

O/109/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 1477589
DESIGNATING THE UNITED KINGDOM
IN THE NAME OF
RSD HOLDINGS LIMITED:**



**IN CLASSES 5, 24 AND 25
AND OPPOSITION THERETO UNDER NO. 418081
BY BOLERO CO. LTD.**

Background and Pleadings

1. On 17 May 2019, RSD Holdings Limited (“the holder”) registered the International Trade Mark displayed on the cover page of this decision, under number 1477589 (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 21 November 2018 from the Patent Office of New Zealand under filing number 1107779.

2. The IR was accepted for protection in the UK and published in the Trade Marks Journal on 26 July 2019 in respect of the following goods:

Class 5: *Napkins for incontinent persons; absorbent underwear for incontinent persons; absorbent garments for use by post-operative patients; catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants; sanitary towels; breast pads; breast-nursing pads.*

Class 24: *Textiles and substitutes for textiles; household linen; curtains of textile or plastic; fabric; fabrics for textile use; woven or non-woven textile fabrics; textile material; textile substitutes; mixed fibre fabrics; cotton base mixed fabrics; fabric substitutes; fabrics for interior decoration; waterproof mattress covers; absorbent mattress covers; mattress covers; textile goods for use as bedding; mattress protectors, bedding; sleeping bags; textile sheets; household linen; bath linen, except clothing; bed and table linen; wash cloths; towels of textile; upholstery fabrics; unfitted fabric furniture covers; furniture coverings of textile; furnishing fabrics; furnishing and upholstery fabrics; covers for cushions; absorbent fabric for covers for chair, seats, or cushions; textile fabrics for the manufacture of clothing; absorbent upholstery fabrics; textile fabrics for the use in the manufacturing of protective covers; textile fabrics for the use in the manufacturing of vehicle seat covers; textile fabrics for the use in the manufacture of soft furnishings for aeroplanes, those soft furnishings being seat covers, cushions, pillows, wall and floor coverings; moisture absorbent microfiber textile fabrics; lingerie fabric; lining fabric for footwear; labels of textile; cloths for removing make-up.*

Class 25: *Clothing; sportswear; underwear; bras; absorbent clothing; absorbent sports clothing; absorbent childrens' clothing; absorbent underwear; absorbent underwear for children; sweat-absorbent undergarments; moisture-wicking clothing; moisture-wicking underwear and undergarments; gussets for underwear being parts of clothing; swim wear; maternity bras; nursing bras; maternity singlets.*

3. On 15 October 2019, BOLERO Co. Ltd. (“the opponent”) opposed the IR under Section 5(2)(b)¹ of the Trade Marks Act 1994 (“the Act”). The opponent relies on its earlier European Union Trade Mark (EUTM) registration no. 15350838. The earlier registration’s details are outlined below:

EUTM15350838



Filing date: 19 April 2016

Date of entry in register: 21 September 2016

Class 5: *Dietetic substances adapted for medical use; vitamin drinks; vitamin preparations; nutritional additives for medical purposes.*

Class 21: *Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware; kitchen utensils not of precious metal; tableware, cookware and containers; cups and mugs; tableware not of precious metal; tableware made of terra-cotta; decanters; mugs; glasses (receptacles); bottles; drinking bottles for sports; siphon bottles for carbonated water; squeeze bottle [empty]; reusable plastic water bottles sold empty; reusable*

¹ In addition to Section 5(2)(b) the opponent initially made a claim under Section 5(3). However, the Section 5(3) was subsequently deemed withdrawn because the opponent did not file any evidence to support the claim that the earlier mark had a reputation.

stainless steel water bottles sold empty; thermal insulated containers for food or beverage; ice buckets and coolers for wine and champagne; insulated bottles; cool bags; refrigerating bottles; portable coolers; corkscrews, bottle openers; picnic baskets, including dishes; plate holders; trivets [table utensils]; non-electric coffee percolators; candlesticks not of precious metal; vases not of precious metal; lunch boxes; oil and vinegar cruets.

