

O/336/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3187836

BY COVENTRY CHEMICALS LIMITED

AND

OPPOSITION No. 408978

BY ENERGIZER BRANDS II, LLC

Background and pleadings

1. This is an opposition by Energizer Brands II, LLC (“the opponent”) to an application filed on 27th September 2016 (“the relevant date”) by Coventry Chemicals Limited (“the applicant”) to register the mark shown below.



2. Following an amendment to the list of goods the application now covers:

“Cleaning, polishing and scouring preparations; bleaching preparations; detergents; glass and mirror cleaner; antibacterial surface cleaner; floor cleaner; scale removing preparations for household purposes; household cleaning preparations; grout cleaner; mould and mildew removing preparations; all the aforementioned being household cleaning products and not for use in relation to automobiles.”

3. The opposition is based on the opponent’s earlier trade mark UK3004444. The earlier mark is shown below.

Refresh

4. The earlier trade mark was entered in the register on 31st October 2014. It is registered in classes 3 and 5 in relation to:

“Class 3: Leather cleaning preparations; automobile cleaning preparations; automobile interior cleaning preparations; automobile, tyre, bumper, chrome, glass, carpet and wheel cleaning preparations; Automobile and car wax preparations; all of the aforesaid goods for use in relation to automobiles only and none being for use on a person's skin.

Class 5: Disposable wipes impregnated with disinfecting chemicals or compounds therefor for use in interior of automobiles; air fresheners and air deodorizers; all of the aforesaid goods for use in relation to automobiles only and none being for use on a person's skin.”

5. The opponent claims that the marks and the respective goods are similar and that there is a likelihood of confusion on the part of the public. Therefore, registration of the contested mark would be contrary to s.5(2)(b) of the Act.

6. The applicant filed a counterstatement denying the ground of opposition. I note, in particular, that the applicant:

- Claims that the earlier mark consists of the word REFRESH in a script which resembles that produced by a handwritten marker pen;
- Claims that its mark, by contrast, consists of the elements ‘Re’ and ‘Fresh’ in different tones followed by an exclamation mark and arranged on a contrasting multi-tonal background with stars;
- Denies that there is more than a limited degree of similarity between the marks;
- Claims that its mark would be verbalised as RE – FRESH, the separate elements making a different (albeit similar) sound to REFRESH as one word;
- Contends that the word ‘refresh’ means ‘refreshing’ or ‘cleaning’ i.e. ‘making fresh again’;
- Claims that if any conceptual link is made between the marks based on their word elements, it would be only a descriptive (and therefore non-distinctive connection);

- Claims that the earlier mark is devoid of any, or has only a low degree of, distinctive character;
- Contends that the household goods covered by the application are different to the specialist car products covered by the earlier mark and aimed at different users;
- Claims that certain items, namely 'grout cleaner', 'mould and mildew removing preparations' and 'bleaching preparations' are manifestly not similar to the goods covered by the earlier mark;
- Asserts that there are many trade marks protected in the UK in classes 3 and 5 that include the word REFRESH which are not owned by the opponent.

7. Both sides seek an award of costs.

Representation

8. The applicant is represented by Sanderson & Co, Chartered Patent Attorneys. The opponent is represented by Norton Rose Fulbright LLP, Solicitors. Neither side asked to be heard. However, this decision takes account of the evidence and written submissions filed by the parties.

The evidence

The opponent's evidence

9. The opponent's evidence consists of two witness statements by Clare Jackman, who is a solicitor and chartered trade mark attorney with Norton Rose Fulbright. Ms Jackman's first statement simply provides the results of some research she did in September 2017 (i.e. about a year after the relevant date). Exhibit CJ1 consists of the results of three internet searches. The first looked at cleaning products on the website of Homebase. I note that these are generally divided by category into 'Cleaning Products' and 'Car care products'. However, I also note that household cleaning products and car care products are displayed (under these respective

