

O-319-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2458259  
BY THE DUBARRY PERFUMERY COMPANY LIMITED TO REGISTER THE  
TRADE MARK  
DUBARRY  
IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 96802 BY  
U.S. INTERNATIONAL TRADING CORP.**

## BACKGROUND

1) On 13 June 2007 The Dubarry Perfumery Company Limited applied to register the trade mark DUBARRY. After examination, the trade mark was accepted and subsequently published for opposition purposes on 4 January 2008 in Trade Marks Journal No.6717 for the following goods:

Class 3: Soaps; perfumery; essential oils; non-medicated toilet preparations; anti-perspirants; deodorants for personal use; cosmetics, hair lotions; dentifrices.

2) On 4 April 2008 U.S. International Trading Corp. (the opponent) filed a notice of opposition. In summary the opposition is based upon the following:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Filing date / registration date	Class	Specification
DUBARRY	CTM 182923	01.04.96 / 16.06.98	1	Chemical products used in industry, science, photography, agriculture, horticulture, forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
			3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, non-medicated toilet preparations; anti-perspirants; deodorants for personal use; depilatory preparations; cosmetics, hair lotions; dentifrices.
			5	Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin.

b) The opponent states that the goods in Classes 1, 3 & 5 are identical and/or similar to the applicant's goods in Class 3 and that the marks are identical. The opponent states that its mark has been used since 1920. They contend that in 2007 Mr Miller, on behalf of the applicant, discussed a commercial arrangement regarding the Dubarry brand. The opponent contends that at all stages it was made clear to the applicant that the intellectual property rights in the mark were owned by the opponent. Despite this the applicant sought to

register the mark. The mark in suit is said to offend Sections 5(1), 5(2)(a) and 5(4) of the Trade Marks Act 1994. Also the mark is said to have been applied for in bad faith, contrary to section 3(6) of the Act.

3) On 16 June 2008 the applicant filed a counterstatement. Mr Miller states that the original Dubarry Perfumery Company was formed in 1924 and traded in perfumes from its base in Brighton & Hove. At the same time a company in America was also using the name Dubarry on a range of perfumes. Mr Miller states that the opponent purchased the various rights accumulated by the American company and its successors. He states that no perfume or cosmetics under the Dubarry name have been sold in the UK since 1982. Mr Miller accepts that he did have discussions with the opponent company. However, he contends that these discussions were in regard of designs of bottles, graphics and formulae of perfumes. He was given to understand that the opponent company had the intellectual property rights relating to these matters which once belonged to the original British company. Mr Miller states that it was his intention to revive the original British products and he was willing to pay licence fees to the opponent for formulae, packaging etc. He contends that during the discussions it transpired that the opponent company did not have such information or rights despite their claims. He also put the opponent to proof of use on the following goods “Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use; air perfuming preparations.” I note that the term “air perfuming preparations” does not appear within the opponent’s specification.

4) Both sides filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. The matter came to be heard on 8 October 2009 when the applicant company was represented by Mr Miller (its founder and sole share holder) and the opponent was represented by Mr Smith of Messrs HGF Law.

### **OPPONENT’S EVIDENCE**

5) The opponent filed two witness statements. The first, dated 3 December 2008, is by Geoffrey Edward Smith the opponent’s Trade Mark Attorney. He states that the opponent has a long association with the brand DUBARRY and sells products under this brand around the world. He provides a brief history of the opponent company and also copies of pages from its internet site. The internet pages show a lipstick, foundation powder and eye shadow. These are referred to as the “DuBarry Color[sic] Colection [sic]” in the comments underneath the picture. However, the only product that has a mark which can be seen is the face powder which has “DuB” on its front. On another page is a photograph of what is termed the “DuBarry Basic Skin Care” which is stated to consist of “Cleansing cream”, “Penetrating Cleanser”, “Skin Freshener”, “Liquid Treasure” and “Eye Cream”. All of these are skin care treatments. At exhibit GES3 he provides two invoices, two packing slips and two shipping orders. The latter are dated 14 November 2007 and 28 September 2007 but do not mention the mark DUBARRY simply referring to the goods shipped as being “hair care products”. The invoices are dated 12 November 2007 and 26 September 2007 and refer to “Millcreek and DuBarry Hair Care/Cream & Lotions” valued at US\$7,186 and US\$8,214 respectively, both are addressed to the same company in Markington, Harrogate. Mr Smith comments that “I am informed by the Opponent that these shipments contained certain products as shown in Exhibit 2 bearing the DuBarry name”.

