

**O-165-17**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
REGISTRATION NO 3075286  
BY RANDHOM SOLUTIONS LTD  
FOR THE TRADE MARK:**



**IN CLASS 21  
AND  
THE APPLICATION FOR A DECLARATION OF INVALIDITY THEREOF (UNDER  
NO. 501111)  
BY  
RASHPAL KAUR DHILLON**

## BACKGROUND

1) Randhom Solutions Ltd ('the proprietor') is the registered proprietor of the following trade mark registration in respect of *Brushes for cleaning footwear* in class 21:



2) The trade mark was applied for on 03 October 2014 ('the relevant date'). It was subsequently published in the Trade Marks Journal for opposition purposes on 24 October 2014 and entered on the register on 02 January 2015.

3) Rashpal Kaur Dhillon ('the applicant') claims that the trade mark registration offends under sections 5(2)(b) of the Trade Marks Act 1994 ('the Act') and should therefore be declared invalid. In support of this ground, two trade mark registrations are relied upon. Both are for the mark **BOOT BUDDY** and cover identical goods in classes 3 and 21. Neither is subject to proof of use as per Section 6A of the Act. It therefore suffices to use only one of the registrations as the basis for my decision, as the opponent's prospect of success is the same for both. The details of the mark I will use, including the goods relied upon, are as follows:

**TM No: 3057371**

## **BOOT BUDDY**

**Class 3: Cleaning, polishing, scouring and abrasive preparations; shoe polish.**

**Class 21: Articles for cleaning purposes; brushes for cleaning footwear.**

**Filing date: 28 May 2014**

**Date of entry in the register: 10 October 2014**

4) The proprietor filed a counterstatement in which it denies, with supporting explanation, that there is any visual, aural or conceptual similarity between the marks.

5) Both parties filed evidence and submissions during the evidence rounds. Neither party requested to be heard. Only the applicant filed written submissions in lieu of a hearing. I now make this decision on the basis of the papers before me.

**Applicant's evidence**

6) This takes the form of two witness statements. The first is in the name of the applicant. Much of this statement contains submissions regarding the similarity of the marks and goods which I will not detail here but will bear in mind and refer to, as appropriate, in the following decision. In terms of factual information, the applicant states, inter alia, the following:

- The first ever BOOT BUDDY unit was sold in March 2015 in the UK. This is after the relevant date.
- Approximately £4000 has been spent on advertising through a number of magazines and around £1500 on advertising through social media. No explanation is given as to when this advertising took place and therefore, it is not clear whether it took place prior to the relevant date.
- Confusion has already arisen between the respective marks. When searching for BOOT BUDDY on amazon.co.uk, the applicant obtained a reference to BOOTBRO. He exhibits a print-out of the search results for 'BOOT BUDDY' on that website showing three results which includes a Bootbro product. He states that it can be seen from the print-out that the product sold under Bootbro is the same as the product that he sells under BOOT BUDDY and that this means people searching for a boot cleaning product will think the proprietor's mark belongs to him.

7) The second witness statement is from Debra Clare Hiddleston of ip21 Limited, the applicant's representative in these proceedings. Ms Hiddleston provides a printout from the trade marks register showing "only 45 hits" for live marks beginning with the word BOOT in class 21. She also states that none of those marks are for *brushes for cleaning footwear*.

### **Proprietor's evidence**

8) This comes from Daksha Mistry, Company Secretary of Randhom Solutions Ltd. This consists of a mixture of factual statements and submissions about the similarity of the marks and the parties' goods which I will not summarise here but will refer to if and when it is appropriate to do so in my decision.

### **DECISION**

9) Section 5(2)(b) of the Act states:

"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."

10) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## **The principles**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

11) The proprietor asserts that, although the parties' goods are similar, the applicant's goods have a water element whereas its goods are brushes uniquely designed to clean football and rugby boots. These submissions do not assist the proprietor. The applicant has not had to file proof of use meaning that I must take into account the full breadth of goods covered by its registration. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Further, marketing strategies are temporal and may change with the passage of time. See for instance, *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, where the Court of Justice of the European Union stated:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is

inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

It follows that I am required to make the assessment of the likelihood of confusion notionally and objectively solely on the basis of the marks and goods as they appear before me. The actual goods which either party may currently be providing in the marketplace is irrelevant to that assessment. Proceeding on that basis it is self – evident that the proprietor’s *brushes for cleaning footwear* are identical to the same goods listed in the applicant’s specification.