headings) on the same web page in one instance.¹ Ms Jackman also searched the website of B & Q. Judging from the search results page she exhibits, she appears to have searched on 'cleaner'. This produced 239 hits for all kinds of cleaning products, including household and car care products. The third search was directed at the website of Wilko. Judging from the search results, searches were made on the terms 'leather cleaner' and 'window clear'. The search on leather cleaner produced 5 hits. Most were for leather cleaners. The fourth was for a chamois leather. I am not clear why this was considered relevant. The search on 'window clear' produced some hits for household glass cleaners as well as a screen wash for use in vehicles. Finally, Ms Jackman says that she went to a branch of Tesco and found air fresheners, including one for use in vehicles, sold in the same aisle as cleaning products for home and domestic use.

The applicant's evidence

10. The applicant's evidence consist of a witness statement by James Sanderson. Mr Sanderson is a patent attorney, but says that he has been handling trade mark matters for many years. He also did some research connected to the matters in dispute. Exhibit JLS01 consists of pictures showing a range of 13 cleaning products and/or what appear to be additives for air-con systems, all bearing the word REFRESH alongside other descriptive indications and trade marks. There is no evidence as to when or where these products were offered for sale, although I note that one product has a sale price shown in pounds sterling. The [legible] words visible on the packaging for the products are in English. Exhibit JLS03 is said to consist of a screen shot from Google showing the way in which car cleaning products are marketed. What it actually shows is that a search for 'images' of 'car cleaning products' conducted on the search engine 'bing' (unsurprisingly) produced pictures of car cleaning products. Exhibit JLS06 shows that the opponent's mark is used in relation to cleaning and air freshening products for cars, and that the words "your car" appear under the mark, as shown below.

¹ See page 4 of CJ1



11. Mr Sanderson also filed some 'state of the register' evidence, to which Ms Jackman's second statement replied. It is well established that evidence of entries in trade mark registers is irrelevant to the assessment of the likelihood of confusion between two particular marks. This is because it does not show whether such marks are in use, or where, or for which goods. Therefore, I need say no more about this evidence. That completes my review of the evidence, so far as I consider it necessary.

Proof of use

12. The registration process for UK3004444 was completed on 31st October 2014. This was less than 5 years prior to the date of publication of the contested mark. This means that the proof of use requirements in s.6A of the Act do not apply. Consequently, the opponent can rely on the registration of the earlier mark in relation to the goods for which it is registered without having to show any use of the earlier trade mark.

Section 5(2)(b)

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

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

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

Comparison of goods

14. The respective goods are shown below.

Goods covered by contested mark	Goods covered by earlier mark
Class 3: Cleaning, polishing and scouring preparations; bleaching preparations; detergents; glass and mirror cleaner; antibacterial surface cleaner; floor cleaner; scale removing preparations for household purposes; household cleaning preparations; grout cleaner; mould and mildew removing preparations; all the aforementioned being household cleaning products and not for use in relation to automobiles.	Class 3: Leather cleaning preparations; automobile cleaning preparations; automobile interior cleaning preparations; automobile, tyre, bumper, chrome, glass, carpet and wheel cleaning preparations; Automobile and car wax preparations; all of the aforesaid goods for use in relation to automobiles only and none being for use on a person's skin. Class 5: Disposable wipes impregnated with disinfecting chemicals or compounds therefor for use in interior of automobiles; air fresheners and air deodorizers; all of the aforesaid goods for use in relation to automobiles only and none being for use on a person's skin.

15. In considering whether the goods are identical it is necessary to take account of the limitations to the respective class 3 goods; namely, that the goods covered by the contested mark are household cleaning products whereas those covered by the earlier mark are for use in relation to automobiles. This means that the goods at issue are not identical.

16. Turning to the issue of similarity, I note that in *Canon*², the CJEU stated 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

² Case C-39/97 at paragraph 23 of the judgment

intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. The earlier mark covers *leather cleaning preparations, glass, carpet cleaning preparations* [for automobiles] which are similar in nature, purpose and method of use to the corresponding cleaning products for household use. Similarly, the *polishing and scouring preparations* [for household use] covered by the contested mark appear to be similar in nature, purpose and method of use to *automobile and car wax preparations* [for automobiles], which is wide enough to cover car polishes and scouring agents for cleaning vehicle wheels etc. Further, *antibacterial surface cleaner* and *detergents* covered by the contested mark appear to have a similar relationship to anti-bacterial wipes/cleaners and detergents for use on automobiles, which are covered by *automobile cleaning preparations* in the earlier registration.

