

O/407/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3387973

FOR THE FOLLOWING TRADE MARK

WOLF

IN THE NAME OF FLOW BEAUTY CARE INC.

IN CLASSES 3 AND 5

AND

OPPOSITION THERETO UNDER NO. 417423

BY

DR. AUGUST WOLFF GMBH & CO. KG ARZNEIMITTEL

Background and Pleadings

1. On 29 March 2019 Flow Beauty Care Inc. (“the Applicant”) filed an application to register the trade mark “WOLF” numbered 3387973 for goods in classes 3 and 5 as set out below. The application was accepted and published on 21 June 2019.

Class 3: Hair care preparations; hair care products, namely shampoos, hair conditioners, hair gels, hairsprays, hair masques and hair treatments; beauty care products, namely lotions and creams for hair; body wash; body creams; beauty creams; topical comfort creams; CBD infused hair care preparations; CBD infused hair care products, namely shampoos, hair conditioners, hair gels, hairsprays, hair masques and hair treatments; CBD infused beauty care products, namely lotions and creams for hair; CBD infused body wash; CBD infused body creams; CBD infused beauty creams; CBD infused topical comfort creams.

Class 5: Topical comfort creams; CBD infused hair care preparations; CBD infused hair care products, namely shampoos, hair conditioners, hair gels, hairsprays, hair masques and hair treatments; CBD infused beauty care products, namely lotions and creams for hair; CBD infused body wash; CBD infused body creams; CBD infused beauty creams; CBD infused topical comfort creams.

2. Dr. August Wolff GmbH & Co. KG Arzneimittel (“the Opponent”) opposes the application relying on its International Registration designating the UK under number 927667 for the trade mark “Dr. Wolff” (“IR”). It achieved protection in the UK on 13 January 2008. Whilst registered for goods and services in other classes, for the purposes of this opposition the Opponent relies only on those goods in classes 3 and 5 as set out below:

Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; disinfectants.

3. The Opponent opposes the application on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) claiming that there is a likelihood of confusion because the respective goods are identical or similar and the marks are similar.

4. The Applicant filed a defence and counterstatement denying the claims made, putting the Opponent to proof of use of its IR.

5. In these proceedings the Applicant is represented by CSY London, whereby the Opponent is represented by Sandersons. Only the Opponent filed evidence during the evidence rounds, accompanied by submissions. The Applicant chose not to file evidence in reply nor submissions. A hearing took place before me on 4 June 2020, by video conference. At the hearing the Opponent was represented by Ms Ashton Chantrielle, instructed by Sandersons and the Applicant was represented by Ms Amanda Michaels, instructed by CSY London. Both parties filed skeleton arguments.

Evidence

6. The Opponent’s evidence is in the form of a witness statement filed by Angela Thevessen dated 14 January 2020 accompanied by 3 exhibits marked AT1-3. Ms Thevessen is currently the Opponent’s Head of International Key Account Management 3 having previously held the position of Export Manager. She has worked for the company/Opponent for seven years. Ms Thevessen is duly authorised to make the statement on behalf of the Opponent and the facts contained come from her personal knowledge and experience and from the company or its associated companies’ records.

7. Ms Thevessen’s statement serves to introduce a number of images and screen shots which she states demonstrate proof of use of the Opponent’s trade mark for the goods relied upon.

8. Exhibit AT 1 is described as examples of use of the Dr. Wolff trade mark between 28 March 2014 and 28 March 2019 in relation to the ALPECIN product range. Exhibit AT1 consists of a number of images displaying the IR on bottles taken from stills of television/print/poster and online advertisements published and broadcast in the UK during 2014, 2015, 2016, 2017, 2018 and 2019. The advertisements are for “Alpecin Caffeine shampoo”. Examples of the IR displayed on the Opponent’s products as produced within Ms Thevessen’s statement are reproduced as follows:

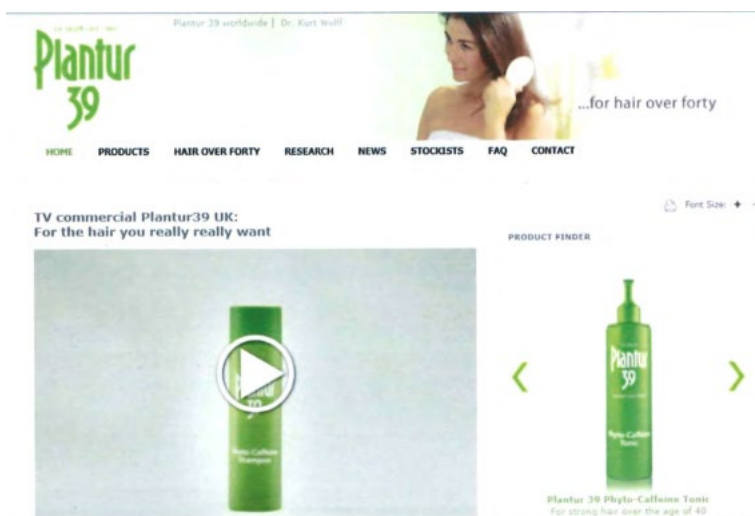


9. Exhibit AT 2 is described as further examples of use of the Dr. Wolff trade mark between 28 March 2014 and 28 March 2019 in relation to the PLANTUR 39 product range. Exhibit AT2 consists of a number of images, stills and screenshots taken from various sources to include printed publications, television and social media advertisements, a trade show display and the product's website.

10. Page 21 is annotated as an image taken from a brochure distributed in the UK in 2017 where the Dr Wolff trade mark can be seen above the Plantur 39 branding. The image produced is as follows:



11. Ms Thevessen includes a screen shot (reproduced below) taken from “the Plantur 39 product UK website” during 2014:¹



¹ Page 18 AT2

12. Ms Thevessen produces the following image described as a banner taken from the Plantur 39 UK Facebook page from 2016. The annotation describes the “Dr.Wolff trade mark as being visible above the Plantur 39 branding, at bottom left.”²



13. The images produced on Pages 26 and 27 are taken from Facebook advertisements in September 2018 and November 2018 displaying the IR on the bottles. The images are displayed as follows:



14. The image on page 22 is described as taken from a trade show display in London in November 2017 displaying the mark above the Plantur 39 branding.

² page 19 Exhibit AT2



15. Ms Thevessen exhibits two images taken from promotional articles published in Best and Prima magazines in the UK the former in June 2018 and the latter in October 2018. The article in Best magazine is said to include a reference within the text to “experts at the Dr Wolff Laboratories.”³ Similarly, the promotional article published in Prima magazine is described as referring to “hair experts at Dr. Wolff”.⁴

best PROMOTION

Great hair day

Thick, healthy hair with lots of volume and shine makes us feel youthful and confident. Here's how to help maintain your mane, whatever your age...

A full head of strong, healthy hair is so important to our body confidence, and a bad hair day really takes its toll. Yet, during the menopause, our supplies of oestrogen – the hormone that protects the hair roots – tend to dip, and you may find your tresses are thinner and more brittle. What to do? Well, caffeine is a proven hair booster. Developed by experts at the Dr Wolff Laboratories, Plantur 39's rich Phyto-Caffeine Complex helps to reduce hair loss with its unique blend of caffeine, zinc, niacin and phytoflavonoids, every time you shampoo. So, take control to replenish your hair and restore its natural beauty.

70 per cent of women who tried the Plantur 39 range noticed less hair loss*



DR KLENK ON THINNING HAIR
 Plantur an expert Dr Adolf Klenk says, "We routinely lose up to 100 hairs a day, but if you're losing more and find you're shedding a lot of hair on your brush, your roots may be the problem. If you're over 40, that is when premature hair loss can increase. To prevent hair thinning, it's a good idea to minimize stress and eat a nourishing diet that's rich in eggs, leafy greens, fruits and nuts. Avoid extreme weight-loss diets, too, and add the Plantur 39 Phyto-Caffeine Complex to your regular haircare routine."



Ready to experience thicker, fuller hair and take steps against hair loss? Find the full Plantur 39 range - including Plantur 39 tonic, shampoo and conditioner - in Boots stores, supermarkets and pharmacies. To find out more, visit plantur39.com/en-gb

*BASED ON THE 2017 & 2018 SURVEY OF 1000 WOMEN

³ Page 23 Exhibit AT2

⁴ Page 24 Exhibit AT2

Prima promotion



Problems like hair loss and thinning hair are often thought of as concerns faced by men. However, they can affect women, too – all thanks to our hormones. In women, oestrogen protects hair roots, so when our levels of this hormone dip during menopause, hair can be left feeling thin and brittle, even if you've had a full and healthy head of it all your life. Losing that youthful fullness can often mean a loss of confidence for women, too – one study found that more than a third of women said thinning hair left them feeling older, less attractive or insecure!

