

O/576/18

TRADE MARKS ACT 1994

TRADE MARK APPLICATION No. 3223936

BY VIATOR HEALTH LIMITED

AND

OPPOSITION No. 409855

BY DEBONAIR TRADING INTERNACIONAL LDA

Background and grounds of opposition

1. This is an opposition by Debonair Trading Internacional LDA (“the opponent”) to an application filed by Viator Health Limited (“the applicant”) on 10th April 2017 to register the mark shown below.



2. The goods/services listed in the application are:

Class 3: Soaps; perfumes, essential oils, cosmetics, hair lotions, body lotions, massage oils, massage lotions, shower gels, massage creams, bubble baths, body powders, body paints, lip balms, depilatory preparations.

Class 5: Lubricant substances for use on the penis, anus or vagina; preparations for arousing sexual desire or improving sexual performance; preparations, potions, aphrodisiacs and herbs for medicinal purposes; nutritional preparations; tampons.

Class 10: Massage devices; devices for massaging, vibrating or stimulating the body; devices for aiding copulation, masturbation and sexual arousal, including synthetic reproductions of parts of the male and female anatomy, synthetic reproductions of penises and vaginas, penis rings, nipple clamps, vibrators, dildos, dongs, butt plugs, penis sleeves, penis extensions, harnesses, masturbators, body prostheses, love dolls; vaginal exercisers; condoms.

Class 25: Clothing, footwear, headgear; erotic lingerie; fantasy clothing of leather or latex, body suits, belts, uniforms, straps, hoods, masks, blindfolds, gags.

Class 35: Retail services, mail order retail services, online retail services connected with the sale of sex toys, lubricants, massage gel, candles.

3. The opponent relies on 40 earlier trade marks consisting of, or including the element **SO... ?** as well as one earlier trade mark consisting of the words **SO YOU** and two earlier marks consisting of the words **SO COSMETICS**. Most of these marks are registered for perfumery, deodorants, body sprays, cosmetics and hair care products in class 3. However, two of the marks (i.e. **SO... ?** and **SO YOU**) are applied for and (in the case of **SO YOU**, registered) in class 25 for clothing and similar products.

4. The opponent claims that (a) the contested mark and the earlier marks are similar, (b) the goods and services covered by the contested mark are the same or similar to the goods covered by 37 of the earlier marks, and there is a likelihood of confusion, including the likelihood of association. This includes the likelihood of association arising from the contested mark being wrongly assumed to a member of the opponent's 'family' of **SO** marks. Therefore, registration should be refused under section 5(2)(b) of the Trade Marks Act 1994 ("the Act").

5. Alternatively, the opponent claims that (a) 13 of the earlier trade marks have a reputation in the UK or EU, (b) use of the contested mark would, without due cause, take unfair advantage or, and/or be detrimental to, the distinctive character or reputation of the earlier marks. The opponent claims that the contested mark will gain an unfair advantage if it is thought to be a member of the opponent's established 'family' of **SO** marks. Conversely, the earlier marks will suffer damage to their distinctive character and reputation, particularly given that the goods/services covered by the contested mark are marketed as sex aids/toys. Further, the opponent claims that this will be the case even if the contested mark is not thought to be a member of the opponent's 'family' of **SO** marks. In that event, the mental link established between the marks will still be sufficient to give the contested mark an unfair advantage and/or to damage the reputation and/or distinctive character of the earlier marks. Registration should therefore be refused under s.5(3) of the Act.

6. The opponent also relies on its common law rights in 14 further unregistered marks consisting of, or including, the element **SO...?** (including **SO...? DIVINE**). According to the opponent, these marks have been used in relation to perfumery, deodorants and/or cosmetics and the opponent has acquired goodwill under them.

The opponent claims that use of the contested mark would constitute a misrepresentation to the public that the user of the mark is connected to the opponent. This would damage the opponent's goodwill. Therefore, use of the contested mark would be contrary to the law of passing off and registration should be refused under s.5(4)(a) of the Act.

Case Management

7. The original notice of opposition was filed on 25th July 2017. It ran to 302 pages. The casework examiner wrote to the opponent on 26th July 2017 stating that the registrar considered that the number of earlier marks and rights relied on by the opponent appeared excessive, unnecessary and disproportionate to any possible benefit. However, the opponent resisted the registrar's request to reduce the volume of earlier marks/rights and instead focus on its best case. It pointed out that its case was based on a large family of marks and submitted that it was for the opponent to decide how best to present its case.

8. A joint hearing was held by teleconference on 12th September 2017 to determine the admissibility of the notice of opposition and any directions relating to it. The hearing was before Mr Matthew Williams, another of the registrar's Hearing Officers. The applicant was represented by Mr Olaf Kretschmar of IP Service International Pty Limited. The opponent was represented by Ms Deborah Selden of Beck Greener. The opponent maintained that it should be allowed to base its case on all 43 earlier marks/rights listed in the notice of opposition. Following the hearing, on 15th September 2017, the Hearing Officer issued a reasoned decision with directions that:

- (i) The opposition proceedings should be separated under Rule 62(1)(h) of the Trade Mark Rules 2008 and dealt with in two parts;
- (ii) The opponent should nominate its best 8 earlier trade marks for the purposes of its s.5(2)(b) case, its best 6 earlier marks for the purposes of its s.5(3) case, and its best 6 earlier rights for the purposes of its s.5(4)(a) case;
- (iii) These would comprise Part 1 of the proceedings, which would proceed as usual;

- (iv) The remainder of the opponent's earlier marks/rights would form Part 2 of the proceedings;
- (v) Part 2 of the opposition would be stayed pending the outcome of Part 1;
- (vi) If the contested mark was wholly refused because of the Part 1 proceedings, the Part 2 proceedings would become redundant;
- (vii) If the contested mark survived the Part 1 proceedings, in whole or in part, the opponent should consider the reasons why the Part 1 proceedings had failed, or partly failed, and re-evaluate whether it had any better case under Part 2;
- (viii) If it decided that it did have a better case, it could apply for the stay of the Part 2 proceedings to be ended.

9. The Hearing Officer accepted that it was reasonable to rely on a larger than usual number of earlier marks where it is claimed that, although different, they constitute a 'family' of earlier marks with common distinctive elements. However, he pointed out that there were diminishing returns from the time and cost involved in preparing and considering the evidence required to establish a family of 30+ marks compared to a 'family' of (say) 8 marks. He rejected the opponent's submission that the proposed restriction on the opponent's case amounted to the registrar dictating how the opponent should plead its case. Rather, he decided that it was a matter of determining the best way to manage the case after taking account of the interests and resources of both parties, the Registry, and by extension other users of the system.

10. The Hearing Officer drew the opponent's attention to the requirement in the caselaw that to be members of a 'family' of marks, the marks must be "*present on the market.*" And he pointed out that for the purposes of opposing a UK application, the most relevant market is the UK market.

11. The opponent subsequently nominated its best-case earlier marks/rights in accordance with the directions and the proceedings were separated accordingly. The Part 1 notice of opposition was served on the applicant.

12. The applicant filed a counterstatement denying the grounds of opposition. I note that the applicant:

- (i) Required the opponent to provide proof of use of 7 of the earlier trade marks (4 EU marks and 3 UK marks) which, because of the age of the registrations, were subject to statements of use;
- (ii) Pleaded that the punctuation in the earlier **SO...? [Blank]** marks played an important part in the distinctive character of those marks, which is absent from the contested mark (and from the opponent's **SO YOU** mark);
- (iii) Contended that the figurative elements of the contested mark are an important aspect of that mark and, partly because of this, the contested mark is visually dissimilar to the earlier marks;
- (iv) Contended that the goods/services covered by the contested mark are selected visually;
- (v) Denied that the earlier **SO...? [Blank]** marks had been used and acquired a reputation/enhanced distinctive character in relation to cosmetics, even if that is the case with perfumes and dry shampoos;
- (vi) Denied that the goods in classes 5 or the 10 of the application are complementary or otherwise similar to the opponent's goods in class 3;
- (vii) Relied on the co-existence of the opponent's marks and the applicant's word mark **SO DIVINE** as showing that there is no likelihood of confusion or other detriment to the earlier marks.