18. I note that users of household cleaning products are often also car users and therefore potential users of car cleaning and polishing products.

19. The opponent’s evidence seek to show that household cleaning products are sold alongside automobile products. I do not accept that this is what the evidence shows. The most helpful evidence, from the opponent’s perspective, is that a search on B & Q’s website produced hits for all kinds of cleaning products. However, this appears to be the result of the decision to search on the rather general term ‘cleaner’. No one searching for a particular household cleaning product would search on just ‘cleaner’. Therefore, this does not establish that B & Q places household cleaning products and automobile products in the same product category, or that they are usually sold side by side. The other internet searches and the evidence from a visit to a Tesco store, are inconclusive. At most, they show that household cleaning products are sometimes displayed in the same aisle, or on the same web page (but not on the same shelves or in the same product category) as some automobile products. My own experience is that household cleaning products are generally displayed on different shelves to automobile products and/or grouped in different product categories.

20. Nevertheless, taking all of the above into account, I find that although the goods under consideration are not usually in direct competition with one another, they are similar to a medium degree. This finding applies to the following descriptions of goods listed under the contested mark, all of which cover, or are wide enough to cover, similar goods for use in the home:

cleaning, polishing and scouring preparations;

glass and mirror cleaner;

household cleaning preparations;

detergents;

antibacterial surface cleaner.

21. This leaves [household] *bleaching preparations, floor cleaner, scale removing preparations for household purposes, grout cleaner* and *mould and mildew removing preparations*. The applicant relies on definitions of the words ‘grout’, ‘mould’ and ‘mildew’ in the Oxford Dictionary to show that grout, mould and mildew are not usually associated with automobiles. The opponent’s evidence-in-reply does not address the matter. However, I note that in its written submissions the opponent asserts that mould and mildew preparations could “conceivably” be used in the care and cleaning of automobiles. No further explanation is provided. It is not clear to me why preparations for removing mould and mildew would normally be used for the care and cleaning of automobiles. I therefore reject the opponent’s submission. The opponent did not specifically take issue with the applicant’s argument about ‘grout’ having no application in automobiles. Consequently, I find that the same applies to *grout cleaner*. Looking at the matter in the round, I find that *grout cleaner* and *mould and mildew removing preparations* are similar to the goods covered by the earlier mark, but only to the limited extent that they may both be classified, at a high level of generality, as cleaning products. The slight similarity of purpose implied from that observation is not sufficient to establish any more than a low degree of similarity between the respective goods.

22. In my view, the same applies to the similarity between the goods covered by the earlier mark and *scale removing preparations for household purposes*.

23. The opponent submits that *floor cleaner* could cover household carpet cleaner, and is therefore similar to products for cleaning carpets in automobiles. I disagree. Terms in trade mark specifications should be given their ordinary and natural meaning.³ The ordinary meaning of 'floor cleaner' is cleaning products for floors. This would naturally be taken to include floor surfaces, such as tiles, but not soft coverings, such as carpets. Cleaners for the latter would naturally be described as carpet cleaners, not floor cleaners. I therefore find that there is, at most, only a low degree of similarity between *floor cleaner* and any of the goods covered by the earlier mark. Similarly, I see no clear comparable usage between *bleaching preparations for household use* and any of the goods covered by the earlier trade mark for use on automobiles. Therefore, the degree of similarity between these goods is again, at most, only low.

Average consumer

24. 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 or services in question: *Lloyd Schuhfabrik Meyer*.⁴

25. The average consumer of the goods covered by the contested mark is likely to be a member of the general public buying products to clean his or her home. I see nothing about the goods which suggests that such a user will pay an unusually high or low degree of attention when selecting such products. I therefore conclude that such a user will pay an average or 'normal' degree of attention.

