

In the matter of THE TRADE MARKS ACT 1994

**And in the matter of Application No. 3241954
in the name of DOMINIQUE TILLEN to register**

Go-Kidz

as a trade mark in classes 3, 5, 10 and 21

**and Opposition thereto no. 410594
by DESIGN GO LIMITED and DG CAPITAL LIMITED**

On appeal from the decision of Mr C J BOWEN dated 26 November 2018

DECISION OF THE APPOINTED PERSON

Introduction

1. This is an appeal from the decision of the Hearing Officer, Mr Bowen, upholding the Opposition brought by the Opponents, Design Go Limited and DG Capital Limited, against the application of Ms Dominique Tillen to register a trade mark.
2. The mark applied for is **Go-Kidz** for a series of goods in classes 3, 5, 10 and 21.
3. It was opposed under s5(2)(b) of the Trade Marks Act based on the following trade mark, number 3016419



registered as of 2 August 2013 in respect of various goods including in classes 5 and 21. I shall refer to it as 'the Go Device'.

4. The Opponents also relied on a trade mark for the word **GO** registered as of 4 April 1998 including in classes 5 and 21. To succeed they would have required to establish proof of use of this mark in relation to the goods relied on. The Hearing Officer did decide the question of use, having decided that the Opposition succeeded under the device mark shown above. The Respondent did not pursue the Opposition based on the word mark on Appeal, and therefore I need not consider it further.
5. Finally, the Opponents relied on the following unregistered trade mark under s5(4)(a) of the Trade Marks Act



claiming that they owned substantial goodwill in the United Kingdom associated with the said mark, having used it since 2012 in relation to *'a range of children's and baby products'*, specifically *'Corner protectors for babies, shelves and furniture, padded door stops, wrist links and walking reins/harnesses for children, chair harnesses, torches/lights for children, sterilising bags for babies bottles, zip lock bags for children's travel essentials such as nappies, cups, medicines, drinks and snacks, wipe*

clean baby bibs, nappy bag dispensers, changing mats, baby towels, travel blankets, comfort blankets, cuddly toy travel pillows for children, cuddly toy neck pillows, cuddly nightlights in the form of toys, mosquito nets for cots, cribs prams and pushchairs, children's headphones. I shall refer to it as 'the Go Travel Kids' device.

6. It is convenient to set out below the goods in respect of which the Go-Kidz mark was applied for, next to the goods relied on by the Opponents from the specification of the Go Device registration, adapted from the table set out by the Hearing Officer in paragraph 30 of his Decision:

Opponent's goods relied on	Applicant's goods
<p>Class 5 - First aid kits comprising adherent and non-adherent dressings, gauze bandages, plasters, dressing tape, cleansing wipes and antiseptic wipes; mosquito repellent wipes; insect repellent wipes.</p> <p>Class 21 - Toothbrushes, toothbrush heads and toothbrush cases.</p>	<p>Class 3 - Dentifrices; Tooth care preparations; Baby wipes; Pre-moistened cosmetic wipes; Moist wipes impregnated with a cosmetic lotion.</p> <p>Class 5 - Impregnated medicated wipes; Moist wipes impregnated with a pharmaceutical lotion; Wipes for medical use.</p> <p>Class 10 - Baby teething rings; Teething rings for relieving teething pain; Teething soothers; Teething rings; Rings (Teething -); Baby dummies; Dummies for babies; Pacifiers [babies dummies].</p> <p>Class 21 - Electric toothbrushes; Manual toothbrushes; Toothbrushes; Toothbrushes, electric.</p>

7. The Hearing Officer held that there was substantial identity or an above medium degree of similarity between all the goods applied for by the Applicant in classes 3, 5 and 21 and equivalent goods for which the Go Device was registered in classes 5 and 21. So far as the Applicant's goods in class 10 (teething products and dummies) were concerned, however, he held that there was no similarity with any of the goods for which the Go Device was registered, although the Opponent had established goodwill across all the children's and babies' products set out in paragraph 5 above.
8. Turning to the grounds of Opposition, the Hearing Officer held:
 - (i) that the Opposition based on the Go Device partially succeeded under s5(2)(b), since there was a likelihood of confusion between the Go Device and the Go-Kidz mark when used in relation to the goods in classes 5 and 21.
 - (ii) that the Opposition based on the unregistered Go Travel Kids device partially succeeded under s5(4)(a), since the use of the Go-Kidz mark in relation to the goods in class 10 would be likely to cause confusion amongst the relevant public with whom the Opponent had goodwill and therefore amount to passing off.
9. Given those findings, the Opposition succeeded in relation to all the goods covered by the application.
10. The Applicant appeals that decision. The Opponent also has a Respondent's Notice which I shall deal with at the appropriate point in this Decision.

Section 5(2)(b)

11. No challenge was made to the findings of the Hearing Officer that the goods in question (that is to say the goods of the application in classes 3, 5 and 21) were substantially identical or very similar to equivalent goods in the registration of the Go Device.

