

**O-607-19**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3303434  
BY CHARLES LANDON, A PARTNER IN WILDER BOTANICS  
TO REGISTER IN CLASSES 3, 5 & 30  
THE TRADE MARK**



**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 413339  
BY  
THE BOOTS COMPANY PLC**

## BACKGROUND

1) On 12 April 2018, Charles Landon, a Partner in Wilder Botanics (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following goods and services:


In Class 3: Bath oils (Non-medicated -);Bath oils for cosmetic purposes; Aromatic oils for the bath; Bath and shower oils [non-medicated];Non-medicated bath oils; Body oils; Body oils [for cosmetic use];Body and facial oils; Body massage oils; Face oils; Face cream (Non-medicated - ); Face creams; Face creams for cosmetic use; Creamy face powder; Face and body creams; Bath salts; Bath salts, not for medical purposes; Cosmetic bath salts; Non-medicated bath salts; Scented bathing salts; Hand cream; Hand creams; Cosmetic hand creams; Beard oil.

In Class 5: Mineral salts for baths; Salts for mineral water baths.

In Class 30: Teas; Teas (Non-medicated -);Teas (Non-medicated -) containing lemon; Teas (Non-medicated -) flavoured with lemon; Herb teas, other than for medicinal purposes; Herb teas, other than for medicinal use; Herbal teas [infusions].


2) The application was examined and accepted, and subsequently published for opposition purposes on 4 May 2018 in Trade Marks Journal No. 2018/018

3) On 6 August 2018 The Boots Company Plc (hereinafter the opponent) filed notice of opposition, subsequently amended. The opponent in these proceedings is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
	3283002	16.01.18 20.04.18	3	Cosmetics; toiletries; skin preparations; shave balm; cleansing balm; lip balm; balms; bubble bath; hand and body butter; softening cleanser; colourants; conditioner; hand and body cream; cleansing cream; day cream; night cream; eye cream; shower cream; hydrating day

				<p>cream; hydrating night cream; mattifying day cream; mattifying gel cream; protecting day cream; replenishing night cream; hydrating eye cream; anti-aging day cream; anti-aging night cream; bath elixir; deep cleansing foam; shave gel; eye gel; lavender gel; grains for buffing; hand and body lotion; moisture body lotion; day lotion; face mask; skin clay mask; hydrating mask; moisturiser; anti-ageing moisturiser; skin moisturiser; cleansing mousse; hand and body oil; facial oil; cleansing oil; cleansing balm; eye make-up remover; face wipes; aromatherapy oil; essential oils; lavender oil; eucalyptus oil; tea tree oil; rosemary oil; citronella oil; massage oil; microdermabrasion polish; body polish; make-up remover; face scrub; exfoliating body scrub; body scrub; gel scrub; purifying face scrub; hair care serum; anti-ageing serum; eye correction serum; facial serum; skin calming serum; beauty serums with anti-ageing properties; skin relief serum; bath soak; body soufflé; shampoo; conditioner; toning spritz; cleansing toner; revitalising toner; face wash; hair and body wash; foam wash; face wipes; make-up pads of cotton wool.</p>
			18	Toiletry bags; Cosmetic bags.
			21	Hair brushes; loofahs; sponges; nail brushes; body polishers

BOTANICS	EU 16521271	02.10.16 12.12.18	3	Skin whitening preparations; Polishing preparations; Grease-removing preparations; Abrasive preparations; Soap; Perfume; Essential oils; Cosmetics; Hair lotion; Depilatory preparations; Make-up removing preparations; Lipsticks; Beauty masks; Shaving preparations; Preservatives for leather [polishes]; Creams for leather.
BOTANICS	EU 16264012	18.01.17 10.12.18	3	Cosmetics; toiletries; skin preparations; shave balm; cleansing balm; lip balm; balms; bubble bath; hand and body butter; softening cleanser; hair colourants; conditioner; hand and body cream; cleansing cream; day cream; night cream; eye cream; shower cream; hydrating day cream; hydrating night cream; mattifying day cream; mattifying gel cream; protecting day cream; replenishing night cream; hydrating eye cream; anti-aging day cream; anti-aging night cream; bath elixir; deep cleansing foam; shave gel; eye gel; lavender gel; grains for buffing; hand and body lotion; moisture body lotion; day lotion; face mask; skin clay mask; hydrating mask; moisturiser; anti-ageing moisturiser; skin moisturiser; cleansing mousse; hand and body oil; facial oil; cleansing oil; cleansing balm; eye make-up remover; face wipes; aromatherapy oil; essential oils; lavender oil; eucalyptus oil; tea tree oil; rosemary oil; citronella oil; massage oil; microdermabrasion polish; body polish;