26. The goods are likely to be selected from shelves, websites or published advertisements. Therefore, the goods are likely to be selected mainly by the eye, although word of mouth recommendations may play some part in the process. Consequently, the way the marks look matters more than the way that they sound, but some account must be taken of the latter.

³ See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was)

⁴ Case C-342/97, CJEU

Distinctive character of the earlier mark

27. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,⁵ 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).”

28. There is no evidence of use of the earlier mark prior to the relevant date. Consequently, I need only consider the inherent distinctiveness of the earlier mark.

29. The applicant submits that the word REFRESH means “to make fresh again” or “to make as if new; to repair; to restore”. According to the applicant, these definitions come from “a” dictionary. Unfortunately, the applicant does not say which one. The Oxford English Dictionary provides a number of meanings for the word REFRESH.

⁵ Case C-342/97

The first one given is “*To impart fresh strength or energy to (a person, the spirits, a part of the body, etc.); to reinvigorate, revive; to provide with refreshment.*” This meaning seems to apply mainly to people. However, I note that meaning ‘3a’ is “*To restore to a fresh or bright condition; to brighten or clean up; to give a fresh or new appearance to.*” This meaning appears applicable to objects, including automobiles. I recognise these meanings as ones that are in everyday use. Considered in relation to products for cleaning, waxing and air freshening for automobiles, I find that the word is descriptive of the intended purpose of the goods. Further, I find that average consumers of the goods at issue would, without difficulty, recognise that REFRESH is descriptive.

30. The applicant submits that in these circumstances average consumers would pay more regard to the other features of the earlier mark, specifically the script in which the earlier mark is registered. According to the applicant, this resembles that produced by a hand-drawn marker pen. I think this submission overstates the distinctiveness and impact of the script in which the word REFRESH is registered. In my view, it is a very ordinary and non-distinctive script. It would be artificial to find that the script in which the word REFRESH is registered constitutes the distinctive element of the earlier mark. In my view, it makes only a minor contribution to the distinctive character of the earlier mark.

31. These observations might suggest that the earlier mark has no distinctive character at all. If it were open to me to make such a finding, then I would. But it is not. This is because, firstly, registration is *prima facie* evidence of validity.⁶ The applicant has not applied to invalidate the earlier mark. Consequently, the earlier mark must be treated as a valid trade mark. A finding that the mark is devoid of any distinctive character would amount to a finding that it is invalid. That would be inconsistent with the statutory presumption of validity. Secondly, in *Formula One Licensing BV v OHIM*⁷ the CJEU found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack

⁶ See s.72 of the Act

⁷ Case C-196/11P

of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

32. It is true that this statement applied to a conflict between a national trade mark and an EU trade mark, rather than between two national marks. However, the reasoning appears equally applicable to the current situation in circumstances where the validity of the earlier mark has not been challenged through the appropriate means, i.e. an application for invalidation.

33. I therefore find that the earlier mark has a minimum degree of distinctive character. This legal fiction does not justify adopting the wholly artificial approach of treating the distinctive character as arising simply from the use of a handwritten form of script. I will therefore assume that the word REFRESH has a minimum degree of distinctiveness.



Comparison of marks

34. The CJEU stated in *Bimbo SA v OHIM*⁸ that:

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

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 respective trade marks are shown below:

	
Earlier trade mark	Contested trade mark

36. The opponent submits that the average consumer would perceive the contested mark first and foremost as the word REFRESH with some generic graphic elements, namely stars which suggest sparkling or shine, i.e. the intended purpose of the goods at issue. The exclamation mark merely adds emphasis. Therefore, the word

⁸ At paragraph 34 of its judgment in Case C-591/12P

REFRESH should be considered as the dominant element of the contested mark, as it is of the earlier mark. Consequently, the marks are visually similar.

37. The opponent submits that the word elements of the marks would be pronounced in the same way. Therefore, the marks are aurally identical.