### **Average consumer and the purchasing process**

12) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

13) The average consumer of *Brushes for cleaning footwear* is the general public. They may vary in price but can generally be described as inexpensive. The consumer is likely to take into account the functionality of the product and may wish to ensure that it is suitable for purpose and therefore, generally speaking, I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act is likely to be mainly visual given that these are goods which will likely be selected off the shelf in a retail establishment or after perusal of

images of the product from a website. However, I do not discount aural considerations which may also play a part.

### **Comparison of marks**

14) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

It would therefore be wrong to artificially dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

15) In its evidence, the proprietor has provided images of what it states are the respective marks to be compared. However, the proprietor does not show the exact mark which is relied upon by the applicant in these proceedings. Rather, it shows a mark consisting of BootBuddy + a stylised device of the letter ‘B’ + the strapline “Leave the outdoors outside”. In approaching the assessment of similarity of the marks and likelihood of confusion, I must do so on the basis of the parties’ marks as they appear on the register. In this regard, the following comments of the Court of Appeal in *L’Oreal SA v Bellure NV* [2008] R.P.C. 9 are pertinent:



“The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too—as though it formed part of the registered mark.”

Accordingly, the marks to be compared are:

**BOOT BUDDY**

v



16) The applicant’s mark consists of the words BOOT BUDDY in a standard font. The two words combine to form a unit in which neither word materially dominates the other. The overall impression and distinctiveness of the mark lies in the combination of the two words.

17) The proprietor’s mark consists of the words BOOT and BRO conjoined, in a very slightly stylised font. BRO is presented in green. The two words in this mark also combine to form a distinctive unit in which neither materially dominates the other. The second element of the mark is the outline and sole of a shoe. That element is not particularly distinctive (if at all) in relation to the goods at issue for obvious reasons; although its visual impact is not insignificant and it is far from negligible, it has much less weight in the overall impression than the BOOTBRO element.

18) Insofar as visual similarity between the marks is concerned, I should first of all point out that, as the applicant’s mark could notionally be used in the same colour (green) as the proprietor’s mark that is not a factor which distinguishes the marks. A clear point of visual similarity is that both marks contain the word BOOT as their first word. However, the second words BUDDY and BRO, although both beginning with the letter ‘B’, are visually quite distinct. There is also the sole device in the proprietor’s mark which is absent from the applicant’s mark. Considered overall, there is a low degree of visual similarity.

19) In terms of aural similarity, the sole device in the proprietor's mark will obviously not be articulated. The word elements in the respective marks will be pronounced in an entirely predictable fashion. The first syllable of the marks (BOOT) is obviously identical. The second syllables are different despite both beginning with 'B' (BRO v BUD) and the third syllable of the applicant's mark (DY – pronounced DEE) is absent from the proprietor's mark. I find there to be a fairly low degree of aural similarity overall.

20) Turning to the conceptual comparison, the applicant argues that the marks "are very similar indeed" because both marks start with BOOT and 'BRO' and 'BUDDY' both mean a friend, pal or chum<sup>1</sup>. I accept that that is how the word BUDDY is likely to be instantly perceived in the applicant's mark such that the mark, overall, sends a message of a 'boot friend'. However, it seems to me that the position as regards the proprietor's mark is less clear cut. Whilst I accept that some consumers may perceive the word BRO as meaning friend, others may perceive it simply as an abbreviation for BROTHER and nothing more (i.e. a male sibling) resulting in an overall concept of a 'boot brother' and others may perceive no clear meaning at all from the combination BOOTBRO. In the first scenario, the marks would be conceptually highly similar (if not identical); in the second and third scenarios, the overall concept of the applicant's mark would not be shared by the proprietor's mark.

### **Distinctive character of the earlier mark**

21) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular

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<sup>1</sup> Definitions from the Free Dictionary are provided in support of this.

undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

22) Although the applicant has filed some evidence to demonstrate that it has used its mark, the first sale did not take place until after the relevant date and there is also nothing to show that the advertising in magazines took place before that date. Accordingly, I can only take into account the inherent distinctiveness of the mark.