12. So far as the overall impression of the average consumer of the marks themselves is concerned, there was no challenge to the following findings of the Hearing Officer:

- (i) Whilst the device component of the Go device is not negligible and contributes to the overall impression conveyed, it has very little if any distinctive character. Rather it is the word 'Go' that dominates the overall impression the opponents' trade mark conveys and it is in this component that the vast majority of any distinctiveness the trade mark enjoys lies. [Decision paragraph 54].
- (ii) The Go device mark is possessed of a fairly low degree of inherent distinctive character [Decision paragraph 66].
- (iii) The word 'KIDZ' in the Go-Kidz mark would be construed by the average consumer as a simple misspelling of the word 'Kids'. [Decision paragraph 56].

13. Nor did the Appellant challenge the finding of the Hearing Officer that there was a medium degree of visual, aural and conceptual similarity between the marks [Decision paragraph 57-60].

14. There was a faint challenge to the Hearing Officer's finding that the average consumer was an ordinary member of the general public paying a normal degree of attention. It was suggested that insofar as the goods covered by the application were designed for use by children, the public (being for this purpose caring parents) would pay an above-average degree of attention to their purchase. It seems to me that there is no general principle to this effect. Whilst no doubt an above average degree of care may be taken with products which might be considered by a parent to be carry inherent dangers for their children, this would not be the case with most if not all the products covered by the application. And of course, it might equally be argued that harassed parents in a store might be more prone to confusion. All in all I do not think this is a valid criticism of the Hearing Officer's approach.

15. The basis for the appeal against the decision under s5(2)(b) consists of an attack on the Hearing Officer's approach to the question of likelihood of confusion. In particular, the following criticisms (which are linked) were advanced:

- (i) he erred in considering that the Go-Kidz mark would be understood by the average consumer as comprising two words in which the first word had an independent distinctive role.
- (ii) he did not take account (or at least sufficient account) of the fact that the similarity between the Go Device and the Go-Kidz mark applied for consisted entirely of the word 'GO' which has a very low degree of distinctive character.

16. The first point is obviously central to the assessment of the likelihood of confusion in the present case. If the word Go would not be seen as a separate element in the mark applied for, but rather simply as an integral part of a unitary whole, then confusion would be less likely. The Hearing Officer plainly had this issue well in mind when considering his Decision. In paragraph 72 he quotes from the decision of Arnold J in Whyte and Mackay Ltd. v. Origin Wine UK Ltd and Another [2015] EWHC 1271 (Ch), at paragraph 18 onwards. In that case, the mark ORIGIN was being relied on in opposition to the trade mark JURA ORIGIN for alcoholic drinks. The Judge held that there was no likelihood of confusion, essentially because when used after the name of the island Jura the name Origin became entirely descriptive and would simply be taken as indicating that the product in question came from the island, rather than having any independent trade mark significance. In paragraphs 19-21, the Judge considers the effect of various CJEU cases on composite marks, in particular Bimbo, case C-591/12P as establishing three points where a composite mark contains an element which is similar to an earlier mark:

'19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or

more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.'

17. In the present case, the Hearing Officer held this about the perception of the average consumer of the mark Go-Kidz [Decision paragraph 56]:

'It is possible that the combination of the words 'Go' and 'Kidz' may create a unit in the average consumer's mind, for example, when one requests a group of children to move (in which case the word 'Go' would not play an independent distinctive role and the overall impression the trade mark conveys and its distinctiveness would reside in the unit created). However, as the word 'Kidz' is freighted with descriptive connotations, it is, in my view, equally likely that the, irrespective of the hyphen, it is the word 'Go' that will have a higher relative weight in the overall impression the trade mark conveys and it is in that word the overwhelming majority of the trade mark's distinctiveness would lie.'

He returned to the point in his summary of his findings for the purpose of assessing the likelihood of confusion at the 8th bullet point of paragraph 69:

'the words 'Go' and 'Kidz' will dominate the overall impression the applicant's trade mark conveys. While that combination may create a unit, the distinctiveness lying in the totality created, it is equally likely the word 'Kidz' will be construed as indicating the group for whom the applicant's goods are intended, resulting in the distinctiveness being weighted heavily in favour of the word 'Go.'

And again at paragraph 75:

'While I accepted above that it is possible the words in the applicant's trade mark will create a unit in which the word "Go" does not play an independent distinctive role, I also concluded that it is equally likely that the average consumer will not consider the applicant's trade mark to create a unit and will simply interpret the word "Kidz" as indicating the group for whom the applicant's goods are intended.'

