

**O/119/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3338003 BY  
OTO INTERNATIONAL LTD  
TO REGISTER:**

**oTo**

**oto**

**OTO**

**OtO**

**Oto**

**oTO**

**AS A SERIES OF TRADE MARKS IN CLASSES 3, 4, 5, 30, 32, 33, 34  
AND 35**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO  
UNDER NO. 414930 BY  
OTTO (GMBH & CO. KG)**

## BACKGROUND AND PLEADINGS

1. OTO International Ltd (“the applicant”), under its previous name of Hedony Limited, applied to register **oTo**, **oto**, **OTO**, **OtO**, **Oto** and **oTO** as a series of trade marks in the United Kingdom on 12 September 2018. They were accepted and published in the Trade Marks Journal on 28 September 2018 in respect of the goods and services shown in the table in paragraph 14.

2. The application was opposed on 24 December 2018 by Otto (GmbH & Co KG) (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the applied-for goods and services. The opponent is relying upon EU Trade Mark No. 13713151:



Colours claimed: Red

The mark was applied for on 3 February 2015 and registered on 1 December 2016 in respect of the goods and services shown in the table in paragraph 14, all of which the opponent states it is relying on.

3. The opponent claims that the marks are highly similar and that the goods and services covered by the applicant’s specification are the same as, or similar to, the goods and services covered by the earlier mark, leading to a likelihood of confusion on the part of the public. Therefore, registration of the contested mark should be refused under section 5(2)(b) of the Act.

4. The applicant filed a defence and counterstatement, denying the grounds.

5. Neither party filed evidence in these proceedings.

6. A hearing took place before me on 17 January 2020. The applicant was represented by Charlotte Blythe of Counsel, instructed by Bird & Bird LLP. The opponent did not attend the hearing, but made written submissions in lieu of attendance. In these proceedings, the opponent is represented by A. A. Thornton & Co.

## **DECISION**

### **Legislation**

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

“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.”

8. An “earlier trade mark” is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

9. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provision. In this opposition, the opponent is relying upon all of the goods and services for which this earlier mark is registered. As the mark was

registered within the five years before the date on which the applicant's mark was published, it is not subject to the requirement to prove use and the opponent is therefore entitled to rely on all the goods and services for which the mark stands registered.

## **Case law**

10. In considering this opposition, I am guided by the following principles, gleaned from the decisions of the courts of the European Union 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone 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 greater degree of similarity between the marks and vice versa;

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

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

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

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

### **Comparison of goods and services**

11. When comparing the goods and services, all relevant factors should be taken into account, per *Canon*:

“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.”<sup>1</sup>

12. Guidance on making the comparison was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

13. In *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (CJEU) stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The General

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<sup>1</sup> Paragraph 23.

Court (GC) clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06:

“... 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.”<sup>2</sup>

14. The goods and services to be compared are as follows:

Opponent’s goods and services	Applicant’s goods and services
	<p><u>Class 3</u></p> <p><i>Cosmetics; nutritional oils for cosmetic purposes; skin and body topical lotions, creams and oils for cosmetic use including facial, body and hand cream, bath and skin lotions, bath salts, bath bombs, skin moisturizers, skin cleansers and non-medicated serums for use on the skin, eye and exfoliant cream, shampoo, hair conditioners, and body wash; cosmetics for anti-aging purposes; anti-aging cosmetics, namely, anti-aging cream, anti-aging moisturizer, non-medicated anti-aging serum, anti-aging eye cream, anti-aging defoliant; Face masks; Hemp-derived cosmetic and nutritional oils for cosmetic purposes; hemp-derived skin and body topical lotions, creams and oils for cosmetic use; pillow sprays containing essential oils and/or hemp-derived product; Roll-on cosmetics containing essential oils and/or hempderived product; Room mist containing hemp-derived product.</i></p>
	<p><u>Class 4</u></p> <p><i>Candles; wicks for candles and lamps; tallow; fuel for lighting; paper spills for lighting; room mist, beeswax; oils and waxes, all for preservation purposes; soya bean oil</i></p>

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<sup>2</sup> Paragraph 82.

Opponent's goods and services	Applicant's goods and services
	<i>preparations for non-stick treatment of cooking utensils; all included in Class 4.</i>
	<p><u>Class 5</u></p> <p><i>Dietary and nutritional supplements; dietary and nutritional supplements containing oils and crystals; dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary food supplements; health food supplements; nutritional supplement containing essential hemp oils and/or water-soluble hemp products found in plant extracts; pharmaceuticals based on botanical and plant extracts; pharmaceuticals based on botanical and plant extracts for use in the treatment of skin diseases, neuropathic pain, cancer pain, autoimmune diseases, anorexia, psychiatric disorders, neurovegetative disorders and metabolic disorders; Dietary supplements based on botanical and plant extracts; Dietary supplements based on botanical and plant extracts in the form of pharmaceuticals for treating skin diseases, neuropathic pain, cancer pain, autoimmune diseases, anorexia, psychiatric disorders, neurovegetative disorders and metabolic disorders; meal replacement powders comprised of hemp for medical purposes; meal replacement bars comprised of hemp for medical purposes; meal replacement drink mixes comprised of hemp for medical purposes; hemp-based topical creams, gels, salves, sprays, balms and ointments for analgesic purposes; nutritional supplements comprised of hemp in drop form, capsule form, and in liquid form; edible hemp oil for use as a dietary supplement; pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and</i></p>



Opponent's goods and services	Applicant's goods and services
	<p><i>animals; Plasters, materials for dressings; disinfectants; Preparations for destroying vermin; Material for stopping teeth; Dental wax; Fungicides; herbicides; medicated creams and lotions; herbal remedies.</i></p>
<p><u>Class 16</u> <i>Printed matter, in particular catalogues.</i></p>	
<p><u>Class 25</u> <i>Clothing, footwear, headgear.</i></p>	
	<p><u>Class 30</u> <i>Tea based beverages, tea extracts, iced tea, herbal tea, infusions of tea, non-medicated chewing gum; meal replacement bars and meal replacement coffee/tea/cocoa/ chocolate drink mixes; protein based nutrient dense granola-based snack bars; non-alcoholic hemp based beverages with tea flavour; Coffee cocoa and artificial coffee; Rice; Tapioca and sago; flour and preparations made from cereals; Bread, pastry and confectionery; Ices; sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice; Chocolates; Chocolate mini-bites, Small pastry gods. Teas; herbal tea; drinking coffee; coffee capsules, drinking cocoa; tea based beverages; iced tea, tea infusions; infusions of tea and tea products; confectionery; all of the aforesaid containing hemp-derived product.</i></p>
	<p><u>Class 32</u> <i>Alcoholic hemp based beverages, namely, beer; non-alcoholic hemp based beer flavoured beverages; non-alcoholic beverages and hemp-based beverages namely, sodas; energy drinks; fruit juices; vegetable juices, non-alcoholic bitters, non-alcoholic shots; non-alcoholic ready-to-drink shots; non-alcoholic hemp-based malt beverages; hemp based whey beverages; hemp based isotonic beverages; Non-alcoholic spirits; mineral and carbonated waters; preparations for</i></p>

