dentifrices” in class 35. These services are extremely similar to the goods in class 3 on the basis that they are effectively retail of the goods in question and that on the basis of current case law relating to the comparison of goods and services these should be considered at least highly similar.

3) In class 41 in many of the opponent's earlier rights there is coverage for "education; providing of training". These terms encompass, "education and training relating to the production, sale or use of any cosmetic, perfumery or cleaning preparation" and on this basis the services should be considered extremely similar to the goods covered by the opposed application on the basis of current case law relating to the comparison of goods and services.

4) Many of the opponent's earlier rights cover the term "hygienic and beauty care for human beings" in class 44. As beauty care often has cosmetic and perfumery products directly relating to the services, or provided in conjunction with the services, these services are extremely similar to the goods covered by the opposed application.

We believe that these goods and services are the closest terms covered by the opponent's earlier rights to the opposed application from a similarity of goods and services point of view. If the Registry would like us to identify exactly which earlier rights these terms relate to we would be more than happy to do so.

This does not mean that we believe that other terms in these specifications are not similar, but we do not believe that any other terms are more similar than the terms listed above.

The Registry has indicated that a restriction of the terms at this point may be taken into account in relation to the assessment of costs. Whilst of course this is acceptable, we would point out that the opponent still believes that all of the goods and services are relevant to the assessment, but for the purpose of procedural efficiency we are providing this list so as to focus the issues of the hearing. The opposition was filed more than two years ago and it would not of [sic] been appropriate for the opponent to limit the scope of its opposition at that stage on the basis that there is a real possibility that some or all of these rights could have been restricted or cancelled in the two years between filing the opposition and coming to hearing. There is a possibility that the coverage listed above no longer existed in the Opponent's earlier registrations and so would have been identifying different goods and services for the purpose of this assessment. We will argue very strongly against any impact on the costs award in this matter."

- f) The opponent contends that the marks and goods and services are similar and that there is a likelihood of confusion. It contends that the mark in suit offends against Section 5(2)(b) of the Act.
- g) The opponent contends that it has reputation in its marks CTM 7177363, CTM 9053497, CTM 9062845, UK 2279371 and UK 2296255 in relation to goods and services in classes 9, 38 & 41. These relate to its core telecommunication goods and services and its entertainment venue/services. It contends that use of the

mark in suit would, without due cause, take an unfair advantage of or be detrimental to the distinctive character or repute of the opponent's earlier trade marks. In particular, if the opponent is, through its O2/O₂ trade marks, portraying a young, trendy, cool and high tech brand to its customers, then the fact that the applicant has adopted the opponent's trade mark in its application takes unfair advantage of the distinctive character and/or repute of the opponent's marks. It is submitted that when consumers view the mark in suit the opponent's earlier marks are brought to mind and given the reputation in those marks there is an unfair advantage being taken. In the alternative the opponent contends that the consumer may believe that there is an economic link between the two parties, thereby giving the applicant an unfair advantage. Further, if the quality of the goods was poor then this could result in detriment to the distinctive character or repute of the opponent's marks. The opponent contends that the application offends against Section 5(3) of the Act.

4) On 10 December 2012 the applicant filed a counterstatement denying all the grounds. They put the opponent to strict proof of use of its marks 2197825, 2198460, 2279371 and 2296255. The applicants also contended that the opponent does not have a monopoly in the term O2 / O₂ and its variants for all goods and services (for ease of writing I shall henceforth use the term "O2" when referring to use of O2 and O₂); especially in classes where O2 may designate a characteristic of the goods. The applicant does not accept that the opponent has a reputation throughout the EU in relation to telecommunication goods and services and entertainment venue/services. The applicant points out that it already owns the following UK registrations and so its use of the term O2 is not without due cause.

Mark	Number	Date of filing and registration date	Class	Specification
Pure O ₂	2262951	19.02.01 01.02.02	3	Non-medicated toilet preparations; powders; creams and lotions, all for the face, hands and body; nail polish; nail polish remover; cosmetics; soaps; shower and bath preparations; preparations for the hair; preparations for cleaning the teeth; shaving and aftershave preparations; perfumes, colognes, toilet waters, eau de colognes; deodorants and anti-perspirants for personal use; toilet articles; essential oils.
ANEW Pure O ₂	2336776	03.07.03 13.02.04 REMOVED	3	Creams and lotions, all for the face, hands and body; skin moisturiser, skin cream, skin lotion, skin cleanser, facial treatment, eye cream, facial toner and facial mask; nail polish; nail polish remover; cosmetics; preparations for the hair; preparations for cleaning the teeth; shaving and aftershave preparations; deodorants and anti-perspirants for personal use; all the aforesaid being alone, in combination and/or in gift sets comprised of some or all of these items.