13. This decision covers Part 1 of the opposition proceedings.

The evidence

14. The opponent's evidence consists of two witness statements by Mr Karim Gangji (with 19 exhibits), two witness statements by Ms Deborah Selden (with 6 exhibits) and a witness statement by Ms Petrina Moore (with 1 exhibit).

15. Mr Gangji is the director of Incos Limited, the opponent's exclusive licensee in the UK and EU. Ms Moore is an employee of Incos Limited. Since August 2016 she

has been responsible for search engine optimisation and digital marketing of the exclusive licensee's goods. Ms Selden is a trade mark attorney.

16. The applicant's evidence consists of a witness statement by Mr Andrew Robert Wills with 14 exhibits and a witness statement by Mr Olaf Kretzschmar with 11 exhibits.

17. Mr Wills is a director of the applicant. Mr Kretzschmar is the director of One IP International Pty Limited, which represents the applicant in these proceedings.

18. I have read all the evidence.

Representation

19. Neither side asked to be heard on the substantive issues. However, both sides have filed extensive written submissions, which I have considered.

The opponent's marks which were "*present on the market*" at the relevant date

20. A major part of the opponent's case is that it has a 'family' of **SO** marks. I will therefore start by assessing which of the opponent's marks were present on the market at the relevant date, and therefore capable of constituting a 'family'. The requirement that to be protected as a 'family' of marks the earlier marks must be "*present on the market*" comes from the judgment of the Court of Justice of the European Union ("CJEU") in *Il Ponte Finanziaria SpA v OHIM*.¹ The relevant average consumer for the purposes of the opposition is a UK consumer. Accordingly, the relevant market is the one known to the UK consumer, which is mainly the UK market for the goods covered by the earlier marks. The relevant date for assessing the s.5(2) and s.5(3) grounds is the date of filing of the application to register the contested mark, i.e. 10th April 2017. The question is therefore which of the earlier marks were recognised as being on the market at that date.

¹ Case C-234/06 at paragraphs 63 to 66 of the judgment

21. Answering this question should also resolve the question as to whether the 7 earlier marks that are subject to proof of use have been shown to have been put to genuine use in the UK or EU markets during the 5-year period specified in s.6A of the Act. However, I will keep in mind that (a) the relevant period for this purpose (22nd April 2012 to 21st April 2017) ends slightly later than the relevant date for assessing the s.5(2) and s.5(3) grounds, and (b) the requirement to show use of the earlier EU marks relates to the EU market.

22. The earlier trade marks on which the opponent bases Part 1 of the proceedings are as follows:

Earlier mark	Proof of use?	Goods relied on under s.5(2):	Goods relied on under s.5(3)
EU485078 SO...?	YES	Class 3: Toilet preparations; preparations for use in the shower and the bath; toilet soaps; fragrances; aftershaves, creams, gels, and lotions; cosmetics; eau de cologne; toilet waters; hair styling products; anti-perspirants; deodorants for personal use.	Class 3: Perfumes; fragrances; toilet waters; deodorants for personal use;
EU7237671 SO...?	YES	Class 25: Clothing; footwear; headgear; T-shirts; caps.	None
EU7055239 SO...? ETERNAL	YES	Class 3: Hair care preparations; perfumery; perfumed body spray; eau de toilette; cosmetics; personal care deodorants; body lotion; shower gel.	Class 3: Perfumery; perfumed body spray; eau de toilette; personal care deodorants.
UK2602397 SO...? LOVELY	NO	As above	None
UK2642838 SO...? FABULOUS	NO	Class 3: Hair care products; perfumery; perfumed body spray; eau de toilette; cosmetics; personal care deodorants; body lotion; shower gel; dry shampoo; hair care shampoo; hair care conditioner.	None
UK2155752	YES	Class 3: Toilet preparations; perfumes, toilet waters;	Class 3: Perfumes, toilet waters,

SO...? DESIRABLE		fragrances; cosmetics; preparations for the hair; deodorants;	fragrances, deodorants.
UK2642811 SO...? GLAMOROUS	NO	Class 3: Hair care products; perfumery; perfumed body spray; eau de toilette; cosmetics; personal care deodorants; body lotion; shower gel; dry shampoo; hair care shampoo; hair care conditioner.	None
EU12442811 SO YOU	NO	Class 25: Clothing; footwear; headgear; T-shirts; caps.	None
UK2259592 SO...? KISS ME	YES	None	Class 3: Toiletries; haircare products; perfumery, cosmetics, deodorants.
UK2408599 SO...? SUPERSTAR	YES	None	Class 3: Perfumery, deodorants.
EU5530993 SO...? SENSUAL	YES	None	Class 3: Perfumery, perfumed body spray, eau de toilette, personal care deodorants.

23. Mr Gangji's evidence is that his company sells a range of cosmetic and fragrance goods in the EU, including toiletries, hair care products, dry shampoo, perfumery, cosmetics, deodorants, fragrances, body mists, body lotions, shower gels and body butters.

24. In "*certain countries*" in the EU, the opponent supplies the goods directly to retailers. However, in other EU countries they are supplied via an intermediary distributor, one of which is Sogen Limited.

25. Mr Gangji says that perfumery products, including eau de toilette and deodorants bearing the **SO...?** mark were launched in 1994 by a company called Yardley & Company. This was followed in 1997 by **SO...? DESIRABLE** and other **SO...?** [blank] marks and in 1998 by a range of men's fragrances, deodorants and bath and shower products under the marks **SO...FOR HIM**, **SO...MAX FOR HIM** and **SO...COMICAL FOR HIM**.

26. In late 1998, the opponent acquired the trade marks and goodwill of Yardley and Company. In that year, Incos Limited sold over £3m worth of products in the UK and Ireland under the **SO...?** or **SO...? [blank]** marks. These goods were aimed at women in their late teens and early twenties. Additionally, the company sold over £1.3m worth of products from its men's range under the marks shown in the preceding paragraph.

27. According to Mr Gangji, the opponent has launched between 70 - 80 products since 1999 under **SO** marks, as well as over 100 different gift sets comprised of individual products bearing the **SO...?** mark, or a variation of that mark. Mr Gangji provides annual sales figures for various products sold under these marks in the EU between 2008 and 2013. He also provides sales figures for products sold in the UK over the whole period between 1st November 2012 and 31st October 2017.² The EU figures show that in 2012 the opponent sold 8252 products in the EU bearing the mark **SO...? DESIRABLE**.

28. The following figures show the sales of products in the EU in 2013:

Trade mark	No. of products sold
SO...? KISS ME	1.7m
SO...?	1.25m
SO...? SUPERSTAR	229k
SO...? ETERNAL	130k
SO...? SENSUAL	35k
SO...? LOVELY	28k
SO...? FABULOUS	24k
SO...? GLAMOROUS	24k
SO...? DESIRABLE	4394

29. I note that between 2008 and 2013 there were no recorded sales of any products bearing the marks **SO...FOR HIM**, **SO...MAX FOR HIM** and **SO...COMICAL FOR HIM**. However, in 2013 there appears to have been sales of around 5.5k products in the EU under the marks **SO...HIM**, **SO...MAX**, **SO...CHILLED** and **SO...HARD**.

² See exhibit KG-1

30. The sales figures for the UK covering the whole period 1st November 2012 to 31st October 2017 are:

Trade mark	Approximate No. of products sold
SO...? KISS ME	6.4m
SO...?	5.5m
SO...? [mixed sets]	1.8m
SO...? SUPERSTAR	614k
SO...? ETERNAL	453k
SO...? FABULOUS	97k
SO...? LOVELY	80k
SO...? GLAMOROUS	15k
SO...? SENSUAL	14k
SO...? DESIRABLE	4k

31. I note that the UK figures also include the sale of 5580 products under the mark **SO...HIM**. These are the only recorded sales of the opponent's products in the UK under a **SO** mark which does not contain a '?'.