Opponent's goods and services	Applicant's goods and services
	<p><i>making beverages, fruit beverages, vegetable juices (beverages); Syrups and other preparations for making beverages; beverages based on water and plant extracts; carbonated non-alcoholic drinks; carbonated soft drinks; Cola drinks; De-alcoholised drinks; Fruit flavoured drinks; Fruit-flavoured soft drinks; Non-carbonated soft drinks; Soft drinks.</i></p>
	<p><u>Class 33</u>  <i>Alcoholic beverages (except beers); wines, spirits and liqueurs; alcoholic preparations for making beverages; spirit or wine-based cocktails and aperitifs; beverages containing wine; Any of the aforementioned containing hemp-derived products and/or botanicals.</i></p>
	<p><u>Class 34</u>  <i>Personal vaporisers and electronic cigarettes, and flavourings and solutions therefore; Flavourings, other than essential oils, for use in electronic cigarettes; Electronic cigarette atomizers; Electronic cigarette cartomizers; Refill cartridges for electronic cigarettes; Inhalers for use as an alternative to tobacco cigarettes; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerine; Smokeless cigarette vaporizer pipes; Electronic cigarettes; Electronic cigars; Liquid solutions for use in electronic cigarettes; liquids for electronic cigarettes; Cigarette paper; Cigarette filters; Cigarette tubes; Ready-made cigarette tubes with filters; Tobacco containers and humidors; Lighters for smokers; Pocket machines for rolling cigarettes; Liquids for electronic cigarettes (e-liquid) made from cannabidiol; Liquids for electronic cigarettes (e-liquid) made from industrial hemp; Tobacco substitutes exclusively derivative from cannabidiol; Herbs for smoking exclusively derived from cannabidiol; Flavourings</i></p>

Opponent's goods and services	Applicant's goods and services
	<p><i>for tobacco exclusively derivative from cannabidiol; Cigarettes containing tobacco substitutes exclusively derivative from cannabidiol; Alternative smokers' articles, namely electronic cigarettes, electronic shisha pipes, electronic smokers' pipes, electronic cigars; electronic cigarillos; Optimised electronic cigarettes, most of the elements thereof being configurable, E-liquid for electronic cigarettes, Flavourings for liquids for electronic cigarettes or personal vaporisers, flavourings for electronic cigarettes; liquid solution containing nicotine; Flavoured essences for electronic cigarettes; Nicotine bases for electronic cigarettes, nicotine-based substitutes for electronic cigarettes; Electronic cigarette filters; Cases for electronic cigarettes; Boxes for electronic cigarettes, cases for electronic cigarettes; Tips for electronic cigarettes; Tips of yellow amber for cigar and cigarette holders; Tobacco substitutes, not for medical purposes; solutions to be inhaled through electronic cigarettes; Electronic vaporisers; Essences for use with oral vaporisers for smokers; Vapour cigars and vaporiser alternatives; Vapour tubes for smokeless cigarettes; Nicotine inhalers; Scented cartridges for use with electronic devices replacing cigarettes, cigars, cigarillos and pipes, containing tobacco substitutes, not for medical purposes; Clearomizers for electronic cigarettes; wicks for electronic cigarettes; Mouthpieces (drip tips) for electronic cigarettes; Nicotine bases; Liquid solutions containing food flavourings for electronic cigarettes.</i></p>
<p><u>Class 35</u> <i>Wholesaling and retailing of manures, paints, varnishes, lacquers, printing ink, toners (ink) for photocopiers, bleaching preparations and other substances for laundry use, cleaning, polishing,</i></p>	<p><u>Class 35</u> <i>Marketing consultation in the field of hemp-based products, namely, hemp-based personal care products, anti-aging products, food and nutritional supplements, chewing gums, candies,</i></p>

<b>Opponent's goods and services</b>	<b>Applicant's goods and services</b>
<p><i>scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, industrial oils and greases, lubricants, dust absorbing, wetting and binding compositions, fuels (including motor spirit) and illuminants, candles and wicks for lighting, pharmaceutical and veterinary preparations and health care preparations, dietetic substances for medical use, food for babies, plasters, materials for dressings, disinfectants, common metals and their alloys, metal building materials, transportable buildings of metal, materials of metal for railway tracks, non-electric cables and wires of common metal, ironmongery, small items of metal hardware, pipes and tubes of metal, safes, dishwashers, mixers (machines), electric blenders for household purposes, whisks (electric, for household purposes), clothes washing machines, suction cleaning machines and machine tools, motors and engines (except for land vehicles), agricultural implements other than hand-operated, hand tools and implements (hand-operated), cutlery, side arms, razors, scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, cash registers, calculating machines, data processing equipment and computers, fire-extinguishing apparatus, orthopaedic articles, blood pressure measuring apparatus, gloves for massages, massagers, condoms, baby bottles, dummies for babies, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, vehicles, apparatus for locomotion by land, air or</i></p>	<p><i>beverages, edible oils, and vaporizers; retail services provided through direct solicitation by a network for independent distributors and independent representatives directed to end-users featuring hemp-based products, namely, hemp-based personal care products, anti-aging products, food and nutritional supplements, chewing gums, candies, beverages, edible oils, and vaporizers; online retail store for hemp-based products, namely, hemp-based personal care, anti-aging products, electronic vaping devices, food and nutritional supplements, chewing gums, candies, beers, beverages, alcoholic and non-alcoholic beverages, edible oils, honey, bath salts, room sprays, and vaporizers; Business administration and business management of retail outlets; purchasing and demonstration of goods for others; retail services, internet retail services and mail order services connected with the sale of non-medicated toilet preparations and substances, beauty preparations and substances, cosmetics, make-up, lip-stick and lip gloss, dentifrices, fragrances, perfumery, colognes, toilet waters and eau de colognes, deodorants for personal use, anti-perspirants, sun-tan and sun-screening preparations and substances, depilatory preparations and substances, massage oils, powders, creams and lotions, nail polish, nail polish remover, soaps and shampoos, shaving and after-shave preparations, preparations and substances for the conditioning, care and appearance of the skin, body, face, eyes, hair, teeth and nails, shower and bath preparations, bath oils and bath salts, talcum powder, moisturisers, pot pourri, incense, incense sticks, room fragrances and articles for perfuming rooms, non-medicated baby oils and baby creams, non-medicated baby</i></p>

<b>Opponent's goods and services</b>	<b>Applicant's goods and services</b>
<p><i>water, fireworks, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, musical instruments, paper, cardboard, printed matter, catalogues, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artist's materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging, rubber, gutta-percha, gum, asbestos, mica, packing, stopping and insulating materials, flexible pipes, not of metal, trunks and travelling bags, bags, key cases, backpacks, pocket wallets, purses, umbrellas and parasols, walking sticks, building materials (non-metallic), non-metallic rigid pipes for building, non-metallic transportable buildings, jalousies (not of metal), awning constructions (not of metal), parquet, furniture, mirrors, picture frames, filing cabinets, tea trolleys (furniture), beds, bedding, except linen, picture frames, flower stands, flower display stands, library shelves, bookends, sideboards, office furniture, boxes of wood or plastic, coat stands, curtain rods, plate racks, stools, highchairs for children, drawer chests, wickerwork, latex mattresses, deckchairs, mattresses, screens (furnishings), upholstered furniture, rattan, racks (furniture), umbrella stands, keyboards for hanging keys, cupboards, writing desks, lockers, service trolleys (furniture), sofas, mirror tiles, toy boxes, spring mattresses, statues of wood, wax, gypsum or plastic, chairs, tables, display cases (furniture), decorative wall plaques, washstands (furniture), waterbeds, magazine racks, newspaper display racks, household or kitchen utensils and containers (not of previous metal or coated therewith), combs and sponges, brushes (except paintbrushes), brush-making materials,</i></p>	<p><i>wipes, cotton wool, candles, perfumed candles, pillow sprays, tapers; the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase such goods in health and beauty stores, in fitness centres and in hair and beauty salons, and from mail order catalogues and online from web pages on the Internet; advice, information and assistance relating to all the aforesaid services.</i></p>