5) Both sides filed evidence and both parties seek an award of costs in their favour. The matter came to be heard on 28 April 2014 when the applicant was represented by Mr Roberts of Counsel instructed by Messrs DLA Piper UK LLP; the opponent was represented by Mr Stobbs of Messrs Stobbs.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 19 February 2013, by Peter Holmes the Director of Brand for Telefonica Europe Plc and O2 Holdings Limited which form part of the O2 Group of Companies along with companies in Germany, Ireland, Slovakia and the Czech Republic. All of these companies use O2 as their consumer brand. He states that his company has traded under the O2 mark since 1 May 2002. In October 2007 it launched its broadband service and opened the O2 arena in June 2007. He provides a large number of updates for each year, which would have been more easily digested and understood if it had been placed in a simple table format as well as being considerably shorter. All of the evidence is in relation to telecommunications, events (both sporting and artistic) held at the O2 arena (formerly the Millennium Dome) or sponsorship of arts events or sports teams by the company where the brand O2 featured prominently. By the end of 2009 the company had 21.3 million telecoms customers in the UK, excluding those who used the O2 service via Tesco; this figure includes both contracted and pay-and-go customers. Whilst accurate turnover figures for the period 2002-2010 are not provided due to issues following the buyout by Telefonica in 2007, it is clear from the figures provided that turnover has been in the thousands of millions. Advertising figures for the years 2006-2008 inclusive average approximately £63 million per annum. The company has also won a number of awards, all connected to telecommunications. A number of comments by various judges in relation to other cases pursued by the opponent were quoted. In all instances the finding was, on the evidence provided in those cases, that there was a strong reputation in relation to O2 used on telecommunication services. What is not stated is what evidence was provided in each of these cases. All of the exhibits provided relate to use of trade mark 2396406 / CTM 7177363 / CTM 9352337 / CTM 9053497 / CTM 9062845 / CTM 9279456 / 2279371 and 2296255. That is to say either O2 or O₂. There is no use shown of 2197825, 2198460, 2399319 or CTM 4347514.

7) Mr Holmes also provided a lot of information regarding events prior to May 2002 which clearly cannot relate to use of the O2 brand, and also information regarding the joint venture with Tesco which trades under the Tesco mark; neither of which is of assistance in my decision. The witness statement does not appear to have been tailored for this case at all but seems to be a generic catch all statement that can simply be printed out on each and every occasion required. This is clear from the statement in paragraphs 4 & 37 where he mentions a relevant date of 30 July 2012; and in paragraph 9 where he mentions a relevant date of 27 October 2010. Neither of these dates is the relevant date in the instant case. The turnover figures are shown in a mix of Euros and Sterling which seems an unnecessary complication.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 3 January 2014 by John Bergin, the Chief Trademark & Copyright Counsel of Avon, a position he has held since 1999. He provides his views on the similarity of the marks. He also provides lists of other trade marks registered by the IPO and OHIM for goods in class 3 which have O2 or O₂ within them. He contends that the existence of these marks shows that the IPO and OHIM consider the O2 element to have a weak inherent distinctiveness in relation to class 3 goods. Further, for goods in class 3 the rejuvenating effect of oxygen on the skin is so well known that the element lacks distinctiveness when used on such goods. He provides a list of class 3 products where the mark includes O2 which he states are on sale in the UK. There are fourteen such marks, 2 of which are for makeup, one for detifrices, one for nail varnish and ten for skincare. The evidence of use relates to a single page taken from the internet which in most cases shows the item being for sale. However, the majority are dated after the relevant date and at least one is not on sale in the UK but in Australia. There is no evidence of the scale of sales under any of the marks. He points out that the word "PURE" has several meanings such as wholesome, unsullied, unmixed with other matter. He also points out that the mark was chosen as his company have used "a virtually identical mark" (paragraph 32 of the witness statement) beginning in 2001 on class 3 goods. During the period 2001- 2006 sales in the UK and Ireland of such branded goods were USD6.5 million.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) At the hearing a number of preliminary issues were raised. In response to a question regarding whether the evidence of Mr Holmes was prepared specifically for this case given the relevant dates quoted, which bore no relation to the instant case, Mr Stobbs replied:

"This specific witness statement was prepared for this case, but obviously a lot of the material in it has been used in other cases. It may well be that those dates have come across and have not been corrected adequately. I can only apologise for that."