32. Mr Gangji states that all the **SO...? [blank]** branded products marketed since 2007 also bear the mark **SO...?** alone, at least on the reverse of the packaging.³

33. A representative sample of invoices for these goods are in evidence.⁴ The most relevant invoices date from the five-year period prior to the date of filing of the contested mark. There are 27 invoices in this date range.⁵ Nearly all are addressed to customers in the UK. So far as I can tell from the descriptions of the goods, the sales in this period were generally of body fragrances, body sprays and eau de toilette. However, there is also evidence of the marketing in 2016 of body lotions and shower gels under the mark **SO...? KISS ME**.⁶ I also note that there were sales of

³ Some examples are in exhibit KG-2

⁴ See exhibit KG-3

⁵ See pages 17-43 of KG3

⁶ See exhibit KG-4 at page 17 of the evidence

commercial quantities of dry shampoo under the marks **SO...? LOVELY** and **SO...? FABULOUS** on 7th March 2017 to a company in the Netherlands.⁷

34. According to Mr Gangji, the opponent's goods are available in over 6000 shops in the UK and nearly 3800 shops elsewhere in the EU. The UK outlets include Boots, Superdrug, Lloyds the chemists, Sainsbury's, Tesco, Asda, Morrison's, Wilkinson's, Poundland and Sports Direct.

35. Mr Gangji provides information about the amount spent promoting the opponent's goods in the EU. This is normally in the region of £1.5m – £2m per annum. Most of this is spent on promotions and in-store marketing. In 2016, around £140k was spent on advertising the opponent's various **SO...?** branded goods in the EU. No separate figures are in evidence for the UK. However, Mr Gangji says that his company frequently places advertisements promoting the **SO...?** brand in EU and UK publications aimed at young women, including Closer (circulation 223k), Women's Own (circ' 185k), Red (circ' 184k), Love It! (circ' 82k), Top of the Pops (circ' 50k), Shout (circ' 37k), Yours (circ' 254k), Heat (circ' 136k), The Sun (circ' 1.5m) and The Star on Sunday (circ' 136k).

36. Mr Gangji also provides evidence about the coverage given to **SO...?** branded goods by magazines. For example, Bliss magazine ran a piece in September 2012 featuring the celebrity Gwen Stephani and **SO...? SUPERSTAR** perfume. Hair ideas ran a hair styling guide explaining how to create three hairstyles with the assistance of **SO...?** dry shampoo. The same product appeared in Shout magazine in April/May 2014. **SO...?** branded goods are also promoted through competitions in magazines. For example, Mizz magazine ran a competition in August 2012 to become the face of **SO...?** fragrance.

37. The Superdrug Christmas Gift Guide of 2012 included **SO...?** branded gift sets, featuring eau de toilette and lip balms.⁸ In his second statement, Mr Gangji states that over 2m lip balms were sold in the UK under **SO...? [blank]** marks between

⁷ Mr Gangji says that although the brands are listed as "So Lovely" etc. on the invoices, the actual goods carried the marks as registered, i.e. **SO...? LOVELY** etc.

⁸ See exhibit KG-2

2010 and 2016. Additionally, around 30k of the gift sets sold in the UK in 2016 under the marks **SO...?**, **SO...? SINFUL** and **SO...? KISS ME** included nail varnishes.

38. The **SO...?** branded goods are also promoted through internet sites and through social media. According to Ms Moore's evidence, online marketing of the exclusive licensee's goods is of increasing importance. She says that "*in the past*" the company's website sofragrance.com had over 45k registered subscribers with up to 30k individual visits per month. Mr Moore also provides figures for the number of followers of the company's Facebook, Twitter and Instagram accounts (79k, 15k and 19k, respectively), but these figures reflect the position in June 2018, whereas the relevant date is over a year before.

39. Mr Gangji's evidence is that the opponent's goods have also been promoted through TV and radio advertising, but this appears to have been between 2006 – 2008 and therefore a long time prior to the relevant date. Mr Gangji also provides information about the promotion of **SO...?** body mist on public transport. However, this appears to have started in July 2017 and therefore postdates both the relevant date and the end of the period for showing genuine use of some of the earlier marks.

40. According to Mr Gangji, the **SO...?** branded goods have won awards. For example, **SO...? BRIT** won Best Self Select Fragrance at the Pure Beauty Awards in 2012 and **SO...? SEXY** was nominated for the same award the following year. In 2015, **SO...? COUTURE** won a silver medal in the same category.

41. Mr Gangji also says (in his statement dated January 2018) that his company had "*recently*" introduced a range of fragranced dry shampoos under the marks **SO...? VA VA VOOM**, **SO...? FABULOUS**, **SO...? GLAMOROUS** and **SO...? LOVELY**. I note that this was 9 months after the relevant date.⁹

42. There is no evidence that **SO...?** (or any variant mark) was in use or "on the market" in relation to clothing at the relevant date, or during the relevant period for the purpose of s.6A. Mr Gangji mentions that T-shirts were "*sent out*" in 2008 to

⁹ And also, well after the 5-year period for showing use of the earlier marks subject to proof of use.

promote the launch of a **SO...? ETERNAL** product, but (a) there is no evidence of any trade in T-shirts, and (b) this was long before the relevant date/relevant period.

43. I accept Mr Gangji's evidence that the **SO...?** mark has been used as a house mark on all its class 3 products since 2007 in addition to forming part of its individual product marks, such as **SO...? KISS ME**.

44. The evidence shows that the fragrances, eau de toilette, body sprays, dry shampoos, lip balms and nail varnishes were sold under the **SO...?** mark in the UK during the five-year period preceding the relevant date.

45. The following table sets out my findings on the marks that have shown to be present on the market at the relevant date (and likely to be known to UK consumers). Additionally, I have also shown which marks have been shown to have been put to genuine use in the UK or EU, as appropriate, during the relevant 5-year period.

Earlier mark	Goods for which shown to be present on the UK market	Proof of use in the UK or EU
EU485078 SO...?	Class 3: Shower gels; fragrances; body lotions; eau de toilette; dry shampoos; deodorants for personal use; lip balms; nail varnishes.	Class 3: Shower gels; fragrances; body lotions; eau de toilette; shampoos; deodorants for personal use; lip balms; nail varnishes.
EU7237671 SO...?	Class 25: None	Not required
EU7055239 SO...? ETERNAL	Class 3: Perfumery; perfumed body spray; eau de toilette; personal care deodorants.	As previous column
UK2602397 SO...? LOVELY	As above	Not required
UK2642838 SO...? FABULOUS	As above	Not required
UK2155752 SO...? DESIRABLE	None	Class 3: Perfumes, eau de toilette, fragrances, deodorants.
UK2642811 SO...? GLAMOROUS	Class 3: Perfumes; perfumed body spray; eau de toilette; personal care deodorants.	Not required

EU12442811 SO YOU	None	Not required
UK2259592 SO...? KISS ME	Class 3: Shower gel; dry shampoo; perfumes, lip balm, deodorants; eau de toilette; body lotions; nail varnishes.	Class 3: Shower gel; shampoo; perfumes, lip balm, deodorants; eau de toilette; body lotions; nail varnishes.
UK2408599 SO...? SUPERSTAR	Class 3: Perfumery, deodorants.	Class 3: Perfumery, deodorants.
EU5530993 SO...? SENSUAL	Class 3: Perfumery, perfumed body spray, eau de toilette, personal care deodorants.	As previous column.