38. The opponent further submits that there is a strong conceptual similarity between the marks. It does not identify what this concept is. I assume it relates to the dictionary meanings of the dominant word REFRESH.

39. In its written submissions, the applicant accepts that the marks are aurally and conceptually identical. However, it submits that as the common word REFRESH is descriptive and non-distinctive in relation to the goods at issue, the identity of [non-distinctive] sound and concept is immaterial to the likelihood of confusion. As to visual similarity, the applicant submits that the differences between the marks are “not trivial.” In contrast to the hand-drawn marker pen-like appearance of the earlier mark, the contested mark has the components ‘Re’ and ‘Fresh’ in different tones (reflecting contrasting colours) with a capital “F” and an exclamation mark on a contrasting multi-tonal background containing four 5-pointed stars. Additionally, the lettering in the contested mark has “a bold and distinctive outline.”

40. The applicant also submits that the registrar should take account of how the earlier mark appears “in practice”, i.e. in use. This submission is wrong in law. In *J.W.Spear & Sons Ltd and Others v Zynga Inc.*⁹, Floyd L.J. considered the CJEU’s judgment in *Specsavers*, Case C-252/12, in which it had been submitted that matter used with, but extraneous to, the earlier mark should be taken into account in assessing the likelihood of confusion with a later mark. The judge stated:

“46. Mr Silverleaf submitted that, in the light of this guidance, the proposition stated by Jacob LJ in *L’Oreal* can no longer be regarded as representing the law. He starts by recognising that acquired distinctiveness of a trade mark has long been required to be taken into account when considering the likelihood of confusion. He goes on to submit that *Specsavers* in the CJEU has made it

⁹ [2015] EWCA Civ 290

clear that the acquired distinctiveness to which regard may properly be had included not only matter appearing on the register, but also matter which could only be discerned by use. The colour, on which reliance could be placed in *Specsavers*, was matter extraneous to the mark as it appeared on the register. It followed that if something appears routinely and uniformly in immediate association with the mark when used by the proprietor, it should be taken into account as part of the relevant context.

47. I am unable to accept these submissions. The CJEU's ruling does not go far enough for Mr Silverleaf's purposes. The matter not discernible from the register in *Specsavers* was the colour in which a mark registered in black and white was used. It is true that in one sense the colour in which a mark is used can be described as "extraneous matter", given that the mark is registered in black and white. But at [37] of its judgment the court speaks of colour as affecting "*how the average consumer of the goods at issue perceives that trade mark*" and in [38] of "*the use which has been made of it [i.e. the trade mark] *in that colour or combination of colours*". By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used "*in association with the mark*". Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely are not matters which affect the average consumer's perception of the mark itself."*

41. I therefore find that the form in which the opponent uses its mark is irrelevant to the likelihood of confusion, which must be assessed on the basis of normal and fair use of the earlier mark as registered. That would not include the whole mark shown in paragraph 10 above.

42. I find that the marks at issue are aurally and conceptually identical. The common concept being "*To restore to a fresh or bright condition.*" I agree with the applicant that this concept has more to do with the nature of the goods than who is responsible for them.

43. I accept the opponent's submission that the word Refresh/ReFresh is the dominant element of the respective marks. I find that the so-called marker pen-like script used for the earlier mark makes only a minor contribution to the overall visual impression the mark will make on average consumers. I also accept the opponent's submission that the background device and stars shown in the contested mark lack distinctiveness in relation to cleaning products. In my view, the contrasting tones used for 'Re' and 'Fresh', and the capital letter 'F' in the middle of that word, have more visual impact than the background device, but they are not particularly distinctive or striking. Nevertheless, I accept that none of these elements are negligible. In other words, they each contribute to the overall visual impact created by the marks. By contrast, the dark outline of the letters in 'ReFresh' and the exclamation mark after that word in the contested mark are trivial elements. They could easily be missed altogether, even when the mark is in plain sight. They are therefore negligible and make no material difference to the degree of visual similarity between the marks. Comparing the marks as wholes, I find that they are visually similar to a medium to high degree.