Class 25: *Headgear, clothing, footgear; T-shirts; caps.*

Class 30: *Coffee, teas and substitutes therefor.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 33: *Alcoholic beverages (except beers).*

Class 41: *Education; providing of training; entertainment; sporting and cultural activities.*

Class 43: *Services for providing food and drink.*

4. The first point to note is that the opposition is based solely on a EUTM. Although the UK has left the EU and the transition period has now expired, EUTMs are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice (2/2020) on “*End of Transition Period - impact on tribunal proceedings*” comments on the Tribunal’s Practice for all tribunal proceedings that, like the present case, were launched before the end of the transition period on 31 December 2020 (referred to as “IP Completion Day”):

“Practice for:

All tribunal proceedings launched before IP Completion Day (i.e. before 11pm on 31 December 2020) and,

Oppositions filed on, or after, IP Completion Day against trade mark applications filed before IP Completion Day

3) The transitional provisions provide that these proceedings should continue to be dealt with under the Act as it existed before IP Completion Day (i.e. the old law continues to apply). Users should note the following:

- EUTMs and IR(EU)s will continue to constitute earlier trade marks for the purpose of these proceedings. This applies to both registered and pending marks, although, in the case of the latter, this is subject to the earlier mark subsequently being registered or protected.”

5. The opponent can therefore continue to rely on its earlier EUTM in these proceedings.

6. The opponent submits that there is a likelihood of confusion between the respective marks due to the close similarity between them and the identity and/or similarity of the respective goods and services.

7. The holder filed a counterstatement denying the claims made. I note the following points from the counterstatement:

- The holder denies that the marks are similar. In this connection, the holder states that the only similarity between the marks is that both marks consists of a letter incorporated within a figurative element described as ‘droplet device’ but argues that such droplet devices are commonplace and that the dominant and distinctive element of the respective marks are the letters ‘B’ and ‘C’, which are different;
- The holder admits that the respective goods in class 25 are identical or similar but denies that the contested goods in class 5 and 24 are either identical or similar to the opponent’s goods and services.

8. Both parties filed evidence in these proceedings. The holder also filed written submissions dated 28 July 2020. I have read all the papers filed and shall refer to matters of evidence only to the extent that I consider necessary. A hearing was held before me, by videoconference, on 7 December 2020, at which the holder was represented by Mark Hiddleston from Hiddleston Trade Marks. The opponent, who is represented by Stobbs, chose not to attend the hearing.

The holder's evidence

9. The holder's evidence in chief consists of a witness statement dated 28 July 2020 from the same Mr Hiddleston who represented the holder at the hearing. Attached to Mr Hiddleston's witness statement are the following exhibits:

- RMH1: consists of printouts from the holder's website at www.confitex.co.uk. They show use of the contested mark in relation to absorbent underwear and nursing pads. Mr Hiddleston points out that the contested mark is derived from the name of the holder, i.e. CONFITEX, and that it is used in conjunction with that name;
- RMH2: consists of printouts from the opponent's website at www.bolero.com. They show the earlier mark being used in relation to a range of beverages. Mr Hiddleston states that it could not find any use of the earlier mark in relation to any other goods;
- RMH3: consists of details of UK and EUTM registrations and applications for marks containing a droplet device in classes 5, 21 and 25. Mr Hiddleston explains that the marks selected are some of those revealed by COMPU-MARK, a trade mark search company, and that the search results revealed a total of 398 marks containing a droplet device in these classes. In relation to this evidence I note the following:
 - i. Most of the examples relate to marks featuring droplet devices used in conjunction with brand names with the relevant specifications covering goods for which the droplet device would be understood as a symbol describing (or alluding to) certain characteristics of the product. This

includes, for example, use of a droplet device in marks intended to be used for period pads, breast pads, incontinence pads, underarm sweat absorbent pads, sweat monitors, drying technology applied to clothing, retail services for use in relation to products for treating incontinence, provision of information about incontinence, waterproof clothing, rainwear, diabetes finger test wipes, swimwear, beverages (in relation to which the drop device would be seen as denoting a liquid, being it a body fluid, a drink, water or rain), cleaning products and toiletry preparations for the care and cleaning of the skin and hair (in relation to which the droplet device would be seen as denoting the consistency of the products or alluding to the concept of water - since water is a symbol of purification);

- ii. Although Mr Hiddleston provides evidence of use in the UK of some of the trade marks listed, it consists mainly of examples of goods being offered for sale and there is no specific evidence as to the extent to which any of the marks listed have been put to use in the UK prior to 21 November 2018 (the priority date) or 17 May 2019 (the registration date);
- iii. There are 7 examples of marks featuring one letter incorporated within a droplet device, but in all cases the mark contains the brand name as well:

- 1) UK 3441635 (series of two)



- 2) UK 3344100



- 3) EUTM 14508089



- 4) EUTM 10858637

drydy^e

5) EUTM 1285726



6) EUTM 11605755



- RMH4-5: consist of Internet extracts showing use of various droplet devices in relation to menstrual and incontinence pads in a descriptive sense, namely, to indicate that the products absorb liquids.

