

O-778-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3260533

BY EVOIQ LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 3

AND

OPPOSITION THERETO UNDER NO. 411400

BY LA BROSSE ET DUPONT, SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE

Background and pleadings

1. On 02 October 2017, EVOIQ LIMITED (“the applicant”) filed trade mark application number UK00003260533 for the mark detailed on the cover page of this decision, for the following goods:

Class 3: Products for body care, oral care, lip care and baby care namely, washes, lotions, creams, soap, toothpastes, gels, lip balm, lip gloss, lip shimmer, baby shampoo, diaper rash cream and sunscreens; all the aforesaid goods being organically produced.

2. The application was accepted and published for opposition purposes on 20 October 2017. LA BROSSE ET DUPONT, Société par Actions simplifiée (“the opponent”) partially opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon EU Trade mark (“EUTM”) registration 3799939, the pertinent details of which are as follows:

Mark: MISS DEN

Filing date: 28 April 2004

Date of registration: 07 September 2005

Goods (as relied upon): Class 3: cosmetics

3. The goods opposed by the opponent are ‘products for body care, lip care namely, washes, lotions, creams, soap, gels, lip balm, lip gloss, lip shimmer and sunscreens; all the aforesaid goods being organically produced’ in Class 3.

4. By virtue of having a filing date that predates the filing date of the contested mark, the opponent’s EUTM qualifies, under section 6 of the Act, as an earlier mark for the purposes of these proceedings. As the earlier mark completed its registration procedure more than five years prior to the publication date of the applicant’s mark, it is subject to the proof of use conditions, as per section 6A of the Act. To this extent, the opponent made a statement of use corresponding to the goods on which it relies (cosmetics). The applicant, in its counterstatement, did not request the opponent provide proof of use of the earlier registered mark upon which it relies. The

consequence of this is that the opponent is entitled to rely upon the goods for which it claims use (cosmetics) without having to file evidence to establish genuine use.

5. The opponent claims that the applied for mark is phonetically similar to its earlier mark and that some of the goods applied for are identical or similar, leading to a likelihood of confusion.

6. The applicant filed a counterstatement in which it denies that the marks and the goods are similar.

7. The opponent is represented by Dolleymores, whereas the applicant represents itself. Neither party chose to be heard, nor did they file evidence. The applicant filed written submissions at the evidence rounds and the opponent filed written submissions in lieu of a hearing.

Preliminary issues

8. The applicant, in its written submissions, has made comparisons between its applied for mark and what it refers to as the opponent's mark. What the applicant has attached to its written submissions as the opponent's mark is a stylised form of the words MISS DEN. This is not what the opponent relies upon for the purposes of this opposition. The opponent relies upon its plain word mark ('MISS DEN') and so that is what I must compare the application to.

9. The opponent, in its written submissions, submits the following:

"The Applicant's submissions have incorrectly identified the Opponent's trade mark. The Opponent's trade mark registration on which the opposition is based is the word only mark MISS DEN and not the stylised version set out in the applicant's submissions. [...] As was determined in the CFI decision *Peek & Cloppenburg v OHIM T-386/07*,

"the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue.

...since the earl[jier] mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for.”

As such, the protection acquired through the registering of a word only trade mark is not limited to a particular stylisation and must be considered to include any stylisation applied to the mark in the application, which includes a stylisation identical or similar to that in the Application.

[...]

As set out in paragraph 13, the Opponent’s trade mark is a word only mark, therefore the visual comparison should be made on the basis that both marks are using identical stylisation.”

10. Whilst a word trade mark registration does protect the word itself written in any normal font¹, I do not consider it right, in the case before me, to make any form of comparison based on an envisaging of the opponent’s word mark in the same (or similar) script to the DEN element of the applied for mark. In my view, such stylisation is outside the realms of fair and notional use.

Decision

Section 5(2)(b)

11. Section 5(2)(b) of the Act states that:

“5 (2) A trade mark shall not be registered if because –

(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,

¹ See Professor Ruth Annand’s comments in *Bentley Motors Limited v Bentley 1962 Limited*, Case BL O/158/17

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

The principles

12. The following principles are gleaned from the judgments 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 BV*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *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 the 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

13. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*² that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v*

² Case T-133/05

OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

14. When making the comparison of goods, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*³ is also relevant. The Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

15. Guidance on this issue has also come from Jacob J in the *Treat*⁴ case, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of service;
- (c) The respective trade channels through which the goods or services reach the market;
- (d) 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;
- (e) 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.

³ Case C-39/97

⁴ [1996] R.P.C 281

16. The goods to be compared are as follows:

Earlier mark (as relied upon)	Applied for mark (as opposed)
Class 3: cosmetics	Class 3: products for body care, lip care namely, washes, lotions, creams, soap, gels, lip balm, lip gloss, lip shimmer and sunscreens; all the aforesaid goods being organically produced

17. In reaching the conclusions which follow, I have taken into account (but do not intend to record here) all the written submissions made in relation to this aspect of the case.

