

**O-239-11**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2516568  
BY  
THE BOOTS COMPANY PLC  
TO REGISTER THE TRADE MARK**

**BOOTS SKIN CLEAR ULTRA**

**IN CLASSES 3 AND 5**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 99554  
BY  
RECKITT & COLMAN (OVERSEAS) LIMITED**

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1. On 21 May 2009, The Boots Company PLC ('Boots') applied to register BOOTS SKIN CLEAR ULTRA as a trade mark. The application was made for the following goods and services which are in classes 3 and 5<sup>1</sup>:

*Class 3: Cosmetics; skin care preparations including facial washes, facial masks, facial creams, facial moisturisers, facial wipes, facial scrubs, body moisturisers, body scrubs; cleansing pads; facial strips; nose strips; treatment gels; medicated skin preparations; therapeutic skin cleansers; soaps; essential oils.*

*Class 5: Pharmaceutical preparations; sanitary preparations for medical uses; skin care preparations for medical purposes; medicated soap; medicated skin preparations; medicated skin cream; medicated ointments; therapeutic skin cleanser; therapeutic preparations for cleansing the skin; plasters; materials for dressings.*

2. The application was published in the *Trade Marks Journal* on 19 June 2009. Reckitt & Colman (Overseas) Limited ('R&C') filed notice of opposition to the trade mark application, claiming that registration would be contrary to sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the Act'). It relies upon a single earlier Community trade mark ('CTM') registration in relation to the section 5(2)(b) and 5(3) grounds:

5475603  
CLEARASIL ULTRA

*Class 3: Non-medicated toilet preparations; skin care preparations; cosmetics; facial wipes and pads; make up removal wipes and pads, cotton wool in the form of wipes and pads for cosmetic use; preparations for the hair; soaps, perfumes and essential oils; dentifrices.*

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<sup>1</sup> As per 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.

Class 05: *Pharmaceutical preparations and substances; medicated skin care preparations; preparations for treatment of acne.*

3. Section 5(2)(b) of the Act states:

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

....

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

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

R&C relies upon all the goods of its registration to attack all the goods of the application under this ground. It claims the goods are identical and/or similar. Further, R&C claims that CLEARASIL and BOOTS SKIN CLEAR are recognised by the relevant public as two brands of acne treatment and the position of ULTRA in both parties' marks will be seen as a sub-brand, with a distinctive and independent role within each mark. There will be a likelihood of confusion, R&C claims, when the marks are compared as wholes.

4. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

R&C relies upon a reputation in all the goods of its registration to attack all the goods of the application under this ground. R&C claims the following:

“The CLEARASIL range is divided into 2 ranges: CLEARASIL STAYCLEAR and CLEARASIL ULTRA which have their own visual identity and characteristics, ULTRA being a range created to work faster and on an ‘*ad hoc*’ basis whilst the STAYCLEAR range is for daily use.

CLEARASIL ULTRA is known by a significant part of the relevant public for acne treatment products. In this particular market in the UK, the Opponent is the only company to offer an ULTRA range and the mark

CLEARASIL ULTRA has established a reputation in the field through substantial use.

By adding the word ULTRA to its existing BOOTS SKIN CLEAR range, the applicant is attempting to trade upon the reputation of the Opponent's mark CLEARASIL ULTRA and use of the opposed application will confer an unfair commercial advantage on the Applicant by creating an association with the characteristics of the CLEARASIL ULTRA range in the mind of the relevant public.

The addition of the word ULTRA to the BOOTS SKIN CLEAR range of the Applicant in the format BOOTS SKIN CLEAR ULTRA is also detrimental to the Opponent. It is detrimental to both the distinctiveness of the Opponent's trade mark in the field of acne treatment products and to the reputation which CLEARASIL ULTRA has acquired over the years.

Further, because the CLEARASIL business was assigned by the Applicant to the Opponent in 2006, there is a serious risk that consumers buy BOOTS SKIN CLEAR ULTRA products in the belief that there is still a connection with the Opponent's mark CLEARASIL ULTRA. The earlier ownership of the CLEARASIL ULTRA range by the Applicant increases the chances of association between the marks."

5. Section 5(4)(a) of the Act states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented —

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

R&C relies upon its earlier sign ULTRA which it states was first used in 2005 and has been used throughout the UK in relation to *medicated and non-medicated skin care products for the treatment of acne*. This ground is also directed at all the goods of the application. R&C claims:

"The trade mark ULTRA has been used for several years by the Opponent and the previous owner of the CLEARASIL business.