10. At the hearing Mr Hiddleston took me in detail through the exhibits attached to its witness statement and made detailed submissions as to the evidence contained in them. Mr Hiddleston's submissions were limited to certain parts of the evidence which showed use of the marks listed in the UK.

The opponent's evidence in reply

11. The opponent's evidence in reply consists of a witness statement dated 28 September 2020 from Emma Louise Hewson, a trade mark attorney employed by Stobbs IP, the opponent's representative.

12. Ms Hewson's witness statement is simply a vehicle for introducing a number of printouts from Lloyds Pharmacy website. They show the following goods being offered for sale: drink sachets, including meal replacement sachets such as power, porridge and chocolate drinks, herbal tea sachets and cold and flu sachets (ELH1), incontinence pants, shorts (ELH2) and pads (ELH3), vitamin tablets and capsules (ELH4). Ms Hewson points out that Lloyds Pharmacy also provides NHS prescription

services, provision of online doctor services, diabetes tests, vaccinations and weight loss services and sells a variety of goods including skincare and haircare products, fragrances and electrical goods (ELH5). However, she says nothing about the relevance of this evidence or whether it is meant to support any legal submission the opponent intends to make.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act is 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”.

14. Section 5A of the Act is as follows:

“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.”

14. By virtue of their earlier filing date, the EUTM upon which the opponent relies qualifies as an earlier mark pursuant to Section 6 of the Act. As it had not been protected for five years or more at the priority filing date claimed by the IR, it is not subject to the proof of use provisions contained in Section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods and services listed above without having to establish genuine use.

Section 5(2) – case law

16. Although the UK has left the EU, Section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

18. 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 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.”

19. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. 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 OHIM*, Case T-325/06, the General Court (GC) 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”.

21. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated:

“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”.

22. The goods and services to be compared are as follows:

The holder's goods	The opponent's goods and services
<p>Class 5: <i>Napkins for incontinent persons; absorbent underwear for incontinent persons; absorbent garments for use by post-operative patients; catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants; sanitary towels; breast pads; breast-nursing pads.</i></p>	<p>Class 5: <i>Dietetic substances adapted for medical use; vitamin drinks; vitamin preparations; nutritional additives for medical purposes.</i></p>
	<p>Class 21: <i>Household or kitchen utensils and containers; combs and sponges; brushes (except paintbrushes); unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware; kitchen utensils not of precious metal; tableware, cookware and containers; cups and mugs; tableware not of</i></p>

	<p><i>precious metal; tableware made of terra-cotta; decanters; mugs; glasses (receptacles); bottles; drinking bottles for sports; siphon bottles for carbonated water; squeeze bottle [empty]; reusable plastic water bottles sold empty; reusable stainless steel water bottles sold empty; thermal insulated containers for food or beverage; ice buckets and coolers for wine and champagne; insulated bottles; cool bags; refrigerating bottles; portable coolers; corkscrews, bottle openers; picnic baskets, including dishes; plate holders; trivets [table utensils]; non-electric coffee percolators; candlesticks not of precious metal; vases not of precious metal lunch boxes; oil and vinegar cruets.</i></p>
<p>Class 24: <i>Textiles and substitutes for textiles; household linen; curtains of textile or plastic; fabric; fabrics for textile use; woven or non-woven textile fabrics; textile material; textile substitutes; mixed fibre fabrics; cotton base mixed fabrics; fabric substitutes; fabrics for interior decoration; waterproof mattress covers; absorbent mattress covers; mattress covers; textile goods for use as bedding; mattress protectors, bedding; sleeping bags; textile sheets; household linen; bath linen, except clothing; bed and table linen; wash cloths; towels of textile;</i></p>	

