

O/789/18

TRADE MARKS ACT 1994

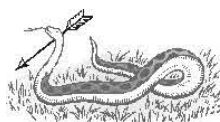
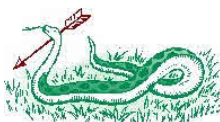
IN THE MATTER OF APPLICATION NO. UK00003256122, UK00003256132 AND
UK00003256130 BY

THE BRITISH DISPENSARY (L.P.) COMPANY LIMITED

TO REGISTER THE FOLLOWING SERIES OF MARKS IN CLASSES 3 AND 5:

SNAKE BRAND **SNAKE BRAND**

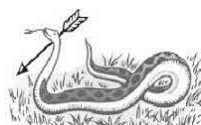
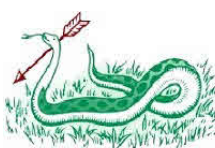
AND



**SNAKE
BRAND**
蛇牌

**SNAKE
BRAND**
蛇牌

AND



**SNAKE
BRAND**

**SNAKE
BRAND**

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NO. 411777, 411778 AND 411779 BY

TOP BELGIAN BRANDS BVBA

BACKGROUND AND PLEADINGS

1. On 12 September 2017, The British Dispensary (L.P.) Company Limited (“the applicant”) applied to register the three series of trade marks shown on the cover page of this decision in the UK. The applications were all published for opposition purposes on 1 December 2017. The applicant seeks to register all three series of marks for the following goods:

Class 3 Cosmetics; cosmetic preparations for skin care; make-up preparations; perfumery; perfumes; essential oils; eau de toilette; eau de Cologne; antiperspirants [toilettries]; deodorants for human beings; soap; bar soap; liquid soap; antiperspirant soap; bath and shower gel; bath and shower cream; bath and shower foam; bath salts, not for medical purposes; cosmetic preparations for baths; talcum powder, for toilet use; make-up powder; baby powder; perfume powder; cooling powder; body spray; deodorant spray for personal use; refreshing and moisturising water spray for the body and face; wipes impregnated with cleaning preparations not for medical use; hair tonic.

Class 5 Prickly heat powder.

2. The applications were opposed by Top Belgian Brands BVBA (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on its earlier International Trade Mark No. 1276709 (designating the EU) for the following trade mark:



3. The earlier mark was granted European Union protection on 18 May 2015. The following goods are relied upon in this opposition:

Class 3 Cosmetics, cosmetic articles; perfumery; essential oils; cosmetic facial and body care products including creams, lotions, gels, emulsions, foams and milk for the care of the body, skin and hair; shaving cream; depilatories in the form of creams and gels, depilation wax; shampoo, hair care products; soaps; massage oils, non-medical; deodorants.

4. The oppositions are directed against the applicant's class 3 goods only. The opponent argues that the respective goods are identical or similar and that the marks are similar.

5. The applicant filed counterstatements denying the claims made.

6. The proceedings were consolidated. The opponent is represented by Bureau M.F.J. Bockstael NV. The applicant is represented by Nucleus IP Limited. The opponent filed written submissions dated 23 July 2018 and the applicant filed written submissions dated 20 September 2018. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

7. In its written submissions the applicant has made reference to other registered marks which include the word SNAKE. The applicant suggests that this shows that even small differences will be enough for consumers to be able to distinguish between marks. However, my assessment must take into account only the applied for mark and any potential conflict with the earlier mark. The existence of other trade marks on the register is not relevant to the decision I must make¹.

DECISION

8. Section 5(2)(b) of the Act reads as follows:

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

¹ *Zero Industry Srl v OHIM*, Case T-400/06

(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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

10. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

11. The following principles 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.

The principles:

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 to mind the earlier mark, 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

12. The specifications for all of the applicant's series of marks are identical. The competing goods for all three are, therefore, as follows:

Opponent's goods	Applicant's goods
<u>Class 3</u> Cosmetics, cosmetic articles; perfumery; essential oils; cosmetic facial and body care products including creams, lotions,	<u>Class 3</u> Cosmetics; cosmetic preparations for skin care; make-up preparations; perfumery; perfumes; essential oils; eau

<p>gels, emulsions, foams and milk for the care of the body, skin and hair; shaving cream; depilatories in the form of creams and gels, depilation wax; shampoo, hair care products; soaps; massage oils, non-medical; deodorants.</p>	<p>de toilette; eau de Cologne; antiperspirants [toilettries]; deodorants for human beings; soap; bar soap; liquid soap; antiperspirant soap; bath and shower gel; bath and shower cream; bath and shower foam; bath salts, not for medical purposes; cosmetic preparations for baths; talcum powder, for toilet use; make-up powder; baby powder; perfume powder; cooling powder; body spray; deodorant spray for personal use; refreshing and moisturising water spray for the body and face; wipes impregnated with cleaning preparations not for medical use; hair tonic.</p>
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13. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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.”