				<p>make-up remover; face scrub; exfoliating body scrub; body scrub; gel scrub; purifying face scrub; hair care serum; anti-ageing serum; eye correction serum; facial serum; skin calming serum; beauty serums with anti-ageing properties; skin relief serum; bath soak; body soufflé; shampoo; conditioner; toning spritz; cleansing toner; revitalising toner; face wash; hair and body wash; foam wash; face wipes; make-up pads of cotton wool.</p>
			18	Toiletry bags; Cosmetic bags.
			21	Hair brushes; loofahs; sponges; nail brushes; body polishers.
	EU 11571122	31.01.13 19.08.13	3	<p>Cosmetics; toiletries; skin preparations; shave balm; cleansing balm; lip balm; balms; bubble bath; hand and body butter; softening cleanser; colourants for toilet purposes; conditioner; hand and body cream; cleansing cream; day cream; night cream; eye cream; shower cream; hydrating day cream; hydrating night cream; mattifying day cream; mattifying gel cream; protecting day cream; replenishing night cream; hydrating eye cream; anti aging day cream; anti aging night cream; deodorant; bath elixir; deep cleansing foam; shave gel; whitening gel; eye gel; lavender gel; grains for buffing; hand and body lotion; moisture body lotion; day lotion; face mask; skin clay mask; hydrating mask; moisturiser; anti ageing moisturiser; skin moisturiser;</p>

				cleansing mousse; hand and body oil; facial oil; cleansing oil; cleansing balm; eye make up remover; face wipes impregnated with cosmetic lotions; aromatherapy oil; essential oils; lavender oil; eucalyptus oil; tea tree oil; rosemary oil; citronella oil; massage oil; microdermabrasion polish; body polish; makeup remover; face scrub; exfoliating body scrub; body scrub; gel scrub; purifying face scrub; hair care serum; anti ageing serum; eye correction serum; facial serum; skin calming serum; whitening serum; beauty serums with anti-ageing properties; skin relief serum; bath soak; body soufflé; shampoo; toning spritz; cleansing toner; whitening skin refining toner; revitalising toner; face wash; hair and body wash; foam wash; make up pads of cotton wool.
			8	Body polishers.
			16	Face wipes for removing make-up.
			18	Toiletry bags; cosmetic bags.
			21	Hair brushes; loofahs; sponges; nail brushes.

- a) The opponent relies upon the goods shown above for which its four marks are registered and also claims that it has a reputation in all of these goods. The opponent contends that its marks and the mark applied for are very similar and that the goods applied for in classes 3 & 5 are identical and/or similar to the goods for which the earlier marks are registered. The goods in class 30 are not opposed. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent relies upon the four marks shown above and claims that it has a reputation in these marks in respect of the goods in classes 3, 18 & 21 and claims that use of the mark in

suit would take unfair advantage of its mark as the marks and goods are identical or similar. Use of the mark in suit would also dilute the distinctiveness of its mark, and cause tarnishing and detriment to the opponent's marks without due cause. The goods in class 30 are not opposed. As such the mark in suit offends against section 5(3) of the Act.

- c) The opponent claims that it has used signs identical to its its marks 3283002, EU 16264012 & EU 11571122 on a wide range of cosmetics, creams, bubble bath, lotions, oils, shampoo, cosmetic and toiletry bags, hair brushes, loofahs & sponges since 01.01.96 and as such has goodwill and reputation in these marks in relation to the goods listed. It has also used a sign identical to its mark EU 16521271 on Skin whitening preparations; Soap; Perfume; Essential oils; Cosmetics; Hair lotion; Depilatory preparations; Make-up removing preparations; Lipsticks; Beauty masks; Shaving preparations; dentifrice in class 3 since 01.01.96 and has goodwill and reputation in this mark. It states that use of the mark in suit upon the goods applied for in classes 3 & 5 at (a) above will lead to misrepresentation, and cause damage. The goods in class 30 are not opposed. As such the mark in suit offends against section 5(4)(a) of the Act.