Opponent's goods and services	Applicant's goods and services
<p><i>articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, ropes, string, nets, tents, awnings, tarpaulins, sails, sacks, padding and stuffing materials (other than rubber or plastics), raw fibrous textile materials, hammocks, awnings of synthetic material and textile material, yarns and threads, for textile use, textiles and textile goods, bed covers, table covers, clothing, footwear, headgear, lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile), games and playthings, gymnastic and sporting articles, decorations for Christmas trees, meat, fish, poultry and game, meat extracts, frozen, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible ices, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, grains and agricultural, horticultural and forestry products, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt, beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages, alcoholic beverages (except beers), tobacco, smokers' articles, matches.</i></p>	

15. The list of goods and services is lengthy. I shall therefore group them where this is appropriate. In *SEPARODE Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”<sup>3</sup>

16. While making my comparison, I bear in mind the comments of Floyd J (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”<sup>4</sup>

17. In *FIL Limited & Anor v Fidelis Underwriting Limited & Ors* [2018] EWHC 1097 (Pat), Arnold J (as he then was) considered how this principle should be applied in the case of services:

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<sup>3</sup> Paragraph 5.

<sup>4</sup> Paragraph 12.

“... terms in specifications of goods and services should be given their ordinary and natural meaning, but this is subject to two overlapping qualifications: first, specifications of services are inherently less precise than specifications of goods, and therefore should be interpreted in a manner which confines them to the core of the ordinary and natural meaning rather than more broadly; and secondly, terms should not be interpreted so liberally that they become unclear and imprecise.”<sup>5</sup>

18. The opponent has prepared a detailed comparison of the goods and services. I shall use this as my starting point, while also referring to the submissions of the applicant.

19. I will need to compare certain goods with various retail services. The opponent submits that:

“It is established practice that the retail of specific goods is considered similar to those specific goods (see Case T-715/13, *Castello (fig.) / Castelló y Juan S.A. (fig) et al.*). Although the nature, purpose and method of use are not the same, the goods and services share similarities by virtue of the fact that the services are offered in the same place where the goods are offered for sale, are directed at the same public and are frequently offered by the same entity. For a finding of similarity, the goods covered by the retail services of the Earlier Registration and the specific goods covered by the Contested Application must be identical to or fall under the natural and usual meaning of the category of goods.”<sup>6</sup>

20. At the hearing, Ms Blythe drew my attention to the following case law, beginning with the decision of the GC in *Oakley Inc v OHIM*, Case T-116/06, where it was held that, 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 distributed through the same trade channels, and therefore similar to a degree.

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<sup>5</sup> Paragraph 86.

<sup>6</sup> Paragraph 11 of the opponent's written submissions.



21. In *Tony Van Gulck v Wasabi Frog Ltd (MissBoo)*, BL O/391/14, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, reviewed the law and said:

“The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”<sup>7</sup>

22. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13 P, and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, upheld on appeal in *Waterford Wedgwood Plc v Assembled Investments (Proprietary) Ltd*, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

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<sup>7</sup> Paragraph 9.

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

23. Ms Blythe particularly emphasised paragraph 25 of Mr Hobbs' decision (my underlining):

"... the assessment of 'similarity' had to proceed substantively upon the premise that the Listed Services in Class 35 could not simply be characterised as dealing in goods of the kind to which they were linked. On the contrary, they had to be seen as involving real and significant performance of the functions of selecting an assortment of goods offered for sale and offering a variety of retail services aimed at inducing consumers to purchase goods of the kind specified. And then, from that perspective, it was necessary to give effect to the propositions noted in paragraph [19] above and to do so on the basis that there is no rule that 'complementary' always or necessarily equals 'similarity' for the purposes of Section 5(2)(b). In evaluating whether and, if so, to what degree retail services across the spectrum covered by the Listed Services were 'similar' to 'handbags' in Class 18 and 'shoes for women' in Class 25, it was necessary, in keeping with the principle of proportionality, to consider the greater or lesser likelihood that a single economic undertaking would naturally be regarded as responsible for providing not only goods of that kind, but also retail services of the kind in question. The degree to which retail services within the spectrum were found on evaluation to be 'similar' to such goods would be a co-variable with the degree of 'similarity' between the signs in the overall assessment of the existence or otherwise of a likelihood of confusion."

24. Finally, Ms Blythe referred to the decision of Ms Anna Carboni, sitting as the Appointed Person, in *GIANT Trade Mark*, BL O-264-14, where she observed that:

“... in the modern age of retail stores, particularly on-line retailers, that sell almost anything one can envisage wanting to buy, trade mark tribunals have to be careful not to give undue weight to the existence of an overlap in the channels of distribution and sales outlets, particularly in the absence of any specific evidence on the point.”<sup>8</sup>

25. What I take from these decisions is that, in comparing goods against retail services, there may be some similarity based upon complementarity and shared trade channels; the goods do not have to be identical to the subject goods of the retail service; and that the level of similarity may be weak, or even non-existent, depending on the presence or absence of other *Canon* factors.

*Class 3: Cosmetics; nutritional oils for cosmetic purposes; skin and body topical lotions, creams and oils for cosmetic use including facial, body and hand cream, bath and skin lotions, bath salts, bath bombs, skin moisturizers, skin cleansers and non-medicated serum for use on the skin, eye and exfoliant cream, shampoo, hair conditioners, and body wash; cosmetics for anti-aging purposes; anti-aging cosmetics, namely, anti-aging cream, anti-aging moisturizer, non-medicated anti-aging serum, anti-aging eye cream, anti-aging defoliant; Face masks; Hemp-derived cosmetic and nutritional oils for cosmetic purposes; hemp-derived skin and body topical lotions, creams and oils for cosmetic use; Roll-on cosmetics containing essential oils and/or hempderived product*

26. The opponent submits that these goods all fall within the broad category of “cosmetics” and are similar to the opponent’s *Wholesaling and retailing of essential oils, cosmetics, hair lotions*, which are identical cosmetics goods. The applicant submits that the nearest comparable service to the whole of its Class 3 list of goods is *Wholesaling and retailing of soaps, perfumery, essential oils, cosmetics, hair lotions*.

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<sup>8</sup> Paragraph 31.

27. I agree with the opponent that all the goods listed above can be considered together. Cosmetics are products that are used on the body to improve its appearance and are sold by a wide variety of bricks-and-mortar and internet retailers, from specialists to department stores and supermarkets. They may also be sold through catalogues or person-to-person consultations. The opponent's services would involve selecting and bringing a range of cosmetic goods together and services aimed at encouraging the consumer to buy the goods there, rather than from another retailer.

29. There is no similarity of nature or purpose between these goods and services. However, the users of the retail (although not the wholesale) services will be the same as the users of the goods, and trade channels are likely to be the same. There is no competition but there is, to my mind, a degree of complementarity as cosmetics are indispensable to the service of retailing of cosmetics and the consumer may believe that the retail services and the goods are the responsibility of the same undertaking. They will be accustomed to seeing retailers selling cosmetics under the same mark. I find there to be a medium degree of similarity between the applicant's goods and the opponent's *Retailing of cosmetics*.

