

O-237-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3187707 & 3187337
BY TANTRUM INTERNATIONAL LIMITED and TATUM INTERNATIONAL LIMITED
TO REGISTER THE TRADE MARKS
TANTRUM AND TATUM
IN CLASSES 3, 16 & 26 AND
IN CLASSES 3, 14, 25 & 26 RESPECTIVELY
AND**

**IN THE MATTER OF OPPOSITIONS
THERE TO UNDER No. 408880 AND 408882 BY
AZIENDE CHIMICHE RIUNITE ANGELINI FRANCESCO A.C.R.A.F. SPA**

BACKGROUND

1) On 23 September 2016, Tatum International Limited applied to register the trade mark TATUM in respect of the following goods:

In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.

In Class 14: Precious metals; jewellery; precious stones; chronometric instruments.

In Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

2) The application was examined and accepted, and subsequently published for opposition purposes on 23 December 2016 in Trade Marks Journal No.2016/052.

3) On 26 September 2016, Tantrum International Limited applied to register the trade mark TANTRUM in respect of the following goods:

- In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps.
- In Class 16: Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks.
- In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

4) The application was examined and accepted, and subsequently published for opposition purposes on 23 December 2016 in Trade Marks Journal No.2016/052.

5) On 23 March 2017 Aziende Chimiche Riunite Angelini Francesco A.C.R.A.F. S.p,A (hereinafter the opponent) filed notices of opposition, subsequently amended which are only directed at the class 3 goods applied for in both applications. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
TANTUM ROSA	M 1199750	<p>International registration date and Date of Designation of the EU: 12.12.13</p> <p>Priority date 18.07.13 (ITALY)</p> <p>PENDING</p>	3	<p>perfumery, essential oils, cosmetics, hair lotions; Goods and services limited to: after-shave lotions; beard dyes; beauty masks; bleaching preparations [decolorants] for cosmetic purposes, cleansing milk for toilet purposes; color-removing preparations; colorants for toilet purposes; cosmetic creams, cosmetic dyes, cosmetic kits, cosmetic pencils, cosmetic preparations for eyelashes, cosmetic preparations for baths, cosmetic preparations for skin care, cosmetics, cream for whitening the skin, depilatories, depilatory preparations, depilatory wax; douching preparations for personal sanitary or deodorant purposes [toilettries]; eau de cologne; essential oils, essential oils of cedarwood, essential oils of citron, essential oils of lemon; extracts of flowers [perfumes]; eyebrow cosmetics, eyebrow pencils; false eyelashes, false nails; hair colorants, hair dyes, hair lotions, hair spray, hair waving preparations; heliotropine; henna [cosmetic dye]; hydrogen peroxide for cosmetic purposes; incense; ionone [perfumery]; jasmine oil; javelle water; lavender oil, lavender water; lip glosses; lipsticks; lotions for cosmetic purposes; make-up, make-up powder, make-up preparations, make-up removing preparations; mascara; mint essence [essential oil], mint for perfumery; moustache wax; musk [perfumery]; mustache wax; nail art stickers, nail care preparations, nail polish, nail varnish; neutralizers for permanent waving; oils for cosmetic purposes, oils for perfumes and scents, oils for toilet purposes; perfumery; perfumes; petroleum jelly for cosmetic purposes; pomades for cosmetic purposes; rose oil; scented water; shampoos, skin whitening creams; sun-tanning preparations</p>

