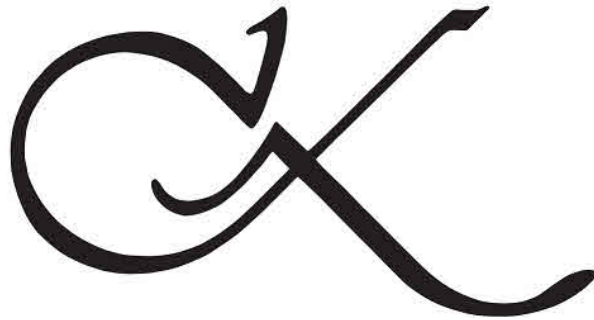


**O-028-21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3433387 BY  
THE SUNRIDER CORPORATION TRADING AS SUNRIDER INTERNATIONAL**

**TO REGISTER:**



**AS A TRADE MARK IN CLASSES 3 & 21**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001298 BY  
CALVIN KLEIN TRADEMARK TRUST**

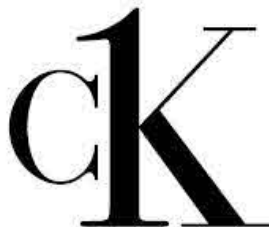
## Background & pleadings

1. On 2 October 2019, The Sunrider Corporation trading as Sunrider International (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods:

**Class 3** - Perfumes and colognes; body, hand and liquid soaps; bath and shower gel; personal and beauty care articles, namely, body, face, eye, hand cleansing creams, foams, moisturizers, lotions, gels, scrubs, oils, powders, splashes, toners, astringents, balms, moisturizing masks; non-medicated bar soap; articles for hair care, namely, shampoo, conditioner, crème rinse, styling glaze, spray, mousse, gel; shaving cream, after shave lotion; sunscreen cream; deodorants and antiperspirants; cosmetics, namely, foundation, powder, concealer, eye shadows, eye pencils, liquid eyeliner, mascara, lip pencils, lipsticks, lip gloss, lip balms, nail polish.

**Class 21** - Make-up brushes; combs and sponges including make-up sponges.

2. On 16 January 2020, the application was opposed under the fast track opposition procedure by Calvin Klein Trademark Trust (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying upon all the goods (shown in paragraph 18 below) in United Kingdom registration no. 3374267, for the trade mark (shown below), which has a filing date of 11 February 2019 and which was registered on 3 May 2019:



3. The applicant filed a counterstatement in which, inter alia, it denies there is a likelihood of confusion. It states:

“The Applicant has been using the stylised K trade mark, which is the subject of their application, since as early as 1991. The representation was the subject of UK Trade Mark Registration No. 2018368 which lapsed unintentionally through non-renewal.”

4. In these proceedings, the opponent is represented by Dennemeyer & Associates SA and the applicant by J A Kemp & Co.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. In an official letter dated 12 November 2020, the parties were allowed until 26 November 2020 to seek leave to file evidence and/or request a hearing and until 14 December 2020 to provide written submissions. Although neither party requested a hearing or sought leave to file evidence, both elected to file written submissions. In reaching a conclusion, I will bear in mind the contents of the various pleadings and written submissions.

## **DECISION**

8. The opposition is based upon section 5(2)(b) of the Act, which reads as follows:

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

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

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under section 6 of the Act. As this earlier trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, as a consequence, entitled to rely upon the trade mark in relation to all of the goods indicated without having to prove that it has made genuine use of them.

### **Section 5(2)(b) – case law**

10. The following principles are gleaned from the decisions of the courts of the European Union 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 the earlier mark to mind, is not sufficient;

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

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

### **The scope of the opposition**

11. Question 12 on the Form TM7F (“Notice of FAST TRACK opposition...”) reads:

“Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark listed at Q1?”

12. In response to that question, the opponent ticked the box which reads: “All goods and services.” However, in its Notice of opposition, the opponent stated:

“...The earlier mark covers goods in class 3 that are very similar to identical to the goods requested under the contested mark...we hereby request the refusal of the trademark application UK00003433387 for all the goods In class 3” (my emphasis).

13. In the official letter of 28 January 2020 sent to the parties, the Casework Examiner (“CWE”) stated:

“It is noted that despite ticking the option “All goods and services” to Question 12 of the form, the answer given to Question 13 clearly shows that the opposition is directed against Class 3 only of the trademark being opposed.”

14. In its written submissions filed on 14 December 2020, the opponent states:

“2...The opposition has been directed against all the goods claimed by the opposed mark in classes 3 and 21.”

15. Although the applicant did not comment on the goods at issue in its counterstatement, in its written submissions (also filed on 14 December 2020), it states:

“The opponent alleges...that the goods applied for in class 3 are “very similar to identical” to the opponent’s goods in that class. The applicant concedes that the goods under consideration in this opposition are similar.”

16. As noted by the CWE, the Notice of opposition contained a clear ambiguity as to exactly which goods in the application were being opposed. In the official letter of 28 January 2020 (which served the Form TM7F upon the applicant), the CWE notified the parties that the opposition was only to be regarded as being directed against class 3 of the application.