By the time the Applicant applied for registration of BOOTS SKIN CLEAR ULTRA, the mark ULTRA had established a strong reputation in the UK in the field of acne treatment products through extensive use and advertisement.

Further, the Opponent is the only company to sell an ULTRA sub-range of products in the UK market of acne treatment products and the trade mark ULTRA has become distinctive of the Opponent's products through use. The mark ULTRA has acquired an independent reputation and the relevant public is regarding this trade mark as an indication of origin. As such it should be protected by the law of passing-off.

Boots' SKIN CLEAR range is already present in the acne treatment market and the offering of acne products under the mark BOOTS SKIN CLEAR ULTRA will constitute a representation likely to lead the relevant public to attribute the commercial origin of these products to the Opponent.

The relevant public is likely to infer from the defendant's use of ULTRA that Boots SKIN CLEAR and CLEARASIL are connected, especially as the CLEARASIL trade marks were previously owned by Boots. The Opponent is likely to suffer commercial damage as a result."

6. R&C's CTM completed its registration procedure on 15 November 2007, which is less than five years before the date on which Boots' application was published in the *Trade Marks Journal*. R&C's mark is, therefore, an earlier trade mark which is not subject to the proof of use provisions<sup>2</sup>.

7. Boots filed a lengthy counterstatement containing submissions which I bear in mind in reaching my decision. Boots denies a likelihood of confusion and denies that its use of the applied-for mark would take unfair advantage of, or would be detrimental to, the distinctive character or repute of R&C's mark. Further, Boots relies upon the defence of due cause because it states that the generic and descriptive nature of the element ULTRA indicates that the term is available for general use and provides Boots with due cause to use this element within its trade mark. Attached to the counterstatement are printouts of trade marks which include the word ULTRA in classes 3 and 5, from the Intellectual Property Office's trade mark register which Boots claims show that ULTRA is a "very generic term". Boots denies the section 5(4)(a) ground; in particular, Boots states that the presence of the well-known trade mark BOOTS in the mark identifies the source of the goods so that there will be no misrepresentation; it states that R&C has failed to demonstrate any confusion; and it states that, in relation to the assignment, average consumers are not in the habit of making

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<sup>2</sup> 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 5<sup>th</sup> May 2004.

assessments as to the origin of goods based on previous transactions; further that the average consumers for acne products are teenagers who are unlikely to have been aware of the assignment in 2006.

8. R&C filed evidence and submissions and Boots filed written submissions. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. In making my decision, I have taken into account the evidence and submissions of both parties, including those made in the opposition statement of case and in the counterstatement.

### **R&C's evidence**

9. This comprises a witness statement (dated 17 March 2010) and exhibits from Ms Isabelle Schuller, who is a Category Trade Mark Manager of Reckitt Benckiser Corporate Services (on record as acting for R&C in these proceedings), a position she has held since January 2009. Her statement comes from her personal knowledge or from the records of "her company" (although it is not clear whether this is Reckitt Benckiser Corporate Services or R&C. I assume the latter is a commercial division of the former).

10. Ms Schuller states that CLEARASIL is a 50-year old brand which enjoys tremendous reputation in the 'Young Skin Care' market worldwide. ULTRA was first used in the UK in 2005 for a new sub-range of CLEARASIL products. At that time the CLEARASIL business was owned by the Boots group of companies, who assigned it to the Reckitt Benckiser group of companies in 2006. She states that the CLEARASIL brand has two pillars: ULTRA and STAYCLEAR. The former is for rapid acne treatment and the latter is for everyday use to prevent acne. Ms Schuller describes ULTRA as being "positioned around the concepts of speed, fast response, strength and efficacy." A dark blue colour scheme is used for ULTRA products, whilst a pale blue colour scheme is used for STAYCLEAR. Ms Schuller states that the colour schemes were introduced so that the two ranges are easily recognisable by consumers.

11. Ms Schuller states that the goods on which ULTRA has been used are: non-medicated and medicated acne treatment and acne prevention products, namely washes, scrubs, wipes, pads, lotions, creams and gels. Exhibit IS1 shows pictures of ULTRA packs sold in the UK since 2005. These all appear to be "rapid treatment cream". In all cases, the position of ULTRA is beneath CLEARASIL. There is no indication as to whether the products looked like this at the date of application (I note that one of the product boxes shows an expiry date of 2007). IS2 are prints from the clearasil.co.uk website (there is no date) of pictures of CLEARASIL ULTRA products. The packaging is quite different to that of the exhibits in IS1, and in these pictures the word ULTRA still appears beneath CLEARASIL, but it is much smaller than in IS1. The products displayed in the website prints show washes, scrubs, lotions, creams, wipes and pads. Similar pictures to those in IS1 and IS2 are shown in IS3, which is a print-out from the

'Global New Products Database', showing CLEARASIL ULTRA products launched since 2005 (both by R&C and its predecessor, Boots).