				[cosmetics]; sunscreen preparations; talcum powder, for toilet use; terpenes [essential oils]; tissues impregnated with cosmetic lotions; toilet water; toiletries; waving preparations for the hair;
TANTUM	EU 8602567	Filing date: 08.10.09 Date of entry in register 01.03.10	5	Pharmaceutical preparations; sanitary preparations for medical purposes; dietetical substances for medical use, disinfectants;
TANTUMFLU	EU 13801592	Filing date 06.03.15 Date of entry in register 19.06.15	5	Dietary supplements and dietetic preparations; Pest control preparations and articles; Dental preparations and articles; Medical and veterinary preparations and articles; Nutritional additives to foodstuffs for animals, for medical purposes; Nutritional supplements; Albuminous foodstuffs for medical purposes; Dietary supplements for humans; Dietetic foods adapted for invalids; Dietetic foods for use in clinical nutrition; Dietetic foods adapted for medical purposes; Food for diabetics; Food for medically restricted diets; Analgesics; Antipyretic analgesics; Anaesthetics; General anesthetics; Local anaesthetics; Inhalant anesthetics; Analgesic balm; Pharmaceutical compositions; Topical analgesic creams; Decongestants; Febrifuges; Paracetamol; Chemical preparations for pharmaceutical purposes; Effervescent analgesic pharmaceutical preparations; Pharmaceutical preparations; Chemicals for pharmaceutical use; Chemico-pharmaceutical preparations; Suppositories; Tisanes [medicated beverages]; Cachets for pharmaceutical purposes; Chemical preparations for medical purposes.
TANTUMGRIP	EU 15326291	Filing date 12.04.16 Date of entry in register 28.07.16	5	Dietary supplements and dietetic preparations; Pest control preparations and articles; Dental preparations and articles; Medical and veterinary preparations and articles; Nutritional additives to foodstuffs for animals, for medical purposes; Nutritional supplements; Albuminous foodstuffs for medical purposes; Dietary supplements for humans; Dietetic foods adapted for invalids; Dietetic foods for use in clinical nutrition; Dietetic foods

			adapted for medical use; Food for diabetics; Food for medically restricted diets; Analgesics; Antipyretic analgesics; Anaesthetics; General anesthetics; Local anaesthetics; Inhalant anesthetics; Analgesic balm; Pharmaceutical compositions; Topical analgesic creams; Decongestants; Febrifuges; Paracetamol; Chemical preparations for pharmaceutical purposes; Effervescent analgesic pharmaceutical preparations; Pharmaceutical preparations; Chemicals for pharmaceutical use; Chemico-pharmaceutical preparations; Suppositories; Tisanes [medicated beverages].
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a) The opponent contends that the marks of the two parties are highly similar and the respective goods are identical and/or similar. It contends that, in respect of its goods in class 5, existing case law deems such goods to be similar to the class 3 goods applied for, (although it does not name the cases) as they coincide in purpose, are directed at the same relevant public and can be manufactured by the same companies. They also claim that the distribution chain is the same with them all being sold via chemists, pharmacists, drug stores and supermarkets. It suggests that the goods are complementary and so similar. With regard to 15326291 the opponent contends that “pharmaceutical preparations” includes goods intended for personal cleansing such as medicated soaps which are similar to the applicant’s goods as they are in competition with, of a similar nature and purpose and part of the same “personal care” industry. The opponent again claims that existing case law suggests that cosmetics and pharmaceutical preparations are similar, being directed at the same public, manufactured by the same companies, sold through the same distribution channels and are complementary and thus similar. As such it contends that the application offends against Section 5(2)(b) of the Act.

6) For ease of reference I shall henceforth refer to Tatum International Ltd and Tantrum International Ltd as the applicants. On 6 June 2017 the applicants filed counterstatements. They deny that the marks are similar, either visually, aurally or conceptually. They put the opponent to proof of use regarding all goods in respect of EU 8602567. They also seek to rely upon the MOBILIX v OBELIX Case T-336/03.

7) In November 2017 the applicants amended their 3187707 specification by deleting the term “soaps” from the class 3 specification. The new specification therefore reads: In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions.”

8) This amendment was not enough for the opposition to be withdrawn.

9) Both parties seek an award of costs in their favour. Only the opponent filed evidence. Neither party wished to be heard. Both parties provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT’S EVIDENCE

10) The opponent filed two witness statements. The first, dated 20 September 2017, is by Gianluigi Maria Frozzi the sole director of the opponent company. He points out that although the opponent’s trade mark EU8602567 is registered for goods in classes 3 & 5 it is only relying upon the goods listed above (see paragraph 5) in class 5 namely “Pharmaceutical preparations; sanitary preparations for medical purposes; dietetical substances for medical use, disinfectants”. He states that the mark TANTUM has been used *solus* and in combination with descriptive elements such as ROSA, VERDE, LEMON AND EUCALYPTUS on goods such as anti-inflammatory creams and gels and ointments; throat and mouth lozenges/sprays/liquids; gynaecological preparations in liquid and powder form and sanitizing wipes. He states that products sold under the mark TANTUM have been sold in pharmacists, supermarkets and on-line such as by Amazon. He provides the number of products sold in the EU under the mark TANTUM as follows:

Year	No of products sold	Total turnover in EU €	Advertising €million
2012	16,864,935	62,399,730	10.0
2013	17,071,468	65,713,723	7.9
2014	16,766,294	65,904,053	7.6
2015	17,596,797	72,887,760	9.3
2016	16,739,980	71,733,140	9.0

11) Mr Frozzi does not specify exactly what products have been sold, nor does he provide any breakdown into figures for the most popular products. Nor does he provide any indication of the price of goods or market share. He provides figures for advertising by country but these are in a number of

currencies. Concentrating on the main countries such as Germany, Austria, Greece, Italy, Portugal and Spain which are all in Euros I have amalgamated them in to a single (approximate) figure in the table above. The vast majority of advertising each year (approximately 90% of the expenditure) was in Italy. He provides the following exhibits:

- AMF1: The photographs and examples of packaging are said to show use of TANTUM on cream products sold in Belgium and the Netherlands during the 5 year period December 2011-December 2016; on creams/gels sold in Spain; on creams, gels, wipes, mouthwash, nasal solutions and lozenges sold in Italy and product literature (dated April 2016 and December 2013); promotional material and mock up packaging (dated September 2011) for lozenges sold in Eire. It is pointed out that the packaging for Spain and Italy has “use by dates of 2018/19 and 2020. Mr Frozzi states that pharmaceutical products have a shelf life of three years so the use-by dates indicate that the packaging was produced in 2015-2017. Whilst it is clear that some of the packaging relates to cream with pain relieving properties, it is not clear because of the various languages used (none are in English) what conditions these products were intended to relieve/assist. That the lozenges are for sore throats and painful mouths is very clear.
- AMF2: Printouts from the Wayback Machine archive showing use of the trade mark on four websites. Also in this exhibit is a google image search for the word TANTUM with the majority of images being the opponent’s products. The search was not carried out during the requisite period but Mr Frozzi contends that it shows an online presence that could not have come about in the short time between the publication of the applications and the search being done.
- AMF3: Invoices relating to the Belgium and Dutch sales shown at exhibit 1, as well as various other EU countries such as Spain, Austria, and Lithuania. He points out that the mark is often abbreviated on invoices to “TNT”. The vast majority of invoices refer to TANTUM cream, with the majority of the remainder showing sales of TANTUM lozenges. There are a couple of mentions of mouthwash and sprays.
- AMF4: This shows advertisements for throat lozenges in weekly magazines in Greece, in 2015-2016.

12) The second witness statement, dated 22 September 2017, is by Clare Louise Mann the opponent’s Trade Mark Attorney. She provides a definition of the term “cosmetics” i.e. a substance

placed in contact with the exterior of the human body with the purpose of cleaning, perfuming, protecting it, or changing its appearance. She also contends that the opponent's class 5 goods and the class 3 goods of the applicant are similar as they are part of the same market sector, target the same relevant public and have the same distribution channels. She provides details from the Chemist Direct UK and Superdrug websites which show that both sell make-up and perfumery in the same store as pharmaceutical and dietetic substances. She claims that this shows that both sets of goods fall within the personal care sector and are complementary. She contends that the word "ROSA" is easily understood by the average UK citizen as meaning "rose" or "pink". She provides numerous examples of use of the term "ROSA" in just such a context where they contain rose oil, are rose scented or simply pink. She states that "FLU" is easily understood as an indication of the illness and that the term "COLDS AND FLU" are frequently used. She also provides a definition from Collins English Dictionary for the word "influenza" which mentions that it used to be known as "grippe" or "grip". The definition for "grippe" states it is a former name for influenza. However, I note that the definition implies that it is an eighteenth century word.

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

DECISION

14) The opposition is based upon 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."

15) 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.”