Class 3: Pillow sprays containing essential oils and/or hemp-derived product: Room mist containing hemp-derived product

Class 4: Room mist

30. The opponent submits that the Class 3 goods listed above fall within the broad category of "perfumery" and are similar to its *Wholesaling and retailing of soaps, perfumery, essential oils*. I would expand this grouping to include the applicant's *Room mist* in Class 4, and in my view they fit within a broader category of "fragrances for the home". In my view, the average consumer would interpret "perfumery" as referring not only to preparations for scenting the body, but also for fragancing rooms or other items in the home. The users of the goods will be the same as the uses of *Retailing of perfumery and essential oils*, as will the trade channels. The uses will be different and the goods and services are not in competition. I consider that there is a degree of complementarity between the goods and services and that the average consumer will, as with cosmetics, believe that the retail services and the goods are the responsibility

of the same undertaking. I find there to be a medium degree of similarity between these goods and the opponent's *Retailing of perfumery and essential oils*.

*Class 4: Candles; wicks for candles and lamps; tallow; fuel for lighting; paper spills for lighting*

31. The opponent submits that these goods are all candles or associated goods, namely materials for making or lighting candles and are similar to its *Wholesaling and retailing of fuels (including motor spirit) and illuminants, candles and wicks for lighting*. The applicant identifies this service as the nearest comparison to all its Class 4 goods.

32. It seems to me that the goods in this group will not have the same users, so I shall divide it. While a member of the general public may be expected to use *candles, fuel for lighting* or *paper spills for lighting*, I find it unlikely that they will use *wicks for candles and lamps* or *tallow*, which are the components of candles and thus more specialist goods targeted at businesses or hobbyists.

33. The users of *candles, fuel for lighting* or *paper spills for lighting* are the same as the users of *Retailing of fuels (including motor spirit) and illuminants, candles*, as will the trade channels. There is no similarity of nature or purpose between the goods and services. There is no competition, although there is some complementarity. It seems to me that the average consumer would expect the goods and services to be the responsibility of the same undertaking. I find them to be similar to a medium degree.

34. I turn now to *wicks for candles and lamps* and *tallow*. Tallow is defined in the *Oxford Dictionary of English*, 3<sup>rd</sup> edition, as "a hard fatty substance made from rendered animal fat, used (especially formerly) in making candles and soap". Its nature and purpose are different from *Retailing of fuels (including motor spirit) and illuminants, candles and wicks for lighting*. It is not in competition with these services and there will only be a small overlap in the users. It seems to me that the trade channels will also be different and that there is no complementarity here. There are no other goods or services in the opponent's specification that, in my mind, are closer. I find *Tallow* to be dissimilar to the opponent's goods and services. For a section 5(2)(b) opposition to succeed, the goods and/or services must be similar: see *eSure*

*Insurance v Direct Line Insurance* [2008] ETMR 77 CA, paragraph 49. The opposition therefore fails with respect to *Tallow*.

35. In the case of *wicks for candles and lamps* and the *Retailing of wicks for lighting*, I find the nature and purpose to be different, and the users and trade channels to be the same. The goods and services are not in competition. I have no evidence before me to indicate whether the average consumer would expect the goods and services to be the responsibility of the same undertaking, but, bearing in mind the specialist nature of the goods, it seems to me more likely that a provider of the associated retail services would not be expected to be responsible for the goods themselves. In making this finding, I have taken account of the case law that states that merely selling one's goods (for instance on a website) does not in itself constitute *Retailing*. I find there to be a low degree of similarity.

*Class 4: Beeswax; oils and waxes, all for preservation purposes; soya bean oil preparations for non-stick treatment of cooking utensils*

36. The opponent submits that these are goods that are used for the cleaning, polishing and preservation of other goods, such as furniture, and are similar to its *Wholesaling and retailing of cleaning, polishing, scouring and abrasive preparations, industrial oils and greases, lubricants*.

37. Although it is not its only use, *beeswax* is a substance that is used for polishing other goods, particularly furniture. This means that there is some overlap in the nature, purpose, users and trade channels with the opponent's *Retailing of ... polishing ... preparations*. The goods and services are not in competition but there is a degree of complementarity. I find there to be a low level of similarity.

38. The applicant has not defined what precisely is meant by *oils and waxes, all for preservation purposes*, so I must consider what the average consumer would understand by the term. In my view, the average consumer would think that cleaning and polishing would be among the activities undertaken to prolong the life of an object. The applicant's term would include specialist preparations as well as goods that have a more general use. It follows that there would be some overlap in the nature, purpose,

users and trade channels with the opponent's *Retailing of cleaning, polishing ... preparations*, and also a degree of complementarity. I find there to be a low level of similarity.

39. The users of *soya bean oil preparations for non-stick treatment of cooking utensils* would either be the manufacturers of those items, in which case the goods are likely to be obtained from specialist suppliers, or members of the general public, who had purchased non-stick cooking utensils and wished to prolong their life. For the latter group, the goods are likely to be purchased from similar retailers to those who sell *cleaning, polishing, scouring and abrasive preparations*. The purpose and nature of these goods will be different from those of the opponent's services and the goods and services are not in competition. There is a degree of complementarity, but this is at a fairly low level. I find there to be a low level of similarity.

*Class 5: Dietary and nutritional supplements; dietary and nutritional supplements containing oils and crystals; dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; dietary food supplements; health food supplements; nutritional supplement containing essential hemp oils and/or water-soluble hemp products found in plant extracts; Dietary supplements based on botanical and plant extracts; Dietary supplements based on botanical and plant extracts in the form of pharmaceuticals for treating skin diseases, neuropathic pain, cancer pain, autoimmune diseases, anorexia, psychiatric disorders, neurovegetative disorders and metabolic disorders; meal replacement powders comprised of hemp for medical purposes; meal replacement bars comprised of hemp for medical purposes; meal replacement drink mixes comprised of hemp for medical purposes; nutritional supplements comprised of hemp in drop form, capsule form, and in liquid form; edible hemp oil for use as a dietary supplement; Dietetic food and substances adapted for medical or veterinary use, food for babies; Dietary supplements for humans and animals*

40. The opponent submits that these goods are all forms of dietary supplement and are similar to its *Wholesaling and retailing of dietetic substances for medical use; food for babies*. The applicant submits that the closest comparison to all of its Class 5 goods is *Wholesaling and retailing of pharmaceutical and veterinary preparations and health*

*care preparations, dietetic substances for medical use, food for babies, plasters, materials for dressings, disinfectants* in Class 35. The users and trade channels will be the same, while the nature and purpose are different. There is no competition between the goods and the services. The average consumer may expect to see a retailer selling such goods under its own name, so there is some complementarity. I find these goods and services to be similar to a medium degree.

*Class 5: Pharmaceuticals based on botanical and plant extracts; pharmaceuticals based on botanical and plant extracts for use in the treatment of skin diseases, neuropathic pain, cancer pain, autoimmune diseases, anorexia, psychiatric disorders, neurovegetative disorders and metabolic disorders; hemp-based topical creams, gels, salves, sprays, balms and ointments for analgesic purposes; pharmaceutical and veterinary preparations; herbal remedies*

41. The opponent submits that these goods all fall within the broad category of “pharmaceutical and veterinary preparations and health care preparations” and are similar to its *Wholesaling and retailing of pharmaceutical and veterinary preparations and health care preparations*. In my view, the same analysis applies here and I find the goods and services to be similar to a medium degree.

*Class 5: Sanitary preparations for medical purposes*

42. The opponent submits that these goods are forms of cleaning or sanitation product used for medical purposes and are similar to its *Wholesaling or retailing of cleaning, scouring and abrasive preparations*, which, it submits, covers such goods for both medical and non-medical purposes. Ms Blythe submitted that there is no similarity between these goods and services.