<p><i>upholstery fabrics; unfitted fabric furniture covers; furniture coverings of textile; furnishing fabrics; furnishing and upholstery fabrics; covers for cushions; absorbent fabric for covers for chair, seats, or cushions; textile fabrics for the manufacture of clothing; absorbent upholstery fabrics; textile fabrics for the use in the manufacturing of protective covers; textile fabrics for the use in the manufacturing of vehicle seat covers; textile fabrics for the use in the manufacture of soft furnishings for aeroplanes, those soft furnishings being seat covers, cushions, pillows, wall and floor coverings; moisture absorbent microfiber textile fabrics; lingerie fabric; lining fabric for footwear; labels of textile; cloths for removing make-up.</i></p>	
<p>Class 25: <i>Clothing; sportswear; underwear; bras; absorbent clothing; absorbent sports clothing; absorbent childrens' clothing; absorbent underwear; absorbent underwear for children; sweat-absorbent undergarments; moisture-wicking clothing; moisture-wicking underwear and undergarments; gussets for underwear being parts of clothing; swim wear; maternity bras; nursing bras; maternity singlets.</i></p>	<p>Class 25: <i>Headgear, clothing, footgear; T-shirts; caps.</i></p>
	<p>Class 30: <i>Coffee, teas and substitutes therefor.</i></p>

	Class 32: <i>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</i>
	Class 33: <i>Alcoholic beverages (except beers).</i>
	Class 41: <i>Education; providing of training; entertainment; sporting and cultural activities.</i>
	Class 43: <i>Services for providing food and drink.</i>

Class 5

Napkins for incontinent persons; absorbent underwear for incontinent persons; absorbent garments for use by post-operative patients; catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants; sanitary towels; breast pads; breast-nursing pads.

23. The opponent's specification in class 5 covers *Dietetic substances adapted for medical use; vitamin drinks; vitamin preparations; nutritional additives for medical purposes*. Although I note that the parties' goods are in the same class, I bear in mind that whether goods are in the same or different classes is not decisive in determining whether they are similar or dissimilar as per Section 60A of the Act:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

24. The holder argues that the respective goods in class 5 are dissimilar because they perform clearly different functions, which are respectively that of addressing leakage of body fluids and that of addressing deficiencies in a person’s diet.

25. Apart from the general statement (contained within the statement of grounds) that the contested goods and services are identical or highly similar to those for which the earlier mark is registered, the opponent made no further comments as regards the similarity of the goods and services at issue. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that evidence of similarity will be required if the contested goods are not identical or self-evidently similar to those for which the earlier mark is registered. Although I assume that the evidence put forward on behalf of the opponent was aimed at showing that the competing goods in class 5 can be sold through the same trade channels, i.e. pharmacies, it is much too general a connection to give rise to similarity since pharmacies sell goods of all kinds.

26. I agree with the holder that the contested goods in class 5, which are all types of absorbent underwear and garments, have a very specific purpose that does not coincide with that of the opponent’s dietetic substances, vitamins and nutritional additives in the same class. They also have a different nature and are aimed at consumers with different needs. Furthermore, they are neither complementary to each other nor in competition with each other. They are, therefore, dissimilar.

27. The earlier mark is also registered for goods and services in classes 21, 25, 30, 32, 33, 41 and 43. The closest clash that I can see is with the opponent’s *clothing*. This is because, although the holder pointed out in its written submissions that given the specific absorbent function of the contested goods in class 5 they will not be categorised as general underwear and will not be considered to be substitutable for general underwear (which fall within class 25), I note that 1) the holder’s goods in class

25 - which the holder admits are identical to the opponent's *clothing* in class 25- include, inter alia, specific items of absorbent underwear, e.g. *absorbent underwear* and *absorbent underwear for children* and 2) the holder's goods in class 5 also include items of absorbent underwear, namely *absorbent underwear for incontinent persons* and *catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants*. The unavoidable consequence of this is that there is a commonality of purpose between the holder's *absorbent underwear for incontinent persons and catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants* in class 5 and the opponent's *clothing* in class 25, which, would include underwear (absorbent or otherwise). However, there is a difference in nature, as the holder's goods in class 5 would generally be made of disposable material whilst the opponent's goods in class 25 would normally be made of washable fabrics. Further, the goods are likely to be sold through different channels, as I would expect *absorbent underwear for incontinent persons* and *catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants* in class 5 to be sold in pharmacies and supermarkets, whereas I consider (absorbent) underwear in class 25 to be sold in specialised shops or department stores. Finally, the goods are not complementary, although they might be competitive to a certain degree. These goods are in my view similar to a low degree.

