

O-155-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2384901
BY
RDPR LIMITED
TO REGISTER THE TRADE MARK**

ROJA DOVE

IN CLASSES 3 AND 42

**THE OPPOSITION THERETO
UNDER NO 94284
BY
UNILEVER PLC**

Trade Marks Act 1994

**In the matter of application no 2384901
by RDPR Limited
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ROJA DOVE

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**and the opposition thereto
under no 94284
by Unilever Plc**

Introduction

1. On 18 February 2005, RDPR Limited ('RDPR') applied to register the trade mark ROJA DOVE under number 2384901. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 13 January 2006 with the following specifications:

perfumes and perfumery products; aromatic substances for use in the manufacture of perfumes; perfumed products; perfumed bath foam preparations; perfumed bath salts; perfumed milks; perfumed lotions; perfumed sprays; perfumed creams; perfumed soaps.

research services into the development of perfume products.

The above goods and services are in classes 3 and 42 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. On 13 April 2006, Unilever Plc ('Plc') filed notice of opposition to the trade mark application. The opposition is directed at the complete list of goods and services. Plc claims that registration of the mark would be contrary to section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994. Under sections 5(2)(b) and 5(3), Plc relies upon a single earlier right which is trade mark number 2371471, registered in the United Kingdom on 11 March 2005:

DOVE

Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair, shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash; 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.

Razors and razor blades; manicure implements; pedicure implements; scissors; nail files; nail clippers; cuticle clippers; tweezers; eyelash curlers; hair curling and waving devices; hair clippers; hair removing devices.

Toilet cases and vanity cases; small domestic utensils and containers; wash-bags; brushes; combs; sponges; powder puffs; powder compacts; toilet utensils; toothbrushes; dental floss, tape; dental sticks; cloths for cleaning; dusting and polishing cloths; pads for cleaning or scouring; containers and dispensing devices for toilet preparations.

Towels; flannels; silk squares; exfoliating mitts; mitts for washing the body; cloths; cloths for washing the body.

Towelling robes; slippers; footwear for use in health and beauty salons; swimwear; items of clothing used in exercising.

The bringing together, for the benefit of others of a variety of goods enabling customers to conveniently view and purchase health and beauty and other products in health and beauty stores, health and fitness centres and beauty salons; the bringing together, for the benefit of others, of a variety of goods to enable customers to view and purchase health, beauty and other products from an Internet site specialising in health, beauty and fitness or by mail order, advertising and promotion services, and information services relating to thereto.

Beauty salon services; hairdressing services; manicure and pedicure services; aromatherapy; sun tanning services; sauna, solarium and massage services; information and advisory services relating to health, diet, exercise, lifestyle, healthcare, beauty care, skin care, perfumery, deodorants, nutrition and hygiene; research services relating to health, diet, exercise, lifestyle, healthcare, beauty care, skin care, perfumery, deodorants, nutrition, hygiene.

The above goods and services are in classes 3, 8, 21, 24, 25, 35 and 44 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3. Plc states that all of the above goods and services for which its mark is registered are similar to those of the application, such that there exists a likelihood of confusion under section 5(2)(b).

4. In relation to its section 5(3) ground, Plc states that the mark has a reputation for soaps; deodorants and antiperspirants; shampoos and conditioners; bath and shower preparations; skin care preparations. Its complaint against the application under this ground is confined to aromatic substances for use in the manufacture of perfumes; research services into the development of perfume products. Plc states

that “[u]se of the mark applied for on the above goods and services will lead to actual confusion and/or dilute the distinctive character or repute of the earlier mark.”

5. Plc relies upon its earlier right DOVE under section 5(4)(a), which it states has been used throughout the UK on soap since at least the late 1950s, and on body wash, antiperspirants, deodorants, shampoos, conditioners, moisturising creams, creams and lotions for the face and body, bath creams, washes, and scenting preparations, body firming and lifting preparations since at least 1995.

7. In its notice of opposition, Plc also states:

“To the extent that the applicant has relied upon Section 7 of the Trade Marks Act 1994, it is contended by the opponent that in the face of this opposition, that Section no longer provides a basis for acceptance in accordance with the provisions of Section 7(2) of the Act or in the alternative that the case for honest concurrent use has not been made out.”

The published details of the trade mark application indicated that the mark had been accepted and published on the basis of honest concurrent use with registration numbers 2147816, 2417922 and ‘others’.

8. RDPR filed a counterstatement denying all grounds. It admitted that the application and the opponent’s mark share the common ‘Dove’ element but stated that the mark ‘Roja Dove’ had been used extensively by the applicant without any evidence of confusion with any other trade marks, the opponent’s mark included. In relation to the section 5(4)(a) ground, RDPR denies misrepresentation and damage to any reputation and goodwill. RDPR gives the answer ‘No’ in response to the question on the statutory Form TM8 Notice of Defence and Counterstatement “If a statement of use of any earlier trade marks has been given in support of the opposition or invalidation action, do you accept this statement”. It further stated that it required Plc to provide proof of use for the mark DOVE for soap, body wash, antiperspirants, deodorants, shampoos, conditioners, moisturising creams, creams and lotions for face and body, bath creams, washes, and scenting preparations, body firming and lifting preparations.

9. Since its mark had been registered for less than five years at the date on which the application was published, there is no statutory requirement in relation to the ground under section 5(2)(b) for Plc to prove use of its mark on the goods and services upon which it relies¹. It did not therefore make a statement of use in its notice of opposition in relation to its section 5(2)(b) ground. However, in order to support its claims under sections 5(3) and 5(4)(a), an opponent is required to prove it has a reputation and goodwill for the mark(s) which it relies upon for both grounds, unless the applicant makes an admission as to the same. In its defence and counterstatement RDPR has made no admission to Plc enjoying a reputation or goodwill in DOVE, the mark upon which it relies for both grounds; whilst not actually denying that Plc has a reputation or goodwill, it has expressly stated that it does not admit the same. (Later in the proceedings, it becomes more apparent that Plc’s

¹ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

reputation was admitted.) To the extent that RDPR has required proof of use, it can only relate to the grounds of opposition under sections 5(3) and 5(4)(a).

10. Both sides filed evidence. A hearing was held on 18 March 2009. Plc filed written submissions in lieu of attending the hearing. RDPR was represented by Mr Simon Malynicz, of counsel, instructed by Fry Heath & Spence LLP.

Plc's evidence

11. This consists of a statutory declaration by Matthew Close, supported by four exhibits. Mr Close is Plc's business director for health and beauty and is responsible for the range of personal care products sold under the trade mark DOVE.

12. Mr Close states that the mark DOVE was first used in the UK in 1959 by Plc's predecessor in title and business in relation to a mild soap bar. The use of DOVE in relation to soap has been continuous since that date, but in 1992 DOVE was 'relaunched', beginning a rollout of "what is one of the UK's most successful range of personal care products." Exhibit MC1 gives a chronology of product launch dates:

Product	Launch date in UK
Cleansing bar with moisturising properties	1992
Cream soap bar, including light perfume bar	1995
Deodorant	1996
Baby soap bar	1996
Sensitive skin moisturising body wash	1997
Ultra moisturising body wash in two fragrances	1999
Hair care range	2002
Dry skin bureau opened	2002
Firming lotion	2002
Pure silk range of bath and body wash, exfoliator and moisturiser launched incorporating silk extract	2003
Hair care range specially for coloured hair	2004

Ex-factory sales and advertising figures relating to these items are given below, up to the date of application (18 February 2005) for 2384901:

Year	Turnover (£ million)	Advertising (£ million)
2000	36.3	13.2
2001	41.4	13.7
2002	67.2	27.1
2003	73.5	28.2
2004	83.9	25.7

A breakdown for 2004 shows the percentage of sales and market share of the items, which are grouped into four broader personal care product categories:

Product	% of sales values	Market share %
Hair	21	3.6
Skin (cleansing)	45	10.0
Deo	23	6.1
Body care	11	10.7

13. Mr Close states that the DOVE products are some of the best sellers in their market and are sold by all major supermarkets and personal care retailers throughout the UK. Advertising has take place extensively by way of television commercials, leading lifestyle magazines and national newspapers, mail shots, billboard and posters. Exhibit MC2 is a DVD containing a selection of television commercials which Mr Close states ate from 1992 to 2004; although the vast majority are undated on the DVD, they show DOVE on items from the four product categories identified above. Exhibit MC3 is a selection of advertisements which appeared in Cosmopolitan, Radio Times, Heat, Spirit of Superdrug, Prima, New Woman and The Grocer magazines between 1998 and 2005. These also show DOVE products from the above four product categories. Exhibit MC4 is a copy of an advertisement published in a number of magazines, including Cosmopolitan and Prima, showing that 'Dove' was the winner of the 'overall beauty brand award' in the Beauty Magazine Awards 2003 for best overall beauty brand, best bodycare brand, best shampoo, best conditioner and ultimate pampering product (Dove silk bath).