46. The evidence shows that 8250 sales of products bearing the mark **SO...? DESIRABLE** took place in the EU in 2012 and that the level of such sales reduced to 4394 in 2013. The figures provided for the UK for the whole period 1 November 2012 to 31st October 2017 show 4013 sales under the mark. As the UK is part of the EU it follows that these sales are included in the EU sales for 2012 and 2013. The EU figures could therefore cover all the UK sales. This means that the evidence does not show that there were any (or any significant) sales of products bearing the **SO...? DESIRABLE** after 2013. Therefore, I do not therefore accept that that mark was “present on the market” at the relevant date.

47. Nevertheless, I accept that the opponent had a ‘family’ of marks present on the UK market at the relevant date. This ‘family’ consisted of **SO...?, SO...? KISS ME, SO...? SUPERSTAR, SO...? ETERNAL** and (on a lesser scale) **SO...? FABULOUS, SO...? GLAMOROUS, SO...? LOVELY** and **SO...? SENSUAL**.

48. In deciding whether the evidence shows genuine use of the earlier marks (where required) I have considered the case law of the CJEU as summarised by Arnold J. in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*.¹⁰

49. In deciding upon fair specifications of goods for the purposes of s.6A(6) of the Act I have applied the established case law, particularly (by analogy) *Property*

¹⁰ [2016] EWHC 52

Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors,¹¹ in which Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not

¹¹ [2016] EWHC 3103 (Ch)

constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;

Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

50. In my view, the descriptions I have used to set out the goods for which the **SO...?** marks have been used are fair descriptions of the use shown, except in relation to dry shampoos. I find that these are just a variation of shampoos and an average consumer would regard them so. Consequently, I consider that the opponent’s marks are, where appropriate, entitled to protection for just ‘shampoos’.

51. The opponent submits that perfumes, body lotions, eau de Cologne, deodorants and shampoos are cosmetics and that, along with the use of some of the earlier marks in relation to lip balms and nail varnishes, this justifies the protection of the marks in relation to ‘cosmetics’. In this connection, the opponent relies on (a) the definition of cosmetics in article 1.1 of EU Council Directive 76/768/EEC, and (b) the interpretation of that term by the EUIPO.

52. As regards the EU Directive, I note that its main purpose is stated as being the protection of public health. The Directive requires regulation of any substance intended to be placed in contact with the human body and mainly or wholly intended to clean, perfume, change the appearance of, correct the odour of, or maintain the condition of, the relevant part of the part of the body. The word ‘cosmetic’ is used (subject to various listed exceptions) as a catch-all term to cover substances applied to the exterior of the body and the oral cavity. By contrast, I note that the English Oxford Dictionary defines a cosmetic as something “*serving to improve the appearance of the body, particularly the face.*” In my view, that accords with the ordinary meaning of the word.

53. As regards decisions of the EUIPO, whilst I have noted these, they do not support the adoption of the very broad definition of 'cosmetic' in the EU Directive. Further, they are not binding on me.

54. I therefore adopt the meaning given in the dictionary. I find that perfumes, body lotions, eau de Cologne, deodorants and shampoos do not fall within the natural and ordinary meaning of 'cosmetics'. I accept that lip balms and nail varnishes are cosmetics. However, these are distinct sub-categories of cosmetics and do not justify protection of the still-broad term 'cosmetics'.

The section 5(2)(b) ground of opposition

55. 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”.

56. I will start by considering the opponent's marks individually before returning to the case based upon its 'family' of marks. So far as the first exercise is concerned, it is only necessary to consider the earlier marks EU485078 **SO...?** (one of the opponent's two closest marks, which also has one of widest protectable specifications), UK2155752 **SO...? DESIRABLE** (the opponent's other closest mark) and EU7237671 **SO...?**, (one of two earlier marks entitled to protection - subject to its eventual registration¹² - in class 25). If the opposition fails on these marks, the opponent will be no better off with any of the other earlier marks. This is because they are less similar to the contested mark than the marks identified above.

¹² EU7237671 has been pending at the EUIPO since 2008.

Identity and similarity of goods/services

57. The respective goods are set out below.

Goods covered by earlier marks	Goods/services of the contested mark
<p>EU485078 SO...?</p> <p>Class 3: Shower gels; fragrances; body lotions; eau de toilette; shampoos; deodorants for personal use; lip balms; nail varnishes.</p> <p>EU7237671 SO...?</p> <p>Class 25: Clothing; footwear; headgear; T-shirts; caps.</p> <p>UK2155752 SO...? DESIRABLE</p> <p>Class 3: Perfumes, eau de toilette, fragrances, deodorants.</p>	<p>Class 3: Soaps; perfumes, essential oils, cosmetics, hair lotions, body lotions, massage oils, massage lotions, shower gels, massage creams, bubble baths, body powders, body paints, lip balms, depilatory preparations.</p> <p>Class 5: Lubricant substances for use on the penis, anus or vagina; preparations for arousing sexual desire or improving sexual performance; preparations, potions, aphrodisiacs and herbs for medicinal purposes; nutritional preparations; tampons.</p> <p>Class 10: Massage devices; devices for massaging, vibrating or stimulating the body; devices for aiding copulation, masturbation and sexual arousal, including synthetic reproductions of parts of the male and female anatomy, synthetic reproductions of penises and vaginas, penis rings, nipple clamps, vibrators, dildos, dongs, butt plugs, penis sleeves, penis extensions, harnesses, masturbators, body prostheses, love dolls; vaginal exercisers; condoms.</p> <p>Class 25: Clothing, footwear, headgear; erotic lingerie; fantasy clothing of leather or latex, body suits, belts, uniforms, straps, hoods, masks, blindfolds, gags.</p> <p>Class 35: Retail services, mail order retail services, online retail services connected with the sale of sex toys, lubricants, massage gel, candles.</p>

58. The earlier marks cover *perfumes, body lotions, shower gels* and *lip balms*. The same goods are covered by the contested mark. These goods are therefore literally

identical. According to the caselaw¹³ the goods can also be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark. Looked at in this way, *essential oils* are identical to *fragrances*, *cosmetics* are identical to *lip balms* and *nail varnishes*, and *body powders* are identical to *deodorants for personal use*.

59. Turning to the similarity of the respective goods/services, I remind myself of the guidance of the CJEU in *Canon*¹⁴ 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”.

60. The opponent's *shower gels* and the applicant's *soaps* plainly serve the same purpose, are used in the same way, and are competitive products. They are clearly highly similar goods. *Fragrances* covers essential oils, which are clearly highly similar to the applicant's *bubble baths*. The applicant's *hair lotions* are used to style or strengthen the hair. These are very similar to the opponent's *shampoos*, which are also used on the hair, are similar in nature, applied in the same way, and often serve a complementary purpose. The applicant's *massage oils*, *massage lotions* and *massage creams* are highly similar to, and applied to the body in the same way as, the opponent's *body lotions*. These goods are also similar in nature. Additionally, although *massage lotions etc.* have the specific purpose of relaxing the person to whom they are applied, they often also serve to fragrance the body, e.g. aromatherapy lotions. These are therefore also highly similar goods. Words used in

¹³ See, for example, *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court, at paragraph 29 of the judgment

¹⁴ Case C-39/97

trade mark specifications should be given their natural or ordinary meaning.¹⁵ Therefore, although it would be possible to argue that *body lotions* cover the applicant's *depilatory preparations*, I do not think it does. In my view, a *body lotion* is typically used to describe a lotion used to moisturise and/or fragrance the body. The purpose of these goods is therefore different. However, they can be similar in nature and could be complementary (in the sense that a body lotion may be applied after a *depilatory preparation* has been used). In my view, these goods are similar to a medium degree. Similarly, the applicant's *body paints* are not identical to the opponent's *lip balms* and *nail varnishes*. However, they are all used to decorate the body and are therefore similar to a medium degree.

61. All the goods in class 25 covered by the contested mark are identical to the goods covered by EU7237671.

62. As regards the goods in classes 5 and 10 of the contested application, the opponent argues that these are similar to the goods covered by class 3 of the earlier marks on the basis that (a) they are sold through the same outlets, and (b) they are complementary goods. In support of these points the opponent filed evidence¹⁶ showing that in January 2018 the website of Superdrug:

- (a) included a microsite promoting sexual health products, including condoms, lubricants, male enhancement pills, adult toys & vibrators and emergency contraceptives;
- (b) had separate pages promoting fragrances, make-up and skincare products;
- (c) all the above pages could be accessed from a link on the home page entitled 'Valentine's'.