12. Ms Schuller states that goods bearing the ULTRA trade mark are available across the UK at Asda, Boots, Morrisons, Sainsbury's, Superdrug and Tesco. IS4 includes prints from the websites of Sainbury's, Asda, Boots and Express Chemists, showing CLEARASIL ULTRA products for sale. These prints are undated, but the packaging is the same as that for the pictures in IS2 (the undated Clearasil website prints). Presumably, these were printed at the time of Ms Schuller's witness statement and show the current/recently used forms of packaging. Page 20 of the exhibits, in IS3 which is the Global New Products Database, shows the new style of packaging and the smaller ULTRA in use in February 2009, which is three months before the date of application. The prints indicate that the representation of CLEARASIL ULTRA changed after December 2007 but before February 2009 to show ULTRA in the smaller letter size compared to CLEARASIL above the word ULTRA.

13. Sales figures of the CLEARASIL ULTRA goods in the UK are given as follows:

2004 - 2005	£1,317,000	(figures obtained from Boots)
2006	£2,291,534	(not a full year's figures in view of the assignment)
2007	£4,721,656	
2008	£5,248,035	
2009	£5,276,960	

14. Ms Schuller states that the CLEARASIL ULTRA figures represent about 50% of the total CLEARASIL sales in the UK. The market share of the ULTRA range is around 9% of the UK Young Skin Care market (2005 to 2009). Exhibit IS6 shows advertising figures for the whole of the UK Young Skin Care market and for the whole Clearasil brand. Between 2007 and 2009, the whole Clearasil range accounted for 18.2% to 28.3% of the total advertising spend of the whole of the market for Young Skin Care. Exhibit IS7 is a list of TV advertisements for ULTRA products aired in the UK since February 2005 (copies are provided on a CD in exhibit IS8). The advertisements each lasted for between 10 and 30 seconds and were shown on mainstream UK TV channels between 1 February 2005 and 29 March 2009. The advertisements on the CD always refer to the words CLEARASIL ULTRA together. Ms Schuller states that, in November 2005, the advertising agency behind the ULTRA radio advertisement won an award for best advertisement. Ms Schuller does not state whether ULTRA was used in conjunction with CLEARASIL, but the report of the award (exhibit IS10) refers to the advertisement as being for 'Clearasil Ultra Face Wash'.

15. Exhibit IS9 gives details of what Ms Schuller describes as two survey results from the marketing magazine *Brand Republic*. Ms Schuller states that, in May 2005 and June 2007, polls conducted among 1000 adults aged 16-64 about the

TV commercials they remember seeing showed that, respectively, 35% and 28% remembered seeing a CLEARASIL ULTRA advertisement recently. The question asked was “Which of the following TV commercials do you remember seeing recently?” and then gives a list of advertisements together with a percentage result. There are no other details; for example, how the respondents were selected or where they were when they were asked; whether there were any advertisements for R&C’s goods bearing the mark in the vicinity; whether the interviewees were in the process of buying personal care goods. These are serious defects which are detrimental to the weight which can be given to the evidence.<sup>3</sup>

16. Exhibit IS11 gives details of various instances of marketing of CLEARASIL ULTRA, including in March 2005 a series of posters and a competition, together with radio and TV advertisements and the spot blocker pen, launched in April 2009, referred to under the mark CLEARASIL ULTRA, supported by television and cinema advertising. The details of the latter are from [grocerytrader.co.uk](http://grocerytrader.co.uk) and there is reference in the text to both CLEARASIL ULTRA and ULTRA solus. An article in the *Sun* newspaper refers to Clearasil Ultra (dated 18 November 2007). A report in *Marketing Week*, dated 19 January 2006, refers to CLEARASIL ULTRA as the “‘crisis’ range, designed to combat major outbreaks of acne in three days”.