14. 'Dove' appears on all the packaging shown in the advertisements and also on the soap bar product itself. In all cases, it appears adjacent to a golden silhouette device of a bird, mostly above or below the word Dove.

RDPR's evidence

15. This consists of a witness statement by Peter Causer, together with twenty – three supporting exhibits. A number of further witness statements form the basis of several of these exhibits, having been made by people engaged in the retail of perfumery and also those involved in publishing magazines which feature articles related to perfumery and personal care goods. Exhibit PC22 contains a copy of a statutory declaration made by Peter Causer on 1 December 2005; this was made during the course of the ex officio examination of the application in suit, resulting in it being accepted at that stage on the basis of section 7(1) of the Act ('honest concurrent use')².

16. Mr Causer is the director and company secretary of the applicant. He states that the initials of the company, RDPR, stand for 'Roja Dove Public Relations' and that Mr Roja Dove is the Managing Director and majority shareholder in the company, which was set up in 2002 to handle Mr Dove's expanding business affairs.

² Since the application was accepted for publication, The Trade Marks (Relative Grounds) Order 2007 (SI 2007/1976) has come into effect, under the terms of which an application will be accepted and published in the face of an earlier right (unless the applicant withdraws it), thereby superseding the 'honest concurrent use' route to acceptance previously possible under section 7.

17. Mr Causer makes some statements to convey the profile of Mr Dove in the field of perfumery:

“Roja Dove is recognised as a, if not ‘the’, leading world expert in perfumery”;

“Roja Dove’s expertise is in all things related to perfume”.

“As the only ‘*Professeur de Parfums*’, Roja Dove is the most quoted and respected fragrance expert in the world”;

“Roja Dove is always referred to by his full name, ‘Roja Dove’. My company’s goods and services are provided under Roja Dove’s full name, which is never abbreviated to ‘Dove’”.

To support his claim that Mr Dove is a renowned perfume expert, Mr Causer has exhibited a quantity of press cuttings, some of more relevance than others. In view of the volume involved, I will not detail them all in this summary, but I have borne them in mind in reaching my decision. There are also a number of ‘independent’ witness statements, which I will refer to as necessary, without detailing the content of them all.

18. Mr Causer’s evidence reveals that Mr Dove owes the development of his perfumery expertise to his time (twenty or so years) spent as the lead perfumier at Guerlain, in France, “one of the world’s most respected perfume houses”. Exhibit PC2 is a typed list of quotations from the press which, although attributed, are undated and are not the original copies of the published quotations. They invariably attest to Mr Dove/RDPR as a fragrance expert or the leading fragrance authority. Other exhibits show a connection with very limited edition perfumes and, since 2003, the creation of bespoke ‘signature’ fragrances for clients whose identities are undisclosed in the evidence, for a fee of £20,000. Only a few people a year ‘around the world’ are offered this service, according to Mr Causer.

19. Exhibit PC3 is an article, dated nine months after the date of application, from the Guardian newspaper. It gives details of a perfume, limited to ten bottles, created by Roja Dove, sold in Harrods in commissioned Baccarat crystal and large diamond bottles, for £115,000 (or £355 for the version with a tiny diamond) and delivered in a Bentley car. Mr Causer states that this is the most expensive perfume in the world. Exhibit PC4 concerns Mr Dove’s scent selection personal consultations at Harrods priced at £200 to £250 an hour. The exhibit is undated but Mr Causer states that Mr Dove opened the Roja Dove Haute Parfumerie, located within the ‘Urban Retreat’ at Harrods in October 2004. Along with similar perfumeries at Jenner’s of Edinburgh and House of Fraser stores in Manchester and Guildford, the Haute Parfumerie locations sell perfumes hand picked by Mr Dove and at which his personal consultations are available. Page 93 of exhibit PC11 is a copy of an article in ‘Goldarth’s Review – The Online Luxury Magazine’ dated 25 February 2008 referring to this service, but not indicating when it commenced. The article is entitled ‘Haute Parfumerie’ and gives details of similar services in Paris by master perfumers of the Houses of Jean Patou (costing €50,000), Guerlain and Cartier (on page 9 of exhibit PC11 Mr Dove said that these houses followed his *haute parfumerie*). The article says that Roja Dove is “widely regarded as the world’s foremost authority on

perfumery [and] is inspirational, knowledgeable and on a personal mission to revive and help people relive the rich history of perfume.”

20. Besides the hand picked perfume range, the creation of bespoke fragrances and the personal consultations, Mr Causer states that Mr Dove created a fragrance in 2005 for Kérastase, a division of L’Oréal, to be used in their candle sets for a Christmas gift for their customers (the date of application is 18 February 2005). Mr Causer says that the candles bore Roja Dove’s signature. Exhibit PC19 is filed in support; the signature is heavily stylised and appears subordinate to ‘KÉRASTASE PARIS’. Mr Causer includes, at page four of this exhibit, a print of an Ebay auction for the candles, which shows the auction finishing on 28 November 2007, with three bids, the ‘current’ bid being for £1.70, with postage at £2.99. It does not say who is selling the candles.

21. Roja Dove launched a fragrance line of three perfumes bearing his name in July 2007 retailing at £350 for a 100ml atomiser. This was after the relevant date. Since 2005, Mr Dove has also created and sold an exclusive range of semi-bespoke fragrances under his name (eight at the time Mr Causer made his witness statement), each limited to fifty customers. According to the invoices exhibited at PC6, the retail value of these is upwards of £1000 each.

22. As to turnover, Mr Causer states:

“Until 2000 Roja Dove was employed by Guerlain, the French perfume house. As such, although he was known the world over for his mastery of perfumery and his name has been synonymous with perfume for many years, he did not generate turnover for himself under his own name until 2001. Roja Dove, and since 2002, my company, have generated turnover under the mark ROJA DOVE by means of personal appearances, lectures, training courses, bespoke perfumery services and, since 2004, his Haute Parfumerie stores . My company’s turnover since 2002 has previously been set out in my Statutory Declaration of 1 December 2005, which is attached hereto as **Exhibit PC22**. For the avoidance of doubt, I should point out that these figures are not representative of the level of Roja Dove’s reputation and recognition in the perfume world.”

The said turnover figures, which the statutory declaration specifies as being the quantity and value of sales under the mark ROJA DOVE, are:

Year	£
2001 (part)	22,000
2002	202,000
2003	319,000
2004	543,000
2005 (relevant date 18.2.05)	650,000+

The figures are not broken down into goods or services sold. There are no advertising figures.

23. A considerable amount of RDPR's evidence seeks to establish the fame of Mr Dove within the world of perfume and to explain his *raison d'être*, or from where he derived his inspiration and experience. As a young man, he was fascinated by perfumes from the early 20th century, devoting his time and money to collecting and learning as much as he could about perfume, and bombarding the French perfume house Guerlain with requests for information. The head of Guerlain, Robert Guerlain, eventually gave him a job and his aptitude and success within the company as a master perfumier led to him being given the title 'professeur de parfums'. Page 9 of PC10 (a Mail on Sunday article dated 10 December 2007) says that this is an honorary title given to him through the industry, of which he is the only holder in the world. In contrast, the witness statement (19 November 2007) of Daniela Rinaldi, head of perfumery and concessions at the Harvey Nichols store in Knightsbridge, London (exhibit PC21) says "While he was at Guerlain, he had responsibility for the training of fragrance consultants and, being completely self-taught, he then started to educate himself about other perfume and fragrance brands. He carved himself a niche as a self-styled 'Professeur de Parfums' which gave him credibility and enabled him to give consultations to customers."