6) Mr Smith also filed exhibits relating to the discussions between the parties and details of the applicant company. I summarise these exhibits below:

- Exhibit GES4: The first part of this is a history of the original UK company, its products and the DuBarry name. It is also a proposal for a joint venture between the two parties in this case to sell perfumes under the DuBarry name. There is then an exchange of e-mails which makes it clear that the applicant was anticipating that the opponent would provide intellectual property and would benefit from this, provided that the applicant company also profited from the IP provided. Also provided is a copy of a “Confidentiality and Non Use Agreement”.
- Exhibit GES5: A copy of the incorporation certificate of the applicant dated 23 April 2007.

7) The opponent’s second witness statement, dated 17 December 2008, is by Panch Prasad the President/CEO of the opponent company a position he has held since founding his company in 1990. He states that his company sells products (haircare, skincare & cosmetics) worldwide under a variety of trade marks, DuBarry being one of them. He provides many of the exhibits previously provided in Mr Smith’s statement. In exhibit 4 he includes a letter from a UK company, Mistair Beauty Ltd, in Markington, Harrogate. This letter is dated 15 September 2007. It states:

“A quick up-date on what’s been happening with the DuBarry product line.....

Firstly it has been a real; pleasure working with you on the DuBarry project for the last two years or so.

Since May 2005 when we took on the brand, we have introduced the products to the Professional Salon market and a number of pharmacies. Both are showing very encouraging levels of interest.

The new concept of Anti-aging and Anti-oxidant has also drawn some interest and the new packaging is great.

We are still working on the re-launch plan and hoping to complete this by October 15<sup>th</sup>.”

8) The above letter is signed by Mr Everingham the Managing Director of Mistair Beauty Limited. Also included in exhibit 4 is a shipping note for “Millcreek” products to Norway, and an invoice dated 17 September 2007 to a company in Norway. This invoice does not state the name or brand of the products referring simply to “Cream and Lotions”. Also included is a fax dated 9 October 2007 from a Norwegian company stating that “We have been distributing DuBarry products for the Scandanavian market since July 2003. The products are currently sold in select Pharmacy’s, healthcare chains and direct marketing base.”

9) Mr Prasad then goes into considerable detail regarding meetings, phone conversations and correspondence between himself and Mr Millar. It is clear that Mr Millar contacted the opponent

company with a proposal for using the DuBarry brand. The document sent by Mr Miller was titled "Outline proposal for reviving the DuBarry Cosmetics brand in the UK (and maybe beyond)". This document is dated 4 April 2007. Mr Prasad states that the basis of any deal would involve a licence by which Mr Miller would pay the opponent a royalty. He states that all intellectual property would remain with the opponent company. He states he did not give Mr Miller permission to register the company name or domain names which include the word "DuBarry". I note the following from exhibit 5.

Page 11: A copy of an e-mail from Mr Miller, dated 20 April 2007, to the opponent stating that he had registered two domain names, [www.dubarryperfume.co.uk](http://www.dubarryperfume.co.uk) and [www.dubarryperfume.com](http://www.dubarryperfume.com) and announcing that he was about to register a company, The Dubarry Perfume Company Limited. He asks: "Permission is sought from Panch [Mr Prasad] on behalf of USITC Inc. [the opponent] to enable this, without encountering copyright infringement issues."

## **APPLICANT'S EVIDENCE**

10) The applicant filed a witness statement, dated 28 January 2009, by Michael Stuart Miller the founder and sole shareholder of the applicant company. Much of his evidence is similar to that filed at the counterstatement stage. He contacted the opponent in May 2007 as he understood that the opponent held rights relating to the formulae of various old "English" DuBarry perfumes and also design rights relating to the containers. He points out that the opponent has shown no use in the UK prior to the date of his application. He states that the opponent was seeking payment of US\$200,000 as an "up front licence fee (exhibit 9). When he sought information as to quite what intellectual property the opponent held which would justify this fee, no satisfactory answers were forthcoming. Mr Miller provides a range of e-mail correspondence between the two parties which shows that negotiations were on going for some time. It is clear that the opponent preferred a licence agreement with a large up-front payment whereas the applicant was looking for an investment partner. In none of the correspondence does the opponent states that it is selling in the UK although reference is made to the registration of the trade mark. He also provides the following exhibit:

Exhibit 5: A page from "The Beauty Industry Directory for Great Britain and Ireland" dated 2006 which shows no entry for the mark DuBarry. This is said to be the "bible" for the perfumery industry.