17. The remainder of Ms Schuller’s witness statement consists of submission which I will, of course, bear in mind but will not include in this summary of factual statements. In reply to submissions made by Boots on 11 June 2010, Ms Schuller filed a second witness statement, dated 22 September 2010, which contains, largely, submissions concerning the average consumer’s perception of ULTRA having acquired distinctiveness. I will bear the submissions in mind but I will record only the evidence. Ms Schuller states that R&C is the only skin care manufacturer in the field of acne treatment to have organised its brand under 2 sub-ranges, one for everyday use and one for “stronger, faster treatment under the trademark ULTRA”. Ms Schuller exhibits (IS1) pictures showing products on shop shelving which she states are the main products available in the UK Young Skin Care Market. These are Tea Tree Witch Hazel, Clean & Clear, Garnier

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<sup>3</sup> The head note of *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293 indicates the way that a survey should be conducted: “If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewees as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”



Pure, Neutrogena Visibly Clear, Nivea Visage, Simple, Bioré, Freederm, Oxy and Good Things. Ms Schuller states that none of these brands is positioned like CLEARASIL, i.e. only CLEARASIL has two sub-ranges with their own colour schemes<sup>4</sup>. Ms Schuller also states that Boots has begun using the mark since she made her first witness statement and that the pictures of this use in exhibit IS2 demonstrate Boots' intention to pass its goods off as R&C's.

## Decision

### Section 5(2)(b)

19. The leading authorities which guide me in this ground are from the Court of Justice of the European Union ('CJEU'): *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) 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

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<sup>4</sup> Although I note that page 7 shows the Clean & Clear range grouped in packaging of different blues and also in green; the Oxy lids are silver or pink, and the Garnier packaging has a brown or blue label. It is unclear whether all the shelves are included in the exhibit.

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*

f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

#### Average consumer and the purchasing process

20. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services.

#### 21. Class 3

The average consumer for these goods is the general public. With regard to preparations for the skin, such as for the prevention of acne, a reasonable level of attention is likely to be paid to such goods, which are usually selected visually, since the purchase may involve a scrutiny of the promised effect on the user. Cosmetics can vary enormously in price, but even at the less expensive end of

the market, I consider that the purchasing process will involve a fairly close inspection of the goods and thus also a reasonably high, but not the highest, level of attention. Those who wish to enhance their appearance are likely to make a reasonably considered purchase, since the desired effect will be important to them. That purchase is also much more likely to be a visual purchase than an oral purchase.

## 22. Class 5

In *Mundipharma AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-256/04, the Court of First Instance (CFI) stated:

“44 Second, it has not been disputed in the present case that the relevant public for the goods covered by the mark applied for, namely therapeutic preparations for respiratory illnesses, is made up of patients in their capacity as end consumers, on the one hand, and health care professionals, on the other.

45 As to the goods for which the earlier mark is deemed to have been registered, it is apparent from the parties’ written submissions and from their answers to the questions put at the hearing that some therapeutic preparations for respiratory illnesses are available only on prescription whilst others are available over the counter. Since some of those goods may be purchased by patients without a medical prescription, the Court finds that the relevant public for those goods includes, in addition to health care professionals, the end consumers.”

The pharmaceutical goods of both marks are not limited to those which must be prescribed and so could be prescription-only or purchased over the counter or via self-selection from a supermarket shelf. The relevant public for over the counter or self-selected goods is the general public; for prescription-only goods it is both the prescriber and the patient. The level of attention will vary according to the type of pharmaceutical (for example, analgesics could be a simple paracetamol or could be more sophisticated and much stronger for severe illness); that said, where pharmaceuticals are concerned, the average consumer, even if the end user rather than a prescriber, is likely to pay a higher degree of attention: in *Aventis Pharma SA v OHIM*, Case T-95/07, the GC stated:

“29 First, as noted in the case-law, medical professionals display a high degree of attention when prescribing medicinal products. Second, with regard to end-consumers, it can be assumed, where pharmaceutical products are sold without prescription, that the consumers interested in those products are reasonably well informed, observant and circumspect, since those products affect their state of health, and that they are less likely to confuse different versions of such products (see, to that effect,

Case T-202/04 Madaus v OHIM – Optima Healthcare (ECHINAID) [2006] ECR II-1115, paragraph 33). Furthermore, even supposing a medical prescription to be mandatory, consumers are likely to display a high degree of attention when the products in question are prescribed, having regard to the fact that they are pharmaceutical products (ATURION, paragraph 27).”