24. Mr Dove's consultations appear to have taken place both in relation to personal fragrance creation and advice and also by way of his appearances in department stores, perfume shops and at beauty 'events'. Examples are given as Peter Jones, Fortnum & Mason, The Savoy, Selfridges, Dagenham's (Stirling), Beauty Box (Ayr), Browns of Chester, Debenhams (Stirling and Belfast), Fenwicks (York), Kendals (Manchester) and Rackhams (Birmingham). These have been advertised and reported in magazines such as *Harpers & Queen*, *Brides*, *Elle*, *Vogue*, *Esprit*, and *Hello!* Some of the events appear to have been held under the banner of Guerlain. The name ROJA DOVE has also appeared in the UK national press and beauty magazines in connection with Mr Dove's expertise within the perfume industry. Several of the exhibits show references to regular appearances from 1996 onwards at a shop called 'Scent' in Boston, Lincolnshire; these appearances were reported in the local press. Mr Dove's rôle at these events has been to lecture on the subject of perfume. He is then on hand to discuss what to look for, how to test perfume and the selection of perfume to buy. He has also performed the latter role in department stores.

25. Mr Causer refers to exhibit 14 as demonstrating instances of media appearances, but my examination of this exhibit reveals only two pages. The first of these is a copy of an invitation to Mappin & Webb on 4 July where Mr Dove was speaking and the second page is an invoice to Ruth Yahal, 50 Ways to Please, Endemol UK, for unspecified goods or services. In his statutory declaration, Mr Causer refers to these as being media appearances; the Endemol invoice for £64.88 was for Mr Dove's involvement in a Channel 5 production called '50 ways to please your lover.' There is no reference to television or radio in relation to the Mappin & Webb appearance. Mr Causer also makes reference to other media productions involving Mr Dove in some capacity, including the BBC's coverage of the Chelsea Flower Show in 2001; an unspecified ITV programme in 2003 on what the super rich buy, in which a Roja Dove bespoke perfume was mentioned and other radio and television appearances after the relevant date. Mr Dove has also spoken at seminars, conferences and exhibitions as a perfume expert, such as the London

College of Fashion (1996), Wentworth Golf Club Ladies Luncheon Club (1998), Coty Annual Conference (2004) and Proctor & Gamble Annual UK Conferences in 2004 & 2005.

26. In 1995 and 1996, Mr Dove represented the Comité Français du Parfum, funded by the French government to promote luxury goods. The Comité toured the UK to give talks about French fragrance. Exhibit 16 is a witness statement dated 15 February 2008 by Michael Sheridan of Sheridan & Co., a retail design agency based in Leicestershire. Mr Sheridan states that his company helped organise the Comité exhibition, visiting a handful of major venues across the UK. At paragraph 4, Mr Sheridan says:

“Roja Dove certainly played a role in the exhibition, although I’m not sure of the exact details of his involvement.”

27. Mr Causer states that Mr Dove has won several prestigious awards, including the Cosmetic and Perfume Retailers Association’s (COPRA) Gordon Whitehead Award in 2000 and the Cosmetic Executive Women 2007 Award for ‘Achievement for Work in Luxury Goods’. Exhibit PC18 contains 132 invoices issued by RDPR for training courses attended by perfume consultants in Selfridges, House of Fraser, Lloyds Chemists and Proctor & Gamble. Mr Causer states that Mr Dove developed and conducted the training courses. Pages 1 to 100 are all headed ‘R.D.P.R.’, ‘RDPR Group’ or ‘RDPR Ltd’, with cheques to be made payable to RDPR Ltd. Pages 101 to 104 are not headed, with cheques to be made payable to R.Dove. Page 104 itemises the service provided as ‘R.Dove Guerlain event at Solihull store 20/11/02’. Page 105 is a letter dated ‘10 November’, possibly accompanying the 20 November 2002 invoice from ‘Roja Dove RDPR’ in which he states he is in a new neutral position, presumably a reference to his having left Guerlain’s employment. The remaining invoice pages are a mixture of unheaded invoices either referring to payment to R. Dove or RDPR Ltd, for the provision of RDPR training courses. Page 109 refers to ‘R Dove training 14/3/06 as agreed’. Pages 121 and 122 refer to ‘Roja Dove Parfumeries November’ invoicing to House of Fraser, dated 13 November 2006 and 30 November 2006, respectively.

28. In addition to the statutory declaration and witness statement already mentioned above which have been provided as exhibits, Mr Causer has also included the witness statements of sixteen individuals. These are:

Janine Roxborough-Bunce (The Fragrance Foundation)
Beryl Lake (Harvey Nichols, Harrods, Fenwicks and QVC)
Kathryn Catanzaro (Fortnum & Mason)
Liz Kershaw (National Magazines)
Sue Peart (Mail on Sunday *You* magazine)
Justine Southall (*Cosmopolitan* magazine)
Daniela Rinaldi (Harvey Nichols)
Marigay McKee (Harrods)
Liz Garrett (Coty UK)
Angela Creasy (Liberty Plc)
Alison Seabourne (House of Fraser)
Jonathan Charles (*Esprit* magazine)

Simon Leadsford (*Brides* magazine)
Annie Holcroft (*Vanity Fair* magazine)
Jane Boardman (Talk PR)
Sally Cartwright (*Hello!* magazine)

Mr Causer's reason for filing them is to provide evidence of Mr Dove's presentations at consumer events and his reputation and fame in relation to perfumery. The first four witness statements comprise exhibit PC8, the fifth comprises exhibit PC12, and the remainder comprise exhibit PC21.

29. The witness statements are all different in content (in other words, the witnesses do not appear to have been presented with an identical pro forma witness statement to top and tail³). They vary in length but include details of the witness's occupation and how they have come to know of Mr Dove. They all give a professional opinion of Mr Dove, attesting to him possessing a high level of perfumery expertise. Some also give their own personal view of him and his expertise (e.g. he is unique, renowned, passionate and inspiring). All give an indication that they would not confuse DOVE with ROJA DOVE. For instance:

- Liz Kershaw

"In my view, 'Dove' is a product name known for promoting skin care but I do not believe 'Dove' is known for promoting fragrance. 'Roja Dove' is recognised as the name of a person, not the name of a product, who is a renowned expert on fragrances." "The 'Roja Dove' and 'Dove' brands are entirely different and so comparing the two would be like trying to compare apples and pears." "Dove products are for everyday use and accessible to everyone, whereas 'Roja Dove' products are only available through a small number of exclusive outlets to a few discerning, high income customers."

- Justine Southall

"Roja Dove products would never be retailed in the same space [as 'Dove' products]."

- Marigay McKee

"[Roja Dove] is entirely different to the name 'Dove' which is known for its white bottles and blue and white 'dove' logo and is associated through its advertising with chubby women in their underwear."

³ In *Re Christiansen's Trade Mark* [1886] 3 R.P.C. 54 it was said: "Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom."

- Liz Garrett

“[Dove’s] advertisements deliberately feature lumpy women rather than models, which reinforces the everyday image of ‘Dove’ products and their mass market appeal. ‘Roja Dove’ products are expensive, exclusive and inaccessible to the ordinary consumer.” “Visitors to Coty Prestige supplied retail outlets would not necessarily know the name ‘Roja Dove’; however, they may be familiar with his products if they are customers of Harrods or House of Fraser because they are generally more sophisticated in their buying habits.”

- Jane Boardman

“‘Dove’ is a mass market, cheaply designed and packaged brand (although perfect for its market). ‘Roja Dove’ is ‘haute couture’, beautiful, elitist and elegant. There is no way you could confuse them.” “I am amazed that the makers of ‘Dove’ think there is confusion; until I was asked to make this statement, I had never even thought about any connection, despite knowing both brands for many years.”