11) Mr Stobbs also accepted that there was no evidence of use in relation to marks 2197825 or 2198460 and so neither could be relied upon as the applicant has put the opponent to strict proof of use of these marks. When asked to explain why they had not been withdrawn at the point of the evidence being filed, when asked on 10 March 2014 to particularise its case, or indeed in his skeleton Mr Stobbs commented:

"I have to admit, sir, that I do not recall seeing your letter of 10th March, which is entirely my mistake. I apologise for the lack of further clarification after that."

After I pointed out that a response had been received, he said:

“Sure, I understand, indicating that we did not seek to further particularise and that we would deal with any narrowing addressing the grounds at the hearing. That tends to be the approach that we have taken in these types of oppositions where there are wide grounds. I apologise if that has caused any inconvenience for yourself.”

He further commented:

“The reason why I have not, at least at the outset of the case -- and it may well be that from a best practice point of view we should have particularised further earlier this year -- is because we were never quite sure. These oppositions can take a long time. We are never quite sure of the nature and extent of the rights that will still be in existence at the time of the hearing. Therefore, we do tend to not want to restrict unduly just in case there are issues with the earlier rights.”

12) Having confirmed that the opponent’s strongest case was clearly based on the class 3 goods of the three marks 2396406, 7177363 and 9053497, Mr Stobbs accepted that he could not provide a cogent argument as to why the vast majority of the other goods and services for which these three marks are registered/applied for would be considered similar to the goods applied for by the applicant. Nor could he explain why his skeleton argument referred to all the classes of goods and services for which the three marks now relied upon are registered as opposed to the restricted specification in the statement of grounds dated 29 April 2013. In response to why I should not regard the opponent’s original reliance on these goods and services as an abuse of process he replied:

“Obviously, it is entirely up to you as to whether you consider it an abuse of process. I can only apologise if it has caused inconvenience. I do not tend to feel that where there is a class of goods that has relevant services in it -- for the purposes of an analysis like in the context of horticultural or agricultural services there are services in that class covered by that mark that could certainly be argued as being similar -- it really helps in any significant way to particularise any further. I think it is very clear from the arguments that have been put in by both sides, both in submissions and in the skeletons, what the actual issues are. It does not cause any significant additional time or effort on the part of any party to do so.”

13) In relation to the above points Mr Roberts relied, firstly, on the comments contained within his skeleton, where he had commented at length on the inadequacies (as he saw them) of the opponent’s pleading. However he accepted he could provide further submissions in relation to costs. Also at the hearing, Mr Roberts accepted that there was considerable overlap in the class 3 goods between the mark applied for and the class 3 goods of the three marks now relied upon, albeit they differ slightly due to the differences in the opponent’s registrations. He accepted that the respective class 3 goods varied from similar to identical. With these considerations in mind I now turn to the first ground of opposition under Section 5(2)(b) which reads:

5.-(2) A trade mark shall not be registered if because -

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

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

14) 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.”

15) The opponent is relying upon its three trade marks UK 2396406, CTM 7177363 and CTM 9053497 which are all clearly earlier trade marks. Given the interplay between the dates that the opponent’s marks were registered (respectively, 5 October 2007, 20 November 2008 and pending) and the date that the applicant’s mark was published (4 February 2011) the Trade Marks (Proof of Use, etc) Regulations 2004 do not apply.

16) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *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 and *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). In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out summary shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch):

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make

direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Distinctive character of the opponent's earlier trade marks

17) The opponent has provided evidence of use of its mark in the EU/UK. It is clear from the evidence (and the applicant accepted) that in relation to the three marks relied upon the opponent had a substantial reputation in relation to mobile phones and telecommunications services. However, there was no use provided by the opponent in relation to class 3 goods, nor was any argument put forward that companies in the mobile and telecommunications field were known for also supplying cosmetics. The

opponent's marks cannot therefore benefit from an enhanced distinctiveness in relation to the goods in class 3.