Likelihood of confusion

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

The principles

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well

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

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

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

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

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

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

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

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

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

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

45. I have found that the marks are visually similar to a medium to high degree and aurally and conceptually identical. Some of the goods covered by the contested mark are similar to a medium degree to the goods covered by the earlier mark, whilst others are similar to only a low degree (if at all). In another case these factors might be sufficient to indicate a likelihood of confusion, at least when considering the use of the marks in relation to goods which are similar to a medium degree.

46. There are two factors which mitigate the likelihood of confusion in this case. Firstly, the goods at issue are likely to be selected mainly by the eye. This means that the level of visual similarity (and difference) is more important than aural identity. The marks are clearly more distinguishable to the eye than they are to the ear.¹⁰ Secondly, and more importantly, the common element – the word REFRESH – is low in distinctiveness in relation to the goods at issue.

47. I recognise that the low level of distinctiveness of the element which is common to the marks does not preclude a likelihood of confusion. In *BSH Bosch und Siemens Hausgeräte GmbH v EUIPO and LG Electronics Inc.*¹¹ the first-named party had filed an application to register the mark shown below as an EU trade mark in relation to goods in classes 7, 9 and 11.



48. The application was opposed by LG Electronics Inc. based on an earlier mark comprised of the word KOMPRESSOR. Insofar as the respective goods were the same or similar, the EUIPO upheld the opposition. Appeals to the Board of Appeal

¹⁰ See *New Look Limited v OHIM*, General Court, joined cases T-117/03 to T-119/03 and T-171/03

¹¹ Case C-43/15P

and the General Court were rejected. A further appeal was made to the CJEU. One of the grounds for appeal was that insufficient weight had been given to the fact that the word COMPRESSOR was descriptive for certain categories of relevant goods; namely, those that included a compressor. The appeal was heard by the Grand Chamber of the CJEU. It summed up the appellant's submission like this:

“48. In BSH's submission, where the earlier mark is a readily recognisable variant of a descriptive indication and the later mark contains the descriptive indication itself, even the existence of major similarities between the signs and identity of the goods which the opposing marks cover are not capable of permitting the conclusion that there is a likelihood of confusion if the similarities of the signs are limited to the descriptive indications and concern only goods which are described by the indication. The public does not perceive any indication of origin in a descriptive indication, but is guided by the other elements of the mark.”

49. Turning to the judgment under appeal the CJEU stated that:

“56. After recalling the relevant case-law in paragraphs 26 and 27 of the judgment under appeal, the General Court stated in paragraph 28 that, as regards the goods in respect of which the First Board of Appeal of EUIPO upheld the opposition, the latter found, without this being contested by BSH, first, that the goods at issue are in part identical and in part similar and, secondly, that the opposing signs are similar. The General Court observed that the cumulative effect of those findings is sufficient, in any event, to be able to conclude that there is a likelihood of confusion, even if the earlier national marks were to be regarded as having a weak distinctive character.

57. The General Court added, in paragraph 29 of the judgment under appeal, that, when assessing the likelihood of confusion, the First Board of Appeal of EUIPO did take account of the fact that, as regards the goods at issue, neither the earlier national marks nor the mark applied for are particularly distinctive. However, the Board of Appeal recalled that, according to the case-law, even for marks with a weak distinctive character, there can be a likelihood of

confusion, particularly in view of the similarity of the signs and of the goods or services covered, and stated that that is true where, as in the present case, the goods are identical and the opposing marks are highly similar.

58. In paragraph 31 of the judgment under appeal, the General Court observed that to accept BSH's argument would have the effect of disregarding the similarity of the marks as a factor in favour of the factor constituted by the distinctive character of the earlier mark, which would thus 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 that mark was reproduced in its entirety by the mark applied for, depriving the degree of similarity between the signs in question of any significance. Such a result would not be consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94.

59. Therefore, the General Court held, in paragraph 32 of the judgment under appeal, that BSH's arguments relating to the weak distinctive character of the earlier national marks could not affect the conclusion of the First Board of Appeal of EUIPO as to the existence of a likelihood of confusion.