30. The witnesses are all involved in the beauty trade, through the industry itself, retail or journalism of beauty products. Janine Roxborough-Bunce is the Executive Director of The Fragrance Foundation, an industry body. Beryl Lake has 35 years experience in the fashion and perfumery industry. Liz Kershaw is the Executive Group Publishing Director of The National Magazine Company, which appears to be an umbrella company for magazines such as Harpers Bazaar and Good Housekeeping. Kathryn Catanzaro is the Beauty and Fragrance Buyer for Fortnum & Mason. Sue Peart is the editor of the Mail on Sunday’s *You* magazine. Justine Southall has been in the women’s magazine industry for 24 years, having worked for *Cosmopolitan*, *Eve*, and *Marie Claire*. Daniela Rinaldi is Head of Perfumery and Concessions for Harvey Nichols, who says she had not heard of Roja Dove before meeting him professionally. Marigay McKee is the Director of Fashion and Beauty at Harrods who has known of Roja Dove since she has been in the beauty industry. Liz Garrett is the Managing Director of Coty UK Limited, a perfume manufacturer, and was previously employed by L’Oreal. Angela Creasy is the Perfume Buyer for Liberty plc who says she had not heard the name Roja Dove before she joined the beauty industry. Angela Creasy is the consultant staffing manager of the beauty team for House of Fraser, having first come to know of Mr Dove when she was a store manager and he trained her staff. Jonathan Charles is the publisher/director of *Esprit* magazine which has a readership made up of trade subscribers, in-store beauty consultants, perfume manufacturers and perfume bottle makers. Simon Leadsford is the publisher of *Brides* magazine. Annie Holcroft is the publishing director of *Vanity Fair* magazine. Jane Boardman is the Chief Executive of Talk PR, who first came to hear about Mr Dove through her previous association with P & G Prestige Beauté, where he was a consultant fragrance expert. Sally Cartwright is the Director at Large for *Hello!* magazine. Several of the witnesses know Mr Dove personally (Ms Kershaw says he is a friend).

Plc's reply evidence

31. This takes the form of two elements. Plc has filed a witness statement from its in-house trade mark advisor, Stephen Francis Beale. Mr Beale has responsibility for branding issues relating to the Dove range of personal care products. Mr Beale criticises parts of RDPR's evidence. Mr Beale says Exhibit PC2, the typed list of undated quotations from the press, has no context. He states that similar deficiencies are to be found in exhibit PC4, PC6 PC11 being post material date or undated. The Haute Parfumerie in Harrods opened three months prior to the application and the fragrance line was launched after the material date, in July 2007. Mr Beale criticises the relevance of the candles and the lack of specificity in relation to the media appearances.

32. The second element of Plc's reply evidence is in the form of observations dated 9 October 2008 on, in particular, the witness statements of the individuals listed in paragraph 28 of this decision. The observations come from Mark Hickey of Murgitroyd & Company, trade mark attorneys acting for Plc in this matter. Mr Hickey criticises the statements for not being original and for possibly having been the product of leading questions. Mr Hickey says that the opinions of the witnesses are irrelevant as they cannot speak for the average consumer and they know Mr Dove personally. In addition, the witnesses' opinions about the positions of the parties in the market with respect to the cost of goods are without merit because the specifications do not and cannot reflect this difference. Mr Hickey observes that the witnesses' opinions as to the lack of confusion or association between the marks can carry no probative value in the context of the market in question which is for goods which are well known to the Tribunal.

33. Mr Hickey appears to invite me to attach little or no weight to the witnesses' evidence because, firstly, the witnesses are all engaged in the trade, know Mr Dove personally and/or professionally and cannot therefore be independent; and secondly because the Tribunal is able to reach its own view of the likelihood of confusion between the respective marks based upon its own knowledge of the area of trade.

34. Millet LJ said, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, that it is for the Tribunal to determine the likelihood of confusion:

“The function of an expert witness is to instruct the judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge may otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity... In the end the question of confusing similarity was one for the judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses.”

I must therefore make up my own mind whether the marks are likely to be confused. That is not to say that expert evidence is never of assistance; an expert's testimony

may be helpful to the Tribunal in matters about which it would not otherwise have knowledge. However, Mr Hickey states that the witnesses cannot assist in this case because the context of the market in question is for goods which are well-known to the Tribunal (he does not mention services, which are also the subject of this application). In this context, I believe Mr Hickey has in mind the words of Lady Justice Arden in *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA:

“62 First, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view. That is not to say that there may not be a role for an expert where the markets in question are ones with which judges are unfamiliar: see, for example, *Taittinger*. However, the evidence of Mr Blackett on confusion was of no weight in this case: he merely gave evidence as to his own opinion about a market which would be familiar to judges. If more cogent evidence of customer perception is needed, the traditional method of consumer surveys must (subject to my second point) carry more weight and is to be preferred. Mr Mellor went so far as to suggest that expert evidence is inadmissible on the question of consumer perception. I do not consider that it is necessary to go quite that far because there are exceptional situations, but I note that in *European Ltd* at 290-291 Millett L.J., with whom Hobhouse and Otton L.J.J. agreed, considered that the evidence of trade witnesses who gave their opinion of the likelihood of confusion was “almost entirely inadmissible”. He added: “It is not legitimate to call such as witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity.” The cogency of their evidence must in any event, save where expert knowledge of the particular market is required, be in real doubt. Its use may therefore lead to a sanction in costs. (Mr Mellor also made objections to the evidence of Mr Tildesley, but in the circumstances it is unnecessary for me to deal with these separate objections.) If the objection can be dealt with as one going to weight, this is often the course which the court takes: *M and R (Minors)* (*Child Abuse: Expert Evidence*), *Re* [1996] 4 All E.R. 239.”

35. Mr Hickey is concerned that the witnesses cannot speak for the average consumer as they are engaged in the trade. In this respect, *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 890 is helpful:

“33. The five trade witnesses include such people as a buyer of toasters for Harrods and a director of the relevant trade association, the Association of Catering Equipment Manufacturers and Importers. These five witnesses were asked, in January to April 1996, whether they associated the two designs, represented in two dimensions as in the application for registration, with any and if so what maker. They all said that they associated the design with the applicant. These, however, are people whose business it is to know the applicant's products and the products of other manufacturers in the market. The fact that they knew their job and could recognise the shapes as being those of the applicant's products does not seem to me to begin to show that “the relevant class of persons, or at least a significant proportion thereof, identify [the] goods as originating from a particular undertaking because of the

trade mark". The relevant class of persons is not trade buyers such as these witnesses but customers."

The occupations of the witnesses and the contents of their statements clearly show that these individuals would be expected to be alive to the brands which occupy the perfumery/personal care retail market and therefore better able to differentiate between them through familiarity. However, the matter is not as entirely straightforward as Mr Hickey suggests it is because the application has been made not simply for goods which may be said to be bought by the general public, but has also been made for research services into the development of perfume products. I will say more about this below in the context of the relevant consumer and the nature of the purchasing process.

Decision

36. The relevant part of section 5(2)(b) of the Act is as follows:

"(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 marks 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."

Section 6(1)(a) of the Act defines an earlier mark as:

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

Plc's trade mark upon which it relies is an earlier mark as per section 6(1)(a).

37. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

The average, relevant consumer and the nature of the purchasing process

38. Plc's mark is not subject to proof of use and so I must consider the relevant public across the entire range of the goods and services of the application. RDPR's evidence makes much of the contention that its consumer is anything but average. Instead, RDPR seeks to convey that only the perfume cognoscenti who have the purchasing power required to buy what is, by any standards, expensive perfume from a few selected outlets are its relevant public. It seeks to draw a stark contrast between these consumers of prestige perfumery and the buyers of Plc's goods aimed at the 'mass-tige' market (Liz Kershaw's witness statement). To draw an analogy with clothing, perhaps it could be put like this: ROJA DOVE is *haute couture* while DOVE is off the peg.

