

O-244-18

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO 3194423
BY LEANORA HARPER
TO REGISTER


BOTEGA NATURALS
Nature's Child

AS A TRADE MARK
IN CLASSES 3 & 30
AND OPPOSITION THERETO (UNDER NO.408715)
BY
LORENZ SNACK-WORLD HOLDING GMBH

Background & pleadings

1. Leanora Harper ('the applicant') applied to the register the mark outlined on the title page on 1 November 2016. The trade mark was published on 2 December 2016. The application was made in classes 3 and 30, however only class 30 (for which the goods are outlined below in paragraph 10) has been opposed.

2. Lorenz Snack-World Holding GmbH ('the opponent') opposes the mark under Section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of specific class 29 goods from its earlier International Registration set out below:

WE0000899517B	Goods relied on in Class 29
 International registration date: 15/7/06 Date of designation of the EU: 15/7/06	Potato crisps

3. The opponent's trade mark is an earlier mark, in accordance with Section 6 of the Act. As it completed its registration procedure more than 5 years prior to the publication date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed a counterstatement in which it denied the ground of opposition and requested that the opponent produce evidence to demonstrate proof of use.

5. In these proceedings the applicant has represented herself and the opponent has been professionally represented by KSB INTAX.

6. Neither party requested to be heard. The opponent filed evidence and written submissions in lieu. The applicant filed nothing beyond the counterstatement. I make this decision based on the material before me.

Approach

7. For the sake of procedural economy and for reasons which will become apparent during the course of the decision, I have not considered the evidence provided by the opponent.

Decision

8. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the

chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

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

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

Comparison of Goods

10. The goods to be compared are:

Opponent's goods	Applicant's goods
Potato crisps	Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea; Beverages (Cocoa-based -); Beverages (Coffee-based -); Beverages consisting principally of chocolate; Beverages consisting principally of cocoa; Beverages consisting principally of coffee; Beverages containing chocolate; Beverages made from chocolate; Beverages made from cocoa; Beverages made from coffee; Beverages made of coffee; Beverages made of tea; Beverages made with chocolate; Beverages (Tea-based -); Beverages with a chocolate base; Beverages with a cocoa base; Beverages with coffee base; Beverages with tea base; Black tea [English tea]; Breakfast cereals; Cereal bars; Cereal bars and energy bars; Cereal based energy bars; Cereal based food bars; Cereal based foodstuffs for human consumption; Cereal based prepared snack foods; Cereal based snack foods;

	Cereal flour; Cereal powders; Cereal snacks; Cereal-based snack food; Cereals; Cocoa; Cocoa powder; Cocoa products; Coffee; Earl Grey tea; Flapjacks; Green tea; Herb tea [infusions]; Herb teas, other than for medicinal purposes; Herbal preparations for making beverages; Oat-based food; Oat-based foods; Oolong tea; Snack food products consisting of cereal products; Snack foods made from cereals; Tea bags; Tea (Iced -); Tea leaves; Tea mixtures; Tea pods; Tea-based beverages; Teas; Yerba mate.
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11. With regard to the comparison of goods and services, in the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

15. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

16. In relation to the goods, the applicant contends in the counterstatement that,

“I do not believe that there is any similarity in the brand from spelling to the tagline and what the brand Botega Naturals: Nature’s Child represents which is vegan, raw, organic, fair trade products”.

17. Before going any further into this opposition it is necessary to explain why, as a matter of law, the point above about the applicant’s goods being ‘vegan, raw, organic and fair trade’ has no bearing on the outcome of this opposition. A trade mark registration is essentially a claim to a piece of legal property, i.e. the trade mark. The goods for which the mark is registered sets some limits to the claim, although since marks can be protected against the use of the same or similar marks in relation to goods which are only similar to those for which the earlier mark is registered, the limits of the claim are not precise. Every registered mark is therefore entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods, if there is a likelihood of confusion.

18. Until a trade mark has been registered for five years (when the proof of use requirements set out in Section 6A of the Act apply), it is entitled to protection in relation to all the goods for which it is registered. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for the goods listed in the Notice of Opposition. The concept of notional use is set out in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

"78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

19. In its written submission the opponent contends that,

"Identical to 'potato crisps' are Cereal bars, Cereal bars and energy bars, Cereal based energy bars, Cereal based food bars, Cereal based foodstuffs for human consumption, Cereal based prepared snack foods, Cereal based snack foods, Cereal flour, Cereal powders, Cereal snacks, Cereal based snack food, Cereals, Snack food products consisting of cereal products and Snack foods made from cereals. All these goods are either ingredients for crisps products respectively snacks products or snack products itself. These goods are mostly consumed while sitting together with other people or watching e.g. TV. Furthermore, such products are sold in shops near to each other...The remaining contested goods are mainly beverages based on different plants or herbs. Those beverages are often consumed with snacks based on cereal. Therefore the goods are highly similar to each other".