16) The opponent is relying upon its trade marks listed in paragraph 5 above which are clearly earlier filed trade marks. The applicants have requested proof of use of the opponent’s mark EU 8602567 which has a registration date of 1 March 2010, which is more than five years prior to the publication of the applicants’ marks on 23 December 2016. The relevant section states:

“6A. - (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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

17) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the relevant period for the proof of use is 24 December 2011 – 23 December 2016. In deciding this issue I take into account the case of *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, where Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] 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 Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089]

and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as

a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in*

question". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

19) I also take into account the comments of Mr Daniel Alexander Q.C. as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/230/13, where he stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

20) In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls

to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

21) The opponent is relying upon its registration EU 8602567 for “Pharmaceutical preparations; sanitary preparations for medical purposes; dietetical substances for medical use, disinfectants;” in Class 5. In his witness statement Mr Frozzi claims that his company has used the mark upon the whole of the specification. However, the evidence which was filed to corroborate this statement falls short, as it showed use of the mark TANTUM only on a pain relief cream and mouth lozenges. The invoices filed showed a similar picture, with no explanation provided as to precisely what the products were intended for, or why they fell into the categories for which the mark is registered. It is clear from the comments of the learned judge at paragraph 19 above that where it would have been relatively easy for the opponent to submit invoices/sales slips relating to the items claimed for the relevant period I should be slow to accept inconclusive evidence. I must therefore consider the specification for

which the mark has been used. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

22) In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

23) To my mind, the wording in the specification is far too wide for any of them to be upheld. I do not believe that there is a reasonable term which can act as an overall description of the goods on which use has been shown and so will have to rely upon the actual description of each item. **I therefore find that the opponent has shown use only upon pain relief cream and mouth lozenges in the relevant period.**

24) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *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.

(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.

The average consumer and the nature of the purchasing process

25) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

26) The goods at issue in these proceedings are solely in classes 3 & 5. In broad terms these can be regarded as beautification products and pharmaceuticals. The average consumer for such goods will be the public at large, including businesses such as beauticians, hairdressers. All of the goods at issue may be sold through a range of channels, such as retail premises, the Internet and catalogues. I also have to take into account the possibility of recommendations so aural considerations have to be taken into account. As neither party's specifications are limited I must keep all of these trade channels in mind. Clearly, the average consumer's level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive cosmetics or mouth lozenges, the average consumer will pay attention to considerations such as the exact function, what the ingredients are as well as issues such as colour. **Overall the average consumer for the goods is likely to pay a reasonable degree of attention to the selection of beautification products and pharmaceuticals.**

Comparison of goods

27) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

28) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

29) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

30) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM* case T-133/05, the General Court (“GC”) stated:

“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 T110/01 *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).”

31) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

32) The relevant Class 3 goods of the two parties to be compared are:

Opponent’s goods	Applicants’ goods
M1199750: perfumery, essential oils, cosmetics, hair lotions; toiletries;	3187337: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps 3187707 : Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions;

33) Clearly, the specifications of both of the applicants’ marks are fully encompassed by the opponent’s specification. In some instances the words are identical “perfumery; essential oils; cosmetics; hair lotions”, whilst the terms “make-up; eye make-up; eyeliners; blushers; lipsticks;” are all recognised cosmetics and so encompassed by that term within the opponent’s specification. Similarly the term “soaps” in 3187337 is encompassed by the term “toiletries” within the opponent’s specification. **The class 3 goods of the two parties are identical.**

34) I next turn to consider the opponent’s class 5 specifications with the applicants’ class 3 goods. The opponent’s specifications in respect of marks 13801592 and 15326291 are identical with the exception of the word “purpose” underlined below in 13801592 becomes “use” in 15326291 and 13801592 has the additional wording in italics at the end of the specification which do not appear in 15326291. The goods to be considered are as follows:

Opponent’s Goods	Applicants’ Goods
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<p>8602567: Class 5: pain relief cream and mouth lozenges.</p> <p>13801592 and 15326291: Class 5: Dietary supplements and dietetic preparations; Pest control preparations and articles; Dental preparations and articles; Medical and veterinary preparations and articles; Nutritional additives to foodstuffs for animals, for medical purposes; Nutritional supplements; Albuminous foodstuffs for medical purposes; Dietary supplements for humans; Dietetic foods adapted for invalids; Dietetic foods for use in clinical nutrition; Dietetic foods adapted for medical <u>purposes</u>; Food for diabetics; Food for medically restricted diets; Analgesics; Antipyretic analgesics; Anaesthetics; General anesthetics; Local anaesthetics; Inhalant anesthetics; Analgesic balm; Pharmaceutical compositions; Topical analgesic creams; Decongestants; Febrifuges; Paracetamol; Chemical preparations for pharmaceutical purposes; Effervescent analgesic pharmaceutical preparations; Pharmaceutical preparations; Chemicals for pharmaceutical use; Chemico-pharmaceutical preparations; Suppositories; Tisanes [medicated beverages]; <i>Cachets for pharmaceutical purposes</i>; <i>Chemical preparations for medical purposes</i>.</p>	<p>3187337: Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps</p> <p>3187707: Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions;</p>
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35) The opponent contends that there are similarities between the applicants' "cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions" and its own products such as "pharmaceutical preparations", "sanitary preparations for medical purposes", and "dietetical substances for medical use" because it contends they are part of the same market, target the same relevant public, and have the same distribution channels as cosmetics (as well as perfumes, essential oils, and soaps), all being sold through online or high-street pharmacies such as Boots. The opponent also contends that "pharmaceutical products" and "cosmetics" are similar and refers to the ruling of the General Court of the European Union in *El Corte Inglés v Market Watch Franchise & Consulting, Inc.* (T62/15) [2016], in which the General Court upheld the decision of the Board of Appeal and affirmed that pharmaceutical preparations in Class 5 were similar to cosmetics in Class 3, since "(i) the purpose of certain pharmaceuticals, such as skin or hair care preparations with medical properties, medicated dentifrices and medicated soaps, coincide in part with the purpose of cosmetic creams or lotions, dentifrices and soaps not for medical use and (ii) both of those types of products were sold in pharmacies" [27]. The opponent claims that:

“Further, UK case law has for many years recognised the narrowing between these fields of goods to the extent that a product can be both a pharmaceutical and a cosmetic, leading to the use of the term ‘cosmeceuticals’ in many newspapers and magazines in the UK owing to the growth of over-the-counter pharmaceuticals, as well as cosmetics with pharmaceutical ingredients in order to promote restoring/modifying physiological functions (*Ozone Laboratories v Ozone UK* (O-245-09) [2008] [26]).”

36) The opponent further claims that the terms “dietetical substances for medical use”, “dietary supplements”, “nutritional supplements” in its specification are also similar to the applicants’ “cosmetics” owing to similarities in purpose (namely, improving one’s health and appearance). It also refers me to the Registry decision in *Clinique Laboratories LLC v Clinique La Prairie Franchising* (O-488-13) [2013] in relation to which the opponent states:

“nutritional supplements in Class 5 were deemed similar to cosmetics in Class 3 as these products coincide in purpose and are complementary in the sense that they are part of the same industry and target the same consumer, so the relevant public often uses both products in order to improve their appearance [47]. In this connection, many dietary supplements comprise vitamins and minerals which have effect on the human body externally as well as internally, such as by improving the appearance of hair or nails. Based on this reasoning, there is clear similarity with the meaning of a cosmetic as previously defined.”

37) The opponent also contends that “hair lotions” are similar to the “pharmaceutical preparations” in its specifications. To support this argument they refer to the decision of the General Court of the European Union in *Glycan Finance UK v LLR-G5* (T539/15) [2016]. The opponent contends that in this case, similarity was found between Class 3 hair lotions and Class 5 pharmaceutical products on the basis that the former “can include chemical or pharmaceutical products, those products can overlap as regards their purpose, they use the same distribution channels such as pharmacies, they target the same public and they are often manufactured by the same companies” [38].

38) The opponent further contends that there is similarity between “soaps” and the “pharmaceutical and sanitary preparations” in its specifications. In support of this claim it refers to the decision in *S. S. H. v Medicom Healthcare* (BL-378-10) [2010], in which “pharmaceutical preparations” were held to be similar goods to “soaps” on the grounds that some pharmaceutical preparations are intended for personal cleansing and moisturising purposes and take the form of a soap substitute [20]. As a result, the applicants’ “soaps” are in direct competition with the Opponent’s “pharmaceutical preparations”,

and are similar in nature and purpose. It also refers to *El Corte Inglés v Market Watch Franchise & Consulting, Inc.* (T62/15) [2016], where the General Court held that sanitary preparations in Class 5 were similar to soaps in Class 3 on the grounds that these products may be manufactured by the same companies and have the same distribution channels and end users and that “*certain sanitary preparations for medical use, such as antiseptics or antibacterial lotions, have, just like soaps, a cleaning purpose*” [27].