28. This conclusion does not apply to the contested *Napkins for incontinent persons; absorbent garments for use by post-operative patients; catamenial products, namely sanitary towels; breast pads; breast-nursing pads*, which are one step removed from the opponent's *clothing*. Consequently, the users, uses, nature and purpose of the goods are different, the goods are neither complementary nor in competition, and will not be sold through the same trade channels. These goods are dissimilar. As some degree of similarity is required for there to be a likelihood of confusion, the opposition must fail in respect of these goods.²

Class 24

Textiles and substitutes for textiles; household linen; curtains of textile or plastic; fabric; fabrics for textile use; woven or non-woven textile fabrics; textile material; textile

² *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

substitutes; mixed fibre fabrics; cotton base mixed fabrics; fabric substitutes; fabrics for interior decoration; waterproof mattress covers; absorbent mattress covers; mattress covers; textile goods for use as bedding; mattress protectors, bedding; sleeping bags; textile sheets; household linen; bath linen, except clothing; bed and table linen; wash cloths; towels of textile; upholstery fabrics; unfitted fabric furniture covers; furniture coverings of textile; furnishing fabrics; furnishing and upholstery fabrics; covers for cushions; absorbent fabric for covers for chair, seats, or cushions; textile fabrics for the manufacture of clothing; absorbent upholstery fabrics; textile fabrics for the use in the manufacturing of protective covers; textile fabrics for the use in the manufacturing of vehicle seat covers; textile fabrics for the use in the manufacture of soft furnishings for aeroplanes, those soft furnishings being seat covers, cushions, pillows, wall and floor coverings; moisture absorbent microfiber textile fabrics; lingerie fabric; lining fabric for footwear; labels of textile; cloths for removing make-up.

29. The opponent did not put forward any reason why these goods should be considered to be similar to any of the opponent's goods and services in classes 5, 21, 25, 30, 32, 33, 41 and 43. The holder denied that the contested goods in class 24 are similar to any of the opponent's goods and services and addressed, in particular, the comparison with the opponent's goods in classes 21 and 25. It seems to me that the holder's approach is right in that the conflict with the remaining goods and services in class 5, 30, 32, 33, 41 and 42 does not improve the opponent's position as there is no obvious similarity with these goods and services.

30. The following goods *household linen; curtains of textile or plastic; fabrics for interior decoration; waterproof mattress covers; absorbent mattress covers; mattress covers; textile goods for use as bedding; mattress protectors, bedding; sleeping bags; textile sheets; household linen; bath linen, except clothing; bed and table linen; wash cloths; towels of textile; upholstery fabrics; unfitted fabric furniture covers; furniture coverings of textile; furnishing fabrics; furnishing and upholstery fabrics; covers for cushions; absorbent fabric for covers for chair, seats, or cushions; absorbent upholstery fabrics; textile fabrics for the use in the manufacturing of protective covers; textile fabrics for the use in the manufacturing of vehicle seat covers; textile fabrics for the use in the manufacture of soft furnishings for aeroplanes, those soft furnishings being seat*

covers, cushions, pillows, wall and floor coverings; moisture absorbent microfiber textile fabrics; lining fabric for footwear; lingerie fabric; labels of textile; cloths for removing make-up in the holder's specification are either raw materials and semi-finished products intended for manufacturing or covering furniture, vehicles, footwear and lingerie and for decoration of interiors, or specific household textiles goods. I note that the opponent's goods in class 21 include items such as household or kitchen utensils, tableware and cookware which could be used in combination with some of the holder's goods in class 21, e.g. towels of textile which would include kitchen towels. However, the goods have different nature and purpose, and although they may be used in the kitchen, it does not mean that they are complementary in the sense that one is indispensable or important of the use of the other and consumers believe that the goods are the responsibility of the same undertaking. Further, the goods are not competitive and although they may be sold in the same department store, they are unlikely to be found in close proximity. Consequently, I consider these goods to be dissimilar. As some degree of similarity is required for there to be a likelihood of confusion, the opposition must fail in respect of these goods.³