39. This distinction is not, and cannot be, reflected in the specifications. In *McQUEEN CLOTHING CO Trade Mark Application* [2005] R.P.C. 2, Geoffrey Hobbs Q.C., sitting as the appointed person, was faced with two parties: the opponent who was at the *haute couture* end of the clothing market, and the applicant who was not. In that case, the applicant tried to separate his specification from the opponent's by offering to exclude *haute couture* clothing from his specification. That was found to be contrary to law as stated by the ECJ in *Koninklijke KPN Nederland NV v. Benelux Merkenbureau (POSTKANTOOR)* Case C-363/99. At paragraph 31, Mr Hobbs said:

"When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account."

40. There is no method by which the specifications can reflect the relative expense and market of the goods. I also bear in mind what was said by the Court of First Instance (CFI), in *Saint-Gobain SA v Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHIM)* in Case T- 364/05:

"67. With regard to the conditions under which the goods at issue are marketed, the applicant's argument that the goods covered by the earlier mark are sold almost exclusively in shops and supermarkets, whereas the mark applied for refers solely to goods sold by mail order, is without foundation. As has already been held, on a comparison of the goods, nothing prevents the goods covered by the earlier mark from also being sold by mail order. In addition, it is apparent from the file that the intervener makes almost 5% of its sales by mail order. Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed."

41. Plc could choose to enter the *haute parfumerie* market; RDPR could decide to diversify and enter a more 'average' market. The point is that a trade mark

specification is designed to specify goods or services, not how they are sold or for how much⁴. A trade mark registration can be sold and a new or subsequent proprietor may decide to use it in an altogether different market. In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 147/03*, the CFI said:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.”

Plc may take the view that although RDPR currently occupies a particular section of the perfumery market, it may not always be the case, nor may RDPR always be the owners of its trade mark. Mr Causer states in his evidence that:

“Unilever Plc has been involved in the perfume business; it owned well known brands such as Calvin Klein, Cerruti and Vera Wang. However, I believe that Unilever Plc pulled out of the perfume business in 2005 and these brands were sold off to a US company, Coty, Inc.”

Page three of the supporting exhibit PC23 refers to Unilever having signed an agreement to sell its ‘prestige perfume business, Unilever Cosmetics International. It seems to me that Plc therefore had an interest in perfumery as well as the goods on which it has filed evidence of use of DOVE. I note that RDPR’s evidence shows it has provided training courses (exhibit PC18) to Proctor & Gamble, an organisation which shares similarities in product lines with Plc. The corollary is that it is possible for one company or group of companies to manage, buy and sell marks within a portfolio of brands which may include those registered for perfumery and personal care goods. Notionally, it would be open to RDPR to do the same.

42. Despite RDPR’s efforts to prove that there is a distinct difference between the average consumers for the parties’ marks, I find that I must make a prospective analysis of the nature of the average consumer across the notional, objective breadth of the specifications, rather than based upon the subjective views of RDPR. In relation to the class 3 goods, these are goods used by the general public, of all ages. RDPR’s evidence has demonstrated that it is as possible within this class to buy very expensive items as it is to buy them cheaply. The ‘Dove’ consumer may purchase one of the ROJA DOVE £350 100ml atomisers for a special present or

⁴ *Bang & Olufsen A/S v OHIM Case T-460/05*, in the context of distinctiveness : “According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM (Brown cigar shape and gold ingot shape)* [2003] ECR II-1897, paragraph 36).”

treat, while the ROJA DOVE consumer may also use DOVE products. The level of attention of the purchaser will vary according to the amount the item costs. It will also vary according to the priorities of the purchaser. For example, someone who just wants shampoo to clean their hair is not likely to give a great deal of thought to the purchase. However, a consumer with highlighted hair may be more interested in the alleged colour retention properties which that shampoo claims. Most people will try perfume before they buy it and may retain a loyalty to a particular scent for years. The level of attention will be greater in this respect. Aesthetics of packaging play a not insignificant part of the purchasing decision in relation to personal care and perfumery goods. It seems to me that there is room for a great variety in the level of attention paid during the purchasing act and also a variety of person within the term average consumer for these goods. The average consumer for the class 3 goods, the general public, is deemed to be reasonably observant and circumspect, but this must be relative to the goods purchased. The attention level of the relevant consumer across the notional breadth of the class 3 specification is at either end of the spectrum and at various points in between. There is room for argument possibly in relation to 'aromatic substances for use in the manufacture of perfumes'; I will deal with the meaning of this term in the comparison of goods below.

43. Plc's submissions are silent on the position with regard to the services, concentrating instead upon the average consumer for the goods. At the hearing, Mr Malynicz said that anybody has knowledge of the class 3 goods and that I could rely upon my own experience; whereas the general public are not the clients of research services into the development of perfume products. Neither side has filed any evidence to guide me (the witness statement of Janine Roxborough-Bunce from The Fragrance Foundation indicates that the Foundation is concerned with the promotion of fragrance, rather than the manufacture of it). As I see it, the relevant consumer group of these services is the manufacturers of perfume products. The level of attention of this group of consumers for these services is likely to be reasonably high since business decisions/ investment will be based upon the result of the research.

Comparison of goods and services

44. Although Plc's registration covers goods and services in classes 3, 8, 21, 24, 25, 35 and 42, according to its notice of opposition Plc relies only upon classes 3 and 44 of its registration, stating that all the goods and services in the application are identical or similar to those in classes 3 and 44 of its registration. At the hearing, Mr Malynicz said early on that there was "identity in large parts of the specification and serious amounts of similarity in other parts". Later on, he said that he accepted that there is identity or almost identity between the specifications as they stand. Almost identity implies, and may exceed, a level of high similarity. Mr Malynicz did not specify between which goods and services there is almost identity. For a complete assessment, the comparison of goods and services is between:

Plc	RDPR
<p>Class 3:</p> <p>Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave,</p>	<p>Class 3:</p> <p>Perfumes and perfumery products; aromatic substances for use in the manufacture of perfumes; perfumed</p>

<p>cologne; essential oils; aromatherapy products; massage preparations; deodorants and antiperspirants; preparations for the care of the scalp and hair, shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash; 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>products; perfumed bath foam preparations; perfumed bath salts; perfumed milks; perfumed lotions; perfumed sprays; perfumed creams; perfumed soaps.</p>
<p>Class 44:</p> <p>Beauty salon services; hairdressing services; manicure and pedicure services; aromatherapy; sun tanning services; sauna, solarium and massage services; information and advisory services relating to health, diet, exercise, lifestyle, healthcare, beauty care, skin care, perfumery, deodorants, nutrition and hygiene; research services relating to health, diet, exercise, lifestyle, healthcare, beauty care, skin care, perfumery, deodorants, nutrition, hygiene.</p>	<p>Class 42:</p> <p>Research services into the development of perfume products.</p>

45. I have listed the most obvious comparisons which demonstrate identity below:

Plc	RDPR
soaps	perfumed soaps
perfumery	perfumes and perfumery products; perfumed sprays
perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products;	perfumed products
bath and shower preparations	perfumed bath foam preparations; perfumed bath salts; perfumed milks
creams and lotions for the skin	perfumed lotions; perfumed creams

This leaves RDPR's 'aromatic substances for use in the manufacture of perfumes.' Plc submits that to the extent that there may be any argument in the case of this term that the description must be included within Plc's 'aromatherapy products' which could also be in the nature of aromatherapy products for manufacture [of perfumes].

46. The following definitions are to be found in Collins English dictionary⁵. 'Aromatic' is defined as:

“adjective 1. having a distinctive, usually fragrant smell. 2. (of an organic compound) having an unsaturated ring containing alternating double and single bonds, especially containing a benzene ring; exhibiting aromaticity. Compare aliphatic. 3. *noun* something, such as a plant or drug, giving off a fragrant smell.”

The term 'aromatherapy' is defined:

“The use of fragrant essential oils extracted from plants as a treatment in alternative medicine to relieve tension and cure certain minor ailments.”

Essential oils are defined as:

“Any of various volatile organic oils present in plants, usually containing terpenes and esters and having the odour or flavour of the plant from which they are extracted: used in flavouring and perfumery.”

Perfumery is:

“1. A place where perfumes are sold. 2. a factory where perfumes are made. 3. the process of making perfumes. 4. perfumes in general.”