43. I must consider the natural and ordinary meaning of the words used in both specifications. In my view, the average consumer will understand *sanitary preparations* and *cleaning preparations* to mean the same thing. The opponent’s specification does not state that the cleaning preparations serve a particular purpose, so it seems to me that I should find that it covers both medical and non-medical purposes. There will be an overlap between the users of the goods and services: in a



professional setting, the members of staff using the sanitary preparations are unlikely to be the ones who would be doing the buying; in a domestic setting, they are likely to be the same. The trade channels will also overlap, but the nature and purpose will differ and there is no competition. There will, in my view, be a degree of complementarity as these are goods that the average consumer might expect retailers to sell as own brand goods. I find there to be a medium degree of similarity between these goods and services.

*Class 5: Plasters, materials for dressings; disinfectants*

44. The opponent submits that these goods are similar to its *Wholesaling and retailing of plasters, materials for dressings; disinfectants*. Much of the above analysis applies here. The goods will be used by both the general public and professionals and the latter are unlikely to be making the purchasing decision. Trade channels will be the same and I find there to be some complementarity. In my view, there is a medium degree of similarity between these goods and services.

*Class 5: Materials for stopping teeth; Dental wax*

45. The opponent submits that these are goods that are used to keep teeth clean and cavity-free and fall within the broad category of “Dentifrices” and so are similar to its *Wholesaling and retailing of dentifrices*. The *Oxford Dictionary of English* defines “dentifrice” as “a paste or powder for cleaning the teeth”. In contrast, the applicant’s goods are specialist products which are likely to be sold to dental professionals for carrying out treatments such as filling teeth. Nature, purpose, users and trade channels will be different and the goods and services are not in competition. It does not seem to me that the average consumer would assume that the goods and services are the responsibility of the same undertaking. I find them to be dissimilar and the opposition fails in respect of *materials for stopping teeth* and *dental wax*.

Class 5: Medicated creams and lotions

46. The opponent submits that these goods are forms of cosmetics, which have medical properties, and fall within the broad category of “cosmetics” and thus are similar to its *Wholesaling and retailing of cosmetics*. I disagree. To my mind, the average consumer is likely to see the term as referring to medication that is delivered by means of a cream or lotion whereas “cosmetics” would be taken to mean products whose main purpose is to improve the appearance. To my mind, they would be encompassed by the broader term *pharmaceutical preparations* and therefore similar to a medium degree to the opponent’s *Retailing of pharmaceutical and veterinary preparations and health care preparations*.

Class 5: Preparations for destroying vermin; Fungicides; herbicides

47. The opponent has not made any submissions in connection with these goods. I can find no goods or services in the opponent’s specification that are similar. The opposition fails with respect to *Preparations for destroying vermin, Fungicides and herbicides*.

Class 30: Tea based beverages, tea extracts, iced tea, herbal tea, infusions of tea; Coffee cocoa and artificial coffee; Teas; herbal tea; drinking coffee; coffee capsules, drinking cocoa; tea based beverages; iced tea, tea infusions; infusions of tea and tea products

48. The opponent submits that these goods are similar to its *Wholesaling and retailing of coffee, tea, cocoa and artificial coffee*. The applicant submits that the closest goods or services to all its Class 30 goods are *Wholesaling and retailing of meat, fish, poultry and game, meat extracts, frozen, preserved, dried and cooked fruits and vegetables, jellies, jams, compotes, eggs, milk and milk products, edible oils and fats, coffee, tea, cocoa and artificial coffee, rice, tapioca and sago, flour and preparations made from cereals, bread, pastry and confectionery, edible ices, sugar, honey, treacle, yeast, baking-powder, salt, mustard, vinegar, sauces (condiments), spices, ice, grains and agricultural, horticultural and forestry products, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals*. The nature and purposes are

different, but the trade channels and the users of the retail services are the same. The goods and services are not in competition, but there is a degree of complementarity, given the average consumer's awareness of own brands. I find there to be a medium degree of similarity between the applied-for goods and *Retailing of coffee, tea, cocoa and artificial coffee*.

*Class 30: Rice; Tapioca and sago; flour and preparations made from cereals; Bread, pastry and confectionery; Ices; sugar, honey, treacle; Yeast, baking-powder; Salt; Mustard; Vinegar, sauces (condiments); Spices; Ice; Chocolates; Chocolate mini-bites, Small pastry goods, confectionery*

49. The opponent submits that, for the most part, these goods are included identically within its retail services, with *small pastry goods, chocolates and chocolate mini-bites* falling within the broader term "pastry and confectionery" contained within its retail services. I agree. The analysis carried out in the above paragraph also applies here and I find there to be a medium degree of similarity.

*Class 30: Non-medicated chewing gum*

50. The opponent submits that these goods fall within the broad category of "confectionery" and are similar to its *Wholesaling and retailing of confectionery*. I consider that the analysis in paragraph [48] applies and there is a medium degree of similarity.

*Class 30: Meal replacement bars and meal replacement coffee/tea/cocoa/chocolate drink mixes; protein based nutrient dense granola-based snack bars*

51. The opponent submits that these goods are all forms of dietetic substances in the form of edible bars or beverages and are similar to its *Wholesaling and retailing of dietetic substances for medical use*. Dietetic substances would, in my view, be understood by the average consumer to refer to substances that are specifically intended to meet particular dietary requirements. I agree that *Meal replacement bars and meal replacement coffee/tea/cocoa/chocolate drink mixes* would fall within this category, as they are most likely to be used to ensure that individuals whose intake of

food is restricted receive the nutrients they require. I do not accept that *protein based nutrient dense granola-based snack bars* would be regarded as dietetic substances. However, I do consider that they would fall within the category of *preparations made from cereals*, under the ordinary meaning of that term. The analysis in paragraph [48] applies and there is a medium degree of similarity.

*Class 30: Non-alcoholic hemp based beverages with tea flavour*

52. The opponent submits that these goods are similar to its *Wholesaling and retailing of non-alcoholic beverages*. The applicant's goods would indeed fall within the general category of *non-alcoholic beverages*. While the nature and the purpose of the goods and services will differ, there will be overlap in the trade channels, as consumers buy the goods from shops or cafés and bars, and the users will be the same. The consumer will be familiar with retailers selling own-brand beverages so there is a degree of complementarity. Overall, I find there to be a medium degree of similarity between the goods and services.

*Class 32: Alcoholic hemp based beverages, namely, beer*

53. The opponent submits that these goods are similar to its *Wholesaling and retailing of beers*. While the nature and the purpose of the goods and services will differ, there will be overlap in the trade channels, as consumers buy the goods from shops or cafés and bars, and the users will be the same. The consumer will be aware that some retailers sell own-brand beers so there is a degree of complementarity. Overall, I find there to be a medium degree of similarity between the goods and services.

*Class 32: Non-alcoholic hemp based beer flavoured beverages; non-alcoholic beverages and hemp-based beverages namely, sodas; energy drinks; fruit juices; vegetable juices, non-alcoholic bitters, non-alcoholic shots; non-alcoholic ready-to-drink shots non-alcoholic hemp based malt beverages; hemp based whey beverages; hemp based isotonic beverages. Non-alcoholic spirits; mineral and carbonated waters; preparations for making beverages, fruit beverages, vegetable juices (beverages); Syrups and other preparations for making beverages; beverages based on water and plant extracts; carbonated non-alcoholic drinks; carbonated soft drinks; Cola drinks;*

De-alcoholised drinks; Fruit flavoured drinks; Fruit-flavoured soft drinks; Non-carbonated soft drinks; Soft drinks

54. The opponent submits that these goods are all types of non-alcoholic drinks or syrups or other preparations for making non-alcoholic drinks and are similar to its *Wholesaling and retailing of non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages*. While the nature and the purpose of the goods and services will differ, there will be overlap in the trade channels, as consumers buy the goods from shops or cafés and bars, and the users will be the same. The consumer will be familiar with retailers selling own-brand beverages so there is a degree of complementarity. Overall, I find there to be a medium degree of similarity between the goods and services.