14. 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.

15. 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.”

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), 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.”

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 trade mark application (Case T-388/00 *Institut for Lernsysteme v 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.”

18. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

19. I have no submissions from the applicant on the similarity of the goods. In its written submissions, the opponent states:

“All the aforesaid goods and services are identical, or at least very similar to the products for which the trademark “SNAKEMAN” is registered.”

20. “Cosmetics”, “perfumery” and “essential oils” appear in both the applicant’s and the opponent’s specifications. These goods are self-evidently identical. “Perfume” in the applicant’s specification is plainly identical to “perfumery” in the opponent’s specification. “Antiperspirants [toilettries]” and “deodorants for human beings” in the applicant’s specification are plainly identical to “deodorants” in the opponent’s

specification. “Soap” in the applicant’s specification is plainly identical to “soaps” in the opponent’s specification.

21. “Cosmetic preparations for skin care”, “make-up preparations”, “cosmetic preparations for baths” and “make-up powder” in the applicant’s specification fall within the broader categories of “cosmetics” and “cosmetic facial and body care products including creams, lotions, gels, emulsions, foams and milk for the care of the body, skin and hair” in the opponent’s specification. “Eau de toilette”, “eau de Cologne” and “perfume powder” in the applicant’s specification fall within the broader category of “perfumery” in the opponent’s specification. “Bar soap”, “liquid soap” and “antiperspirant soap” in the applicant’s specification all fall within the broader category of “soaps” in the opponent’s specification. “Body spray” and “deodorant spray for personal use” in the applicant’s specification fall within the broader category of “deodorants” in the opponent’s specification. “Hair tonic” in the applicant’s specification falls within the broader category of “shampoo, hair care products” in the opponent’s specification. These goods can all be considered identical on the principle outlined in *Meric*.

22. “Bath and shower gel”, “bath and shower cream”, “bath and shower foam”, “bath salts, not for medical purposes”, “talcum powder, not for toilet use”, “baby powder”, “cooling powder”, “refreshing and moisturising water spray for the body and face” and “wipes impregnated with cleaning preparations not for medical use” in the applicant’s specification all fall within the broader category of “cosmetic facial and body care products...for the care of the body, skin and hair” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*. If I am wrong in this finding then they will be considered highly similar as there is significant overlap in their uses, users and trade channels.

The average consumer and the nature of the purchasing act

23. 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 the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The*

Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

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

24. I have no submissions from the opponent on the average consumer or the purchasing process for the goods in issue. In its written submissions, the applicant states:

“The goods under comparison are aimed at the public at large. The goods in question, which are personal care products, are normally not bought over the counter at a verbal request but are selected by purchasers very carefully and compared meticulously with other items. Given such commercial reality and consumer behaviour, public confusion is unlikely to occur.”

25. In my view, the average consumer for the goods will be a member of the general public. The average consumer is likely to consider various factors during the purchasing process (such as suitability for skin type and fragrance). There may, of course, be circumstances in which a higher degree of attention may be paid such as where a particularly expensive item is being purchased. However, I must consider the attention paid during an average transaction and many of the goods covered by the specifications will be everyday items. Overall, I consider that an average degree of attention is likely to be paid. Purchases of these products are likely to vary from fairly frequent (such as purchases of make-up wipes or soap) to fairly infrequent (such as purchases of skincare products and perfumes).

26. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. Consequently,

visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that advice may be sought from a sales assistant or representative.

Comparison of trade marks




27. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 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.”