Thankfully, hair experts at Dr Wolff Research have developed Plantur 39 that, with its rich Phyto-Caffeine Complex, helps energise, strengthen and protect hair from root to tip every time you shampoo. The Plantur 39 range is devoted to helping mature hair look and feel wonderful: its unique blend of caffeine, zinc salts and natural phyto-active substances encourage healthy hair and can help reduce hair loss, meaning your hair will feel thicker, softer and shinier. In other words, a daily dose will help you get your glamour back...

*Survey of 2,000 UK adults in 2010 by Dr Hans-Wolff Grottel & Co. AG

Happy hair, happy you

Menopause can leave your hair feeling much less healthy than it once was. Try a caffeine boost from Plantur 39 to get it looking fabulous again



Plantur 39 has curated the perfect range to help you feel like you again, and it's available at Boots, leading supermarkets and pharmacies. To find out more, visit plantur39.com/en-gb.

16. Page 25 is an image of a print advertisement taken from Hello magazine in the UK in April 2018 and is said to show the earlier IR on the bottle.



17. Pages 28 and 30 consist of images (shown below) taken from flyers for a review campaign in the UK during 2019 described as displaying the IR above the Plantur 39 branding.





18. Page 29 is described as a still taken from a television advertisement broadcast in the UK in 2019. The IR is visible as follows “Dr. Wolff est. 1905” in the text above the Plantur 39 branding but is not visible on the products themselves from the image produced.

19. Exhibit AT 3 is described as further examples of use of the Dr. Wolff trade mark between 28 March 2014 and 28 March 2019 in relation to the VAGISAN product range. The exhibits on pages 32 and 33 are described as images from flyers distributed to pharmacies and consumers in the UK in 2014. The IR is displayed on the packaging of the product and on the flyer itself as follows:

Vaginal dryness

Vagisan® Moisturising Cream
50g cream (with vaginal applicator)

When to apply:

- Intravaginal application daily before bedtime or less often, as needed
- In the external genital area several times a day or less often, as needed
- Creams can also be applied before sexual intercourse

Ingredients:
Vagisan® Moisturising Cream
aqueous benzalkonium, mineral oil, polyethylene glycol, polyethylene glycol, polyethylene glycol, polyethylene glycol, mineral oil or hydrogen

Dr. August Wolff GmbH & Co. KG Arzneimittel
35512 Bad Wildbad - Germany
www.vagisan.co.uk
Manufactured by W. B. Pharmazeutiken Ltd. 1006 2002, Elford Close
Widgates Industrial Estate, Westborough, Rutland, UK, LE15 9JF

Vaginal dryness?

Vagisan Moisturising Cream

Hormone-free



DR WOLFF

Vaginal dryness?

Vagisan® Moisturising Cream
50g cream (with vaginal applicator)

Ingredients:
Vagisan® Moisturising Cream
aqueous benzalkonium, mineral oil, polyethylene glycol, polyethylene glycol, polyethylene glycol, polyethylene glycol, mineral oil or hydrogen


The cream contains no hormones, mineral oils or fragrances

Should you have any questions or requests, please contact us:
www.vagisan.co.uk

Vagisan Moisturising Cream

For vaginal dryness
Noticeable relief right after the first application

Hormone-free



DR WOLFF

Vaginal dryness / dryness in the genital area

► **The Causes**

During **menopause**, dryness in the genital area – inside (on the vaginal) and outside (on the vulva) – is caused by the reduced production of female sex hormones (oestrogen). Less vaginal fluid is produced in the vagina and the skin becomes thinner and more fragile. The process is quite normal, but it is bringing considerable discomfort.


However, even younger women can experience vaginal dryness, e.g. after uterine or ovarian surgery, during pregnancy and lactation, or when taking the pill. Furthermore, chemotherapy, radiation and medications used to treat cancer can cause vaginal dryness as a side effect. Vaginal dryness can also occur under stress or as a side effect of some medication, e.g. those used for treating diabetes, depression, asthma or endometriosis.