Class 33: Alcoholic beverages (except beers); wines, spirits and liqueurs; alcoholic preparations for making beverages; spirit or wine-based cocktails and aperitifs; beverages containing wine; Any of the aforementioned containing hemp-derived products and/or botanicals

55. The opponent submits that these goods are similar to its *Wholesaling and retailing of alcoholic beverages (except beers), syrups and other preparations for making beverages*. While the nature and the purpose of the goods and services will differ, there will be overlap in the trade channels, as consumers buy the goods from shops or cafés and bars, and the users will be the same. The consumer will be familiar with retailers selling own-brand beverages so there is a degree of complementarity. Overall, I find there to be a medium degree of similarity between the goods and services.

Class 34: Personal vaporisers and electronic cigarettes, and flavourings and solutions therefore; Flavourings, other than essential oils, for use in electronic cigarettes; Electronic cigarette atomizers; Electronic cigarette cartomizers; Refill cartridges for electronic cigarettes; Inhalers for use as an alternative to tobacco cigarettes; Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerine; Smokeless cigarette vaporizer pipes; Electronic cigarettes; Electronic cigars; Liquid solutions for use in electronic cigarettes;

liquids for electronic cigarettes; Cigarette paper; Cigarette filters; Cigarette tubes; Ready-made cigarette tubes with filters; Tobacco containers and humidors; Lighters for smokers; Pocket machines for rolling cigarettes; Liquids for electronic cigarettes (e-liquid) made from cannabidiol; Liquids for electronic cigarettes (e-liquid) made from industrial hemp; Tobacco substitutes exclusively derivative from cannabidiol; Herbs for smoking exclusively derivative from cannabidiol; Flavourings for tobacco exclusively derivative from cannabidiol; Cigarettes containing tobacco substitutes exclusively derivative from cannabidiol; Alternative smokers' articles, namely electronic cigarettes, electronic shisha pipes, electronic smokers' pipes, electronic cigars; electronic cigarillos; Optimised electronic cigarettes, most of the elements thereof being configurable, E-liquid for electronic cigarettes, Flavourings for liquids for electronic cigarettes or personal vaporisers, flavourings for electronic cigarettes; liquid solution containing nicotine; Flavoured essences for electronic cigarettes; Nicotine bases for electronic cigarettes, nicotine-based substitutes for electronic cigarettes; Electronic cigarette filters; Cases for electronic cigarettes; Boxes for electronic cigarettes, cases for electronic cigarettes; Tips for electronic cigarettes; Tips of yellow amber for cigar and cigarette holders; Tobacco substitutes, not for medical purposes; solutions to be inhaled through electronic cigarettes; Electronic vaporisers; Essences for use with oral vaporisers for smokers; Vapour cigars and vaporiser alternatives; Vapour tubes for smokeless cigarettes; Nicotine inhalers; Scented cartridges for use with electronic devices replacing cigarettes, cigars, cigarillos and pipes, containing tobacco substitutes, not for medical purposes; Clearomizers for electronic cigarettes; wicks for electronic cigarettes; Mouthpieces (drip tips) for electronic cigarettes; Nicotine bases; Liquid solutions containing food flavourings for electronic cigarettes

56. The opponent submits that these goods all fall within the broad category of "smokers' articles" and are similar to its *Wholesaling and retailing of smokers' articles*. The users of these goods and services will be adults, as the purchasing of tobacco products is restricted in the UK to people over the age of 18. The nature and purpose are different but the trade channels are the same. There is no competition. I have no evidence before me to show whether the goods and services are complementary. The retailers are either specialists or general stores, such as supermarkets or convenience stores, and it does not seem to be a sector where such general retailers will sell their

own branded goods. Any complementarity is in my view at a fairly low level. The goods and services are similar to a low degree.

Class 35: Retail services provided through direct solicitation by a network of independent distributors and independent representatives directed to end-users featuring hemp-based products, namely, hemp-based personal care products, anti-aging products, food and nutritional supplements, chewing gums, candies, beverages, edible oils, and vaporizers; online retail store for hemp-based products, namely, hemp-based personal care products, anti-aging products, electronic vaping devices, food and nutritional supplements, chewing gums, candies, beers, beverages, alcoholic and non-alcoholic beverages, edible oils, honey, bath salts, room sprays and vaporizers; retail services, internet retail services and mail order services connected with the sale of non-medicated toilet preparations and substances, beauty preparations and substances, cosmetics, make-up, lip-stick and lip gloss, dentifrices, fragrances, perfumery, colognes, toilet waters and eau de colognes, deodorants for personal use, anti-perspirants, sun-tan and sun-screening preparations and substances, depilatory preparations and substances, massage oils, powders, creams and lotions, nail polish, nail polish remover, soaps and shampoos, shaving and after-shave preparations, preparations and substances for the conditioning, care and appearance of the skin, body, face, eyes, hair, teeth and nails, shower and bath preparations, bath oils and bath salts, talcum powder, moisturisers, pot pourri, incense, incense sticks, room fragrances and articles for perfuming rooms, non-medicated baby oils and baby creams, non-medicated baby wipes, cotton wool, candles, perfumed candles, pillow sprays, tapers; the bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase such goods in health and beauty stores, in fitness centres and in hair and beauty salons, and from mail order catalogues and online from web pages on the Internet; advice, information and assistance relating to all the aforesaid services

57. The applicant accepts that the contested retail services are identical to the opponent's Class 35 services.

Class 35: Business administration and business management of retail outlets; purchasing and demonstration of goods for others; Marketing consultation in the field

of hemp-based products, namely, hemp-based personal care products, anti-aging products, food and nutritional supplements, chewing gums, candies, beverages, edible oils, and vaporizers

58. The opponent submits that these services are all associated with retail services, provided by the same entities, are directed at the same end consumer and are complementary to the services I have just considered. Consequently, it is the opponent's view that the services are similar. Ms Blythe submitted that the applied-for services are nor similar to any of the opponent's services for the following reasons:

“(a) Those services are B2B services provided to other business and not to consumers.

(b) Each service has its own specific function/purpose that is not simply the bringing together and sale of goods to consumers and is in no way a necessary or fundamental part of the retail process.

(c) Those services therefore have a different purpose to the Opponent's retail services, are provided to different consumers, advertised and purchased through different trade channels and are therefore wholly dissimilar thereto.”<sup>9</sup>

59. I agree with Ms Blythe's submissions. I find these services to be dissimilar and the oppositions fails with respect to *Business administration and business management of retail outlets; purchasing and demonstration of goods for others; Marketing consultation in the field of hemp-based products, namely hemp-based personal care products, anti-aging products, food and nutritional supplements, chewing gums, candies, beverages, edible oils, and vaporizers.*

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<sup>9</sup> The applicant's skeleton argument, paragraph 33.



## Average Consumer and the Purchasing Process

60. The average consumer is deemed to be reasonably well informed and reasonably well observant and circumspect. For the purpose of assessing the likelihood of confusion, I must bear in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: see *Lloyd Schuhfabrik Meyer*.

61. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”<sup>10</sup>

62. The majority of the goods and services are everyday purchases that would be made by members of the general public or, in the case of *wicks for candles and lamps*, candle makers and hobbyists. This is particularly the case with the Class 3 and 30 goods and the associated retail services. The consumer would select them from the shelves of a supermarket or other shop or from a website, and so the visual aspect of the mark would be of most significance. However, I do not wholly discount the oral element as the consumer may ask for assistance from sales staff or have received word-of-mouth recommendations. For most of these goods the average consumer will be paying a medium degree of attention. In the case of low-cost impulse purchases, such as confectionery, they can be expected to be paying a low degree of attention.

63. The average consumer would, in my view, be paying a medium degree of attention when selecting which retail services to use in all but the most impulsive of these

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<sup>10</sup> Paragraph 60.

purchasing decisions. The consumer will consider the range of items on sale, the price of goods, any special offers, the location of the shop, and the levels of customer service given. Both visual and aural elements will be significant as word-of-mouth recommendations will play a role, alongside promotional material and signage in the street.

### *Smokers' articles*

64. In the case of the Class 34 goods and the retail services associated with such goods, the average consumer will be a member of the general public who smokes. These goods are not particularly expensive and are likely to be purchased relatively frequently. For e-liquids, the consumer will be considering the strength of the product and the flavour. For these goods, the consumer will be paying a medium degree of attention, particularly as they will need to ask for the goods, as UK regulations require them to be locked away. Aural considerations will therefore be particularly important, although visual considerations will also play a part as the consumer will see any marks at the point of purchase.<sup>11</sup> When choosing where to buy the goods, the consumer will have the same factors in mind as I have outlined in the previous paragraph and I find that the average consumer will be paying a medium degree of attention.

### *Alcoholic beverages*

65. Turning to the Class 33 goods, beer and related retail services, I note that the average consumer is primarily an adult member of the general public. Owners of licensed premises, such as restaurants, bars and clubs, will also be relevant. Alcoholic beverages are available in general retailers, such as supermarkets or convenience stores, or specialist off-licences, where the selection is likely to be made by a consumer from a shelf. The goods may also be bought from a mail-order catalogue or a website, where the consumer will also select the goods visually. When buying drinks in licensed premises, the consumer will request them orally from a member of staff. Even then, though, the selection will be made primarily visually, with the aid of a drinks

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<sup>11</sup> The applied-for goods do not include cigarettes and hand-rolling tobacco that are required to be sold in plain packaging.

menu or looking at a display of goods on a shelf or in a fridge. The level of attention paid to the purchase will depend on the price of the goods, which can vary greatly. In my view, the consumer will pay a medium level of attention to ensure that the goods purchased meet their, or their customers', tastes. The consumer's choice of a retail outlet will depend on a number of factors, including those I have already mentioned. The level of attention is likely to vary depending on how planned the purchase is. On balance, though, I find that the average consumer will be paying a medium degree of attention.

#### *Pharmaceutical preparations and products*

66. In *Mundipharma AG v OHIM*, Case T-256/04, the GC accepted that there are two groups of relevant consumers for pharmaceutical products: medical professionals and members of the general public. The frequency of purchase of these goods will vary depending on the specific type of product in question and whether the condition for which they are bought is temporary or ongoing. The average consumer is likely to purchase the goods from specialist suppliers, either in retail premises or from a website or mail order catalogue. Consequently, visual considerations are likely to be most significant, although I do not discount the aural element, as orders may be placed by telephone or advice sought from a pharmacist or other specialist. In *Bayer AG v EUIPO*, Case T-261/17, the GC held that the average consumer pays a heightened level of attention when selecting pharmaceutical products, including such products available without a prescription. The average consumer will pay a medium degree of attention when choosing where to buy the goods. They may look for a pharmacy sign, rather than a specific mark, although the range of goods on sale will also be relevant.

#### *Dietetic substances*

67. The average consumer of these goods and services will be a member of the general public or a professional, such as a dietician. The goods are most likely to be selected by the consumer from a shelf in a shop or from a website or printed catalogue. The visual element will therefore be most significant, although the average consumer may also seek advice from a member of staff or receive advice from a professional. The goods are likely to be purchased on fairly frequent basis and will not be very

expensive. However, the consumer will need to make sure that the products meet their particular dietary needs, and so will be paying a relatively high degree of attention to the selection. With regards to the retail services, it is my view that the average consumer will be paying a medium degree of attention.

### **Comparison of Marks**

68. It is clear from *SABEL v Puma* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* that:


“... it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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 of all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”<sup>12</sup>

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

70. The respective marks are shown below:

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<sup>12</sup> Paragraph 34.

Earlier mark	Applied-for marks
 <p>(Colour claimed: red)</p>	<p>oTo oto OTO OtO Oto oTO</p>

71. The applied-for marks consist of the three letters O, T and O in various combinations of upper and lower case. The marks have no other elements. Both parties are agreed that nothing turns on the differences in capitalisation so I shall from now on refer to them in the singular. The overall impression of the mark lies in the letters themselves.

72. The earlier mark consists of the word “OTTO” in red, slightly italicised, capital letters. Ms Blythe submitted that this “red, bubble font” creates a significant visual impact. On the other hand, the opponent submits that:

“The use of the colour red is of low distinctive value, as is the stylisation adopted by the mark. Neither of these characteristics detract from the fact that the Earlier Mark is essentially comprised of the letters OTTO. The dominant and distinctive element of the Earlier Mark are the letters OTTO.”<sup>13</sup>

I agree with the opponent. The dominant and distinctive element of the mark is the word “OTTO”. The typeface and plain colour are relatively banal and make a negligible contribution to the overall impression of the mark.

<sup>13</sup> Opponent’s written submissions, paragraph 6.

### *Visual comparison*

73. Visually, both marks contain the same letters: O and T. The earlier mark has four, and the applied-for mark three, the difference being the repeated T in the middle of the earlier mark, which makes the applied-for mark 25% shorter. The applied-for mark, being a word mark not limited to colour, would be considered to include the marks being presented in all colours: see *Specsavers International Health Care Limited & Ors v Asda Stores Limited* [2014] EWCA Civ 1294, paragraph 5. In my view, the marks have a medium degree of visual similarity, as the differences in the length are more noticeable in relatively short marks.

### *Aural comparison*

74. Ms Blythe submitted that the earlier mark would be pronounced “OTT-OH”, with a short O, while the applied-for mark would be pronounced “OH-TOE”, with a longer first vowel. This follows normal English practice, where a vowel tends to be long if followed by a single consonant and short if followed by a repeated one. It seems to me that the average consumer would pronounce the words in this way. I find that there is a medium degree of aural similarity between the marks.

### *Conceptual comparison*

75. The opponent submits that both marks have no conceptual content and would be seen by the average consumer as invented words. Ms Blythe agreed that the applied-for mark would be viewed in this way, but submitted that the average consumer would recognise the earlier mark to be a name of Germanic origin, as in the statesman Otto von Bismarck, the film director Otto Preminger or a character in *The Simpsons* cartoon series. In the absence of any evidence as to the average consumer’s knowledge of German names, I must proceed cautiously. I can accept that some consumers will identify a name, but it seems to me that there will also be a group of consumers who assume it is an invented word. For these consumers, neither mark will have any conceptual content and so a comparison cannot be made. For the former group, the earlier mark will have a meaning while the applied-for mark will not.