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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

29. The marks which make up each of the applicant’s series of marks are applied for in both black and white and red and green. It is not uncommon for trade marks to be registered in black and white and used in different colours. I do not, therefore, consider that the marks which have been applied for in red and green are materially different to those marks registered in black and white for the purposes of comparison with the opponent’s mark. The colour applied to the marks does not alter their distinctive character. I will, therefore use the marks registered in black and white for the purposes

of my comparison only, as a comparison of the colour marks will not alter the outcome of my decision. The respective trade marks are, therefore, shown below:

Opponent's trade mark	Applicant's trade marks
	<p data-bbox="928 465 1260 638">SNAKE BRAND</p> <p data-bbox="965 667 1225 705">("the First Series")</p>  <p data-bbox="944 1097 1252 1135">("the Second Series")</p>  <p data-bbox="960 1485 1236 1523">("the Third Series")</p>

30. In its written submissions, the opponent states:

"a) Visual comparison

When comparing the trademarks "SNAKE BRAND" and "SNAKEMAN", it is obvious that they are very similar.

The public's perception is usually influenced most by the first syllables of a trademark.

They will focus on the first part "SNAKE", which is identical. The use of the name "SNAKE" is original with regard to the goods of class 3.

Moreover, as the dominant part is the word element "SNAKE", both the contested trademarks Nos. 3256130 and 3256132 and the earlier trademark use an image of this animal.

Bearing such considerations in mind, there is no need for elaborate and/or comprehensive research in order to conclude that the disputed trademarks, once they compete on the market, are likely to create strong and incontestable confusion, which will lead to severe economic damage for our clients.

The consumer will not be able to differentiate between the trademarks and will come to the conclusion that the contested trademarks have the same origin as the earlier trademark.

b) Phonetic comparison

The first, most dominant part of the trademarks, namely the word element "SNAKE", is identical.

In addition, the second part of the trademarks contains the same, dominant "A".

From a phonetic point of view, the earlier trademarks and the contested trademark are thus nearly identical as well, the only difference being the endings of the signs.

c) Conceptual comparison

The first part of both trademarks has the same meaning, namely the animal, the snake.

This conceptual similarity is further reinforced by the image of a snake which is present in both the contested trademarks Nos. 3256130 and 3256132 and the earlier trademarks.”

31. In its written submissions, the applicant states:

“Visually, it is submitted that the marks are not similar. The opponent’s mark consists of one word SNAKEMAN, with the numerals 1899 below and a device of a snakes head above. The applicant’s marks contain two words SNAKE and BRAND, with the word SNAKE positioned above the word BRAND. The applicant’s second and third marks also contain a distinctive device of a whole snake with an arrow. The third mark also contains Chinese characters. The applicant’s marks are series marks and the first marks in the series are all colour marks which also distinguishes them visually. Taking into account all of these different elements the marks are not at all visually similar.

Aurally, it is submitted that the pronunciation of the signs is different. Although they coincide in the sound of the letters SNAKE at the beginning of the marks the second part of the applicant’s marks is the word BRAND whereas the second part of the opponent’s mark is the word MAN. MAN and BRAND are not phonetically similar. Therefore, the marks as a whole are not phonetically similar.

Conceptually, the relevant public will perceive the earlier sign as the word SNAKEMAN. According to Wikipedia, ‘Snake Man, Snake Men or snake people are terms applied to people with snakelike characteristics in mythology or fiction’. The applications will be seen conceptually to refer to the brand SNAKE.”

Overall Impression

The Opponent’s Mark

32. The opponent's mark consists of the conjoined words SNAKEMAN, presented in a slightly stylised lower-case font with the first letter capitalised. The conjoined words appear below a device of a snake's head and are followed by the number "-1899-". The numbers are presented in a smaller font than the words and give the impression of being the year in which the business was founded or the year in which the mark was first used. The overall impression lies in the combination of these elements, with the wording and the snake head device playing a greater role in the overall impression and the numbers playing a lesser role.

The First Series

33. The applicant's mark consists of the words SNAKE and BRAND, presented in a slightly stylised capitalised font. The word SNAKE is presented above the word BRAND, and is presented in a slightly larger font. The word BRAND is likely to be given little trade mark significance as it is descriptive of the function of the mark itself. The word SNAKE, therefore, plays a greater role in the overall impression of the mark with the word BRAND playing a lesser role.

The Second Series

34. The applicant's mark consists of the same wording as appears in the First Series. The wording is presented below a device of a snake and an arrow and is followed by, what appear to be, some sort of symbols. The symbols are likely to be given little trade mark significance as they will not convey any meaning and are likely to be seen as a translation of the English wording that appears above them. The overall impression lies in the combination of these elements with the device and wording playing a greater role in the overall impression.