4) On 18 October 2018 the applicant filed a counterstatement basically denying all the grounds of opposition. The applicant did not put the opponent to proof of use.

5) Both parties filed evidence, and both also seek an award of costs in their favour. Neither party wished to be heard but both parties provided submissions.

## **OPPONENT'S EVIDENCE**

6) The opponent filed a witness statement, dated 21 December 2018, by Miguel Mendes a Trade Mark Advisor of the opponent. He states that he is authorised to make the statement and that all the information comes from his own knowledge and the opponent's records, to which he has full access. Mr Mendes states that the opponent has been using the mark BOTANICS in the UK since 1996 on items such as cosmetics, toiletries, skin preparations, toiletry bags and sponges. He claims that the products are sold throughout the UK in the opponent's own shops which number approximately 2,500. He states that the BOTANICS mark is used on the products, their packaging, point of sale material as well as product literature, flyers and leaflets. He states that the company has spent considerable amounts promoting the mark. He provides information regarding the turnover figures and also advertising figures at exhibits MM6 & 7. These exhibits show that the opponent has a considerable

turnover and spends a considerable amount on promotion. However, these figures relate to the company as a whole and do not provide any details regarding the BOTANICS mark. The BOTANICS brand has, it is said, been promoted via product brochures, press advertising and coverage in numerous magazines. The company awarded itself an award for its BOTANICS lavender spray in 2018. Its BOTANICS eye make-up remover was listed as the best make-up remover by a website in 2010. It is not clear how well known this website is. He also provides the following exhibits:

- MM1: A single extract dated 1995 from the opponent's marketing materials and also an extract from the opponent's website said to be dated 15 October 2004, although this is not visible on the exhibit. The first page shows a picture of a jar, two bottles and a box with the mark BOTANICS upon them. What the products are cannot be read as the print is of very poor quality. The second page is simply the word "Boots; The Power of Plants BOTANICS". It makes no mention of what products are sold under this mark or even the general area of products such as cosmetics.
- MM5: Two pages which show pictures of "Botanics" advertisements on the opponent's website in 2018. These show use of the mark on what appear to be cosmetics, but the print is so small that it cannot be read. It may also be after the relevant date of April 2018.
- MM8L: Examples of the promotion of BOTANICS on: A pillow spray in August 2017 in YOURS magazine; hand cream in October 2012; on what are described as beauty products in the Guardian dated May 2014 and lavender oil in The Telegraph dated April 2018. Most of the pages are undated, or do not show where the print-out comes from. Other pages such as pages 80, 81, 89, 90 are clearly from American publications. None of the dated and identified pages show use of the mark in the form shown in 3283002, only use of mark EU 11571122.

## **APPLICANT'S EVIDENCE**

7) The applicant filed a witness statement, dated 15 March 2019, by Rachel Landon, a partner in the applicant company. She mostly provides submissions and comment upon the opponent's evidence which do not assist in my decision.

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



## DECISION

9) The first ground of opposition is under section 5(2)(b) which reads:

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

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks having been applied for prior to the applicant’s mark. The mark in suit was published on 4 May 2018 at which point only the opponent’s mark EU11571122 had been registered for over five years. However, the applicant did not put the opponent to strict proof of use in its counterstatement. As such the opponent can rely upon the full specifications for which its marks are registered.

12) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*,

Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods**

13) 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) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC 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 für 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”.

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

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

18) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

19) I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

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

20) Thus, where the similarity between the respective goods is not self-evident, the opponent must show how, and in which respects, they are similar.

21) I note that the specifications of three of the opponent’s marks are effectively identical. The only differences are minor and all three contain the terms “cosmetics” and “toiletries”. Clearly, the class 3 specification of the opponent’s marks 16521271 also has the term “cosmetics” but not the term “toiletries”, however given that the mark is identical to 16264012 I will return to this mark if required. When comparing the class 3 specifications I shall therefore use the opponent’s specification as registered for Trade Mark EU 16264012.