23. In relation to the other goods listed in the parties’ class 5 specification, the level of attention paid to these is likely to be reasonably high (at a general level – it may be less for soaps, for instance). Regard will be paid to the promised effect of the medicated skin preparations, side effects, sensitivities/allergic reactions, frequency and length of use of the preparations. With regard to plasters, sanitary preparations for medical uses and material for dressings, these are not likely to be subject to the same level of scrutiny; plasters and dressings are, generally, more mundane and less sophisticated than medical preparations, whilst sanitary preparations for medical uses are more in the nature of medical hygiene goods. An average level of attention is likely to be paid. The purchasing process is primarily visual: if self-selected from a shelf, the purchase will be visual; if over the counter, the product will be seen behind the counter and asked for; if prescribed, the prescription is written out. All of the goods in class 5 are more of a visual purchase than an oral one.

Comparison of goods and services

24. Ms Schuller’s first witness statement sets out a table of the parties’ respective goods and services and makes submissions as to which goods are identical and which are similar:

Opposed Application	Earlier trade mark
<u>Class 3</u> <b>Cosmetics; skin care preparations including facial washes, facial masks, facial creams, facial moisturisers, facial wipes, facial scrubs, body moisturisers, body scrubs;</b> cleansing pads; facial strips; nose strips; treatment gels; <b>medicated skin preparations;</b> therapeutic skin cleansers; <b>soaps; essential oils.</b>	<u>Class 3</u> Non-medicated toilet preparations; <b>skin care preparations; cosmetics;</b> facial wipes and pads; make up removal wipes and pads, cotton wool in the form of wipes and pads for cosmetic use; preparations for the hair; <b>soaps;</b> perfumes and <b>essential oils;</b> dentifrices.
<u>Class 5</u> <b>Pharmaceutical preparations;</b> sanitary preparations for medical uses; skin care preparations for medical purposes; medicated soap; medicated skin preparations; medicated skin cream; medicated ointments; therapeutic skin cleanser; therapeutic preparations for cleansing the skin;	<u>Class 5</u> <b>Pharmaceutical preparations</b> and substances; <b>medicated skin care preparations;</b> preparations for treatment of acne.

plasters; materials for dressings.	
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25. R&C submits:

“The identical goods are highlighted in bold. Regarding the remaining goods, ‘*cleansing pads; facial strips; nose strips; treatment gels; therapeutic skin cleansers*’ are similar to the ‘*non-medicated toilet preparations; skin care preparations; pads for cosmetic use*’ covered by the earlier trade mark registration. In class 5, the ‘*sanitary preparations for medical uses; skin care preparations for medical purposes; medicated soap; medicated skin preparations; medicated skin cream; medicated ointments; therapeutic skin cleanser; therapeutic preparations for cleansing the skin; plasters; material for dressings*’ are similar to ‘*pharmaceutical preparations; medicated skin care preparations; soaps.*”

26. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

The criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 for assessing similarity between goods and services were:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

27. Class 3: The goods of the parties which are in bold are clearly identical; the terms are either present in each specification or are encompassed by the wider term *skin care preparations* in R&C's specification<sup>5</sup>. It is a little odd that Ms Schuller's witness statement submits that R&C's *facial pads* are similar, rather than identical, to the cleansing pads in the application. That being the case, I find that Boot's *cleansing pads; facial strips; nose strips* are so highly similar as to be near-identical to R&C's *facial wipes and pads; make up removal wipes and pads, cotton wool in the form of wipes and pads for cosmetic use*. Boots' *treatment gels and therapeutic skin cleansers* would appear to be covered by R&C's term *non-medicated toilet preparations; skin care preparations* but, again, R&C claims similarity not identity. On this basis, I find that they are so highly similar as to be near-identical. All of the class 3 goods of the application are therefore either identical or near-identical to the goods of the earlier mark.

28. Class 5: *Pharmaceutical preparations* appears as a term in both the competing class 5 specifications, so these goods are self-evidently identical. R&C claims similarity in respect of the remaining class 5 goods of the application. Although R&C, again, claims similarity not identity with its own goods in class 5, Boots' *skin care preparations for medical purposes; medicated soap; medicated skin preparations; medicated skin cream; medicated ointments; therapeutic skin cleanser; therapeutic preparations for cleansing the skin* are so highly similar to R&C's *medicated skin preparations* as to be near-identical. Plasters and dressings are bought alongside antiseptics and wound cleansing pharmaceutical preparations, from self-service pharmacy and supermarket shelves, by the general public in order to dress wounds. Plasters and dressings may be impregnated with antiseptic and/or analgesic substances. They share purpose, users and channels of trade with pharmaceutical preparations. Boots' *plasters; materials for dressings* are highly similar to R&C's *pharmaceutical preparations and substances*. This leaves Boots' *sanitary preparations for medical purposes*. The purpose of these is to clean, disinfect and/or sterilise in a medical capacity. They could be used as part of a suite of products for control of disease, infection or infestation (e.g. a fungicidal spray for shoes to prevent reoccurrence of

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<sup>5</sup> The General Court (GC) (previously the Court of First Instance) said in *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)*, Case T-133/05: "29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42)."

athlete's foot). The uses and users could be the same, whether that is the general public or a health professional treating a condition. The same channels of trade will be involved. There is a high degree of similarity between *sanitary preparations for medical use* and *pharmaceutical preparations and substances*.