31. The most that can be said in relation to the contested *Textiles and substitutes for textiles; fabric; fabrics for textile use; woven or non-woven textile fabrics; textile material; textile substitutes; mixed fibre fabrics; cotton base mixed fabrics; fabric substitutes; textile fabrics for the manufacture of clothing* is that they are used for the manufacture of clothing, which are covered by the opponent's specification in class 25. However, this is not sufficient in itself to conclude that the goods are similar, as their nature and purpose are quite distinct. Although there is a degree of competition to the extent that consumers can buy fabrics and textiles to make their own clothes, the goods have completely different distribution channels and sales outlets, are not usually manufactured by the same undertaking and consumers would not expect that they are manufactured by the same undertakings. Consequently, I consider these goods to be dissimilar. As some degree of similarity is required for there to be a likelihood of confusion, the opposition must fail in respect of these goods.⁴

³ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

⁴ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

Class 25

Clothing; sportswear; underwear; bras; absorbent clothing; absorbent sports clothing; absorbent childrens' clothing; absorbent underwear; absorbent underwear for children; sweat-absorbent undergarments; moisture-wicking clothing; moisture-wicking underwear and undergarments; gussets for underwear being parts of clothing; swim wear; maternity bras; nursing bras; maternity singlets.

32. The holder has accepted in its counterstatement that the contested goods in class 25 are “identical or similar” to the opponent’s goods in class 25. Insofar as the contested specification include items of ‘underwear’ and ‘undergarment’ and the dictionary definition of these words is that of ‘clothes worn next to the skin, under other clothes’ and ‘a piece of underwear’ (respectively), the following goods in the holder’s specification fall within the broad term *clothing* in the opponent’s specification: *Clothing; sportswear; underwear; bras; absorbent clothing; absorbent sports clothing; absorbent childrens' clothing; absorbent underwear; absorbent underwear for children; sweat-absorbent undergarments; moisture-wicking clothing; moisture-wicking underwear and undergarments; swim wear; maternity bras; nursing bras; maternity singlets*. These goods are identical on the principle outlined in *Meric*.

33. This leaves *gussets for underwear being parts of clothing*. These goods are parts and/or fittings for clothing. The fact that a particular good is used as a part, element or component of another is not sufficient for it to be similar to the finished article. The customers, nature and intended purpose of the goods will differ. However, the holder has accepted in its written submissions that all of the holder’s goods in class 25 are identical to the opponent’s goods; accordingly, I find that these goods are also identical to the opponent’s goods.

Average consumer and the nature of the purchasing act

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods in class 5 and 25. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem*

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

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

35. The average consumer of the holder’s *absorbent underwear for incontinent persons and catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants* in class 5 and the parties’ goods in class 25 is the general public. The goods are likely to be purchased relatively frequently and the purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive purchases. The average consumer will, nevertheless, consider factors such as quality, size and suitability of the product in accordance with their individual needs and preferences. Taking the above factors into account, I find that the level of attention of the general public in respect of these goods would be medium. The goods are typically sold in bricks-and-mortar retail establishments or their online equivalents, where the goods are likely to be self-selected from rails and shelves or after viewing information on the internet. In these circumstances, visual considerations will dominate the selection process, although I do not discount aural considerations in the form of word of mouth recommendations or receiving advice from a sales assistant.



Comparison of the marks

36. 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 the marks, bearing in mind their distinctive and dominant components. The

CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

The IR holder's mark	The opponent's mark
	

38. Both marks are figurative marks composed of a droplet device inside of which a capital letter ‘C’ (in the holder’s mark) and ‘B’ (in the opponent’s mark) are positioned centrally. The outer droplets are a separate and identifiable component of each mark and given their size and positioning they will make an important contribution to the overall impression conveyed by the marks.

Visual similarity

39. The only comments made by the opponent as regards the similarity of the marks is that the IR “*is highly similar to the earlier mark on a visual, aural and conceptual*

basis”, however, the opponent did not carry out any specific comparison between the marks taking into account their components (and relative weight) and their overall impression.

40. The holder accepts that the outer droplets in the marks are similar and that although there are some subtle differences between them, they are likely to be lost taking into account imperfect recollection. However, the holder also contends that the outer droplets will be seen by the public as either descriptive (at least in relation to goods relating to water and liquids) or decorative and will have little or no distinctive character. Although the outer droplets are represented in a very similar manner, the letters depicted in each mark, namely the letter ‘B’ and the letter ‘C’, are visibly different. I consider the marks to be visually similar to a medium degree.

Aural similarity

41. Aurally, the signs are dissimilar as the holder’s mark will be pronounced as a ‘C’ mark and the opponent’s mark will be articulated as a ‘B’ mark.