22) I shall first consider the two parties’ goods in class 3. The two sides specifications are as follows:

Applicant's goods in class 3	Opponent's goods in class 3 (EU 16264012)
<p>In Class 3: Bath oils (Non-medicated -); Bath oils for cosmetic purposes; Aromatic oils for the bath; Bath and shower oils [non-medicated]; Non-medicated bath oils; Body oils; Body oils [for cosmetic use]; Body and facial oils; Body massage oils; Face oils; Face cream (Non-medicated -); Face creams; Face creams for cosmetic use; Creamy face powder; Face and body creams; Bath salts; Bath salts, not for medical purposes; Cosmetic bath salts; Non-medicated bath salts; Scented bathing salts; Hand cream; Hand creams; Cosmetic hand creams; Beard oil.</p>	<p>Cosmetics; toiletries; skin preparations; shave balm; cleansing balm; lip balm; balms; bubble bath; hand and body butter; softening cleanser; hair colourants; conditioner; hand and body cream; cleansing cream; day cream; night cream; eye cream; shower cream; hydrating day cream; hydrating night cream; mattifying day cream; mattifying gel cream; protecting day cream; replenishing night cream; hydrating eye cream; anti-aging day cream; anti-aging night cream; bath elixir; deep cleansing foam; shave gel; eye gel; lavender gel; grains for buffing; hand and body lotion; moisture body lotion; day lotion; face mask; skin clay mask; hydrating mask; moisturiser; anti-ageing moisturiser; skin moisturiser; cleansing mousse; hand and body oil; facial oil; cleansing oil; cleansing balm; eye make-up remover; face wipes; aromatherapy oil; essential oils; lavender oil; eucalyptus oil; tea tree oil; rosemary oil; citronella oil; massage oil; microdermabrasion polish; body polish; make-up remover; face scrub; exfoliating body scrub; body scrub; gel scrub; purifying face scrub; hair care serum; anti-ageing serum; eye correction serum; facial serum; skin calming serum; beauty serums with anti-ageing properties; skin relief serum; bath soak; body soufflé; shampoo; conditioner; toning spritz; cleansing toner; revitalising toner; face wash; hair and body wash; foam wash; face wipes; make-up pads of cotton wool.</p>

23) To my mind, the following terms in the opponent's specification fully encompass the terms shown alongside from the applicant's specification:

Applicant's specification	Opponent's specification
Bath oils (Non-medicated -); Bath oils for cosmetic purposes; Aromatic oils for the bath; Bath and shower oils [non-medicated]; Non-medicated bath oils; Body oils; Body oils [for cosmetic use]; Body and facial oils; Body massage oils; Face oils; Beard oil.	Cosmetics; toiletries; bubble bath; bath elixir; bath soak; hand and body oil; facial oil; cleansing oil; aromatherapy oil; essential oils; lavender oil; eucalyptus oil; tea tree oil; rosemary oil; citronella oil; massage oil;
Face cream (Non-medicated -); Face creams; Face creams for cosmetic use; Creamy face powder; Face and body creams; Hand cream; Hand creams; Cosmetic hand creams;	Cosmetics; hand and body cream; cleansing cream; day cream; night cream; eye cream; shower cream; hydrating day cream; hydrating night cream; mattifying day cream; mattifying gel cream; protecting day cream; replenishing night cream; hydrating eye cream; anti-aging day cream; anti-aging night cream; hand and body lotion; moisture body lotion; day lotion; skin preparations
Bath salts; Bath salts, not for medical purposes; Cosmetic bath salts; Non-medicated bath salts; Scented bathing salts;	toiletries; bubble bath; bath elixir; bath soak;

24) **The class 3 specifications are therefore identical.** I next turn to the applicant's class 5 specification which reads: "Mineral salts for baths; Salts for mineral water baths". To my mind these must be regarded as **highly similar to the opponent's class 3 goods** of "toiletries; bubble bath; bath elixir; bath soak" as all are used to enhance one's bathing experience but altering the water qualities and/or providing a pleasing aroma.