► **Typical symptoms**

The symptoms associated with vaginal dryness can impact the quality of life significantly. The sensation of dryness is often accompanied by other discomfort such as itching, burning or pain involving the **vagina, vaginal opening and external genital area**. The discomfort often makes intercourse painful.

► **Treatment**

To relieve the discomfort of vaginal dryness, **hormone-based** vaginal creams or pessaries are frequently used. They require a prescription. For women who cannot or do not wish to use hormones, there is Vagisan Moisturising Cream.



Vagisan Moisturising Cream
For use in the vagina (with applicator) and on the external genital area. Hormone-free cream that provides moisture AND soothing lipids.

With the properties typical of cream, Vagisan Moisturising Cream relieves the symptoms of dryness in the vagina and external genital area (dryness, burning, itching and pain during intercourse). If needed, Vagisan Moisturising Cream can also be applied before sexual intercourse. It is compatible also with latex condoms. (Available from your pharmacy without prescriptions)

Information and tips on vaginal dryness

Information for customers

DR WOLFF

20. The remaining images within exhibit AT3 are similar to those as described above and include images taken from a brochure distributed in the UK in 2016,⁵ a newsletter sent to pharmacies in the UK in November 2016 (reproduced below),⁶ and two print advertisements published in Woman’s Weekly magazine in February 2017 and in Feel Good You magazine supplement in Summer 2017.⁷

Newsletter November 2016

PP Code	Product	Pack Size	Case Size	Sugg. RGP Inc. VAT	Trade Price Unit	Trade Price Case
378267	Vagisan Moist Cream 50ml	50ml	6	£14.00	£9.74	£58.44

*of women aged 45+ (Santoro N, J Sex Med 2003)

⁵ Page 34

⁶ Page 35

⁷ Page 36 and 37

21. This concludes my summary of the Opponent's evidence. Whilst I have read and taken into account the submissions and skeleton arguments filed by both parties, I do not propose to summarise those here, I have however taken them into consideration and will refer to them where necessary later in my decision.

Preliminary issue

Admissibility of the descriptions accompanying the exhibits attached to Ms Thevessen's witness statement

22. The Applicant takes issue with the fact that the Opponent has provided descriptions of the images and stills within the exhibits themselves rather than within the body of Ms Thevessen's witness statement. In her skeleton argument and at the hearing Ms Michael referred to the comments appearing underneath each photograph as not forming part of Ms Thevessen's evidence and therefore should be disregarded. Ms Chantrielle referred me to the case of *Julia Kogan v Nicholas Martin and others* [2019] EWCA Civ 1645 arguing that in this case the judge accepted the contents attached in an annex as forming part of the evidence and therefore the annotations to Ms Thevessen's statement should be read in conjunction with the commentary. The discussion relating to the annex in *Kogan* however appears to be centred on the weight which had previously been placed by His Honour Judge Hacon on the contents of Ms Kogan's witness statement and annex, rather than whether the annex itself formed part of the evidence. I agree with Ms Michaels therefore in this regard that the case is of little significance. Nevertheless, notwithstanding this, I take note that Rule 64 of the Trade Mark Rules 2008, sets out the form in which evidence should take namely that it should be provided by way of a statement, affidavit or statutory declaration and include a statement of truth. I consider that the annotation below each photograph, describing each image is intended to be read together with the witness statement, which is signed and dated by the maker, refers to the exhibits and includes the appropriate attestation clause. As such I am satisfied that the comments form part of the Opponent's evidence and can be taken into account.

Decision

23. The Opponent's IR achieved protection on 13 January 2018 and as such under section 6 of the Act it qualifies as an earlier mark as it has a registration date earlier than that applied for by the Applicant. Since the IR has been registered for more than five years at the date the application was filed it is subject to the proof of use provisions contained in section 6A of the Act. In order for the Opponent to rely upon the goods listed in paragraph 2 it must demonstrate that genuine use has been made of its mark for these goods.

Proof of use

24. The relevant provisions regarding Proof of Use are set out as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

25. Section 100 of the Act is also relevant it states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

26. Accordingly under section 6A(3)(a) of the Act the relevant period in which genuine use must be established is the five year period ending on the filing date of the applied for mark. Consequently, the relevant period is from 30 March 2014 to 29 March 2019.