20. On the basis that the opponent has identified two distinct groups of goods where it believes identity and similarity occur, it will be helpful if I also address each of the applicant's goods in turn and, where appropriate, group terms together.¹

Cereal bars, Cereal bars and energy bars, Cereal based energy bars, Cereal based food bars, Cereal based foodstuffs for human consumption, Cereal based prepared snack foods, Cereal based snack foods, Cereal snacks, Cereal based snack food, Cereals, Snack food products consisting of cereal products, Snack foods made from cereals; Flapjacks; Cocoa products; Oat-based food; Oat-based foods

21. I note that the opponent believes that some of the goods listed above are identical or highly similar to its own goods. As potatoes themselves are vegetables and not cereals, potato crisps and cereal products are different as to their physical nature, but I find that they are highly similar on the grounds that all are considered as snack foods, the users of such goods will be the same, the goods will find their way to consumers through the same trade channels and in a retail environment such as a supermarket these goods being snack products will likely be in the same aisle or in close proximity to each other.

Cereal flour, Cereal powders

22. I note the opponent's contention that it considers the above goods to be identical to its goods. I do not agree with the opponent's contention. These goods are ingredients rather than a finished product such as the opponent's goods. Their physical natures and uses are different. Their users are different. Users of these goods are likely to be looking for ingredients for cooking or baking whereas users of snack products are looking for a ready cooked/prepared snack. Although the respective goods could be found in the same retail environment, they will be found in different aisles. In addition I do not find these goods to be competitive or complementary with opponent's goods. Overall I find these goods are dissimilar to the opponent's goods.

¹ *Separode Trade Mark* BL O-399-10

Breakfast cereals

23. Although these goods may share some of the same users and trade channels as the snack products outlined above, the nature and uses of the products are different as breakfast cereals are not generally considered to be snack products which are eaten on the move. In addition I do not find these goods to be competitive or complementary with opponent's goods. Overall I consider these goods to be dissimilar to the opponent's goods.

Beverages based on coffee; Beverages based on coffee substitutes; Beverages based on tea; Beverages (Cocoa-based -); Beverages (Coffee-based -); Beverages consisting principally of chocolate; Beverages consisting principally of cocoa; Beverages consisting principally of coffee; Beverages containing chocolate; Beverages made from chocolate; Beverages made from cocoa; Beverages made from coffee; Beverages made of coffee; Beverages made of tea; Beverages made with chocolate; Beverages (Tea-based -); Beverages with a chocolate base; Beverages with a cocoa base; Beverages with coffee base; Beverages with tea base; Black tea [English tea]; Cocoa; Cocoa powder; Coffee; Earl Grey tea; Green tea; Herb tea [infusions]; Herb teas, other than for medicinal purposes; Herbal preparations for making beverages; Oolong tea; Tea bags; Tea (Iced -); Tea leaves; Tea mixtures; Tea pods; Tea-based beverages; Teas; Yerba mate

24. Despite the opponent's contention that the above group of goods are often consumed with snacks and are therefore highly similar, I do not find this to be the case. There does not appear to be any real competitive or complementary relationship between these goods and the opponent's in the sense described in case-law and the nature and purpose of these goods, being beverages and constituent parts for beverages coming in dried form as leaves, powders and/or granules to be made up into finished drinks, is very different to the opponent's goods. I consider these goods to be dissimilar to the opponent's goods.

25. As I have concluded that only some of the goods are similar, it follows that the opposition can be dismissed for the goods which I found to be dissimilar. I am

guided in this matter by the following extract of the *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA decision, in which Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

Average Consumer and the purchasing process

26. I must next consider who the average consumers are for the goods I have found to be similar and how those goods are purchased. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

27. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

28. The average consumers for the contested goods are members of the general public. The goods at issue are inexpensive, everyday type of purchases and

consumers will pay a low to average level of attention. The act of purchasing will be mainly visual as consumers will likely make a selection of goods from, for example, a bricks and mortar retail outlet or website. However, I do not discount aural considerations such as word of mouth recommendations which may also play a part.

Distinctive character of the earlier mark

29. I must next consider the distinctive character of the earlier mark. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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



30. Distinctiveness can be enhanced through use of the mark. The opponent has made a specific claim of enhanced distinctiveness in its written submissions and has filed evidence of use. For the purposes of this assessment, the relevant market to

which I must have regard is the UK market². There is no evidence of sales to the UK. Any evidence of promotional activity is confined to Germany. On the basis of the evidence filed, I am unable to determine that the earlier mark has an enhanced distinctive character in relation to the goods at issue.

31. In view of the above, I have only the inherent position to consider. The earlier mark consists of a dictionary word, being the plural form of the word natural, which although is not directly descriptive of the goods, does allude to qualitative characteristics of the goods in terms of being natural products not containing artificial ingredients. Overall I consider that the earlier mark has a low degree of inherent distinctiveness.