### **The average consumer and the nature of the purchasing decision**

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

26) The goods of the two parties in classes 3 & 5 are, broadly speaking, cosmetics including creams and bath salts, which will be purchased by the public at large including businesses. Such goods will typically be offered for sale in retail outlets, in brochures and catalogues as well as on the internet. The initial selection is therefore primarily visual. I accept that such goods may be researched or discussed with a member of staff. Therefore, aural considerations must also be taken into account. To my mind even when selecting such goods the average consumer will pay attention to the item to ensure that it is compatible to their skin type, suitable for their needs and provides the effect required. Whilst businesses may pay a slightly higher attention to the selection of goods they use, I do not believe that this would be much higher than the average member of the public. **Overall the average consumer for these types of goods is likely to pay a medium degree of attention to the selection of such goods.**


### **Comparison of trade marks**

27) Clearly, the opponent’s mark 16264012 provides the opponent with its strongest case. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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



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

Opponent's trade mark	Applicant's trade mark
<p style="text-align: center;"><b>BOTANICS</b></p>	 <p>The logo for 'Wilderness Botanics' features the word 'Wilderness' in a large, lowercase, sans-serif font, with 'botanics' in a smaller, lowercase, sans-serif font directly below it. To the right of the text is a botanical illustration of a plant with several leaves and small flowers.</p>

29) When comparing the marks I take into account the views expressed in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

30) The opponent contends that the word “Wilder” is understood by the average consumer as a derivative of the widely known word “wilderness”. They contend that the word is therefore of low distinctiveness and that it qualifies the word “botanics” leading to the meaning “uncultivated botanics”. They also contend that the flower device reinforces this meaning. The word “wilder” has an actual dictionary meaning of “to lose one’s way” or “be lead astray”; or “to become bewildered”. However, I doubt that the average consumer would know of this definition. To my mind, a number would regard the term “wilder” as simply meaning “more wild”, and that it qualifies the following term “botanics”. I note that it is also a well-known English surname e.g. Billy Wilder & Gene Wilder. Given the size and prominence of the word “Wilder” and the use of a capital letter, more consumer’s would, I believe, view the word as a surname identifying the originator and thus regard it as the distinctive and dominant element of the mark in suit.

31) Visually it is obvious that both marks have the word “botanics” within them. However, it is the sole aspect of the opponent’s mark whilst being the second word of the applicant’s mark. Clearly, the word has a strong meaning when used on cosmetics and toiletries etc such as the goods in the instant case. Plant extracts are commonly used in such items and they are advertised as such. Given that the distinctive and dominant element of the applicant’s mark is the word WILDER, there is a very low degree of visual similarity. The plant device cannot be overlooked but it simply reinforces the point that the goods are plant based or contain plant extract.

32) Aurally, the marks are completely different in their first word, albeit the opponent’s mark appears as the second word of the applicant’s mark. The device element will not be vocalised. The marks are at similar to a low degree.

33) Conceptually, the opponent’s mark merely suggests that the goods have plant extract within them or are somehow plant based, a common claim for such goods in classes 3 & 5. The mark in suit has the same meaning attached to the second word, which is reinforced by the device element, but the first element suggests that the goods originate from someone or a company called Wilder. Conceptually the marks are not similar.

**34) Overall. I believe that the marks have a very low degree of similarity.**

35) Although I consider the opponent’s strongest case to be under mark 16264012, I will for the sake of completeness also compare the other two marks relied upon by the opponent to the mark in suit.

3283002



11571122



36) Clearly, the dominant and distinctive element of mark 3283002 is the word “BOTANICS”. The other words “Nature inspired” and “The power of plants” merely act to reinforce the idea that the goods upon which the mark is placed contain plant extract or are derived from plants. The device element and the word “established” and a date do not provide any detail of where the goods originated, and whilst not completely ignored by the average consumer they will be quickly overlooked and regarded as meaningless. If the device element is seen as important it is merely an additional point of difference. I cannot see how the presence of more words and devices than in the mark previously compared to the instant mark will lead to a more favourable outcome. Overall, the mark is similar to the instant mark to a very low degree and is close to being not similar.

37) Turning to the opponent’s mark 11571122, this again has the word “botanics” in a prominent position and in much the largest font. Once again the words “The power of plants” merely act to reinforce the idea that the goods upon which the mark is placed contain plant extract or are derived from plants. The presence of the word “BOOTS” at the top of the mark is clearly the most dominant and distinctive element as it has no meaning in relation to the goods in classes 3 & 5. It clearly provides even more blue water between the marks of the two parties. Overall, the mark is similar to the instant mark to a very low degree and is close to being not similar.