27. What constitutes genuine use has been subject to a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to

create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Form of the mark

28. In her skeleton argument Ms Michaels argued that “Where the evidence does show use of the name Dr Wolff it takes a variety of forms which are not the same form of the registered mark.” Furthermore, at the hearing Ms Michaels submitted that the variations should be disregarded.

29. Ms Chantrielle submitted at the hearing that the IR is used in a way that does not alter its distinctive character accepting that whilst the font changes between the different products and with additions, the mark is the same.

30. The Opponent’s mark appears in the evidence presented with additional wording, a semi circle device and in a slightly different font as seen below:



and 

31. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1). (emphasis added)

32. Where the earlier IR has been used in the form in which it is registered this will clearly be use upon which the Opponent may rely. The earlier IR as registered is in title case, however notional and fair use would allow it to be presented in any font or case.⁸ Therefore where the earlier IR is presented in the images and stills in upper case this does not prevent it from being use upon which the Opponent may rely.

⁸ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17

33. Even though Ms Michaels argues that the mark is not visible in every image produced and is in considerably smaller font, it may still be visible to consumers and therefore may still be indicative of the origin of the goods. The fact that it is used in conjunction with the sub-brands is still use of the mark as registered. The addition of the words “est 1905” and “Research” and where it is used with a semi-circle device does not in my view alter the distinctive character of the mark and detract from the mark itself which in my view will still be viewed as the mark as registered.

34. In addition, taking the decision of *Colloseum* into account, where the use is in combination with another product name, in this case Alpecin, Plantur 39 and Vagisan, this will also be regarded as acceptable use. Consumers are accustomed to seeing a house mark in conjunction with a brand mark both of which may work as trade marks on the same product to denote trade origin.

Genuine Use

35. Whether the use shown is sufficient, will depend on whether there has been real commercial exploitation of the earlier IR, in the course of trade, sufficient to create or maintain a market for the goods at issue during the relevant five-year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown
- b. The nature of the use shown
- c. The goods and services for which use has been shown
- d. The nature of those goods/services and the market(s) for them
- e. The geographical extent of the use shown

36. Use does not need to be quantitatively significant in order to be genuine, however, proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the [European Union] market for the goods or services protected by the mark” is not genuine use.

37. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

....

28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

38. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round- or lose it”” [original emphasis].

39. It is clear from the guidance that a number of factors must be considered when assessing whether genuine use of the mark has been demonstrated from the evidence filed. The responsibility is on the appropriate party, in this case the Opponent, to provide sufficiently solid evidence to counter the application, a task which should be relatively easy to attain.⁹ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹⁰

40. At the hearing Ms Chantrielle modified the Opponent’s position, accepting that the evidence of use only extended to some of the goods relied upon namely “*cosmetics and hair lotion*” in class 3 and “*pharmaceutical preparations and sanitary preparations for medical purposes*” in class 5, conceding that no use had been demonstrated for “*soaps, perfumery, essential oils, dentifrices, veterinary preparations, dietetic substances adapted for medical use, food for babies, plasters, materials for dressings and disinfectants.*” Even with these concessions, however, there are a number of deficiencies in the evidence filed by the Opponent. Despite Ms Chantrielle’s submissions that the Opponent has filed sufficient evidence to demonstrate use, Ms Thevessen’s witness statement does no more than exhibit a number of images. Other than the annotations describing those images no further explanation or substantive evidence is provided.

⁹ *Awareness Limited v Plymouth City Council*, Case BL O/236/13

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, GC Case T-415/09

41. The evidence produced relies on images and annotations; however, a number of the images themselves (both in the electronic copy and in the paper form) were of such poor quality and clarity that the earlier IR was illegible (for example those images on pages 4, 10, and 11) or did not demonstrate use for the goods relied upon as the particular product was not visible (for example those images on pages 7, 15, and 17). At the hearing Ms Chantrielle took me through each image which she stated clearly demonstrated use of the mark. However, on the whole were it not for Miss Chantrielle directing me to where the mark was positioned, I would not have been able to decipher the mark myself or without a great deal of scrutiny. For example in relation to the image on page 5 described as a print advertisement published in the Sun newspaper in 2015 even Ms Chantrielle conceded at the hearing that “Dr Wolff above the Alpecin logo.. probably cannot be seen”. During the hearing Ms Chantrielle asked me to refer to the electronic copies when assessing the evidence as they were, in her opinion, clearer copies. However even when I have done this I am in no better position. The evidence filed does not in my view support the submissions that the Dr Wolff mark is clearly displayed as stated. Ms Michaels argues, and I accept her submissions, that when coming across the product in a television advertisement which may be only on screen for a matters of seconds the IR may not be visible to consumers. No evidence has been filed to counter this.