39) As a general point the findings in other cases might be of interest but unless the full circumstances and evidence provided are known the findings are not binding upon the Registry. I take into account the comments in *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, where the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

40) Thus where the similarity between the respective goods or services is not self - evident, the opponent must show how, and in which respects, they are similar. The opponent contends (at paragraphs 34 - 37 above) that as goods are aimed at the same relevant public and are sold in the same shops they are similar. Given that the average consumer for the applicants’ products is the general public (including business users) and the goods are sold in a variety of shops including supermarkets, one might conclude, using the same logic, that cosmetics are similar to baked beans. I am willing to accept that certain pharmaceutical products aimed at cleaning skin or hair such as acne cream or lice killers could be deemed similar to cosmetic cleansing products. However, if something is labelled as a “pharmaceutical product” it usually means it has a form of drug in it or it is somehow medicinal. I believe that such products are usually purchased for specific reasons, not simply washing away dirt or imparting a shine as claimed for cosmetic products. When one moves onto lipstick, eyeliners etc. then the similarity is even further removed. The opponent has provided no evidence other than the fact that both pharmaceuticals and lipsticks etc. are sold by outlets such as Boots to show that such products are similar. **I conclude that there is a low degree of similarity between the terms “cosmetics; hair lotions; soaps” in the applicants’ specifications and**

“pharmaceutical products” and “sanitary preparations for medical purposes” in the opponent’s specifications. I also conclude that there is no similarity between the opponent’s goods “pharmaceutical products; sanitary preparations for medical purposes; dietetical substances for medical use” and the applicant’s goods of “make-up; eye make-up; eyeliners; blushers; lipsticks”.

Comparison of trade marks

41) 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 them, 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.”

42) It would be wrong, therefore, to artificially dissect the trade 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 them. To my mind, the opponent’s strongest case lies with its marks M 1199750, EU 8602567 and 13801592. The specifications of 13801582 and 15326291 are highly similar in terms of the relevant goods in this opposition. If the opponent cannot succeed under the three marks I have selected then it would equally fail under its other mark. The trade marks to be compared are:

Opponent’s trade mark	Applicant’s trade marks
M 1199750: TANTUM ROSA	3187707: TANTRUM
EU 8602567: TANTUM	3187337: TATUM
EU 13801592: TANTUMFLU	

43) I fully accept the opponent's contention that the dominant and distinctive element in its mark 1199750 is the word TANTUM as I believe that the ROSA element will be seen as a reference to a colour and/or fragrance. Regarding the visual comparison between TANTUM and the applicants' two marks the opponent states:

"The Applicants' marks differ from "TANTUM" by just one letter: the addition of an "R" in the case of "TANTRUM", and the absence of an "N" in respect of "TATUM". In both cases, the letter in question is in the middle of the mark and thus has little visual impact on the mark as a whole, being lost among the coinciding letters on either side. In support of this point we refer to the decision taken by the Board of Appeal in *Lek Farmaceutvska Družba v Omega Pharma Innovation and Development* (R1925/2014-5) [2016]. In that case, the marks in question shared six identical letters placed in the same order, and differed only by the letter "R", placed in the fifth position in the Applicant's mark (which is precisely the case in respect of the present Applicants' mark, "TANTRUM"). This difference alone was considered incapable of distinguishing the signs, particularly owing to the limited significance of its position in the middle of the overall mark.

When visually comparing the mark "TATUM" with "TANTUM" in their Counter-Statement, the Applicants note the similar lengths of the marks (five and six letters respectively), and claim that the only coinciding elements between these marks are the coinciding letters "TUM". This is clearly incorrect. It is noteworthy that all of the Applicants' mark is included within the opponent's earlier mark and with the letters in the same order. We therefore wholly contend the Applicants' claim that the marks are visually dissimilar. (In respect of "TANTRUM", the Applicants do not engage in a comparison with the Opponent's earlier registration for "TANTUM".)

We submit that "TANTUM" is again the most distinctive element in both of the above marks, with "FLU" and "GRIP" being descriptive terms referring to a characteristic of the goods covered thereby, which include "*pharmaceutical preparations*", "*paracetamol*", and "*tisanes [medicated beverages]*". "FLU" and "GRIP" are terms in the English language that refer to a contagious viral infection and thus the Opponent is using these terms to indicate the circumstances in which its product is designed to be taken. Paragraphs 11 and 12 of the aforementioned Witness Statement demonstrate that these terms are being used descriptively by the Opponent to refer to its pharmaceutical products, and the evidence appended thereto shows that numerous other undertakings selling pharmaceutical preparations have products that include the term "FLU" or a

synonym thereof. Therefore, the average consumer of such goods cannot rely on the elements “FLU” and “GRIP” as an indication of commercial origin.