Comparison of trade marks

29. 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, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

30. The marks to be compared are:

<b>R &amp; C's mark</b>	<b>Boots' mark</b>
CLEARASIL ULTRA	BOOTS SKIN CLEAR ULTRA

R&C's mark consists of two words. The first of these, CLEARASIL is distinctive, being an invented word, whilst ULTRA is a well-known dictionary word. CLEARASIL appears at the beginning of the mark and is the longer element; it is a rule of thumb that the average consumer pays more attention to the beginnings of marks<sup>6</sup>. CLEARASIL is the dominant distinctive element of R&C's mark. The mark applied for consists of four words. The middle two words are entirely descriptive in the context of skincare and so, whilst not negligible in the mark, are not dominant or distinctive elements. The first word, BOOTS, whilst not invented, is very well known in the UK for personal care and medicinal goods: R&C itself states that Boots is well-known and I also consider this to be a notorious fact. Even without this, BOOTS is a distinctive word for the goods. ULTRA is the fourth and last word and although it plays a role in the mark, it is a less dominant role than BOOTS. BOOTS, appearing at the beginning of the mark is the dominant distinctive element of the applied-for mark.

31. There is a single point of similarity between the parties' marks: the word ULTRA is common to both. It is not a negligible element so there is a degree of

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<sup>6</sup> This is not a hard and fast rule; if the beginning of both marks is a descriptive or common combining form, the importance may be reduced: *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, Case T-438/07.

visual and aural similarity between the marks but, owing to the position of ULTRA as the second element of R&C's two-word mark and the fourth element of Boots' four-word mark, combined with the complete dissimilarity between the other elements of each mark, the degree of visual and aural similarity between the marks is low to moderate.

32. ULTRA is the element which is common to both marks. Boots submits:

“On filing their application, the Applicant did not consider ULTRA to be a trade mark by itself or to be a dominant or distinctive component of the Opponent's registration CLEARASIL ULTRA. On this basis, the Applicant proceeded to use ULTRA in addition to its previous range BOOTS SKIN CLEAR simply as a descriptive indicator to the relevant public that its new range is an advanced extension and level above their previous range.”

R&C makes the following submission:

“ULTRA ... being “positioned around the concepts of speed, fast response, strength and efficacy”.

Collins English Dictionary (2000 edition) defines ‘ultra’ as meaning “beyond or surpassing a specified extent, range, or limit” and “extreme or extremely: *ultramodern*”<sup>7</sup>. It is a word commonly used in the senses which both parties have explained. Its concept will be the same in each mark, although the effect of the presence of all the other elements of each mark means that the overall conceptual similarity between the marks is low to moderate. ULTRA will not be the dominant concept which is stored away in the memory.

33. The combination of the visual, aural and conceptual assessment puts the overall similarity between the marks at low to moderate.

#### Distinctiveness of R&C's mark

34. It is necessary to consider the distinctive character of R&C's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion<sup>8</sup>. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public<sup>9</sup>. R&C

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<sup>7</sup> The Intellectual Property Office's Trade Mark Examination Work Manual (Addendum) gives, as a guide, the practice for ULTRA trade mark applications as: “Treatment depends on the totality of the mark but if ULTRA is combined with words which describe characteristics of the goods (ULTRAFINE for thread), the mark as a whole will attract objections under section 3(1)(b) and (c). Each case should be assessed on its merits.”