17. However, despite the very clear indication provided by the CWE, the opponent made no attempt to address the ambiguity identified and it was not until the opponent filed its submissions on 14 December 2020 that the opponent clarified its position. That, in my view, is much too late. Between the date of the official letter and the opponent’s submissions the parties entered into cooling-off, following which the applicant filed its Form TM8 (“Notice of defence”). The fact that the applicant makes no reference to the goods in class 21 in its written submissions strongly suggests that it was proceeding on the basis that such goods were not in issue. In those circumstances, I intend to proceed on the basis that the opposition is limited to only the goods in class 3 of the application. I shall return to this point later in this decision.

### **Comparison of goods**

18. The competing goods are as follows:

<b>The opponent’s goods</b>	<b>The applicant’s goods being opposed</b>
<b>Class 3</b> - Soaps; detergents; bleaching preparations, cleaning preparations;	<b>Class 3</b> - Perfumes and colognes; body, hand and liquid soaps; bath and

<p>perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.</p>	<p>shower gel; personal and beauty care articles, namely, body, face, eye, hand cleansing creams, foams, moisturizers, lotions, gels, scrubs, oils, powders, splashes, toners, astringents, balms, moisturizing masks; non-medicated bar soap; articles for hair care, namely, shampoo, conditioner, crème rinse, styling glaze, spray, mousse, gel; shaving cream, after shave lotion; sunscreen cream; deodorants and antiperspirants; cosmetics, namely, foundation, powder, concealer, eye shadows, eye pencils, liquid eyeliner, mascara, lip pencils, lipsticks, lip gloss, lip balms, nail polish.</p>
---	---

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“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”.

20. As I noted earlier, in its written submissions, the applicant “concedes that the goods under consideration in this opposition are similar.” Notwithstanding that concession, I have conducted a full comparison. Having done so and as terms in the applicant’s specification either find equivalent terms in the opponent’s specification or, where that is not the case, goods in the application would be included within broader terms in the opponent’s specification, the competing goods are either literally identical or are to be regarded as such on the principles outlined in *Meric*.

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

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which such 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.”

22. The parties agree (as do I), that the average consumer of the goods at issue is a member of the general public. As a member of the general public will, for the most part, self-select such goods from the shelves of a bricks-and-mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject

of, for example, word-of-mouth recommendations or oral requests to sales assistants (both in person and by telephone), aural considerations must not be forgotten.

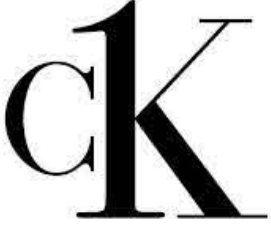
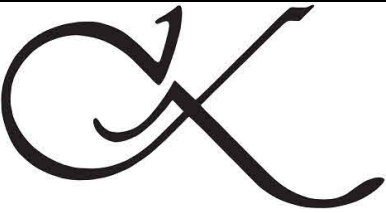
23. The opponent characterises the degree of care the average consumer will display when selecting the goods at issue as “average”, whereas the applicant considers a high degree of attention is likely to be paid. While it is true that the cost of the goods at issue and the frequency with which they may be selected will vary (as will the corresponding level of attention paid by the average consumer), considered overall, the opponent’s position is to be preferred.

### **Comparison of trade marks**

24. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*:

“.....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.”

25. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The competing trade marks are as follows:

The opponent's trade mark	The applicant's trade mark
	

### Overall impression

26. In its written submission, the opponent states:

“1...the number “1” of the invoked earlier mark [is] merged into the letter “K”...The average consumer who does not proceed to analyze details of a sign, is just as likely not to notice the number 1 in the mark...”

27. In its written submission, the applicant states:

“The Applicant’s main contention is that the overall impression given by the marks in the present case is not similar...”

The applicant contends that the number 1 is the visually outstanding, dominant element of the earlier mark. It appears at the centre of the mark in bold type, being used as the stem of the letter K. By contrast, the two ‘arms’ of the letter K appear in a lighter typeface. This is apparent when comparing the baseline of the number one and of the lower arm of the letter K to which the number is conjoined.

The letter C is placed to the left of the number 1 in the earlier mark. It is separate from this letter and appears in a smaller, separate typeface. The letter C therefore plays a weaker role in determining the distinctive character of the sign.

The Applicant submits that as a consequence of the dominance of the number 1 in the earlier sign, which is absent from the subject application, the two marks leave a different overall impression...

By contrast, the subject application is highly stylised in a manner which does not produce one dominant element.

The subject application consists of a single stylised character 'K' in italicised script with a break in its stem."

28. In reaching a conclusion on the overall impression the opponent's trade mark conveys, I note the applicant's submissions as to how the trade mark being relied upon is described on the databases of the Canadian Intellectual Property Office and the United States Patent and Trademark Office. Regardless, it is the perception of the average consumer that is crucial and it is through the average consumer's eyes I must consider the matter.