Perfume is:

“noun 1. a mixture of alcohol and fragrant essential oils extracted from flowers, spices, etc., or made synthetically, used especially to impart a

⁵ Collins English Dictionary, © HarperCollins Publishers 2000

pleasant long-lasting scent to the body, stationery, etc. See also cologne, toilet water. 2. a scent or odour, especially a fragrant one. 3. *verb* (transitive) to impart a perfume to.”

It seems to me that aromatic substances for use in the manufacture of perfumes (RDPR) could include essential oils, which are used in perfumery and in aromatherapy. Plc has cover for perfumery, essential oils and for aromatherapy. I believe that the average relevant consumer for both the goods and services would understand these to mean either simply aromatic substances and essential oils such as lavender oil, rose oil and such like which one can add to a base massage, perfume oil or bath water, for example, or would attribute a more technical meaning, depending on the relevant consumer group. This comparison leads me to find that, if not identical, aromatic substances for use in the manufacture of perfume are highly similar (or almost identical) to perfumery, essential oils and aromatherapy products.

47. In relation to the services, Plc submits that research services into the development of perfume products are identical to its own ‘research services relating to perfumery’ and similar at least to ‘perfumery’ within its class 3 goods. As stated above, RDPR accepts near identity if not absolute identity between the specifications, but does not specify which comparisons do not yield a finding of absolute identity. In order to dot all the i’s and cross all the t’s, I will go on to make a comparison between the specifications, but will first address the anomaly between the class numbers of the parties’ specifications in classes 42 and 44 in respect of the following services:

Plc	RDPR
<p>Class 44</p> <p>Research services relating to...perfumery</p>	<p>Class 42</p> <p>Research services into the development of perfume products</p>

It is an anomaly in the sense that these services appear to be identical in nature and purpose, yet are classified in different classes. Plc’s registration was applied for on 25 August 2004; RDPR’s on 18 February 2005. At both dates the edition of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, which was in force was the eighth edition.⁶ Previous to the eighth edition, goods and services were grouped into forty-two classes, and research services of all types fell under class 42, the heading of which included the catch-all phrase “services which cannot be placed in other classes”.⁷ Subsequently, the eighth edition removed this phrase and split class 42 in four, resulting in the current forty-five class system. According to the eighth edition, research services could fall into more than one class. The class 42 heading is given as:

⁶ It came into force on 1 January 2002; the 9th edition came into force on 1 January 2007.

⁷ The 7th edition, which was published in 1996.

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

The explanatory note says:

“Class 42 includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer specialists, lawyers etc.”

The class 44 heading is:

Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

The explanatory note says:

“Class 44 includes mainly medical care, hygienic and beauty care given by persons or establishments to human beings and animals; it also includes services relating to the fields of agriculture, horticulture and forestry.”

There is no specific indication from the above as to which class research into perfumery might fall.

48. The class 44 heading does not include a reference to research services, while the class 42 heading does. Research into perfumery/perfumes does not appear in the alphabetical listing in the International Classification⁸. The guidance notes, or general remarks, state that if a service cannot be classified using the alphabetical list or the explanatory notes, a series of criteria should be applied to determine which class is correct:

“(a) Services are in principle classified according to the branches of activities specified in the headings of the service classes and in their Explanatory Notes or, if not specified, by analogy with other comparable services indicated in the Alphabetical List.

(b) Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Class 38.

(c) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl.35), financial consultancy (Cl.36), beauty consultancy (Cl.44). The rendering of the advice,

⁸ The only research services specifically mentioned are ‘Research and development [for others]’; ‘Research (Biological-)’; ‘Research (Geological-)’, all in class 42 and ‘Research (Business-)’, falling in class 35. There are no entries in the service classes for any services relating to perfume/perfumery.

information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.”

This may account for RDPR having placed its research services into class 42, the heading of which specifically states ‘research’ (and the explanatory note mentions ‘chemists’). Conversely, Plc clearly preferred to classify its research services as falling into class 44, presumably as this class includes beauty care. The documents on the Trade Mark Registry’s *ex officio* examination file give no indication that the classification of these services was an issue before the examiner (nor on the examination file for the earlier registration).⁹

49. The significance of classification and the relevance of class numbers have been considered by the courts in *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2002] R.P.C. 639, by the Court of Appeal, and in *Avnet Incorporated v. Isoact Limited* [1998] F.S.R. 16, by the High Court. In the latter case, enquiries were made of the Registry in order to ascertain the Registry’s view of the classification of the services at the relevant date; I have noted above that the issue does not appear to have been raised during examination and neither party have raised it in these opposition proceedings. In *Proctor & Gamble Company v. Simon Grogan*, O-176-08, Anna Carboni, sitting as the appointed person, referred to *Altecnic* and said:

“32. The International Classification system also applies to Community trade marks. Rule 2(4) of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd’s Trade Mark Application (CAREMIX)* [2001] EWCA Civ 1928, [2002] RPC 639. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.

⁹ Section 34 of the Act states “(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification. (2) Any questions arising as to the class within which any goods or services fall shall be determined by the registrar, whose decision shall be final.”

35. In *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 280 (“*TREAT*”), Jacob J said (at 289):

When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.

36. He went on (at 295) to set out the following factors as being relevant to the question of similarity (insofar as relevant to goods), without reference to the classes in which they fell:

- (a) The respective uses of the respective goods;
- (b) The respective users of the respective goods;
- (c) The physical nature of the goods;
- (d) The respective trade channels through which the goods 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;
- (f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies put the goods in the same or different sectors.

37. Subsequently, in *Canon Kabushiki Kaisha v MGM Inc.* (referred to above), the ECJ stated the following:

23. In assessing the similarity of the goods or services concerned, ..., all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

38. None of these authorities supports the Applicant’s contention that goods in different classes should be considered to be dissimilar. Nor do they support the contention, which it seems to me underlies the Applicant’s central submission, that lack of similarity in the physical nature of goods overrides all other factors.”

50. It seems to me that the different class numbers in this case do not affect a finding of, at the very least, high similarity between the services or ‘almost’ identity. **The goods and services of the application are identical or almost identical with those of the earlier trade mark registration.**

Comparison of the trade marks

51. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods and services, the category of goods and services in question and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind.

52. The trade marks to be compared are:

Plc's trade mark:

DOVE

RDPR's trade mark:

ROJA DOVE

53. The issue of similarity revolves around the presence of the four letter word DOVE, the second component of RDPR's trade mark, which reproduces the trade mark of Plc in its entirety. For the goods and services, DOVE is distinctive; it is the common classification of a type of bird. Plc submits that ROJA will be seen as an invented word; Mr Malynicz submitted at the hearing that ROJA will either be perceived as a forename or a fancy word. I will develop this point further below, but for the purpose of deciding upon the dominant distinctive elements, the net result of both side's submissions is that ROJA is a fancy (invented) word and is therefore distinctive. Taking into account the whole of RDPR's trade mark, I do not consider that it can be argued that DOVE is the dominant component; DOVE is positioned as the second element, both components are distinctive and both words are equal in length. The presence of the word DOVE in RDPR's trade mark gives rise to an easily observed degree of visual and phonetic similarity. In their written and oral submissions, the parties have concentrated upon arguments based on the conceptual effect of the marks on the average consumer.

54. Plc submits that it is only in the course of these proceedings that it has become apparent that ROJA DOVE consists of the name of an individual and that the average consumer is unlikely to perceive the mark so. Instead, the average consumer will perceive a brand which consists of an invented word (ROJA) followed by a fully distinctive dictionary word (DOVE).

55. Mr Malynicz directed me to two decisions of Geoffrey Hobbs Q.C., sitting as the appointed person: *MCQUEEN CLOTHING CO* (supra) and *CARDINAL PLACE* (BL O/339/04). In his submissions, he said that it is important to take proper account of the 'qualifying effect' of ROJA. Further, I must consider the blend of meaning and significance of the later mark compared to the earlier. Mr Malynicz first addressed the concept of DOVE on its own, which he said means a white bird or a symbol of peace, reinforced by Plc's use of the word with the bird device. He submitted that the meaning and significance of ROJA DOVE could point to either of two things. It

could either be a forename/surname combination which clearly leads away from the bird concept or, if people do not see it as a forename, the mark is a fancy word followed by the word DOVE. He submitted that the latter interpretation disturbs the white bird meaning. Either way, ROJA DOVE points away from the white bird blend of meaning and significance.