18. For the Appellant, Mr Zweck did not contend that the Hearing Officer was bound to determine a 'single impression' which the mark would have on the average consumer. He agreed that if the Hearing Officer was right that the non-unitary impression was one of two equally likely impressions, then it was fair to consider the likelihood of confusion on the basis of that impression. I think he was plainly correct to do so.
19. However, Mr Zweck contended that the Hearing Officer was simply wrong about the impression conveyed by the mark Go-Kidz. Particularly bearing in mind the hyphen which links the two words together, he contended that the average consumer would inevitably see the mark as a unitary whole, conveying the impression of *'particularly active or busy kids who are "on the go"'*.
20. The question of the impression made by a trade mark is one on which an Appellate Court should be wary about interfering with the view of an experienced Hearing Officer. It involves a consideration of the likely response of consumers to an image or a set of words, plainly a multi-factorial and nuanced issue on which there may be room for a spectrum of reasonable views. I would only interfere where the Hearing Officer's view was plainly outside that spectrum. Here it is not. The word 'kidz' (understood as 'kids') is one which the public are used to seeing in brand usage to indicate something suitable for children. It is therefore in my view likely that at least a substantial proportion of average consumers will see the 'Kidz' element of this

composite mark in exactly the way conceived by the Hearing Officer. Read in that way, the Kidz element is a subordinate part of the mark to the main trade mark 'Go' – conveying the impression of 'Go' products for Kids.

21. I therefore reject the first argument.
22. Mr Zweck ran his second point on the basis that the Hearing Officer had underplayed the significance of the fact that the word 'GO' had a very low level of inherent distinctiveness, when considering the likelihood of confusion with a composite mark in which the word was the only similar feature.
23. The Hearing Officer cited in this respect the decision of the CJEU in L'Oreal SA v OHIM, case C-235/05P. That case concerned a successful opposition to the mark FLEXI AIR based on the earlier mark FLEX in the field of hair products. The applicant appealed on the basis that the Court of First Instance had erred by not taking into account (or at least not considering as decisive) the very low level of distinctive character of the word 'FLEX' in the relevant field when considering the likelihood of confusion. The CJEU said as follows at paragraph 45, quoted by the Hearing Officer at paragraph 73:

'45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.'

24. The Hearing Officer went on in paragraph 74 to say as follows:

'Although the opponents' trade mark (when considered both as a whole and in relation to the word "Go" within it) enjoys only a very weak inherent distinctive character, as the above case makes clear, that does not preclude a likelihood of confusion. That is particularly the case where, as here, the only other component in the applicant's trade mark, i.e. the word "Kidz" is, in my view, even less distinctive than the component in common, i.e. the word "Go."

25. Mr Zweck contended that the Hearing Officer had failed properly to direct himself on the law by simply citing L'Oreal. He should have gone on also to cite the following passage from paragraph 44 of Whyte and Mackay:

what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion

and paragraph 27 of the decision of Birss J in *Nicoventures Holdings Limited v The London Vape Company Limited* [2017] EWHC 3393 (Ch), when, after citing the relevant paragraph of L'Oreal, he went on to say:

'Counsel for the respondent submitted that the first sentence of this passage meant that the appellant's submission of law was wrong because it sought to give undue prominence to distinctive character, which is something the CJEU was rejecting in that passage. I do not agree. I have referred to White and Mackay above. If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive.'

26. It is correct to say that the Hearing Officer did not cite those statements of law.

However, I can see nothing in his Decision which is inconsistent with them. The most that is being said in the passages cited is that a low degree of distinctiveness of

common elements in two marks makes confusion less likely, whilst not precluding a finding of likelihood of confusion. That is precisely what the Hearing Officer was saying in the first sentence of paragraph 74 of his Decision cited above. It is plain that the Hearing Officer did take account of the fact that the common element 'Go' had a low level of distinctive character when engaging in his global assessment of the likelihood of confusion. He refers to it on a number of occasions, in particular in paragraph 66, the final bullet point of paragraph 69 and paragraph 74 itself.

27. The point the Hearing Officer was making in paragraph 74 was a perfectly fair one, and indeed was precisely the point the CJEU was making in Bimbo itself. Where a mark of weak distinctive character is combined with a word which is still less distinctive and tends to indicate a variation in the nature of the products, there may well be a likelihood of confusion. Given his findings about the significance of the word 'Kidz' in the present case, this was something which he was entitled to take into account.
28. I therefore reject the second point. The appeal against the Hearing Officer's decision under s5(2)(b) fails.
29. I can deal quite briefly with the appeal against the finding under s5(4)(a), which concerns only the goods in class 10, which are essentially baby teething products and dummies. Essentially this was run on the same basis as the appeal under s5(2)(b), the argument being that the Hearing Officer had failed to take sufficient account of the non-distinctive nature of the common elements between the marks. For the reasons given above, I do not believe that this is a fair criticism. Furthermore, given that the mark in which goodwill was established comprises both the words 'Go' and 'Kids', the case on likelihood of confusion by the mark 'Go-Kidz' was probably stronger than the case based on the registered mark comprising the word 'Go' alone.
30. I thus reject the appeal against the finding under s5(4)(a) as well.
31. In the circumstances I need not consider the Respondent's Notice.
32. I shall award costs to the Respondent in the amount of £1500.

IAIN PURVIS QC

The Appointed Person

7 June 2019