18. Since ‘products for body care, lip care’ defines what the goods in the applicant’s specification are, only the goods after the word ‘namely’ require consideration.

19. Cosmetics are defined⁵ as substances applied to the face or body to improve its appearance. This accords with my understanding of the term. *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*⁶ is relevant here. Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations” ... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

20. Neuberger J. went on to hold that skin lightening cream and/or dry skin lotion fell within the term cosmetics and were thus identical.

⁵ See Cambridge English dictionary

⁶ [2000] F.S.R. 267 (HC)

21. Bearing in mind the above guidance, I come to the view that the applicant's 'lotions, creams, gels, lip balm, lip gloss, lip shimmer' fall within the scope of the opponent's 'cosmetics'. These goods are identical in accordance with the principle outlined in *Meric*.

22. 'Washes' and 'soap' are unlikely to fall within 'cosmetics' given that they are generally just for cleaning purposes rather than improving appearance. However, given their reasonably close trade channels together with the facts that (i) they all form part of the personal grooming regime and (ii) soap and washes could well include ingredients designed to improve the appearance of the face/body (i.e. moisturising), there is still a high degree of similarity between these goods.

23. 'Sunscreens' are also unlikely to fall within 'cosmetics' given the difference in purpose (to protect skin from the sun as opposed to improving its appearance). That being said, the nature and function are similar to body/face lotions, for example, in that sunscreen may contain moisturising ingredients and body/face lotions may have UV protection; they both could be sold in lotion form, sold in similar bottles, and applied in a similar way. Although they do not directly compete with or complement each other, overall, I consider sunscreens and cosmetics to have a reasonably high degree of similarity.

The average consumer and the nature of the purchasing act

24. It is necessary for me to determine who the average consumer is for the respective parties' goods. 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*⁷, 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

⁷ [2014] EWHC 439 (Ch)

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.”

25. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*⁸.

26. I am of the view that the average consumer of the parties’ goods is a member of the general public. Although the price of the goods can vary (for example, some skin lotions can be quite expensive, others less so), they are not, generally speaking, particularly expensive and they are purchased fairly frequently. I bear in mind that the average consumer is likely to consider, for example, the ingredients, the suitability for their skin and the cost of the goods in question and I find that, taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average. The purchase is likely to be predominantly visual: the goods will be self-selected from physical stores or websites. However, I do not discount that there may be an aural element with conversations taking place with sales staff in a retail setting.

Comparison of marks

27. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*⁹ that:


⁸ Case C-342/97

⁹ Case C-591/12P

“...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.”

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

29. The trade marks to be compared are as follows:

Earlier mark	Applied for mark
MISS DEN	

Overall impression

30. In its written submissions, the opponent submits the following:

“The dominant and distinctive component of the mark in the Application is Den.
[...] The dominant and distinctive element of the Opponent’s trade mark is also

DEN. As above, this element is highly distinctive for the goods on which the opposition is based, namely cosmetics. The element MISS will merely be considered by the relevant public to denote that this trade mark relates to a range of products designed for young women and, as such, will not reduce the dominance and distinctiveness of the element DEN.”

31. The opponent’s earlier mark consists solely of the words MISS DEN. Whilst the word MISS makes reference to a female, neither word is smaller, in a subservient position or descriptive for the goods for which the mark is registered. Consequently, the overall impression rests in the two word combination MISS DEN with neither word materially dominating the other.

32. The applicant’s mark consists of a number of elements. The word Den is presented in blue/green letters in a particular form of stylised font. The words ORGANIC PERSONAL CARE are presented below the word Den in black capital letters. Above the letter ‘e’ in Den are three green leaf devices of varying sizes. Behind the words and devices is a grey and white rectangular background. I consider that the word Den has by far the greatest impact in the overall impression, given its size and position. The stylisation of the word also plays a role, although a lesser one. A much lesser role is played by the phrase ORGANIC PERSONAL CARE which, positioned beneath the word Den and in a smaller typeface, is likely to be seen as descriptive by the average consumer. The leaf devices play a fairly weak role in the mark and the grey and white background is likely to be seen as little more than that; a background.

Visual comparison

33. The similarity lies in all three letters (d-e-n) of the more dominant component of the applicant’s mark, which are the same as the second word in the opponent’s mark, a word which makes at least an equal contribution (along with the other word) in that mark. That DEN is presented as Den (in upper and lower case) in the applied for mark does not create a difference because, notionally, the mark could be used in all upper case lettering.

34. In terms of differences, the opponent's mark contains an additional word MISS, and the applicant's mark also has the descriptive phrase ORGANIC PERSONAL CARE and the various figurative and stylistic elements described above.

35. Taking all of these factors into account, and bearing in mind the overall impressions I have outlined, I consider the two marks in question to be visually similar to a medium degree.