<sup>8</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>9</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.



states that CLEARASIL is a 50-year old brand “which enjoys tremendous reputation in the Young Skin Care market worldwide”. Further, R&C states that ULTRA has been used on non-medicated and medicated acne treatment and acne prevention products, namely washes, scrubs, wipes, pads, lotions and creams. Any claim to an enhanced distinctive character for CLEARASIL ULTRA can only be relevant in relation to these goods, not the whole range of goods covered by the earlier mark. In terms of the goods not specified as having been sold under CLEARASIL ULTRA, CLEARASIL is an invented word which contains, at most, an evocation of CLEAR. It has a high degree of inherent distinctive character. ULTRA, in view of the meanings identified above, will be interpreted as having a reference to a characteristic of the goods which is quasi-laudatory: that the goods offer something extra, are more effective, are the optimum choice etc. The mark, as a whole has a reasonably high degree of inherent distinctive character. The evidence also shows that, in relation to acne-treatment goods, CLEARASIL ULTRA has achieved a significant market share (9%) of the UK’s young skin care market. I accept that, in relation to CLEARASIL ULTRA, R&C is entitled to claim an enhanced degree of distinctive character in relation to acne-treatment goods. However, ULTRA is not used alone: it appears in conjunction with CLEARASIL. There is no evidence that the ULTRA element has become recognisable without the presence of CLEARASIL. The enhanced distinctive character is in respect of CLEARASIL ULTRA, as a whole. I say more about this below.

#### Likelihood of confusion

35. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). In this case, the goods of the parties are either identical or almost so but I have found that there is only a low to moderate level of similarity between the marks.

36. R&C cites the judgments of the CJEU in *Medion* and *Société des Produits Nestlé v Mars UK Ltd* [2005] E.T.M.R. 96 as support for its claim that ULTRA retains a distinctive and independent role within both the trade mark CLEARASIL ULTRA and the trade mark BOOTS SKIN CLEAR ULTRA. R&C points out that a secondary trade mark can acquire distinctive character as a result of its having been used with a house mark (the CJEU did not rule on such a specific circumstance in *Nestlé* but ruled that distinctiveness may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark). In *Medion*, the CJEU had been asked to rule on the specific question of whether there is a likelihood of confusion (assuming the goods/services to be identical) when a word mark with normal distinctiveness is reproduced in a later composite sign of a third party whereby the third party

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places its company name in front of the mark. In that case, the earlier mark was LIFE (not a German word, which was the territory in question) and the third party's mark was THOMSON LIFE. This is not on a par with these proceedings: I am not assessing BOOTS SKIN CLEAR ULTRA versus ULTRA, solus. The earlier mark is CLEARASIL ULTRA. Secondly, ULTRA is only weakly distinctive, rather than being a word of "normal distinctiveness". There is nothing inherently similar about the BOOTS and CLEARASIL elements in the marks and nothing about the overall impressions of the marks which would lead, on the *Medion* basis, to the average consumer assuming that there is, at the least, an economic connection (paragraph 31, *Medion*).

37. In *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40, Jacob LJ said:

"83 Finally, although I agree with the judge's questioning of the Court's proposition of fact that "there is a greater likelihood of confusion with very distinctive marks" there is some truth with the opposite proposition. The Court in *Lloyd* said:

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

24. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; ..."

84 The last sentence is an acknowledgement of a fact that has long been recognised: where a mark is largely descriptive "small differences may suffice" to avoid confusion ( per Lord Simonds in *Office Cleaning Services v Westminster Window and General Cleaning* (1946) 63 R.P.C. 30 at p.43). This is not a proposition of law but one of fact and is inherent in the nature of the public perception of trade marks.

85 It is worth examining why that factual proposition is so—it is because where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another. Thus in the cited case "Office Cleaning Association" was sufficiently different from "Office Cleaning Services" to avoid passing off.

86 The same sort of consideration applies when there is use of two common surnames, as in this case. The average consumer will be alert for differences—just in the same way as one distinguishes WH Smith from other Smiths by the initials. That is of importance here in making the global assessment.”

I keep in mind that it is a global assessment, and that this global assessment includes two marks which each have a distinctive ‘house mark’ which is nothing like the other and that each mark contains a shared element which is of weak distinctive character for the goods. R&C’s evidence shows that CLEARASIL ULTRA is always used in combination (apart from one mention in ‘grocerytrader.co.uk’, a trade publication). In the evidence, CLEARASIL is always more prominent than ULTRA, both in font size and in position on the packaging. Although there is no requirement that, for distinctiveness to have been acquired in consequence of the use of a mark as part of or in conjunction with a registered trade mark, that part of a mark has to have been used independently, this still does not answer the multi-factorial global appreciation question under section 5(2)(b). It is only one factor. 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 (*Medion*). The particular circumstances in *Medion* are not reproduced in this case and the evidence has not persuaded me that R&C is entitled to claim ULTRA as its own. **There is no likelihood of confusion: the opposition under section 5(2)(b) fails.**

### Section 5(3)

38. It is a pre-requisite of this section of the Act that the earlier mark has the necessary reputation at the relevant date, as per *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent

and duration of its use, and the size of the investment made by the undertaking in promoting it.”