56. Mr Malynicz also reminded me that it is often repeated that the beginnings of marks are more important than the ends; a different element at the beginning will therefore assist in distancing the marks. Although the CFI referred to consumers generally paying more attention to the beginnings of marks in Case 402/07 *Kaul GmbH v OHIM* at paragraph 85, the court has also stated in Case T-22/04 *Reemark Gesellschaft für Markenkooperation mbH v OHIM*, (at paragraph 37):

“It must also be borne in mind that the Court of First Instance has already held that, on an initial analysis, where one of the two words which alone constitute a word mark is identical, both visually and aurally, to the single word which constitutes an earlier word mark, and where those words, taken together or in isolation, have no conceptual meaning for the public concerned, the marks at issue, each considered as a whole, are normally to be regarded as similar (Case T-286/02 *Oriental Kitchen v OHIM – Mou Dybfrost (KIAP MOU)* [2003] ECR II-0000, paragraph 39).”

I mention this only to say that the beginning of marks is but one factor in the global comparison. I also note that the latter judgment concerns marks where there is no conceptual meaning for the relevant public. There is little room for argument that DOVE solus evokes the concept of a white bird/symbol of peace. It is more difficult to say what the conceptual significance is of ROJA DOVE. It was only through an examination of RDPR's evidence that I became aware that this was an eponymous trade mark application (Mr Dove and RDPR being indissociable). Certainly, I have never seen the word ROJA used as a personal name and while I can guess it might be pronounced as ROGER, it could equally be 'ROE-GER'. My first impression was that it was something to do with the Spanish word for 'red'. I note that Mr Malynicz allowed for the distinct possibility that the average consumer in the UK would not see ROJA DOVE as a personal name. RDPR's evidence does not assist, being in the main from people who know of Mr Dove and therefore do see it as a name. This does not tell me what the average consumer would make of the mark. As far as I can tell, ROJA is not a name which is native to the UK. I also have no assistance as to whether DOVE is a surname or, if it is, how widespread it is in the UK. It is not a word which I have met in a surnominal context. My analysis of ROJA DOVE leads me to the view that even if DOVE is a surname, the presence of ROJA does not reinforce it as a surname. It seems wholly probable to me that the average UK consumer will not understand the significance of ROJA and will instead fasten upon the element of the mark which it does recognise the primary significance of: DOVE, a white bird/symbol of peace. In contrast to CARDINAL and CARDINAL PLACE, each of which creates different blends of meaning and significance, I conclude that ROJA DOVE does not have a blend of meaning and significance which can so easily be differentiated from that of DOVE. While not conceptually identical, there is conceptual similarity in that the average consumer makes sense of words with meanings which s/he recognises, without pausing to analyse whether an unrecognised element disturbs that meaning. If the mark was ROGER DOVE, Mr

Malynicz's point would have more force. However, I consider that for the average English-speaking consumer, the primary conceptual significance of ROJA DOVE is that it evokes an association with a white bird/symbol of peace. I find that there is a high degree of similarity between the marks.

Use and distinctive character of DOVE

57. According to *Sabel BV v Puma AG*, it must be remembered that there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it. The very highest distinctive character is reserved for wholly invented marks which do not describe or allude to the goods or services to which they are attached. DOVE cannot fall into this category because it is an English word, commonly understood as a (white) bird/symbol of peace. That said, it does not describe the goods or services in any way and therefore enjoys a high degree of inherent distinctive character. Plc submits that DOVE enjoys an enhanced degree of distinctive character by virtue of its use.

58. The effect of reputation upon a mark's distinctive character was considered by David Kitchen Q.C., sitting as the appointed person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion."

Plc has not provided any evidence in relation to the services it relies upon. Its evidence is filed in support of the goods in class 3. Its turnover figures rise from £36.3 million in 2000 to £83.9 million in 2004. Plc has also provided a breakdown of market share for the class 3 goods:

Product	Market share %
Hair	3.6
Skin (cleansing)	10.0
Deo	6.1
Body care	10.7

These goods do not represent specialised or 'niche' products; they are everyday items, available through high street retailers and supermarkets. There are also many brands in the market. It seems to me that a 10% share (or even a 3.6% share)

in the UK market for these goods is an extremely large proportion which places DOVE in the 'household name' category of marks. DOVE already has a high degree of distinctive character *per se*, but if it is possible to enhance this any further (because it is not invented and thus not at the pinnacle of distinctiveness), then I conclude that the use shown must elevate what is already an inherently high distinctive character, notwithstanding the bird device which consistently appears with the word element¹⁰.

Likelihood of confusion

59. In considering the likelihood of confusion, I have to bear in mind the nature of the goods and services, the purchasing process and the relevant consumer. I have to weigh the proximity of the goods and services against the relative distance between the marks - the interdependency principle – whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I must consider the relative importance that the similarities between the marks have in relation to the goods and services during the purchasing process. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer's perception of the mark.

60. In paragraph 43, I found that the average relevant consumer for the class 3 goods was not the same as for the services. I will therefore give my conclusions on the likelihood of confusion between the marks for the goods separately from that for the services.

61. Class 3 of the application

At the hearing, Mr Malynicz made what he referred to as a novel point. He said that Plc's reputation under the DOVE mark is for the core goods they actually sell; if RDPR were selling goods which were very similar, they would be able to rely upon this reputation, but could not rely upon it to stretch across to other goods/services (as per section 5(3) of the Act). Mr Malynicz said:

“[Plc] have never sold or shown the slightest inclination of selling perfume. They have been trading for 50 years...[if] they were going to be doing it, they would have done it by now. They have not done it.”

In characterising this as a novel point, Mr Malynicz said that he did not think that there was any law on it; I do not know of any either. I agree that it is a novel concept to preclude a likelihood of confusion when a mark is less than five years old because it has a large reputation through use on certain goods within its specification and not on others. This seems to penalise a proprietor for having a reputation and place him

¹⁰ The distinctive character of a mark may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark, as per *Société des produits Nestlé SA v Mars UK Ltd* Case C-353/03 [2005] ETMR 96; see also *L & D SA v OHIM* Case C-488/06 P, in which the ECJ held that there was no reason to justify any difference of approach in relation to relative grounds.

in a worse position than if he hadn't traded under a sign at all. Furthermore, as I have said in my comparison of goods, perfume is similar to the goods which have been sold under the DOVE mark. In actual fact, RDPR's own evidence belies the submission that Plc has never been engaged in selling perfume; Mr Causer states in his evidence that:

“Unilever Plc has been involved in the perfume business; it owned well known brands such as Calvin Klein, Cerruti and Vera Wang. However, I believe that Unilever Plc pulled out of the perfume business in 2005 and these brands were sold off to a US company, Coty, Inc.”

I do not think that this point can add anything to the global comparison which I have to make. Mr Malynicz also submitted that the public have been educated to see DOVE on its own because it has never been used with any other word and therefore putting ROJA in front would lead away from confusion. Again, this would appear to penalise a proprietor for having used his mark.

62. Mr Malynicz drew my attention to parts of the evidence and submitted that there was no evidence of any confusion between the marks. He particularly noted an absence of Plc having provided any examples of confusion, e.g. “Does this have anything to do with you? Is Dove going upmarket?”

63. Confusion works both ways; it does not matter whose mark is confused with whose¹¹, so it could be the case that someone might think RDPR's goods had entered the 'mass-tige' market. The witnesses have stated that this is never the case because, amongst other reasons, the parties' goods are never sold side by side and are differentiated by price:

- Alison Seabourne: “It would therefore be extremely unlikely for the two to be mixed up or for any confusion to arise because the respective markets and clientele are so different.”
- Liz Garrett: “In marketing terms, ‘Roja Dove’ products target a very small group of what I would refer to as ‘A’ and ‘B’ consumers, whereas ‘Dove’ products target everyone from ‘C1’ ‘C2’, ‘D’ through to ‘E’ consumers.”
- Justine Southall: “Roja Dove products would never be retailed in the same space [as ‘Dove’ products].”