11) That concludes my summary of the evidence filed.

## **DECISION**

12) Two days prior to the hearing the opponent Mr Prasad sought an adjournment as he was ill and could not attend to be cross examined. As he is based in Las Vegas he would have been in transit for many hours and this would have exacerbated his, unspecified, condition. Rather than have an adjournment Mr Miller waived his request to cross examine Mr Prasad which meant that his evidence was unchallenged and there was no requirement for him to attend. On the morning of the hearing the opponent submitted a fax from Mr Prasad which said:

“My physician advised me to remain home and recuperate. He insisted that I take precautionary care due to the current H1N1 flu present here and in the UK.”

14) Also attached to this fax was a letter from Thomas J Hess M.D. which stated:

“Mr Prasad is under my care. I have advised him not to fly due to fever and cough.”

15) As a preliminary point at the hearing Mr Smith, on behalf of the opponent sought an adjournment in order that Mr Prasad could attend. He explained that this would allow Mr Prasad to direct him in his cross examination of Mr Miller and also that it would allow him to provide oral evidence to the Tribunal to respond to whatever Mr Miller may say in his cross examination. Given that the evidence of Mr Miller was filed in January, nine months ago, I could not understand why Mr Smith would require Mr Prasad to direct his questioning. The potential issues were obvious as was the line of questioning. Given that Mr Miller would be examined on his statement and would not be allowed to veer off and provide additional evidence as this would be prejudicial to the opponent I did not accept this as a sound reason to grant an adjournment. I note that Mr Smith has been involved in this case since its inception and has filed evidence in his own name. The opponent has had over eight months to discuss, with its agent, the evidence filed by the applicant. As to the issue of Mr Prasad providing oral evidence to the tribunal Mr Smith was unable to explain why Mr Prasad had not sought to file evidence in reply to the applicant’s evidence, or sought leave to file additional evidence in the months prior to the hearing. The issue of prejudice to the applicant is also manifest. I therefore declined to allow an adjournment.

16) Mr Smith then informed me that he had no instructions from his client as to submissions or cross examination and was therefore unable to continue to play a part in the hearing. He adhered to this line despite being offered the opportunity to address the tribunal on a number of occasions. I will therefore refer to the written submissions that he had already provided.

17) The opposition is based upon sections 3(6), 5(1), 5(2)(a) and 5(4). I shall first deal with the opposition under Sections 5(1) and 5(2)(a) which read:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the earlier trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

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

18) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) 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,”

19) In these proceedings the opponent is relying upon an earlier mark CTM 182923 registered on 16 June 1998 and is therefore subject to The Trade Marks (Proof of Use, etc) Regulations 2004, paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a)....

(b)....

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20) In the instant case the publication date of the application was 4 January 2008. Therefore, the relevant period for the proof of use is 5 January 2003- 4 January 2008. I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. The guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);



- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

21) I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

22) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant.

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about

this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

23) The opponent is relying upon a Community Trade Mark. It is clear that use of a community trade mark in the UK is considered sufficient to meet the proof of use provisions of OHIM. This view was endorsed by Mr Geoffrey Hobbs QC sitting as a Deputy High Court Judge in *Whirlpool Corporation et al and Kenwood Limited* [2008] EWHC 1930 (Ch), (paragraph 76 of his decision refers). Although in that case Mr Hobbs was considering in which jurisdiction a community trade mark must be used to establish a reputation for the purposes of Article 9(1)(c), it is highly relevant. This view was recently confirmed by the European Court of Justice in Case C-301-07 *Pago International GmbH*.

24) In his counterstatement Mr Miller only sought proof of use on the following goods in Class 3 "Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use; air perfuming preparations." He did not request proof of use with regard to the goods in Class 1 or 5 or the following in class 3 "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated toilet preparations; anti-perspirants; depilatory preparations". As a result, irrespective of whether the opponent files any evidence of use, the CTM specification with regard to the whole of the Class 1 and 5 goods and "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated toilet preparations; anti-perspirants; depilatory preparations" in Class 3 have to be taken into account in the Section 5(1) and 5(2)(a) grounds.