18) The applicant contended that the marks "O2" and "O₂" lacked distinctiveness when used on class 3 goods as the average consumer will be aware that body care products frequently use the above terms to designate the oxygenating effect of the product as this is seen as enhancing the effect of the product and is therefore used as a descriptive term. The evidence of Mr Bergin was pointed to, including the evidence of use by others in the cosmetics industry of the term O2/O₂ as a descriptor. State of the register evidence is often put forward but is rarely given much weight as it does not reflect the actual marketplace. Similarly when evidence of use of other marks consists, as in the evidence of Mr Bergin, of a single page from the internet showing each "other" mark on goods offered for sale, it carries little weight. As mentioned in my evidence summary many of these pages were after the relevant date and at least one is from outside the UK. More importantly, there is an absence of information regarding the extent of the use of these marks. Even if I were inclined to accept the contention that the term O2/O₂ would be seen as a reference to the oxygenating effects of body care products, such a descriptor would relate only to items such as skincare products not soaps, perfumes or cosmetics. Further, even in regard to items such as skincare products the opponent's registered marks would still be considered to have a degree, albeit low, of inherent distinctiveness for such products simply on the basis that they are registered marks (Case C 196/11 *Formula One Licensing BV v OHIM*). The opponent's mark has to be regarded as having a high degree of inherent distinctiveness when used on items such as perfume and other non-skincare products.

The average consumer and the nature of the purchasing process

19) I must now determine the average consumer for the goods of the parties, which can be broadly said to be perfumes, soaps, dentifrices, skincare products and cosmetics. Clearly, in today's metrosexual world these products would be aimed at the whole of the general public. Given the number of allergies that such products cater for such as dry oily skin, hair etc, the fact that these products will be used on the consumer's body and the results may be seen by others, particularly in the case of cosmetics where colour will be an important factor, then I believe that such purchases will not be made without some consideration. In smaller independent specialist shops the products tend to be behind the counter and so contact with a sales assistant is required, in larger chains such as Boots, Superdrug or supermarkets these types of products are typically found on shelves or counter where self selection is required, they may also be purchased via the internet, by catalogue. I must take judicial note that such items are also sold by salespersons visiting the purchaser's home. To my mind, selection will be predominantly by eye, although word of mouth recommendations may also have a part to play. Therefore, the initial selection will usually be visual but aural considerations cannot be overlooked.

Comparison of goods

20) Although it was accepted by the applicant that the goods in the respective specifications in class 3 were identical or similar I think it requires greater clarity. The accepted test for comparing goods and services is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the CJEU in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods and services;
- b) The respective users of the respective goods and services;
- c) The physical nature of the goods and services;
- d) The respective trade channels through which the goods and 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 and 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 in the same or different sectors.

21) I also take into account the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

22) For ease of reference I reproduce the class 3 specifications of both parties:






Applicant's specification	Opponent's specification
perfumes, fragrance, toilet waters, eau de colognes; aftershave preparations	2396406: Class 3: Perfumes; aftershaves; eau de toilette. CTM 7177363 : perfumery, CTM 9053497: perfumery,
soaps; Non-medicated toilet preparations; toiletries; shower and bath preparations;	CTM 7177363: soaps; CTM 9053497: soaps;

<p>preparations for cleaning, moisturising, colouring and styling the hair;</p> <p>essential oils (cosmetic);</p> <p>preparations for cleaning the teeth;</p> <p>skin care preparations; skin moisturizers; body and beauty care preparations; powders, creams and lotions, all for the face, hands and body; beauty masks; talcum powder; nail polish; nail polish remover; enamels for manicure; false nails; adhesives for cosmetic purposes; cosmetics; eye makeup remover, eye shadow, eye liner, mascara, lipstick, lip liner, lipgloss; make-up foundation; blusher; tissues impregnated with cosmetic lotions;</p> <p><i>shaving preparations; deodorants and anti-perspirants for personal use; all the aforesaid being alone, in combination and/or in gift sets comprised of some or all of these items.”</i></p> <p>cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes;</p>	<p>CTM 7177363: hair lotions CTM 9053497 hair lotions;</p> <p>CTM 7177363: essential oils, CTM 9053497: essential oils,</p> <p>CTM 7177363: dentifrices. CTM 9053497: dentifrices.</p> <p>CTM 7177363: cosmetics CTM 9053497: cosmetics,</p> <p><i>2396406: Class 3: Perfumes; aftershaves; eau de toilette.</i></p> <p><i>CTM 7177363: soaps;</i> <i>CTM 9053497: soaps;</i> <i>CTM 7177363: hair lotions</i> <i>CTM 9053497 hair lotions;</i> <i>CTM 7177363: essential oils,</i> <i>CTM 9053497: essential oils,</i> <i>CTM 7177363: cosmetics</i> <i>CTM 9053497: cosmetics,</i></p> <p>CTM 7177363: cosmetics CTM 9053497: cosmetics</p>
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23) Using the test set out above I reach the following conclusions. The items above in bold I consider to be identical, those in italics I regard as very similar, those in normal type I regard as only just similar.