23) I note that in his witness statement, Mr Dhillon states:

“I chose the mark BOOT BUDDY because it lets the consumer know what the product is. The word BOOT tells the consumer that the product is for use on boots or shoes, and the BUDDY word alludes to the fact that it is an aid for boots and shoes.”

Although the combination BOOT BUDDY may not be a natural description for the goods, it is, as the applicant itself states, clearly allusive. I consider the mark to be possessed of a below average degree of inherent distinctiveness.

24) In reaching the conclusion above, I have not overlooked the applicant’s assertion that, as the results of the search of the register did not show any marks containing

the word BOOT in relation to *brushes for cleaning footwear*, this shows that that word is not commonly protected as a trade mark for those goods and that BOOT BUDDY is also therefore extremely distinctive. I do not accept this. The lack of any marks on the register containing BOOT for the relevant goods may be precisely because that word, of itself, is non-distinctive in relation to them. That evidence does not, in any way, show that the mark BOOT BUDDY is extremely distinctive.

### **Likelihood of confusion**

25) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

26) The applicant claims that confusion has already arisen between the marks on the website amazon.co.uk. I do not consider that the evidence<sup>2</sup> supports this contention. It merely shows that when searching for the BOOT BUDDY product on that website, a list of similar products are brought back in the search results (i.e. other types of brushes for cleaning footwear), one of which happens to be the BOOTBRO product (there are also others brought back such as 'The New Aqua Brush Muddy Boot'); it does not show that the average consumer, when faced with those results, will be confused between the trade marks on those products. Accordingly, this evidence does not assist the applicant.

27) I have found that the parties' goods are identical which is a factor weighing in the applicant's favour. I have also found that some consumers may perceive the marks as being conceptually highly similar (if not identical). It may be that those consumers

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<sup>2</sup> Exhibit RKD5 to the witness statement of Mr Dhillon.

represent a significant portion (or even the majority) of relevant consumers. This is important because the test is whether a “sufficiently significant”<sup>3</sup> percentage of relevant consumers are likely to be confused (i.e. it is not necessary that all relevant consumers be confused). Nevertheless, having weighed all relevant factors, I do not consider that, when paying a normal degree of attention during the mainly visual purchase, that group of consumers are likely to mistake one mark for the other. The highly similar (if not identical) concept perceived by those consumers is not enough to outweigh the low degree of visual similarity and fairly low degree of aural similarity between the marks, bearing in mind the below average degree of distinctiveness of the earlier mark. Neither do I consider that those consumers are likely to believe that the respective goods come from the same or linked undertaking(s). The common element is not “so strikingly distinctive”<sup>4</sup>, the proprietor’s mark does not “simply add a non-distinctive element to the earlier mark”<sup>5</sup>, it does not appear to me to be “entirely logical and consistent with a brand extension”<sup>6</sup> of the applicant’s mark and I cannot see any other reason why the marks may be indirectly confused. The applicant is in an even worse position as regards other average consumers who perceive it’s mark to have a concept which is absent from the proprietor’s mark. The lack of any conceptual similarity perceived by them means that they are even less likely to be confused. **The application for a declaration of invalidity fails.**

## **COSTS**

28) As the proprietor has been successful, it is entitled to a contribution towards its costs. Using the guidance in Tribunal Practice Notice 4/2007, which was in force at the time of commencement of these proceedings, but keeping in mind that the proprietor has not incurred the expense of legal representation, I award the proprietor costs on the following basis:

Considering the application for invalidation and preparing the counterstatement	£100
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<sup>3</sup> *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, [37]

<sup>4</sup> *L.A. Sugar Limited v By Back Beat Inc.*, Case BL-O/375/10, [16].

<sup>5</sup> *ibid*

<sup>6</sup> *ibid*

Written Submissions £100

**Total: £200**

29) I have made no award to the proprietor for the preparation of its evidence as it was fairly brief, much of it contained submissions rather evidence of fact and the factual information that was present did not assist me.

30) I order Rashpal Kaur Dhillon to pay Randhom Solutions Ltd the sum of **£200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**.Dated this 6th day of April 2017**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**