63. The applicant denies that the goods are similar.

64. Firstly, I note that Superdrug is a very large high street UK retailer. I do not accept that the range of goods available from Superdrug can be taken as

¹⁵ See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was).

¹⁶ See the first witness statement of Deborah Selden and exhibit DS3

representative of the channels through which the goods at issue normally reach the consumer. Secondly, the goods mentioned in the opponent's evidence are shown on different sections of the website and would (where stocked) normally appear on different shelves of a physical store. Thirdly, none of the goods shown in the opponent's evidence are branded as Superdrug goods. They all carry third party marks.

65. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM),¹⁷ 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".

66. The purpose of examining whether there is a complementary relationship between goods is to assess whether the relevant public are liable to believe that the same undertaking (or an economically connected undertaking) is responsible for them. At most, the opponent's evidence shows that the respective class 3 and class 5/10 goods may be sold by the same retailer. That does not establish that the public would expect the undertaking responsible for any sex toys or lubricants sold at Superdrug to be also responsible for any of the fragrances and make-up sold by that retailer. I do not accept that the respective goods are complementary in the sense described in the caselaw (or in any other way).

67. With one exception, I see no similarity at all between the opponent's class 3 goods and any of the goods covered by classes 5 and 10 of the contested application. The exception is *lubricant substances for use on the penis, anus or vagina* in class 5 of the contested application, which appear to be similar in nature and, to a certain extent, method of use, to *body lotions* in class 3. However, the purposes of the goods are different (the one being a fragrance/moisturiser, the other

¹⁷ Case T-325/06

being a sex aid), they are not in competition or complementary and would not normally be sold side-by-side. In my view, these goods are similar to only a low degree.

68. It follows that I see no similarity between the opponent's goods in class 3 and the services in class 35 of the contested application, except for services relating to the marketing of *massage gels*. As I noted earlier, these goods are highly similar to *body lotions*. Although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods and therefore similar to a degree.¹⁸ Further, this does not mean that goods can only be regarded as similar to retail services where the retail services relate to exactly the same goods as those for which the other party's trade mark is registered.¹⁹ It may be sufficient that they are goods of the same kind. Therefore, whilst recognising that the applicant's services in class 35 do not cover *massage gels* as such, I find that the services are complementary to *body lotions* and *fragrances* because the respective services and goods could be those of the same undertaking, i.e. a retailer of *massage gels* might also offer own-brand *body lotions* and/or *aromatherapy fragrances*. However, given the differences between the respective goods/services, I find that the degree of similarity is low.

Average consumer

69. 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.²⁰

70. I find that the average consumer of the goods/services at issue is a member of the general public. The goods at issue may be sold at a range of prices, some of which are quite modest. Therefore, as the opponent submits, it would be inappropriate to assume that the average consumer will pay any more than a normal degree of attention when selecting the goods/services at issue.

¹⁸ See *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57 of the judgment of the General Court.

¹⁹ See *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person.

²⁰ See the judgment of the CJEU in *Lloyd Schuhfabrik Meyer*, Case C-342/97

Distinctive character of the earlier marks

71. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,²¹ 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).”

72. Considering first the inherent distinctive character of the mark **SO...?**, I note that ‘so’ may be used as an intensifier, as in ‘so happy’. However, when used in the form of the mark the word naturally interacts with the question mark symbol which follows it giving ‘so’ (and the mark as a whole) the meaning and significance of a question.

²¹ Case C-342/97

The inclusion of ‘...’ between the word **SO** and the ? symbol suggests that the question relates to a missing word or words. Viewed like this, the earlier mark is not descriptive of the goods for which it is protected. I find that it has a normal degree of inherent distinctive character.

73. Turning to **SO...? DESIRABLE**, I find that the meaning conveyed to average consumers is less clear. The first element of the mark has the same meaning as discussed in the previous paragraph. However, the addition of the word **DESIRABLE** may lead a significant proportion of consumers to (also) treat **SO** as an intensifier relating to the meaning of **DESIRABLE**. The meaning of that word is obvious and plainly descriptive of the quality of perfumes etc., as well as the intended purpose of such goods, i.e. to make the user desirable to others. Accordingly, if the earlier mark is understood as being, essentially, SO DESIRABLE, that is *prima facie* descriptive of the goods in class 3. This means that those words have little or no inherent distinctiveness. It does not follow that consumers who see this descriptive meaning will therefore ignore the presence of the intervening ...? punctuation. Rather, such consumers would regard it as odd punctuation in the middle of an apparent description. Therefore, regardless of whether the consumer sees the mark **SO...? DESIRABLE** as **SO...?** followed by a descriptive word and/or SO DESIRABLE with an odd looking ...? in the middle, the punctuation makes an important contribution to the inherent distinctive character of the earlier mark. Considering the matter in the round, I find that the degree of resemblance between the mark and the descriptive term SO DESIRABLE is sufficiently high that this mark has a below average degree of inherent distinctive character.


74. The opponent has plainly used the **SO...?** mark and various derivative marks on a substantial scale prior to the relevant date. There is no evidence as to the share of the market held by the earlier marks. Further, although significant, the amount spent promoting and advertising the marks in the UK and EU does not appear exceptional in relation to the size of the market for the goods in class 3. Therefore, although I accept that the **SO...?** mark had acquired an enhanced degree of distinctiveness by the relevant date, the evidence does not establish that it was a market leading product or in the household name category. I therefore find that the earlier mark was above average in distinctiveness to UK consumers at the relevant date in relation to

perfumes, fragrances and deodorants, but not at the very highest level of factual distinctiveness.

75. The opponent appears to have used the **SO...? DESIRABLE** mark on a substantial scale in the past, but there appears to have been very little use of it in the UK in the 5-year period preceding the relevant date. Consequently, I do not consider that the opponent has shown that the mark had a highly distinctive character at the relevant date. Of course, the use and recognition of the **SO...?** mark will also have enhanced the distinctive character of **SO...? DESIRABLE**. However, in those circumstances, the enhancement to the distinctiveness of the mark will be the result of the extra distinctiveness consumers attach to the **SO...?** element. Even taking this into account, given the resemblance of the mark to the description SO DESIRABLE, I find that the earlier mark (as a whole) was no more than averagely distinctive at the relevant date.

Comparison of marks

76. The marks are set out below.

Earlier marks	Contested mark
<p>SO...?</p> <p>SO...? DESIRABLE</p>	

77. The CJEU stated in *Bimbo SA v OHIM*²² 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.”

²² At paragraph 34 of its judgment in Case C-591/12P

78. The opponent submits that there is a high degree of visual similarity between the marks. It points out that (the word element of) both marks begin with the word SO. Additionally, in the case of **SO...? DESIRABLE**, the second word in the marks begin and end with the same letter. The opponent argues that consumers will attach limited importance to the punctuation element of the earlier marks, seeing the second mark as, essentially, SO DESIRABLE, which looks similar to SO DIVINE. As regards the figurative element of the contested mark, the opponent submits that heart shaped devices are common and consumers would not look at the device closely enough to notice that the heart is made up of an arrangement of dildos.

79. The applicant points out that the SO element of the contested mark is comprised of the letter S “wrapped around” the letter O. This has a visual impact which distinguishes the SO elements of the respective marks. The applicant accepts that the words DESIRABLE and DIVINE have some degree of similarity, but it points out that DESIRABLE is a longer word than DIVINE. Further, although they both begin with ‘D’ and end with ‘E’, all the other letters are different or in a different position. Additionally, the applicant submits that the punctuation in the earlier marks makes an important contribution to the visual impact of those marks. Therefore, it would not be overlooked, or make only a negligible impact, in the overall visual impression created by those marks. The applicant further submits that the figurative elements of the contested mark makes a major contribution to the visual impact created by the mark. This is so whether or not the heart device is recognised as being made up of coloured dildos.