Accordingly, these terms must be deemed of low distinctiveness within the earlier marks, meaning that “TANTUM” is the memorable element in the mind of the average consumer.

In further support of our position, we would point out that when undertaking a visual comparison of the marks in their Counter-Statements, the Applicants also found that “FLU” and “GRIP” are “*common words*”, indicating their low degree of distinctiveness.”

44) To my mind, the opponent is correct in most of its comments and I accept that visually all three of the applicants’ marks are similar to both of the opponent’s marks to a medium degree.

45) Moving onto the aural comparison the opponent contends:

“We submit that there is also a high degree of aural similarity between the Applicants’ marks and “TANTUM”, one of the Opponent’s earlier marks and the dominant element of its three other earlier registrations. Phonetically, it is noteworthy that both “TANTRUM” and “TATUM” have two syllables, as does the Opponent’s earlier registration, “TANTUM”. “TAN-TUM”, being a hybrid between the Applicants’ trade marks, shares an identical first syllable with “TAN-TRUM” and identical second syllable with “TA-TUM” (these pronunciations were also stated by the Applicants in the Counter Statements).

The remaining syllable in each case is also highly similar. As a result, the Applicants’ marks and “TANTUM” have an identical rhythm, and the alliterative ‘T’ sound which is identically contained in all of the respective marks as repeated, harsh stop sounds dominate the marks phonetically (i.e. “TAN-TRUM”, “TA-TUM”, “TAN-TUM”). In contrast, the dissimilar element in both cases does not occupy a significant phonetic position within the mark, meaning that the absence of the “N” in “TATUM” and addition of an “R” in “TANTRUM” has limited aural impact. In support of this argument we refer to the decision of the Hearing Officer in *Viamax AB v OA Internet Services Ltd* (O365-12) [2012] in which the dissimilar “A” in the third position of the mark “VIAMAX” was not considered an acute difference with the mark “VIMAX”. It was concluded that this difference would not have a significant impact on the average consumer, resulting in a finding of a high degree of aural similarity.”

46) Again I accept much of the opponent's views although the findings in another case are not binding upon me and are not particularly helpful in assisting me to reach a decision. **There is clearly a degree of aural similarity between the marks of the opponent and the applicants, although to my mind the marks of the two parties are similar only to a medium degree.**

47) Turning to the issue of the conceptual comparison the opponent comments:

“Likewise, the Applicants' mark “TATUM” is meaningless and, although the Applicants' mark “TANTRUM” is a dictionary word, it has no relevance in the field of Class 3 and 5 goods. A conceptual comparison therefore cannot be made (a conclusion that the Applicants also arrive at in their Counter-Statements when they state that “*there can be no conceptual comparison between the marks*”).”

48) I disagree with the opponent's views regarding the conceptual comparison. I accept that all three of the opponent's marks and the applicants' mark TATUM are made up words which therefore do not give rise to any conceptual image being formed in the average consumers' mind. The applicants' mark TANTRUM is a well-known dictionary word meaning “an uncontrolled outburst of anger and frustration; a violent demonstration of rage or frustration; a sudden burst of ill temper; typically in a young child”. Whilst this has no relevance to goods in class 3 this does not mean that it possess no conceptual image, indeed quite the reverse. Perfumes and make-up have frequently had odd names which mean little or nothing in respect of the good but which conjure up an image to the average consumer such as “*Flash*”, “*Oriental Lace*” or “*Adventure*”. **To my mind, whilst all three of the opponent's marks and the applicant's mark TATUM are conceptually neutral, the applicants' mark TANTRUM is conceptually different to the opponent's marks.**

Distinctive character of the earlier trade mark

49) 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 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).”