25) I now turn to consider the evidence of use filed by the opponent. This consists of two invoices to a company in the UK in respect of Millcreek and DuBarry Hair Care/Cream & Lotions". It is not clear from the invoices how much of the order relates to "DuBarry" marked goods as opposed to "Millcreek" goods. It would appear from the opponent's website that it sells under both brands and so it is not a case of goods being sold under a "Millcreek and DuBarry" mark. The invoices are dated 12 November 2007 and 26 September 2007. The opponent filed another invoice, dated 17 September 2007 with regard to products provided to a company in Norway. The invoice did not identify the trade mark on the goods. Also the opponent filed two letters, one from the British company, Mistair Beauty Ltd, the other from the Norwegian

company, Promod Pharma. The British company states that it has been “introducing” the DuBarry product range to pharmacies and hair dressers since 2005, the Norwegian company states that they have been “distributing” DuBarry products in the Scandanavian market since 2003.

26) The goods referred to in the above invoices are “hair care/cream & lotions”. I do not consider such a description as relating to “Soaps; perfumery, essential oils, cosmetics, dentifrices; deodorants for personal use; air perfuming preparations”. To my mind such a description could only be used to show use of the mark in suit on “hair lotions”. Given that the Norwegian invoice does not refer to the trade mark in question at all, the fact that Norway is not part of the EU, and the invoices to the UK refer to the mark in suit in conjunction with another brand, Millcreek, I do not consider the evidence sufficient to meet the requirements set out above. The letters from the companies are not persuasive as they do not state the products that have, allegedly been distributed or introduced. They are general in the extreme and are not sufficient to persuade me that the opponent has made use of the mark DuBarry on the goods for which proof of use was requested.

27) The result of my findings in paragraph 24 above, and taking into account the authorities listed earlier, means that the specifications for the opponent’s mark is reduced to the following for the purposes of the comparison of goods under Sections 5(1) and 5(2)(a).

DUBARRY	CTM 182923	Class 1: Chemical products used in industry, science, photography, agriculture, horticulture, forestry; unprocessed artificial resins; unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
		Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated toilet preparations; anti-perspirants; depilatory preparations
		Class 5: Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin.

28) The opponent, in its original statement of grounds, contended that its goods in Class 1 and 5 were similar to the goods of the mark in suit. I do not accept this contention and the opponent has not pursued this contention in its skeleton argument. To my mind, the comparison has to be between the following specifications:

Applicant’s specification	Opponent’s specification
Class 3: Soaps; perfumery; essential oils; non-medicated toilet preparations; anti-perspirants; deodorants for personal use; cosmetics, hair lotions; dentifrices.	Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; non-medicated toilet preparations; anti-perspirants;

29) Clearly, “non medicated toilet preparations” and “anti perspirants” are shown in both specifications and are identical. In my opinion, the term “non medicated toilet preparations” would encompass “soaps, perfumery; essential oils; deodorants for personal use; cosmetics; hair lotions; dentifrices”. Thus, the whole of the applicant’s specification is identical to that of the opponent and the marks are identical. The ground of opposition under Section 5(1) therefore succeeds.

30) In case I am wrong in my view that “non medicated toilet preparations” would encompass the whole of the applicant’s specification I consider the position under Section 5(2)(a). To my mind, if the goods are not identical they must be regarded as very similar. At the hearing the applicant accepted that this was the case. In considering whether this would lead to a likelihood of confusion I must take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *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 and *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 of 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*

31) In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's marks on the basis of their inherent characteristics, assuming normal and fair use of the marks on the goods covered within the applicant's specification and the opponent's reduced specification as a result of the proof of use test.

32) I must view the question from the perspective of the average consumer for the products which, in this case, must be taken to mean the average UK citizen. Taking account of all of the above when considering the marks globally, I believe there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or

provided by some undertaking linked to them. The opposition under Section 5(2)(a) therefore succeeds.

33) In view of the above I do not need to consider the issues under the other grounds of opposition.

### **COSTS**

34) As the opponent has been successful it is entitled to a contribution towards its costs. I order the applicant to pay the opponent the sum of £1,500 (breakdown shown below). This sum 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.

Preparing a statement and considering the other side's statement	200
Preparing evidence and considering and commenting on the other side's evidence	500
Preparing for and attending the hearing	300
Expenses	500
<b>TOTAL</b>	<b>1500</b>

**Dated this 14<sup>th</sup> day of October 2009**

**G W Salthouse  
For the Registrar  
The Comptroller-General**