60. That assessment by the General Court of the likelihood of confusion is not vitiated by any error of law.

61. Indeed, the Court of Justice, rejecting a line of argument similar to that advanced by BSH in the second plea, has already held on a number of occasions that, although the distinctive character of an earlier mark must be taken into account when assessing the likelihood of confusion globally, it is, however, only one factor among others involved in that assessment (see, in particular, orders of 29 November 2012, *Hrbek v OHIM*, C-42/12 P, not published, EU:C:2012:765, paragraph 61, and of 2 October 2014, *Przedsiębiorstwo Handlowe Medox Lepiarz v OHIM*, C-91/14 P, not published, EU:C:2014:2261, paragraph 22).

62. Furthermore, although it is true that the more distinctive the earlier mark the greater the likelihood of confusion will be, such a likelihood of confusion cannot, however, be precluded where the distinctive character of the earlier mark is weak (see, in particular, order of 19 November 2015, *Fetim v OHIM*, C-190/15 P, not published, EU:C:2015:778, paragraph 40 and the case-law cited).

63. Consequently, even in a case involving an earlier mark of weak distinctive character, the General Court may hold that there is a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (see, in particular, orders of 2 October 2014, *Przedsiębiorstwo Handlowe Medox Lepiarz v OHIM*, C-91/14 P, not published, EU:C:2014:2261, paragraph 24 and the case-law cited, and of 7 May 2015, *Adler Modemärkte v OHIM*, C-343/14 P, not published, EU:C:2015:310, paragraph 59).

64. Thus, the findings made by the General Court in paragraph 31 of the judgment under appeal, which reject the proposition put forward by BSH and against which the second plea is directed, in fact do no more than recall the Court of Justice's settled case-law according to which that proposition is not consistent with the very nature of the global assessment which the competent authorities are required to undertake by virtue of Article 8(1)(b) of Regulation No 40/94 since, contrary to the appellant's contentions, it would have the effect of disregarding the similarity of the marks as a factor in favour of the factor constituted by the distinctive character of the earlier mark (see, in this regard, judgment of 15 March 2007, *T.I.M.E. ART v OHIM*, C-171/06 P, not published, EU:C:2007:171, paragraph 41, and order of 19 November 2015, *Fetim v OHIM*, C-190/15 P, not published, EU:C:2015:778, paragraph 46 and the case-law cited).

65. As regards the argument advanced in this regard by BSH that that case-law is wrong given that it leads to the monopolisation of a purely descriptive indication, it must be stated that it is not Article 8(1)(b) of Regulation No 40/94

but Articles 7(1)(b) and (c) and 51 of that regulation and Article 3(1)(b) and (c) of Directive 2008/95 which are intended to avoid such monopolisation.”

50. The CJEU’s judgment confirms pre-existing CJEU case law to the effect that the level of distinctive character of an element which is common to both marks (or similar as between them) is but one element in the global assessment of the likelihood of confusion. Consequently, even where the level of distinctive character of the common element is very low, other factors in the global assessment, such as the identity of the goods/services and a high level of overall similarity between the marks, may still justify a finding that there is a likelihood of confusion.

51. Shortly after the CJEU’s judgment in *Kompressor*, judgment was given in a UK trade mark appeal to the High Court in England and Wales: *Nicoventures Holdings Limited v The London Vape Company Ltd*.¹² An application had been made to register the mark shown below in relation to electronic cigarettes.



52. It was opposed on the basis of the following earlier mark, which was already registered for the same goods.



53. The registrar upheld the opposition, finding that the marks were highly similar and the goods identical. In these circumstances, the low distinctiveness of the elements VAPE and CO was found to be insufficient to avoid a likelihood of confusion. However, an appeal to the High Court was upheld.¹³ The judge stated that:

¹² [2017] EWHC 3393 (Ch)

¹³ EWHC 3393 (Ch)

“31. The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed.