Comparison of trade marks

24) The marks of the two parties are as follows:

Applicant's mark	Opponent's marks
	2396406   A series of two marks
	CTM 7177363 
	CTM 9053497 

25) Given that each of the opponent's marks contains O₂, I shall refer to them in the singular, and use as the basis of comparison CTM 7177363. The applicant contends that its mark is three times as long as that of the opponent; that the mark in suit is three syllables long as opposed to the two syllables in the opponent's mark; the common element is an alphanumerical combination and that the additional word "Pure" is at the start of the applicant's mark which is the aspect most focussed upon by consumers. The applicant also prays in aid comments of various Courts in respect of comparisons between "K9" and "Julius K9"; "21" and "READ 21" and "On" and "PLAY ON". These cases were determined on the facts of the individual cases and do not alter the criteria for assessing the similarity of marks set out earlier in the decision.

26) It is indisputable that the opponent's mark appears in full in the instant mark. The only difference between the marks is that the mark applied for has the word "Pure" as its initial element. It is accepted by both parties that the public will recognise the O₂ element as the chemical symbol for oxygen. The applicant contends that the average consumer will simply regard this as referring to the oxygenating benefits of certain skincare products, it could not explain how this would apply to perfumes and other parts of its specification. The applicant also contended that the word "PURE" is well known and has an accepted meaning of unsullied, or uncontaminated. Its use before the O₂ element is claimed by the applicant to alter the conceptual meaning as it will be seen to allude to connotations of lightness, freshness and brightness in relation to perfumes and cosmetics.

27) There are obvious visual and aural similarities as well as differences. Overall I believe that the marks have a moderate level of visual and aural similarity. Moving onto conceptual similarity, I believe that there will be two groups of consumers. There will be those who are aware that the "O₂" aspect of the mark refers to oxygen and will have the

conceptual image of pure oxygen. Whilst this may be laudatory in respect of certain of the goods which are said to rejuvenate the skin by oxygenating it, this cannot be claimed for goods such as perfume where such a term as “pure oxygen” has no meaning. To my mind, the term “pure” has such a laudatory meaning for all the goods in class 3 suggesting that they are uncontaminated, containing only natural ingredients and kind and gentle on one’s skin. As such I believe that it is more likely that the mark will be seen as a laudatory term “pure” and the sign “O₂” identifying the origin, i.e. pure goods from the O2 people. To my mind there is a reasonable degree of conceptual similarity.

Likelihood of confusion

28) I must now take all the above into account and consider the matter globally taking into account 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. The evidence does not allow me to find the opponent to have a reputation in class 3 goods, however, the goods are either identical or similar. There is also a degree of visual, aural and conceptual similarity between the marks. Whilst this similarity is not that high it is enough that even when used on goods which are only of a relatively low level of similarity that, allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The applicant referred to the use made of similar/identical marks prior to the registration dates of the opponent’s marks. However, as TPN 4/09 pointed out in paragraphs 4 & 5 this is not a defence which can be relied upon under Section 5(2)(b). This seems to be a defence of concurrent use without confusion. I accept that the evidence shows that the applicant had a significant turnover in its earlier mark in the UK, however there is no evidence that the opponent has used its mark upon class 3 goods. Therefore, there is no evidence of concurrent use which could be used to infer that there is no likelihood of confusion in the future. **The opposition under Section 5(2) (b) therefore succeeds.**

29) Given this finding there is no need to consider the other ground of opposition.

CONCLUSION

30) **The opponent has succeeded in its opposition.**

COSTS

31) At the hearing it was agreed that the decision would be issued and that both parties would then have the opportunity to provide written submissions on costs in the light of my comments regarding the conduct of the opponent in this case. Both sides are given two weeks from the date of this decision to provide any submissions they may wish to make solely on the issue of costs. The appeal period will be set as part of the costs award decision.

Dated this 21st day of May 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**