This undermines an argument of ‘honest concurrent use’ as the use has not been concurrent. RDPR's evidence mostly post-dates the relevant date in relation to sales of goods (perfume) and there seem to have been little or no perfume sales prior to the relevant date which could assist a claim to concurrent use but no confusion. I appreciate that absence of confusion after this date could be relevant in establishing concurrent trade and no confusion as a result. It appears to be the case that, as Plc put it in their submissions:

¹¹ *Omega v OHIM*, CFI Case T-90/05, paragraph 14.

“...ROJA DOVE is an individual who, at the material date, appears to have enjoyed a level of reputation in a very exclusive and niche market concerned with the history, content and creation of bespoke perfumery.”

Being a *professeur de parfums* is not the same as showing a trading presence either for sale of perfume, manufacture of perfume or research into perfume. Mr Dove lectures and gives press interviews with a modest (unparticularised) level of turnover which appears lately (after the material date) to include some perfume and consultancy sales which are expensive and restricted in availability. As Millet LJ said in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at page 291:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered mark.”

In *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at paragraph 26, Laddie J said:

“The reason why the rule of thumb referred to above does not give a safe indication of whether there is infringement in this case is because of the nature of the parties’ respective presences in the market. They are not in competition with each other. The business consultancy field is enormous. Indeed, on the basis of the evidence before me, the logistics section of the business consultancy field is enormous. The claimant’s core activities are not in the logistics field, the defendant’s are. Furthermore, even within that field, the defendant is a very small player, as will be explained below. In those circumstances it is not surprising that there has been no confusion in the market-place. To date the claimant and the defendant are in different parts of the market. This does not come close to imitating the notional world used for determining likelihood of confusion under Art.9.1(b).”

This is a principle that was confirmed by Warren J in *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch):

“99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says. *O2 v H3G* was a case considering infringement, not invalidity, and although there is of course some commonality between matters relevant to each, it is correct, in the context of infringement, to look only at the particular circumstances of the alleged infringement. In contrast, in cases of validity, it is necessary to look across the whole range of goods covered by the registration. The Court of Appeal was unimpressed by the suggestion that the abstract test applicable to

validity applies in the case of infringement, but it did not give even a hint that the validity test as understood was incorrect: see paragraph 34 of the judgment of Jacob LJ.”

Given the absence of side by side sales and, in market terms, the fact that RDPR is a very small player in the personal care and perfumery trade, it would be surprising to find instances of confusion. I find that the absence of evidence of confusion tells me nothing about the likelihood of confusion, which is the assessment I am required to make under section 5(2) of the Act¹². I have to decide what the position would be assuming notional use across the specifications.

64. Plc relies upon *Medion*. Plc submits that DOVE has greater distinctive character than ROJA as consumers will recognise DOVE and recall the meaning attributable thereto. I think Plc has conflated distinctive character with an ‘independently distinctive rôle’; ROJA, as an invented word in the eyes of the average consumer, cannot be less distinctive than DOVE. However, I agree that DOVE plays an independently distinctive role in the applicant’s mark. Moreover, it is the element of RDPR’s mark which gives the average consumer a recognisable, comprehensible means by which to remember it, whereas ROJA is an unknown quantity. I bear in mind, as per *Shaker*, that it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element. ROJA is not negligible.

65. The goods are identical or nearly so. The matter must be judged through the eyes of the average, relevant consumer for the goods/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 (*Lloyd*). ROJA DOVE does not have a blend of meaning and significance for the UK English-speaking average consumer for the goods in issue. DOVE is a highly distinctive mark for these goods and is a household name. Even if it was not so famous, it would still provide the average consumer with a known conceptual point of reference, a point of reference which is shared by ROJA DOVE but which is not altered by the presence of ROJA. I think it unlikely that the marks would be directly confused with one another. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the relevant consumer, who is reasonably well informed and reasonably circumspect and observant, wrongly to believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion (*Canon*). I find that there is a likelihood of confusion in relation to class 3 on the basis that the average consumer will believe that the goods come from the same or economically linked undertakings.

¹² See also the ECJ Opinion of the Advocate General in Case C-498/07 P *Aceites del Sur-Coosur v Koipe and OHIM*

66. Class 42 of the application

I have found that the services are near identical if not identical. As stated above, I must judge the matter through the eyes of the average relevant consumer. I have also said that I consider this consumer to pay a high degree of attention to the selection of perfumer development/research services. However, I have been left to draw that conclusion for myself. None of Plc's evidence goes to the services and RDPR's submissions at the hearing on the services were limited. While the tribunal can make up its own mind on the class 3 goods because it has experience of those goods, it would have been helpful to have had evidence or at least submissions in relation to the services.

67. Making the best of it, and despite the above average level of attention of a consumer who is likely to be more well informed, circumspect and observant, I have come to the same conclusion as for the class 3 goods. In order to make this assessment I have started from a position of neutrality in relation to any reputation on the part of Plc; it has not substantiated a reputation for perfumery research and development. Bearing in mind that confusion can work both ways, I find that there is a likelihood of confusion in relation to class 42 on the basis that the average consumer will believe that the services come from the same or economically linked undertakings.

67. The opposition succeeds under section 5(2)(b) for all the goods and services of the application.

Other grounds of opposition

68. My finding under section 5(2)(b) decides the outcome of the opposition; there is no need, therefore, to go on to consider the grounds under sections 5(3) and 5(4)(a).

Costs

69. In its written submissions, Plc has asked for an award at the upper end of the scale, or beyond. Plc bases this request on the large volume of evidence which is post material date and the lack of impartiality of the witnesses which placed an unmerited burden upon Plc. RDPR also asks for costs off the scale, should it be successful, as it submits the opposition was speculative, there was no attendance by Plc at the hearing, and it was put to a large burden to defend, evidence-wise and in instructing counsel. I have to say that the latter was a choice for RDPR.

70. In the event, Plc has been successful and is entitled to a contribution to its costs. I note that box 6 of RDPR's Form TM8 and counterstatement calls for Plc to provide proof of use for soap, body wash, antiperspirants, deodorants, shampoos, conditioners, moisturising creams, creams and lotions for face and body, bath creams, washes, and scenting preparations, body firming and lifting preparations. Firstly, Plc's registration is not subject to the proof of use regulations, so there was no requirement for it provide proof that it had used DOVE on these goods in order to sustain its section 5(2) objection. Secondly, the majority of the witness statements acknowledge DOVE as being a well-known UK brand for these goods. Thirdly, Mr Malynicz's skeleton argument states that RDPR accepts that DOVE has a

particularly distinctive character for certain specific things, particularly for soap, as a result of the use made of it. He confirmed this at the hearing by saying this was something RDPR had never disputed. Plainly, at the time the Form TM8 and counterstatement was filed, it was disputed by RDPR.

71. However, Plc's notice of opposition stated that it relies upon a reputation in soaps; deodorants and antiperspirants; shampoos and conditioners; bath and shower preparations and skin care preparations to mount its ground of objection under 5(3) of the Act; in relation to section 5(4)(a), Plc relies upon soap, body wash, antiperspirants, deodorants, shampoos, conditioners, moisturising creams, creams and lotions for the face and body, bath creams, washes, and scenting preparations, body firming and lifting preparations. These grounds require evidence of a reputation or goodwill. The evidence Plc filed went as far in terms of breadth of specification as required for these grounds; in other words, RDPR's requirement for proof of use did not place a further evidential burden upon Plc. If RDPR had been upfront in accepting Plc's reputation at the beginning, it might have lessened Plc's need to file the evidence it did, although it may still have wished to do so to bolster its claim to the various heads of damage referred to under section 5(3). However, that is speculation and not something which I factor into the award. I consider that the following costs, on scale, should be awarded to Plc:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£100
Preparing and filing evidence	£300
Evidence and submissions in reply	£200
Submissions in lieu of hearing	£100
Total	£1200

I order RDPR Limited to pay Unilever Plc the sum of £1200. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of May 2009

**Judi Pike
For the Registrar,
the Comptroller-General**