80. The heart device is self-evidently much more than just a picture of a dildo (which I accept would be descriptive for sex toys). It is the most visually dominant feature of the contested mark. Therefore, I accept the applicant’s submission that the heart device is a distinctive and dominant element of the mark, which has no counterpart in the opponent’s marks.

81. I also accept the applicant’s submission that the stylisation of the letters SO in the contested mark contributes to the visual impression created by that mark, although not so much as to make it difficult to recognise the letters SO.

82. I have already explained why I regard the punctuation in the earlier marks as making an important contribution to the distinctive character of those marks, including their visual impact. The presence/absence of that punctuation is therefore a further point of visual distinction between the marks.

83. I accept the opponent's submission that the first (or only) word element in the respective marks is the word SO. As a general rule, the beginnings of word marks make more of an impression than the endings. However, this is not always the case.²³ The contested mark is not, of course, a word mark but a composite mark in which the figurative elements will strike the user at the same time as the word elements. Additionally, whilst the general rule about the beginnings of word marks making more of an impact on consumers than the ends makes perfect sense when the mark is a word, such as MUNDICOR²⁴, it has less weight where the common word element is very common word like SO. I accept the opponent's submission that the words in the contested mark would be read as SO DIVINE and the words in the opponent's second mark would be seen by a significant proportion of average consumers as SO DESIRABLE (with odd punctuation). I therefore accept that there is a certain degree of similarity between these words as they appear in the marks.

84. However, considering the marks as wholes, I find that there is a low degree of visual similarity between the earlier marks and the contested mark.

85. The figurative elements of the contested mark are unlikely to be verbalised. Therefore, the contested mark is likely to be expressed as SO DIVINE. The applicant submits that the earlier marks are likely to be pronounced as 'SO' said with "rising intonation" or SO spoken like that and followed by DESIRABLE (DEE-ZIRE-AB-UL). The opponent disputes this. According to Mr Gangji, no one he knows verbalises the earlier marks like this.

²³ See, for example, the judgment of the General Court in *CureVac GmbH v OHIM*, case T-80/08

²⁴ To cite an example from the caselaw of the General Court: see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

86. The gist of the applicant's point is that the punctuation will lead consumers to verbalise **SO...?** in the way that SO would sound when used to pose a question or a challenge. There is no evidence from consumers, but I accept that a significant proportion of average consumers would, if they had reason to verbalise the mark, pronounce it as suggested by the applicant. Having said that, this is a relatively subtle difference and I do not attach much weight to it. The main aural difference between the **SO...?** mark and the contested mark is that the latter includes a second word DIVINE. That word has two syllables: DEE-VINE. Therefore, the earlier mark **SO...?** is composed of a single syllable, whereas the contested mark has three syllables. Consequently, even accepting that the first syllable of the contested mark is the same as the earlier mark, the marks as whole are aurally similar to only a moderate degree.

87. **SO...? DESIRABLE** has five syllables SO-DEE-ZIRE-AB-UL. It is possible that the punctuation in the earlier mark will cause a proportion of average consumers to make a brief pause between the first and second syllables. Again, I do not attach much weight to this. SO DIVINE has three syllables: SO-DEE-VINE. The first two syllables are the same as the earlier mark, but the following syllables are different and the earlier mark is longer. Overall, the marks are aurally similar to a medium degree.

88. I find that the concept of the **SO...?** mark is one of a question (or challenge). By contrast, the words SO DIVINE in the contested mark are laudatory. There is no conceptual similarity. The heart device may add a second concept to the mark, one of love (although as the heart is formed of dildos, not necessarily in the emotional sense). Whether or not that is so, the marks are conceptually dissimilar.

89. The opponent submits that the average consumer "*would interpret the mark applied for as meaning "absolutely heavenly" or words to that effect.*" According to the opponent, this is plainly similar to the meaning of **SO...? DESIRABLE**. The opponent provided extracts from Collins Dictionary which shows that one of the meanings of DIVINE is 'splendid; perfect'. I accept that this is the meaning conveyed by the word DIVINE in the contested mark. The same dictionary indicates that DESIRABLE means 'worthy of desire or recommendation'. If SO acts as an

intensifier, then SO DIVINE means 'very splendid or perfect' and SO DESIRABLE means 'very worthy of desire or recommendation'.²⁵ DIVINE and DESIRABLE have different specific meanings. The similar concept comes from the fact that SO DIVINE and SO DESIRABLE are both laudatory statements, particularly when used in relation to beauty and personal care products in class 3. Therefore, although I accept that there is a degree of conceptual similarity between these marks, the similar concept is not a distinctive one. Rather, the word elements of the marks have a similar descriptive and laudatory concept.

Likelihood of confusion

90. 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;

²⁵ This accords with my earlier assessment of the low degree of inherent distinctive character of that mark.

(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.

91. The applicant submits that the goods are selected mainly by eye. Therefore, the look of the respective marks is more important than the way they sound. In support of this submission, the applicant points to the opponent's evidence showing that the goods are marketed from in-store displays and catalogues.

92. The opponent contends that both parties' goods are sold on-line and that its own goods are marketed via social media. In this connection, the opponent relies on the evidence of Ms Petrina Moore. Ms Moore says that because the '?' symbol is an instruction to the server, i.e. to signal a query, it is not possible to use the symbol as part of the name of a website. Consequently, the opponent's website is sofragrance.com (not so...? fragrance.com). Its social media sites are similar. Thus, if the search string 'So...?' is entered in a search engine, the results are the same as if the user had searched on just 'So'.

93. I accept Ms Moore's evidence for what it is worth. However, I do not see that it detracts from the applicant's submission that the selection process is mainly a visual one. Once a user reaches the parties' websites etc. they will see the marks at issue and make their selection based on those marks, including the punctuation which is part of the opponent's marks and the figurative elements of the contested mark. Proceeding otherwise would offend the requirement to assessment of the likelihood of confusion based on normal and fair use of the marks at issue (not parts of those marks).²⁶ Further, the comparison is between the marks, not the names of the parties' websites. I therefore favour the applicant's submission on this matter.

94. Bearing in mind the low degree of visual similarity between the marks, I see no likelihood of direct visual confusion, including confusion through imperfect recollection. The respective marks simply look too different for an average consumer paying a normal degree of attention to mistake or misremember the contested mark for the **SO...?** or **SO...? DESIRABLE** marks. In the case of the earlier **SO...?** mark, the conceptual dissimilarity between the marks is an additional factor which will make it even less likely that there will be confusion through imperfect recollection of

²⁶ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. at paragraph 78.

the marks.²⁷ I accept that in the case of the **SO...? DESIRABLE** mark, one of the concepts of the marks is similar, but this is not an important factor where the concept is laudatory and descriptive. My finding that there is no likelihood of direct confusion applies even where identical goods are involved and the earlier marks (or at least the **SO...?** mark/element) has acquired an above average degree of distinctive character.²⁸

95. I accept that the marks are closer from an aural perspective, although the marks are only aurally similar (at most) to a medium degree. I have considered the possibility of direct aural confusion, but I find that this carries less weight in the global comparison where the goods are mainly selected by eye.²⁹ Further, the weight that should be accorded to the aural identity between the ‘SO’ elements of the parties’ marks must take into account that neither party has, or has sought, a right in that word as such, but only with specific stylisation or punctuation.³⁰ I do not therefore consider that the aural similarity between the respective marks (as wholes) plays a sufficiently important part in the global comparison so as to justify a finding that there is a likelihood of direct confusion.

96. There is also the possibility of indirect confusion or ‘association’ as it is called in s.5(2) of the Act. The opponent’s strongest case under this heading is based on its ‘family’ of marks. I will therefore consider it under that heading.