The Third Series

35. The applicant's mark consists of the same wording and snake and arrow device as described above. The overall impression lies in the combination of these elements, with neither dominating.

Visual Comparisons

The Opponent's Mark and the First Series

36. Visually, the wording in both marks start with the word SNAKE. As a general rule, the beginnings of marks tend to make more of an impact than the ends². In the opponent's mark this is conjoined with the word MAN and in the applicant's mark it is followed by the word BRAND. A further point of visual difference is created by the existence of the snake head device in the opponent's mark and the presence of the numbers – 1899 – (although these play a lesser role in the overall impression). I consider the marks to share no more than a medium degree of visual similarity.

The Opponent's Mark and the Second Series

37. Visually, the wording present in both marks is as described for the First Series. However, in this case it appears below the snake and arrow device and above the symbols. Differences are created by the presence of the symbols in the Second Series and the numbers in the opponent's mark. However, as noted above these will be given little trade mark significance. Both marks display a snake device, albeit the devices themselves do differ. I consider the marks to share a medium degree of visual similarity.

The Opponent's Mark and the Third Series

38. Visually, the wording and devices present in both marks are as described for the Second Series. I consider the marks to share a medium degree of visual similarity.

Aural Comparison

39. Aurally, all of the applicant's marks will be pronounced identically. That is, the words SNAKE and BRAND will be given their ordinary English pronunciation. The words SNAKE and MAN in the opponent's mark will also be given their ordinary

² *El Corte Ingles, SA v OHIM* Cases T-183/02 and T184/02

English pronunciation. I do not agree with the opponent that the presence of the vowel “A” in both MAN and BRAND adds any significant point of further aural similarity between the marks. If the numbers 1899 in the opponent’s mark are pronounced then there will be no more than a medium degree of aural similarity between the marks. If they are not pronounced then there will be a medium degree of aural similarity between them.

Conceptual Comparison

40. Conceptually, the applicant’s marks create the impression of a brand which is called SNAKE. The presence of the snake and arrow device in the Second Series and the Third Series do not add anything additional to this meaning, but rather just reinforce the use of the word SNAKE in the mark. Similarly, the symbols present in the Second Series will be given no meaning by the average consumer and add nothing to the conceptual meaning conveyed by the mark. For some consumers, I agree with the applicant, that the opponent’s mark will convey the impression of a man associated with snakes in some way. For others, it is likely to convey a brand which is called SNAKE and is, in some way, tailored towards men. In the context of the goods in issue, this may be cosmetics designed specifically for men. Again, the use of a snake head device does not add anything conceptually to the mark, but rather reinforces the use of the word SNAKE. The numbers used in the opponent’s mark are likely to be viewed as a date of incorporation of the business or the date on which the mark was first used or created. For those consumers that view the opponent’s mark as being a man associated in some way with snakes there will be a medium degree of conceptual similarity between the marks. For those who view it as brand called SNAKE which is, in some way, tailored towards men there will be a fairly high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

41. 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-2779, 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 promotion of 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).”

42. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

43. As the opponent has not filed any evidence to show that its mark has enhanced its distinctiveness through use, I have only the inherent position to consider. Neither the opponent nor the applicant have made any submissions about the distinctiveness of the earlier mark.

44. I must make an assessment of the inherent distinctiveness of the earlier mark as a whole. The conjoined words SNAKE and MAN in the opponent’s mark are ordinary dictionary words. The use of the word MAN in the opponent’s mark may be seen as descriptive of the goods offered (that is, that they are targeted at men). The conjoining

of the words SNAKE and MAN may also be viewed as meaning a man that is associated in some way with snakes. In both cases, the use of the word SNAKE in relation to the goods in issue is unusual and additional distinctiveness is added by the snake head device. Overall, I consider that the opponent's mark has a fairly high degree of distinctive character.

Likelihood of confusion

45. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

46. I will undertake my assessment in relation to the opponent's mark and the First Series only. These marks share the lowest degree of similarity and therefore if there is confusion in respect of these marks, it follows that there will be confusion in respect of the Second Series and the Third Series also. I have found the parties' marks to share no more than a medium degree of visual similarity and a medium degree of aural similarity. I have found there to be either a medium degree of conceptual similarity or a fairly high degree of conceptual similarity, depending on the consumer's interpretation of the opponent's mark. I have found the opponent's mark to have a fairly high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who will select the goods primarily by

visual means (although I do not discount an aural component). I have concluded that an average degree of attention will be paid during the purchasing process. I have found the parties' goods to be identical or highly similar.