It is fair to say that the evidence establishes that R&C had the requisite reputation in its earlier CTM CLEARASIL ULTRA<sup>10</sup> at the relevant date

39. However, establishing that there is a sufficient reputation is only the first step in the conditions necessary for success under section 5(3) of the Act. R&C must also establish that there would be a link between the marks, as per the CJEU’s judgment in *Intel Corporation Inc. v CPM United Kingdom Limited*, Case C-252/07<sup>11</sup>. In my findings in relation to the likelihood of confusion I found that the degree of similarity between the marks was low to moderate and that the only common element is weak or low in distinctive character. The reputation is for CLEARASIL ULTRA as a whole; there is nothing to suggest that the applicant’s mark will bring that ULTRA element to mind of itself. There would be no link between the marks in the sense of a bringing to mind. **The opposition under Section 5(3) fails.**

#### **Section 5(4)(a)**

40. The requirements to succeed in a passing off action are well established and essentially consist of 1) the existence and ownership of a commercial goodwill identified by a sign, 2) a misrepresentation by the defendant through the use of a

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<sup>10</sup> In *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, case C-301/07, the CJEU stated:

“Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.”

(The member state in question was Austria). Consequently, both *General Motors* and *Pago* require that R&C’s CTMs must be known by a significant part of the public concerned by the products or services covered by the marks, in the relevant territory. In these proceedings, the relevant territory includes, but is not limited to, the UK.

11. “1. Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that whether there is a link, within the meaning of Case C-408/01 *Adidas-Salomon* and *Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

2. The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon* and *Adidas Benelux*, between the conflicting marks.”

sign identical with, or similar to, the claimant's sign, such as to deceive the public, 3) damage (or the likelihood of damage) to the claimant's goodwill caused by the misrepresentation.

41. R&C's claim under section 5(4)(a) is that it has goodwill in the sign ULTRA. A useful definition of goodwill was given in *Inland Revenue Commissioners v Muller & Co's Margerine Ltd* [1901] AC 217 at 223:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

The first requirement is therefore for R&C to show that it is ULTRA which brings in custom. All the evidence is of the sign CLEARASIL ULTRA; there is no basis for finding a separate goodwill in relation to ULTRA solus. The goodwill is in the sign CLEARASIL ULTRA. The comments cited above in *Reed Executive Plc v Reed Business Information Ltd* are apposite in relation to whether misrepresentation is likely; given that the goodwill resides in CLEARASIL ULTRA and that ULTRA is weak in distinctive character, the public will be alive to the differences between the marks. This is unaffected by the fact that Boots was the previous owner of R&C's mark<sup>12</sup>: there is no reason to suppose that the average consumer for these goods would know of the undertaking behind ULTRA. **The opposition under section 5(4)(a) fails.**

### Costs

42. Boots has been successful and is entitled to an award of costs on the following basis<sup>13</sup>:

Considering the other side's statement and preparing a counterstatement: £500

Considering other side's evidence

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<sup>12</sup> Kerly on Trademarks and Tradenames, 14<sup>th</sup> Edition: "It is not necessary to show that the customers who knew the goods of the claimants firm by a particular name or get-up knew anything whatever about the claimant. [*United Biscuits v Asda* [1997] R.P.C. 513. ] It is immaterial that they did not even know his name, [*Lever v Goodwin* (1887) 36 Ch.D. 1 ; 4 R.P.C. 492 , CA (Sunlight Self-Washer Soap); see Yorkshire Relish illustration below; Jif [1990] R.P.C. 341 , at 406, *per* Lord Oliver.] for it is sufficient to prove that purchasers of his goods recognised, by the use of the marks in question in connection with them, that they were goods of a particular class, and to show that such class is, in fact, constituted by his goods. [Paragraph (which has been in this work since at least 1910) quoted by Jenkins L.J. in *Oertli v Bowman* [1957] R.P.C. 388 at 397. It was also approved by Harman and Russell L.J.J. in *Hoffmann-La Roche v D.D.S.A.* [1969] F.S.R. 410 at 416, 421.]"

<sup>13</sup> As per the scale in Tribunal Practice Notice 4/2007.

and filing written submissions

£800

**Total:**

**£1300**

43. I order Reckitt & Colman (Overseas) Limited to pay The Boots Company PLC the sum of £1300. 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 5th day of July 2011**

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