²⁷ See the judgment of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04P, at paragraph 20

²⁸ There is evidence from Mr Wills that the contested mark has been used in the UK since December 2016 in relation to sex toys, sex aids and related goods, but the extent of such use is not entirely clear and the use is in relation to goods which are dissimilar to those goods in class 3 for which the earlier marks are protected. Therefore, it is not necessary to consider the effect of such concurrent use for the purposes of the s.5(2) ground of opposition.

²⁹ The weight to be attached to the visual and aural similarities varies depending on how the goods are normally marketed: See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the General Court, at paragraphs 49 and 50 of the judgment. Also *Quelle AG v OHIM*, Case T-88/05, at paragraphs 68 and 69.

³⁰ See the decision of Mr Iain Purvis QC, as the Appointed Person, in *The Royal Academy Of Arts V Errea Sport S.P.A.* BL O-016-16

The s.5(2) case based on the opponent's 'family' of marks

97. The opponent can rely on the following 'family' of earlier marks for this purpose.

Trade mark	Goods present on the UK market
EU485078 SO...?	Class 3: Shower gels; fragrances; body lotions; eau de toilette; dry shampoos; deodorants for personal use; lip balms; nail varnishes.
EU7055239 SO...? ETERNAL	Class 3: Perfumery; perfumed body spray; eau de toilette; personal care deodorants.
UK2602397 SO...? LOVELY	As above
UK2642838 SO...? FABULOUS	As above
UK2642811 SO...? GLAMOROUS	As above

98. In *Il Ponte Finanziaria SpA v OHIM*, the CJEU stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of

Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.”

99. I understand this to mean that the risk of the contested mark being thought to be a member of the opponent’s ‘family’ of marks constitutes a risk of indirect confusion, i.e. that consumers will realise that the marks are different, but because of their family resemblance will believe that they are used by the same undertaking.

100. The opponent’s case is that the “*common characteristic*” of its ‘family’ of marks is the word SO. The opponent also submits that its family of marks will be recognised as consisting of SO [descriptor]. According to the opponent, the contested mark shares this “*common characteristic*” and will be thought to be another member of the same ‘family’. In this connection, the opponent points out that it has also used SO marks without the punctuation present in the marks in class 3 pleaded under s.5(2)(b).

101. The applicant denies that the opponent’s family of marks can be defined simply by the presence of the word SO. The applicant submits that the common element is SO...?

102. I accept the applicant’s submission. For the reasons I explained earlier, I find that the punctuation elements of the earlier marks make an important contribution to their distinctive character. Looking at the marks as a ‘family’, the common element is plainly SO...? not just the word SO. Therefore, the contested mark does not share the same characteristic as the earlier marks. This does not necessarily exclude a likelihood of confusion, but it is nevertheless an important factor which points against such a likelihood.

103. The opponent points to some historical use of SO COSMETICS as a house mark and some more recent use of SO... derivative marks (i.e. without a ?) in

relation to some men's toiletries. However, the use of SO COSMETICS ceased 10 years prior to the relevant date. The only information I can find in the evidence about the sales of SO... marks in relation men's toiletries is the UK sales figures for 2012 to October 2017, which show the sale of 5580 products under the mark **SO...HIM**. The past use of SO COSMETICS is too old to affect the perception of consumers of the opponent's goods in April 2017. In this connection, I note that the opponent characterises its customer base as mainly teenagers and young women in their early 20s. So far as the claim that **SO...HIM** is used in relation to men's products is concerned, I note that the claimed sales between 2012 and 2017 are tiny. Further, I cannot tell from the evidence when they occurred, or in relation to which specific goods. The sales could have occurred in 2012/2013, or even after the relevant date in 2017. I find that this evidence is too vague and insubstantial to justify a finding that average consumers of goods marketed under the opponent's pleaded marks were aware at the relevant date that the opponent also used marks without the characteristic SO...? element.

104. I also reject the opponent's submission that its family extends to any mark including SO [descriptor]. I pause here to note that this submission amounts to a claim to a very powerful monopoly in the use of descriptive terms in marks for goods in class 3, 5, 10 as well as services in class 35. Such a broad claim should not be accepted without very clear evidence. As Arnold J. noted in *Whyte and MacKay*³¹:

“...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.”

105. Admittedly, this was said in relation to a conventional mark-for-mark case, but in my view the same point applies where the earlier marks are distinctive as a 'family', but include descriptive elements of low (or no) distinctiveness. The evidence before me does not support the broad conclusion that any mark containing SO [descriptor] would be regarded as a member of the opponent's family. That is so whether the mark in question is used for fragrances or sex aids.

³¹ [2015] EWHC 1271 (Ch)

106. It is also necessary to give some weight to the elements of the contested mark which distinguish it from the opponent's family. Most obviously the heart device composed of coloured dildos. Further, it is also necessary to recognise the significance of the manifest stylisation of the word SO in the contested mark, which is not a feature of the opponent's 'family' of **SO...?** marks. The average consumer is likely to attach particular weight to these elements in circumstances where the word element of the mark is clearly just a laudatory description of the goods and therefore unreliable, by itself, to identify the specific trade source of the goods.³²

107. Considering all the relevant factors, including the reputation and the level of distinctiveness of the earlier 'family' of marks, I find that there is no likelihood that consumers will regard the contested mark as a member of the opponent's 'family'. The s.5(2)(b) ground of opposition is therefore rejected.

The section 5(3) ground of opposition

108. Section 5(3) 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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

109. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

³² See *Nicoventures Holdings Limited v The London Vape Company Ltd*: [2017] EWHC 3393 (Ch)

- a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

110. The opponent can rely on the following marks for this purpose.

Earlier marks	Goods
EU485078 SO...?	Class 3: Shower gels; fragrances; body lotions; eau de toilette; dry shampoos; deodorants for personal use; lip balms; nail varnishes.
EU7055239 SO...? ETERNAL	Class 3: Perfumery; perfumed body spray; eau de toilette; personal care deodorants.
UK2259592 SO...? KISS ME	Class 3: Shower gel; dry shampoo; perfumes, lip balm, deodorants; eau de toilette; body lotions; nail varnishes.

UK2408599	
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SO...? SUPERSTAR	
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	Class 3: Perfumery, deodorants.
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Reputation

111. I accept that each of the earlier marks shown above had a qualifying reputation at the relevant date. I do not accept that **SO...? SENSUAL** also had a qualifying reputation at the relevant date. Although it was present on the market, the volume of sales shown under that mark is very low and insufficient to establish that the mark had a reputation that was distinct from that of **SO...?** alone.

Link

112. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

113. There is a low degree of similarity between the **SO...?** mark and the contested mark. The other marks are, if anything, even less similar to the contested mark.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

114. The goods in class 3 covered by the contested mark are identical or similar to the goods covered by the earlier marks. However, the goods and services in classes 5, 10, 25 and 35 are dissimilar or similar to only a low degree. The relevant public is the general public.

The strength of the earlier mark's reputation

115. The earlier marks have a reasonably strong reputation, including as a 'family' of marks.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

116. The earlier marks were factually distinctive to an above average (but not the highest degree) at the relevant date.

Whether there is a likelihood of confusion

117. There is a no likelihood of confusion.

118. I recognise that the degree of similarity required between the marks to establish a link under s.5(3) may be less than that required to establish a likelihood of confusion under s.5(2).³³ However, in my view, the degree of similarity between the marks is insufficient for the contested mark to bring the earlier marks to mind. This is so whether they are considered individually or collectively.

119. In case I am wrong about this, I will briefly consider the opponent's case of unfair advantage/detriment. In doing so I must necessarily assume, against my primary finding, that a section of the public will make a link between the marks.