47. Taking all of the above factors into account, I consider that there are sufficient visual and aural differences between the marks to ensure that they will not be misremembered or mistakenly recalled as each other. I am satisfied that there is no risk of direct confusion.

48. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

49. I have found that there are two different ways in which the opponent's mark could be perceived: firstly, it could be viewed as referring to a man who is associated with snakes in some way (such as a fictional character with snake-like characteristics) and secondly, it could be viewed as being a brand called SNAKE which produces goods specifically for men. For those that adopt the first conceptual meaning described above, they are more likely to see SNAKEMAN as a conceptual unit and are therefore unlikely to rely on SNAKE more than MAN. For those that adopt the second conceptual meaning described above, there will be a greater likelihood of confusion. In *Interflora*

*v Marks and Spencer*³ the Court of Appeal held that it was appropriate to give due weight to the likely reactions of different sections of the public, provided that these represent the range of likely reactions of persons with the attributes of an average consumer. Kitchen L.J. stated that:

“129.... In deciding a question of infringement of a trade mark, and determining whether a sign has affected or is liable to affect one of the functions of the mark in a claim under Article 5(1)(a) of the Directive (or Article 9(1)(a) of the Regulation), whether there is a likelihood of confusion or association under Article 5(1)(b) (or Article 9(1)(b)), or whether there is a link between the mark and the sign under Article 5(2) (or Article 9(1)(c)), the national court is required to make a qualitative assessment. It follows that it must make that assessment from the perspective of the average consumer and in accordance with the guidance given by the Court of Justice. Of course the court must ultimately give a binary answer to the question before it, that is to say, in the case of Article 5(1)(b) of the Directive, whether or not, as a result of the accused use, there exists a likelihood of confusion on the part of the public. But in light of the foregoing discussion we do not accept that a finding of infringement is precluded by a finding that many consumers, of whom the average consumer is representative, would not be confused. To the contrary, if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then we believe it may properly find infringement.

130. In the circumstances of this case we are, of course, concerned with a claim under Article 5(1)(a) (and Article 9(1)(a)) in the context of internet advertising and the question to be answered was whether the advertisements in issue did not enable reasonably well-informed and observant internet users, or enable them only with difficulty, to ascertain whether the goods and services so advertised originated from Interflora or an undertaking economically linked to Interflora or, on the contrary, originated from M & S, a third party. In answering

³ [2014] EWCA 1403 (Civ)

this question we consider the judge was entitled to have regard to the effect of the advertisements upon a significant section of the relevant class of consumers, and he was not barred from finding infringement by a determination that the majority of consumers were not confused.”

50. It is common in the cosmetic industry for the word MAN to be added to an existing brand to designate goods specifically targeted at the male audience. This is a common brand extension for businesses operating in this sector. In this context, I consider it is likely that a significant number of average consumers would adopt the latter interpretation of the opponent’s mark. For those consumers, bearing in mind my conclusions listed at paragraph 46 above, the opponent’s mark will be viewed as a brand extension of the applicant’s mark. The existence of consumers who will view the opponent’s mark as meaning a man associated in some way with snakes, and who are therefore less likely to view it as a brand extension of the applicant’s mark, does not prevent me from finding a likelihood of confusion. There is, therefore, a likelihood of indirect confusion.

51. As I have found a likelihood of confusion in respect of the First Series, it follows that there will be a likelihood of confusion in respect of the Second Series and the Third Series, as they share a greater degree of similarity with the opponent’s mark.

CONCLUSION

52. The oppositions are successful and the applications will proceed to registration for the goods in class 5 only, namely:

Class 5 Prickly heat powder.

COSTS

53. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £900 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing statements and considering the applicant's statements	£300
Official Fee (x3)	£300
Preparing consolidated written submissions	£300
TOTAL	£900

54. I therefore order The British Dispensary (L.P.) Company Limited to pay Top Belgian Brands BVBA the sum of £900. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 11th day of December 2018

S WILSON

For the Registrar