Conceptual similarity

42. Conceptually, the signs are similar only to the extent that the graphic elements of the marks will be regarded as the representation of a small drop of liquid. This is particularly likely to occur when the marks are applied to certain goods, namely goods in class 5 and 25 which have absorbent properties, as well as swimwear and waterproof clothes in class 25, in which case the concept of a droplet would be weak in distinctiveness. Although the public will also associate the marks with different letters, namely the letter ‘C’ and the letter ‘B’, a letter of the alphabet does not have any semantic content of its own, so I doubt that even if there is any conceptual dissimilarity between the marks to the extent that the only verbal elements of marks are different letters of the alphabet, that conceptual dissimilarity could help to distinguish between them.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

44. The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation and did not file any evidence of use. In terms of inherent characteristics, the earlier mark includes the capital letter ‘B’ written in a commonplace typeface and placed inside a droplet device. The Registrar’s approach to the examination of letters put forward for registration as trade marks under the 1994 Act is summarised in the Trade Marks Manual. This contains the following guidance:

“There is no bar to the acceptance of single letters as trade marks. Each case must be considered individually. A single letter mark may be distinctive for a wide range of services. A single letter may be descriptive or non-distinctive for many goods, but may be acceptable for many other goods. Research is required in each case so as to avoid registering a descriptive indication as a trade mark. For example, the letter “K” appears to be a distinctive trade mark for footwear, but the letter “H” is a customary indication of a width fitting for shoes, and so would not be distinctive. However, the letter “H” would appear to be a distinctive trade mark for drinks. Particular care is required where the goods are technical items such as computers, machines, motors and tools, where particular letters often have a descriptive meaning or have become customary in the language or in the bona fide and established practices of the trade.”

45. Further, the GC has stated in a number of cases that a mark containing a single letter may indeed be inherently distinctive.⁵

46. Single letter marks cannot therefore be regarded as devoid of distinctive character merely because they are single letters. Whilst there is no evidence to suggest that the letter ‘B’ is descriptive or otherwise non-distinctive in relation to the opponent’s goods in class 25, it is inherently distinctive only to a low degree, because it is extremely simple and common, and as such it is less eye catching and memorable than signs which strike the eye (and ear) as less ordinary or commonplace.

47. As regard the distinctiveness of the droplet device, although I find that it has a weak distinctive character in relation to the opponent’s goods which I found to be similar to some of the holder’s goods in class 5 and 25, to the extent that the term *clothing* in the opponent’s specification includes items of clothing and underwear with absorbent quality, swimwear and waterproof clothes, “*the distinctiveness of the earlier trade mark fell to be considered as a matter of impression*”⁶. In my view, the whilst the single elements of the marks are, taken alone, low in distinctive character, the

⁵ T-101/11 § 50; T-176/10 § 36; T-378/12 § 37--51

⁶ BL-O-115/19

combination created by the positioning of the single letter 'B' within the centre of an outer droplet create a mark which is distinctive, as a whole, to a medium degree⁷.

Likelihood of confusion

48. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

49. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

⁷ See paragraph 29, [2017] EWHC 3393 (Ch)

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.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

50. The main points from my analysis are as follows:

- I have found some of the holder’s goods in class 5 to be similar to a low degree to the opponent’s goods in class 25. I also found all of the holder’s goods in class 25 to be identical to the opponent’s goods in the same class;
- I found the average consumer of the parties’ goods to be the general public. I found that the goods will be selected primarily by visual means (although I do not discount an oral component). I have concluded that a medium degree of attention will be paid during the purchasing process;
- I have concluded that the opponent’s mark as a whole is distinctive to a medium degree;

- I found that the marks are visually similar to a medium degree and aurally different. Conceptually, the verbal elements of the marks consist of different letters of the alphabet, namely the letter 'C' in the holder's mark and the letter 'B' in the opponent's mark, however, the presence in both marks of two similar abstract figurative shapes which recall a droplet creates a degree of conceptual similarity.

51. As a preliminary point, I bear in mind that contrary to the holder's submission, the assessment of the likelihood of confusion should not be constrained by an assumption that the respective marks will always be used with accompanying word marks, namely the word CONFITEX (which is used by the holder) and the word BOLERO (which is the opponent's name). This is because normal and fair use of the marks would include use on their own, as registered and applied for, and not necessarily in conjunction with the word marks with which they appear to have been used.