50) The opponent's marks consists of a single word TANTUM which is an invented word, and in the case of mark M1199750 a second word ROSA which will have a meaning to the average consumer of a colour (pink) or fragrance (Rose) when used on goods in class 3 which typically have such characteristics. In the case of 13801592 the second word is FLU which again describes what illness the products are designed to remedy. **To my mind, the earlier marks are of medium to high inherent distinctiveness but cannot benefit from enhanced distinctiveness through use as the evidence provided covers use of a number of variations which include the word TANTUM and which cover a very wide range of goods.**

Likelihood of confusion

51) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive these trade marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means, although not discounting aural considerations and that they will pay at least a reasonable degree of attention to the selection of such goods.
- the opponent's marks have a medium to high degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the class 3 goods of the two parties are identical. The applicant's goods "cosmetics; hair lotions; soaps" in class 3 are similar to a low degree to the opponents named goods in class 5. The applicants' goods "make-up; eye make-up; eyeliners; blushers; lipsticks" in class 3 are not similar to the opponent's goods in class 5.
- the applicants' 3187337 mark TATUM is visually and aurally similar to the opponent's marks to a medium degree, whilst the marks of both parties are conceptually neutral.
- the applicants' 3187707 mark TANTRUM is visually and aurally similar to the opponent's marks to a medium degree, but conceptually different to the opponent's marks.

52) I take into account the comments in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

53) I note that in *The Picasso Estate v OHIM*, Case C-361/04 P, the Court of Justice of the European Union found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the

relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

54) I also note that in *Nokia Oyj v OHIM*, Case T-460/07, the General Court stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

55) Also in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

56) Whilst in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

57) In respect of application 3187337 for the mark TATUM in respect of goods in class 3, I found that these goods are identical to those of the opponent’s mark M1199750 whilst the mark in suit is visually and aurally similar to the opponent’s mark TANTUM ROSA to a medium degree and the parties’ marks are conceptually neutral. Given that in respect of class 3 goods the term ROSA has meaning in

terms of colour and/or fragrance I can quite envisage a consumer believing that the goods were from the same source of origin. I find that there is a likelihood of consumers being confused into believing that the goods applied for under the mark in suit 3187337 TATUM and provided by the applicants are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) succeeds in relation to all the goods applied for in class 3. Although this must be regarded as a provisional finding until the opponent's mark is accepted as having protection in the EU.**

58) In respect of application 3187707 for the mark TANTRUM in respect of goods in class 3, I found that these goods are identical to those of the opponent's mark M1199750 whilst the mark in suit is visually and aurally similar to the opponent's mark TANTUM ROSA to a medium degree. However, I found that conceptually the marks were different, the opponent's mark being meaningless or neutral whereas the applicant's mark has a well-known meaning. Whilst in respect of class 3 goods the term ROSA has meaning in terms of colour and/or fragrance I cannot envisage a consumer believing that the goods were from the same source of origin. The idea of an outburst of rage provides a strong and compelling mental image. I find that there is no likelihood of consumers being confused into believing that the goods applied for under the mark in suit 3187707 TANTRUM and provided by the applicants are those of the opponent or provided by some undertaking linked to it. Nor is there any likelihood of indirect confusion. **The opposition under Section 5(2) (b) fails completely.**

59) As the opponent's mark M1199750 provided it with its strongest case the findings above would not be changed if one took into account the opponent's marks EU 8602567 or EU13801592.

CONCLUSION

60) The opposition under section 5(2)(b) in respect of mark 3187337 TATUM provisionally succeeds in respect of the following goods in Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions; soaps. This is dependent upon the opponent's mark M 1199750 achieving protection in the EU.

61) However, the mark will continue onto the Register in respect of the following goods which were not opposed:

In Class 14: Precious metals; jewellery; precious stones; chronometric instruments.

In Class 25: Clothing; footwear; headgear; swimwear; sportswear; leisurewear.

In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

62) The opposition under section 5(2)(b) in respect of mark 3187707 TANTRUM fails in respect of all the goods in Class 3. Therefore, this mark will continue onto the Register in respect of the following goods:

- In Class 3: Perfumery; essential oils; cosmetics; make-up; eye make-up; eyeliners; blushers; lipsticks; hair lotions.
- In Class 16: Paper; cardboard; printed publications; printed matter; computer printers (Inking ribbons for -); bookbinding materials; books; adhesives for stationery or household purposes; artists' paint brushes; music sheets; music scores; periodical magazines; photographs; stationery and educational supplies; typewriters; Instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printing blocks.
- In Class 26: Lace; embroidery; ribbons; braid; buttons; hooks and eyes; pins; needles; artificial flowers.

COSTS

63) As both sides have achieved a measure of success I do not propose to favour either side with an award of costs.

Dated this 23rd day of April 2018

George W Salthouse
For the Registrar,
the Comptroller-General