29. The opponent's trade mark consists of a slightly stylised letter "c" presented in bold followed by what, in my view, some average consumers will construe as a stylised letter "K" also presented in bold; the letter "c" is much smaller than the letter "K" which accompanies it. While I accept that some average consumers will identify that the stem of the letter "K" is also the numeral "1", I do not agree with the applicant that the numeral "1" is the "visually outstanding, dominant element of the earlier mark". While for some average consumers the overall impression conveyed by the opponent's trade mark will lie in the stylised letters "c" and "K", for others it will lie in the letters and numeral "c1K".

30. The applicant states that its trade mark consists of a "single stylised character 'K' in italicised script with a break in its stem." I am, however, unconvinced that is how the vast majority of average consumers will construe its trade mark. Much more likely, in my view, is that the vast majority of average consumers will treat it as an abstract device with the overall impression conveyed lying in the totality.

31. It is on the basis of those conclusions I shall conduct the visual, aural and conceptual comparison.

32. In its written submission, the opponent states:

“1. Visually, it is not obvious that the Opposed Mark is a stylized letter “K”. On the contrary, the curved line in the beginning of the Opposed Mark looks very much like a letter “C”, and the Opposed Mark can be visually perceived as stylized “CK” letters. Similarly, the Earlier Mark looks like a stylized “CK” since the digit “1” is merged with the letter “K”. As such, both marks can be perceived by the relevant public as being stylized “CK” letters and therefore the signs are visually similar to a high degree.

Aurally, although the visual aspect should be emphasized in the present case since both signs are significantly stylized, the marks also coincide aurally as both marks can be read as “CK” as indicated above. As such the signs are aurally similar to a high degree.

Conceptually, neither of the signs has a meaning for the public in the relevant territory. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.”

33. In its written submissions, the applicant states:

“The signs are not visually similar, being stylised in totally different ways. They are not aurally similar: the earlier mark, as detailed above, would be pronounced as C1K or CK1 by the relevant consumer; the subject application would be pronounced as K. Neither mark has a particularly strong conceptual element, but insofar as they have conceptual elements, these are not similar.”

34. While I accept that the left hand side of the applicant’s trade mark contains a curved device and that two lines radiate from the right hand side of the trade mark, I do not agree with the opponent that “it can be visually perceived as stylized “CK” letters.” As I mentioned earlier, in my view, the vast majority of average consumers

will treat the applicant's trade mark as an abstract device; the degree of visual similarity between the competing trade marks is low. Aurally, the opponent's trade mark is most likely to be pronounced as "see-kay" or "see-one-kay", whereas despite its submissions to the effect that its trade mark will be pronounced as "kay", the applicant's trade mark is, in my view, most unlikely to be verbalised. As neither trade mark is likely to convey any concrete conceptual message to the average consumer, the conceptual position is neutral.

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

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

36. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. In its written submissions, the opponent states:

“4...The earlier registration has no meaning for any of the goods in question from the perspective of the public in the relevant territory and does not describe the designated goods. Thus, we considered the earlier trademark has a normal degree of inherent distinctiveness.” (original emphasis)

37. As in its written submissions the applicant submits that the earlier trade mark “has an average degree of distinctiveness”, the parties are in agreement and it is on that basis I shall proceed.

## Likelihood of confusion

38. 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 it 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.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

40. Earlier in this decision I concluded that:

- the competing goods are either literally identical or are to be regarded as such;
- the average consumer is a member of the general public who, whilst I do not discount aural considerations, will select the goods at issue by predominantly visual means whilst, in the main, paying an average (medium) degree of attention during that process;
- the competing trade marks are visually similar to a low degree and conceptually neutral;
- the opponent's trade mark is likely to be verbalised in the manner indicated in paragraph 34 whereas the applicant's trade mark is unlikely to be verbalised;
- the earlier trade mark is possessed of an average (i.e. normal) degree of inherent distinctive character.

41. The goods at issue are identical; that is a point in the opponent's favour. In reaching a conclusion, I shall proceed on the basis most favourable to the opponent i.e. that during the selection process the average consumer will pay a low degree of attention (thus making him or her more susceptible to the effects of imperfect recollection). While it is possible that some average consumers may construe the applicant's trade mark in the manner the opponent suggests, in my view, the number of such average consumers will be very small.

42. Proceeding on that basis and despite the conceptual neutrality that exists, the fact that for the vast majority of average consumers there will be significant visual differences between the competing trade marks combined with the lack of any aural similarity is, in my view, sufficient to reject the opposition notwithstanding that there may be some confusion amongst what I regard as a very small number of average consumers.



## **Closing remarks**

43. Even if my approach to the extent of the opposition is considered to be wrong (paragraph 17 refers), having reached the conclusion I have in relation to identical goods in class 3, even if the opponent is correct and the goods in class 21 of the application are “highly similar” to its own goods in class 3, it does not assist the opponent.

## **Conclusion**

**44. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.**

## **Costs**

45. As the applicant has been successful, it is entitled to an award of costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2015.

46. Applying the guidance in that TPN, I order Calvin Klein Trademark Trust to pay to The Sunrider Corporation trading as Sunrider International the sum of **£400** in respect of its consideration of the Notice of opposition and the filing of a counterstatement (£200) and the filing of written submissions (£200). This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12<sup>th</sup> day of January 2021

**C J BOWEN**

**For the Registrar**