52. On the other hand, it is appropriate to take into account the following:

- 1) although each mark is composed of a single letter, and the two letters in the marks are different, both marks display a visual depiction of the letter in question within an outer droplet;
- 2) both the letters and the outer droplets are presented in both marks in a nearly identical manner, though in a basic form;
- 3) although the marks are conceptual dissimilar, the conceptual dissimilarity is based on one of the most basic semantic concepts that a mark can portray: a single letter; therefore, it is not of decisive importance;
- 4) even though the outer droplet will be conceptualised by the average consumer as a drop of water or liquid in relation to most of the parties' goods which I found to be identical or similar, the distinctive character of a mark must be assessed *"by reference to the specific individuality of it as graphically presented to the eye of the relevant average consumer and not simply by reference to the broad generality of its conceptual connotations"*⁸;

⁸ BL-O-115/19

5) while the concept conveyed by the representation of a droplet in both marks might be of weak distinctive character in relation to the aforementioned goods, the fact remains that the two devices in the respective marks are represented in the same manner and the combination created by the incorporation in both marks of a plain single letter of the alphabet within an outer droplet is a coincidence that cannot be overlooked completely.

53. Considering the above, my conclusion is that the graphic appearance of the marks and their overall impression is such that the marks are sufficiently visually similar to cause the average consumer to misremember the 'B' for a 'C' where identical goods in class 25 are involved, taking into account the notion of imperfect recollection and the fact that the signs do not have any conceptual meaning that could help to distinguish between them. Even if I am wrong, and the average consumer would notice the difference between the letter 'B' and the letter 'C' in the respective marks, it is my view that the similar overall impression the marks convey is such that it will give rise to the perception of a link in the event of concurrent use of the marks on identical goods so that the average consumer will conclude that holder's mark is another mark used by the same or a commercial connected economic operator.

54. As regards the holder's goods which I found to be to be similar only to a low degree, namely the goods in class 5, I find that the differences in the goods are such that, in the absence of any evidence of enhanced distinctiveness of the opponent's mark, they are sufficient to counterbalance the similarity between the marks and to prevent a likelihood of confusion.

OUTCOME

55. The opposition succeeds in relation to the following goods which will be refused:

Class 25: *Clothing; sportswear; underwear; bras; absorbent clothing; absorbent sports clothing; absorbent childrens' clothing; absorbent underwear; absorbent underwear for children; sweat-absorbent undergarments; moisture-wicking clothing; moisture-wicking underwear and undergarments; gussets for*

underwear being parts of clothing; swim wear; maternity bras; nursing bras; maternity singlets.

56. The opposition fails in relation to the following goods which will proceed to registration:

Class 5: *Napkins for incontinent persons; absorbent underwear for incontinent persons; absorbent garments for use by post-operative patients; catamenial products, namely absorbent underwear, sanitary panties, sanitary knickers, and sanitary pants; sanitary towels; breast pads; breast-nursing pads.*

Class 24: *Textiles and substitutes for textiles; household linen; curtains of textile or plastic; fabric; fabrics for textile use; woven or non-woven textile fabrics; textile material; textile substitutes; mixed fibre fabrics; cotton base mixed fabrics; fabric substitutes; fabrics for interior decoration; waterproof mattress covers; absorbent mattress covers; mattress covers; textile goods for use as bedding; mattress protectors, bedding; sleeping bags; textile sheets; household linen; bath linen, except clothing; bed and table linen; wash cloths; towels of textile; upholstery fabrics; unfitted fabric furniture covers; furniture coverings of textile; furnishing fabrics; furnishing and upholstery fabrics; covers for cushions; absorbent fabric for covers for chair, seats, or cushions; textile fabrics for the manufacture of clothing; absorbent upholstery fabrics; textile fabrics for the use in the manufacturing of protective covers; textile fabrics for the use in the manufacturing of vehicle seat covers; textile fabrics for the use in the manufacture of soft furnishings for aeroplanes, those soft furnishings being seat covers, cushions, pillows, wall and floor coverings; moisture absorbent microfiber textile fabrics; lingerie fabric; lining fabric for footwear; labels of textile; cloths for removing make-up.*

COSTS

57. Both sides have achieved a measure of success. In the circumstances, I consider it appropriate that each party should bear their own costs.

Dated this 19th day of February 2021

T Perks

For the Registrar,

the Comptroller-General