Comparison of the marks

32. The marks to be compared are:

Opponent's mark	Applicant's mark
	

33. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

² On the irrelevance of a reputation in continental Europe when assessing enhanced distinctiveness for the purposes of Section 5(2), see the comments of Iain Purvis QC, sitting as the Appointed Person, in *China Construction Bank Corporation v Groupement des cartes bancaires (BL O/281/14)* at [30]-[34].

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

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

35. The opponent’s mark consists of a single word, **Naturals**, presented in a handwriting style of font and set at a slight angle, such that the end of the word appears to rise above the start of the word. As previously stated I find that the word itself when considered in the context of snack products would be seen as alluding to a lack of artificial ingredients. As a result I consider the word itself to be weak in distinctiveness.

36. The applicant’s mark consists of two words in a stylised font, **BOTEGA NATURALS**, with a circular device representing the letter O, placed above the two words **Nature’s Child**. The **Nature’s Child** element of the mark is presented in a cursive font and is much smaller in scale compared to the words above it. In my view and although the two words are distinctive, the size of the **Nature’s Child** element means it carries less weight in the overall impression of the mark compared to the element above it. It is the **BOTEGA NATURALS** element by which the mark is likely to be referred and which carries the greater weight in the overall impression of the mark. Of these two words I have already found that **NATURALS** alludes to a qualitative characteristic of the goods so it is weaker in distinctiveness. I find that **BOTEGA** is the stronger distinctive and dominant element here.

37. In a visual comparison of the marks, the point of similarity is the word **Naturals**. It is the entirety of the opponent’s mark and one of the four words making up the applicant’s mark. Other than its stylisation, there are no other elements to the

opponent's mark, whereas the applicant has the additional three words and the presentation, i.e. two large words placed above two smaller words, to be considered. These additional words will not go unnoticed. Overall given that only one word out of four in the applicant's mark is shared with the earlier mark I find there is a low degree of visual similarity.

38. In an aural comparison of the marks, again the point of similarity is the word **Naturals** which will be pronounced identically in both cases. As previously stated the shared word is the entirety of the opponent's mark. With regard to the applicant's mark, if only the two larger word elements, **Botega Naturals**, are verbalised, which seems most likely given their size and prominence, then I find there to be a medium degree of aural similarity. If average consumer verbalises all four of the word elements in the applicant's mark, then I find the degree of aural similarity falls to a low to medium level. I conclude this as the greater number of verbalised words there are in a mark, the more likelihood there is of any emphasis on a particular word being lost.

39. With regard to a conceptual comparison, the opponent submits that,

“...Naturals creates a suggestion that the product might be to some extent inartificial and does not comprise artificial ingredients”.

I agree that the opponent's mark is likely to bring to mind something which is natural. The same word in the applicant's mark will bring to mind the same concept, but there is the additional invented word which precedes it, **Botega**, which has no concept of its own. The smaller element **Nature's Child**, may also bring to mind a concept of someone belonging to nature. In relation to the goods at issue here being snack products, the average consumer is most likely to form some form of conceptual hook based on an allusive reference to goods being natural. Overall I find there to be a low to medium degree of conceptual similarity.

Likelihood of confusion

40. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and those outlined in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) Imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer*).

41. Confusion can be direct (when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

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

42. Furthermore in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

43. With regard to the case law in relation to distinctive character, in *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

44. Whereas in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said

in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

45. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

46. So far I have found that only some of the contested goods are highly similar. In addition I found that the average consumer is a member of the general public who will select the goods by primarily visual means whilst paying a low to average degree of attention during the purchasing process. I also found that the earlier mark has a low level of inherent distinctiveness. With regard to the comparison of the marks, I have found that they are visually similar to a low degree and aurally similar to a medium degree if only two of the four words in the applicant’s mark were verbalised, but low to medium of all four words were verbalised. For the conceptual comparison, I found the marks were conceptually similar to a low to medium degree only because of the shared element **Naturals**. But in particular I identified that the **Botega** element of the applicant’s mark was an invented word and was therefore considered as the most dominant and distinctive element of that mark.

47. Given that the shared element, **Naturals**, is considered weak in relation to the distinctive character of the earlier mark, that the opponent’s mark is only one of the four words making up the applicant’s mark and that the goods at issue are selected by primarily visual means, meaning that the visual similarity takes on a particular significance, then I find no likelihood of either direct or indirect confusion between the opponent’s and applicant’s marks.

Conclusion

48. The opposition fails under section 5(2)(b). The application can proceed to registration.

Costs

49. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited her, in their letter dated 9 January 2018, to indicate whether she wished to make a request for an award of costs, and if so, to complete a pro-forma including a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition; it was made clear to the applicant that if the pro-forma was not completed “no costs will be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 18th day of April 2018

June Ralph

For the Registrar

The Comptroller-General