Aural comparison

36. In terms of aural similarity, the opponent submits the following:

“The dominant element of both marks is the word DEN which are aurally identical. The additional aural elements, being ORGANIC PERSONAL CARE in the Application and MISS in the Registration, have lesser distinctive character and although they reduce the aural similarity slightly the relevant consumer will still consider DEN to be aurally dominant in both marks.”

37. Notwithstanding the above submissions, the earlier mark will be referred to as MISS DEN in its entirety. In contrast, it is unlikely that the applicant's mark will be referred to in its entirety ('Den organic personal care'). I find that it is more likely that this would be shortened to Den, with the remaining words, being seen as descriptive and in much smaller lettering, not being articulated. Overall, I consider there to be a medium degree of similarity between the marks. If am I wrong and the average consumer does articulate 'organic personal care' in the application, I would find the aural similarity to be of a low degree.

Conceptual comparison

38. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgements of the GC and

the CJEU including *Ruiz Picasso v OHIM*¹⁰. The assessment must be made from the point of view of the average consumer.

39. The opponent submits the following:

“The element DEN has a meaning in English, however, this is unrelated to the goods in both the Application and the Registration. The element DEN is conceptually identical in both marks. The elements ORGANIC PERSONAL CARE and leaf logo in the Application merely indicate, conceptually, that the products are organic ones. The element MISS in the Registration merely indicates, conceptually, that the products are intended for women. As such, the marks are conceptually identical and merely differ in their designation of the characteristics of the goods. The marks are conceptually highly similar.”

40. It is unclear from the above whether the opponent submits that the marks are conceptually identical or conceptually highly similar, given that it states both.

41. The applicant submits that the words Den organic personal care, with the addition of the green leaves, relate conceptually to ‘naturally & organic’, whereas the earlier mark relates conceptually to women.

42. Conceptually, I am of the view that the average consumer will see MISS DEN as a female’s name, albeit an unusual one. I think it unlikely that the known English word den will have any conceptual significance within the mark. On the other hand, Den is the dominant element of the applied for mark and will be understood by the average consumer to relate to the English word meaning the home of some wild animals (or other meanings derived from this). Overall, I do not consider there to be any conceptual similarity between the marks, indeed, on my assessment, they differ.

¹⁰ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

Distinctive character of the earlier mark

43. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik* 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).”

44. As no evidence has been filed by the opponent, I have only the inherent distinctiveness of the earlier mark, MISS DEN, to consider. Miss and den are ordinary dictionary words individually, but they combine to create a name, albeit an unusual one. I consider it is entitled to an average level of inherent distinctive character.

Likelihood of confusion

45. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]) and I must make a global assessment of the competing factors (*Sabel BV v Puma AG* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]).

46. There are two types of confusion that I must consider:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

47. The overall structure of the respective marks and the degree of similarities that arise from that (particularly bearing in mind the one (more dominant) word v two words (and its concept)) means that in my view the average consumer is unlikely to misremember or miss-recall one as the other, or vice versa. Even accounting for imperfect recollection, I still conclude that there is no likelihood of direct confusion.

48. In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*¹¹:

“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

¹¹ BL O/375/10

other hand, only arises where the consumer has actually recognised 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'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI", etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

49. I have borne in mind that the examples given by Mr Purvis in *L.A. Sugar* were intended to be illustrative in the context of that case, and not to impose rigid rules¹². The categories of cases where indirect confusion may be found are not closed. Each case must be assessed on its own facts, and my assessment must take account of

¹² See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

the overall impression created by the marks. I must try to envisage the instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier, or vice versa. I must assess whether the average consumer will make a connection between the marks of the type that would lead them to assume that the goods or services in question are from the same or economically linked undertakings.

50. The goods are identical or highly similar. The marks are visually and aurally similar to a medium degree. I have, though, found that there is a conceptual difference. Whilst conceptual differences may sometimes counteract aural and visual similarities, this does not always occur in every case (see *Nokia Oyj v OHIM*¹³). In my view, the nature of the common element in the marks DEN/Den is fairly unusual for those goods and is certainly an odd word to form part of the name MISS DEN. This, in my view, would lead an average consumer who has encountered the DEN (stylised) mark to assume that MISS DEN is a female orientated version of that brand; the same operates in reverse. The conceptual difference will not be dwelled upon such that the average consumer will regard the use as mere co-incidence. This leads me to believe that the average consumer will think the goods are provided by the same undertaking.

Outcome

51. There is a likelihood of confusion. The opposition succeeds.

52. As the opposition was only directed against some of the goods of the application, the applied for mark may proceed to registration for the following goods:

‘Products for oral care and baby care namely, toothpastes, baby shampoo, diaper rash cream; all the aforesaid goods being organically produced’ in Class 3.

¹³ Case T-460/07

Costs

53. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the other side’s statement:	£200
Written submissions:	£300
Total:	£600

54. I order EVOIQ LIMITED to pay LA BROSSE ET DUPONT, Société par Actions simplifiée the sum of **£600**. 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 December 2018

Emily Venables
For the Registrar,
The Comptroller-General