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

38) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

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

39) The opponent’s mark consists of a well-known word which has a very obvious and clear meaning in relation to the goods for which the mark is registered. I regard it as effectively descriptive but given that it is registered it has to be considered to have a degree of distinctiveness. To my mind, the earlier mark **has a low degree of inherent distinctiveness**. The opponent has not shown any use of the mark in terms of turnover or advertising figures relating solely to the mark in suit as opposed to the Boots corporation. It has provided no invoices or any independent witness testimony as to sales or that the goods have been offered for sale in the UK. The fact that it gave itself an award is completely unconvincing, the other award was from an unknown website which I am unable to say is ever viewed by anyone. **As such it cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods for which it is registered.**

### **Likelihood of confusion**

40) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make

direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods and services is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a medium degree of attention to the selection of the goods in classes 3 and 5.
- the marks of the two parties have a very low degree of similarity.
- the opponent's mark has a low degree of inherent distinctiveness and cannot benefit from an enhanced distinctiveness through use in relation to the goods for which it is registered.
- The goods of the two parties in class 3 are identical whilst the applicant's goods in class 5 are highly similar to the opponent's class 3 goods.

41) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

42) In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

43) I also consider the issue of indirect confusion, and take into account the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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

45) In view of all of the above, and allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused, directly or indirectly, into believing that the goods provided by the applicant are those of the opponent or provided by an undertaking linked to it. I do not believe that it will be seen as an extension of the opponent’s brand. **The opposition under Section 5(2) (b) therefore fails in respect of all the goods opposed. As the opposition fails in its strongest case, then it must fail in respect of all the opponent’s marks.**

46) I next turn to the ground of opposition under section 5(3) which reads:

“5. (3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a

European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

47) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of

the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

48) The first hurdle is the issue of reputation as set out at points (a) and (b) above. The onus is upon the opponent to prove that its trade marks enjoy a reputation or public recognition. The opponent has singularly failed to meet this requirement. It has not provided any sales figures for the marks it relies upon, merely turnover figures for the Boots corporation. Similarly, the promotion and advertising figures were general and not specific to the marks relied upon. The balance of the evidence is, in my opinion, insufficient for it to get over the first hurdle of reputation in respect of any of its marks. **The opposition under section 5(3) fails.**



49) I case I am wrong in the above conclusion I will consider whether the public will make a link. In Case C-408/01, *Adidas-Salomon*, the CJEU held that:

“28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

50) In C-252/07 *Intel Corp* [2008] ECR I-8823 at paragraph 42 the court set out the factors used to assess a link. Those factors include:

the degree of similarity between the conflicting marks;

the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

the strength of the earlier mark’s reputation;

the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;

the existence of the likelihood of confusion on the part of the public.

51) Earlier in this decision I found that the opponent’s marks to be similar to the mark sought to be registered by the applicant to a very low degree, and in relation to 3283002 and 11571122, verging on being deemed not similar. The opponent’s marks have a low degree of inherent distinctive character

bordering on descriptive and cannot benefit from an enhanced distinctiveness through use in relation to goods in class 3. To my mind, the average consumer would not immediately link goods with the mark in suit upon them to the opponent. I do not even believe that the average consumer would, upon seeing the instant mark, bring to mind the marks of the opponent. **The ground of opposition under section 5(3) fails.**

52) Lastly, I turn to the ground of opposition under section 5(4)(a). In respect of section 5(4)(a) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

53) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

54) It can be seen from the above that in order to succeed under these grounds the opponent needs to show that in respect of the mark/ sign it relies upon it has a protectable goodwill. The opponent has based its claim under this section upon the four marks set out in paragraph 3 above. Whilst the opponent supplied turnover and advertising figures, these were for the corporation as a whole and not for the specific marks relied upon. It did not provide evidence of offering goods under the marks for sale in the UK. It is impossible to state the extent of market share and therefore that a significant part of the relevant public are aware of the opponent’s marks. As such I find that the opponent has no reputation, under the marks relied upon in the UK, other than it the word “boots” which does not assist the opponent. Even if it has established a reputation in the marks relied upon in the UK, given my earlier findings I would not have found misrepresentation. Therefore, **the ground of opposition based upon section 5(4) fails.**

## CONCLUSION

55) The opposition under sections 5(2)(b), 5(3) and 5(4)(a) have failed. The application can be registered in relation to all the goods applied for by the applicant.

## COSTS

56) As the applicant has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering the other sides evidence	£600
Providing submissions	£400
TOTAL	£1200

57) I order The Boots Company Plc to pay Charles Landon the sum of £1,200. This sum to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**09 October 2019**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**