Unfair advantage

120. Part of the opponent's case under s.5(3) is based on the public believing that the contested mark is part of the opponent's family. As I have rejected that proposition it follows that I reject this part of the opponent's s.5(3) case. The opponent claims that even without such a connection, the mental link established between the marks will still be sufficient to give the contested mark an unfair advantage and/or to damage the reputation and/or distinctive character of the earlier marks. As regards unfair advantage, the opponent's case is that [given the

³³ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, CJEU

reputation of the ‘family’ of marks] *“the presence of the word SO and the overall form of the mark on these products will provide a feeling of familiarity and comfort which will increase the attractive power of [the applicant’s goods and services] to the consumer.”*

121. I do not accept that merely being reminded of the earlier marks by the appearance of SO as part of the contested mark will give that mark an unfair marketing advantage. If the contested mark calls the earlier marks to mind at all, the association will be fleeting and not such as to affect the behaviour of average consumers, even in relation to class 3 goods.

Detriment

122. The opponent’s case on detriment has two parts: an allegation of tarnishing and of dilution. The tarnishing claim is based on an unwanted association between the reputation attached to the ‘family’ of marks and the use of the contested mark in relation to sex aids etc. If I had found that the contested mark would bring the earlier marks to mind, I would have found for the opponent on this point. But given the differences between the marks and the dissimilarity between fragrances and sex aids, I do not consider that such an association is at all likely.

123. The opponent’s claim of detriment through dilution is that the contested mark will dilute the distinctiveness of the earlier marks simply by presenting users with another mark with the form SO XXX. The only evidence that the opponent can rely upon to support such a claim is that the marks appear next to each other on Superdrug’s website in an A-Z list of the brands it stocks. That is plainly just a consequence of the alphabetical nature of that list. It cannot be seriously argued that such use will have any bearing on the distinctiveness of the earlier marks.

124. The s.5(3) ground of opposition also fails.

The section 5(4)(a) ground of opposition

125. The s.5(4)(a) ground is based on the following marks.

Earlier signs	Goods claimed/first use
SO...?	Perfumery, cosmetics, deodorants. Since 1994
SO...? DARING	Perfumery, deodorants. Since 2010.
SO...? ENTICING	As previous entry. Since 2010.
SO...? IN LOVE	As above. Since 2012.
SO...? [XXX] DIVINE e.g. SO...? KISS ME DIVINE, SO...? SINFUL DIVINE	As above. Since 2016.
SO...? DIVINE	Not stated in notice of opposition.

126. Section 5(4)(a) 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.”

127. The matter must be assessed as at the date of filing of the opposed application. However, if the contested mark was used prior to this date, it is necessary to also consider whether the use would have amounted to passing off when it started.³⁴ According to Mr Wills' evidence, the applicant first used the contested mark on its website on 2nd December 2016 in relation to "sexual health" goods. I take this to mean the goods listed in classes 5 and 10 of the application. This means that the opponent must show that it could have restrained such use on 2nd December 2016 and 10th April 2017. So far as the goods and services in classes 3 and 5 are concerned, there is no evidence of any use of the contested mark prior to the filing date of the application. Therefore, there is only one relevant date: 10th April 2017 ("the key date").

128. In *Discount Outlet v Feel Good UK*,³⁵ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

129. With one possible exception, I find that the opponent's case under s.5(4)(a) fails for similar reasons to the opponent's s.5(2)(b) case; namely, there is no likelihood

³⁴ See *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person, at paragraph 43 of the judgment.

³⁵ [2017] EWHC 1400 IPEC

that "a substantial number" of the opponent's customers or potential customers are likely to be deceived by the contested mark. Therefore, there is no misrepresentation to the public.

130. The possible exception to this finding relates to the opponent's earlier use of **SO...? DIVINE**. Although Mr Gangji says nothing directly about it in the narrative of his written evidence, according to a table in his first statement this mark was first used in 2009 in relation to a gift set comprised of a body spray and body lotion. The same table indicates that further gift sets bearing the mark were marketed in 2010 and 2016. The one marketed in 2016 seems potentially most relevant because it is more likely that the public will have remembered this use at the key date. However, there is very limited evidence about the use of **SO...? DIVINE** in evidence. Sales figures provided by Mr Gangji show that 13,209 **SO...? DIVINE** gift sets were sold in the UK between 1st November 2012 and 31st October 2017.³⁶ I note that this covers sales in 2016, but does not exclude sales after the key date.

131. According to the table in Mr Gangji's first statement, there are two pictures of a **SO...? DIVINE** gift set in his evidence.³⁷ The first picture is recorded as dating from 2009. It is a page from a Boots catalogue. The fifth item on the page is listed as a **SO...? DIVINE** gift set. It consisted of an eau de toilette, a body spray and a body lotion. The set retailed for £9.99. However, although I can see the mark **SO...?** on the product, I cannot make out the mark **SO...? DIVINE** on the packaging of the gift set, or on the individual products. Consequently, I cannot tell how the mark was applied to the product itself. The second picture also shows a page from a Boots catalogue. It is not dated in Mr Gangji's evidence. And there is no date on the picture itself. Consequently, I cannot tell when this was published. The gift set shown in the picture is listed as **SO...? KISS ME DIVINE**. This second picture is a bit clearer than the first one, so I can make out the mark applied to the individual products. It is **SO...? KISS ME**. The mark **SO...?** also appears on the packaging of the gift set. Again, I cannot see the mark **SO...? KISS ME DIVINE**, except in the product listing. Consequently, although I can see that **SO...? DIVINE** was used at some time as part of the branding of at least one of the opponent's gift sets, it is not possible to tell from

³⁶ See exhibit KG-1 to Gangji 1

³⁷ See pages 17 & 18 of exhibit KG-4 to Gangji 1

Mr Gangji's evidence how that mark appeared to the public when it was used in relation to the 2016 gift set. This makes it hard to assess what impact it would have had on the public, and therefore whether a substantial number of the opponent's customers or potential customers would have recalled the use of this mark at the key date.

132. Given the descriptive character and laudatory nature of the words SO DIVINE for the class 3 goods at issue, I do not consider that the nature and extent of the use shown in the evidence is sufficient to establish that the words SO DIVINE *per se* were distinctive of the opponent's business at the key date. It is well established that where two parties use descriptive marks, smaller differences between the marks may be sufficient to avoid passing off than might be the case with more distinctive signs. The contested mark does not take the **SO...?** element of the earlier sign. Further, it has its own distinctive elements (i.e. the visually dominant heart device and the stylisation of the letters SO) which point away from a trade connection between the user of this mark and the party that has occasionally marketed gift sets under the listing **SO...? DIVINE**. I therefore find that the use of the contested mark would not have constituted a misrepresentation to the public at the relevant date. This is the case whether I consider the earlier signs relied on by the opponent individually or collectively.

133. If I am wrong about this, the s.5(4)(a) ground could only possibly have succeeded in relation to the goods covered by class 3 of the contested mark. This is because it is fanciful to say that use of the contested mark would be likely to deceive a substantial number of the relevant public if used in relation to the other goods and services covered by the application.

134. The s.5(4)(a) ground of opposition therefore also fails.

Overall outcome

135. The opposition has failed. The contested mark may proceed to registration.

Costs

136. The applicant has been successful and is entitled to a contribution towards its costs. I will take account of the scope and complexity of the opponent's case and the effect this must have had on the time and resources required for the applicant to consider and respond to Part 1 of the opposition. I therefore assess the appropriate award of costs as follows:

£650 for considering the notice of opposition and filing a counterstatement;
£200 for attending a case management conference occasioned by the opponent's refusal to focus its case in a proportionate manner;
£2200 for considering the opponent's evidence and filing evidence in reply;
£550 for filing written submissions and considering the opponent's written submissions.

137. I therefore order Debonair Trading Internacional LDA to pay Viator Health Limited the sum of £3600. This to be paid within 21 days of the date set out below or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellant tribunal).

138. I direct the opponent to inform the applicant and the registrar of its intentions vis-à-vis Part 2 of these proceedings. This should follow the final determination of Part 1 of the proceedings. Therefore, such notification should take place within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the final outcome.

Dated this 14th day of September 2018

**Allan James
For the Registrar**