## **Distinctiveness of the earlier mark**

76. There is, as has already been noted, a greater likelihood of confusion if the earlier mark is highly distinctive. The CJEU provided guidance on assessing a mark's distinctive character in *Lloyd Schuhfabrik Meyer*:

“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).”

77. The opponent has filed no evidence of use of the earlier mark and therefore I have only the inherent position to consider. Earlier in this decision I found that some consumers would think that “OTTO” is a name, but that others would believe that it was an invented word. For the first group, the mark would have a medium level of inherent distinctiveness as the word does not describe or allude to the goods and services supplied under it; for the second group, the level of inherent distinctiveness would be high.

## Conclusions on Likelihood of Confusion

78. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred in paragraph 10 of this decision. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods and/or services may be offset by a greater degree of similarity between the marks, and vice versa: see *Canon*, paragraph 17. The distinctiveness of the earlier mark must also be taken into account.

79. Such a global assessment does not imply an arithmetical exercise, where the factors are scored and combined to reveal the likelihood of confusion. I must keep in mind the average consumer of the goods and/or services and the nature of the purchasing process. I note that it is generally accepted that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture they have kept in their mind: see *Lloyd Schuhfabrik Meyer*, paragraph 27.

80. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, sitting as the Appointed Person, explained that:

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



the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”<sup>14</sup>

81. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, gave helpful guidance on making the global assessment:

“81.2 ... the reason why the CJEU has stressed the importance of the ultimate global assessment is, in my view, because it is supposed to emulate what happens in the mind of the average consumer on encountering, for example, the later mark applied for with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.

81.3 ... when a tribunal is considering whether a likelihood of confusion exists, it should recognise that there are four options:

81.3.1 The average consumer mistakes one mark for the other (direct confusion);

81.3.2 The average consumer makes a connection between the marks and assumes that the goods or services in question are from the same or economically linked undertakings (indirect confusion);

81.3.3 The various factors considered in the global assessment lead to the conclusion that, in the mind of the average consumer, the later mark merely calls to mind the earlier mark (mere association);

81.3.4 For completeness, the conclusion that the various factors result in the average consumer making no link at all between the

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<sup>14</sup> Paragraph 16.

marks, but this will only be the case where either there is no or very low similarity between the marks and/or significant distance between the respective goods or services;

81.3.5 Accordingly, in most cases, it is not necessary to explicitly set out this fourth option, but I would regard it as a good discipline to set out the first three options, particularly in a case where a likelihood of indirect confusion is under consideration.”

82. The opponent submits that there is a likelihood of confusion, as the average consumer would easily overlook the differences between the marks and the identity or high degree of similarity between the goods and services is likely to lead the average consumer to believe that the applicant’s goods and services are the responsibility of, or are in some way associated with, the opponent.

83. The applicant submits that there is no likelihood of confusion, as the average consumer would notice the difference between the marks and, even if they did, would not be led to believe that there was a “same stable” relationship between the two parties, as the removal of a letter from a mark would not commonly indicate a sub-brand.

84. Ms Blythe drew my attention to the decision of Mr Iain Purvis QC, sitting as the Appointed Person, in *ELLA Trade Mark*, BL O/277/12, as support for her submission that small differences may have a significant impact in short marks. In paragraph 20, Mr Purvis states:

“In considering visual similarity, it was clearly right to take into account the shortness of the mark, since a change of one letter in a mark which is only 4 letters long is clearly more significant than such a change in a longer mark.”

85. However, Mr Purvis also said in the previous paragraph that each case must be treated on its merits, and visual similarity is just one element to be considered in the global assessment.

86. I recall the comments of Kitchin LJ in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41. Although this was an infringement case, the principles apply equally under section 5(2)(b). The emphasis below is mine:

“ ..... This court considered the characteristics of the average consumer at some length in *Interflora Inc v Marks and Spencer plc* [2015] EWCA Civ 1403 , [2014] FSR 10 from [107] to [130]. The following general points emerge further to those set out above:

i) the average consumer is a hypothetical person or, as he has been called, a legal construct; he is a person who has been created to strike the right balance between the various competing interests including, on the one hand, the need to protect consumers and, on the other hand, the promotion of free trade in an openly competitive market, and also to provide a standard, defined in EU law, which national courts may then apply;

ii) the average consumer is not a statistical test; the national court must exercise its own judgment in accordance with the principle of proportionality and the principles explained by the Court of Justice to determine the perceptions of the average consumer in any given case in the light of all the circumstances; the test provides the court with a perspective from which to assess the particular question it has to decide;

iii) in a case involving ordinary goods and services, the court may be able to put itself in the position of the average consumer without requiring evidence from consumers, still less expert evidence or a consumer survey. In such a case, the judge can make up his or her own mind about the particular issue he or she has to decide in the absence of evidence and using his or her own common sense and experience of the world. A judge may nevertheless decide that it is necessary to have recourse to an expert's opinion or a survey for the purpose of assisting the court

to come to a conclusion as to whether there is a likelihood of deception;

iv) the issue of a trade mark's distinctiveness is intimately tied to the scope of the protection to which it is entitled. So, in assessing an allegation of infringement under Article 5(1)(b) of the Directive arising from the use of a similar sign, the court must take into account the distinctiveness of the trade mark, and there will be a greater likelihood of confusion where the trade mark has a highly distinctive character either per se or as a result of the use which has been made of it. It follows that the court must necessarily have regard to the impact of the accused sign on the proportion of consumers to whom the trade mark is particularly distinctive;

v) if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”<sup>15</sup>

87. I also note that it is necessary to consider the normal and fair use of the earlier mark, as Kitchin LJ said in *Roger Maier & Anor v ASOS plc & Anor* [2015] EWCA Civ 220:

“... the court must ... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a

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<sup>15</sup> Paragraph 34

small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”<sup>16</sup>

88. I found that a proportion of consumers would understand the earlier mark to be an invented word, and consequently for them it would be highly distinctive. Where the services are identical, and bearing in mind imperfect recollection, it is my view that the average consumer is likely to be directly confused.

89. I find confusion also to be likely where the goods and services are similar. Where I found similarity of this level, it was between goods and associated retail services. It seems to me that the average consumer would mistake an inherently highly distinctive earlier mark used for retail services with the applied-for mark when used for those goods. The average consumer who thinks the earlier mark is an invented word has no concept to keep in their mind, and so could quite easily confuse double and single Ts, even in a short word.

90. The opposition succeeds in relation to all the goods and services for which I found similarity in paragraphs 26-59 of this decision.

## **Conclusion**

91. The opposition has been partially successful. The application by OTO International Ltd may proceed to registration in respect of the following goods and services:

### *Class 4*

*Tallow.*

### *Class 5*

*Materials for stopping teeth; dental wax; preparations for destroying vermin; fungicides; herbicides.*

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<sup>16</sup> Paragraph 78.

Class 35

*Business administration and business management of retail outlets; purchasing and demonstration of goods for others; Marketing consultation in the field of hemp-based products, namely, hemp-based personal care products, anti-aging products, food and nutritional supplements, chewing gums, candies, beverages, edible oils, and vaporizers; advice, information and assistance relating to all the aforesaid services.*

**COSTS**

92. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances I award the opponent the sum of £600 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

*Official fee: £100*

*Preparing a statement and considering the other side's statement: £200*

*Preparation of written submissions in lieu of attending the hearing: £300*

*Total: £600*

93. I therefore order OTO International Ltd to pay Otto (GmbH & Co KG) the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings if any appeal is unsuccessful.

**Dated this 26<sup>th</sup> day of February 2020**

**Clare Boucher  
For the Registrar  
Comptroller-General**