32. The Hearing Officer found that the element in the opponent's mark which is the common element (i.e. VAPE and CO) is itself more distinctive than other features of that mark (i.e. the stylised features). That is a decision he was entitled to reach but it does not mean that once that decision has been reached, the low distinctiveness of what is the common element ceases to be relevant to a likelihood of confusion. Far from it. That is not what the CJEU in *L'Oreal v OHIM* was saying at all.

33. Given that the Hearing Officer has erred in this way, the matter needs to be considered again bearing in mind the *White and Mackay's* principle. Given the clarity of the Hearing Officer's decision there is no need to go over this at length.

34. Each mark includes as important elements the terms VAPE and CO. There is more to each mark than that because they each include stylised features which are unremarkable but are different from one another (decision paragraphs 27 and 28). The point is that the marks do have a high degree of visual, aural and conceptual similarity (paragraphs 29-31) but that similarity arises from the common elements of the terms VAPE and CO and the combination of those two words. Bearing in mind the goods and services for which these marks are registered or applied for respectively, those words individually are both descriptive and non-distinctive. Put together the combination is also descriptive and non-distinctive.

35. As the Hearing Officer held in paragraph 31 they connote an undertaking in the vaping market. The average consumer, who is a member of the general public over 18 years old, will pay a relatively high degree of attention to the selection of goods and a reasonable level of attention to the selection of services.

36. Bearing all this in mind but in particular having regard to the low degree of distinctiveness about the features these two marks have in common, even taking into account imperfect recollection the differences in the two marks will take on a greater significance for the average consumer than they might otherwise. Although the stylised aspects of each mark are not very remarkable, the fact remains that these aspects are entirely different. From the point of view of visual similarity, the likelihood of confusion is low. Considering conceptual similarity, the concept the two marks share is entirely down to their non-distinctive elements. It is the common concept which is non-distinctive. That does not lead to a likelihood of confusion. In some ways the respondent's best case could be thought to come from considering the aural similarity. From that point of view of course the visual stylised elements will not be present, and hearing "Vape dot co" or "THE Vape dot co" is not so far away from hearing "Vape and co" but the fact is again that they are not the same and what they share is entirely non-distinctive when one bears in mind this is all in the context of electronic cigarettes.

37. Accordingly I do not consider that there is a likelihood of confusion in this case."

54. The *Whyte and MacKay* principle referred to in the judgment is a reference to an earlier judgment of the High Court in England and Wales¹⁴ in which another judge concluded that:

¹⁴ [2015] EWHC 1271 (Ch)

“...what can be said with confidence is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.”

55. Neither of the judgments of the High Court go quite so far as to exclude the likelihood of confusion where the only element in common between two marks is one that is low in distinctive character. They are therefore consistent with *Kompressor* and the case law of the CJEU which precedes it. However, these cases indicate that a degree of caution is required before finding that there is a likelihood of confusion on the basis of a common element that is descriptive and therefore low in distinctiveness.

56. After giving the matter careful thought, I have decided that the visual differences between the marks combined with the differences between the goods are sufficient to exclude a likelihood of confusion. I accept that it is possible that average consumers of cleaning, waxing and air freshening products for automobiles marketed under the opponent's mark will notice that a similar mark is in use for household cleaning products. However, as the only element in common between the marks is the word REFRESH, which is evidently low in distinctiveness in relation to both sets of goods, I find that this is more likely to be put down to coincidence than to the same undertaking using the same or variant marks in relation to similar products for automobile and household use, respectively.

57. The opposition under s.5(2)(b) therefore fails.

Costs

58. The opposition having failed the applicant is entitled to a contribution towards its costs. I assess these as follows:

Considering the notice of opposition and filing a counterstatement - £400

Filing evidence and considering the opponent's evidence - £400

Filing written submissions - £300.

59. I therefore order Energizer Brands II, LLC to pay Coventry Chemicals Limited the sum of £1100. This sum to be paid within 21 days of the end of the period allowed for appeal.

Dated this 1st day of June 2018

**Allan James
For the Registrar**