42. In relation to the Alpecin product range produced in exhibit AT1, only five images clearly display the earlier IR without having to be directed, namely those on pages 7,8,12,14 and 15. On these pages the earlier IR is displayed in the following variations namely as “DR. WOLFF est. 1905” and “DR WOLFF-RESEARCH”. The image on page 7 is described as being a still from a television advertisement broadcast in 2015 but there is no indication as to the type of goods for which the earlier IR was used. The image on page 15 refers to a “television advertisement broadcast in the UK in 2019” but not only does the image not show the type of goods marketed, it is unclear whether it falls within the relevant period.

43. I am therefore left with only three images within exhibit AT1 produced on pages 8, 12 and 14 that I can categorically point to displaying an acceptable variation of the earlier IR for caffeine shampoo.

44. The images in exhibit AT2 are of no better quality and the Opponent's evidence suffers from the same difficulties for its Plantur 39 range as it does for its Alpecin range. The images on pages 17 and 20 clearly display the earlier IR as registered but it is unclear for what product. The still on page 17 is described as taken from a television advertisement broadcast in "2013 and 2014" but I am unable to clearly say with any certainty whether it was within the relevant period. The undated screen shot on page 18 appears to be taken from the "Plantur 39" website and I am unable to decipher the earlier IR "across the branding, at top left" as described. I cannot say with any clarity from what has been produced what the extent of the exposure to the earlier IR has been to consumers (if any) since I am not told how many views the website generated and whether any consumer would be able to see the IR from what has been produced. I am not able to decipher the earlier IR or the products within the image of the Facebook banner produced on page 19. The images on pages 28, 29 and 30 are ones where the earlier IR mark can be seen but these images are dated in "2019" and therefore again I am unable to say whether they are within the relevant period. I am only able to decipher one image of the earlier IR which relates to hair tonic on page 22 but this by itself is insufficient to demonstrate that the Opponent has created or maintained a market for these goods without any additional corroborative evidence. I do not consider therefore that the Opponent has sufficiently proved use for hair tonic.

45. The promotional articles in Best and Prima magazines in June and October 2018 refer to experts at Dr Wolff Laboratories and Dr Wolff Research within the text "having developed Plantur 39" but no details have been provided as to the circulation of the magazine or how many were sold. Other than two references to advertisements placed on Facebook¹¹ no other details are provided as to the Opponent's social media presence. No information is provided as to the number of followers or the number of clicks or likes the advertisement generated. There are only a small number of images (those on pages 26 and 27) which show the IR (albeit after some examination) displayed on bottles of shampoo and conditioner. In absence of any other corroborating evidence, however, I do not consider that this is sufficient.

¹¹ Pages 26 and 28

46. The images included within exhibit AT3 display a variation of the earlier IR for the Vagisan brand within the text of the printed material and on the packaging. However, the images on pages 32 and 33 are dated 2014 and therefore in absence of any other explanation it is unclear whether they demonstrate use within the relevant period. The newsletter dated November 2016 described as having been sent to pharmacies, refers to a “media campaign planned for 2017” and two magazine advertisements on pages 36 and 37 are produced dated Summer 2017 in support of this. However, no details are provided as to the number of newsletters printed or circulated or the number of magazines sold. Whilst the price details (reproduced below) are listed within the newsletter to pharmacies, no details are provided as to the number of units sold or distributed.

PP Code	Product	Pack Size	Case Size	Sugg. RSP Inc: VAT	Trade Price Unit	Trade Price Case
3782667	Vagisan Moist Cream 50ml	50ml	6	£14.99	£9.74	£58.44

47. I take note of the decision in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, where Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in

the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

48. No information has been filed regarding sales or turnover figures, distribution or supply details. Ms Chantrielle argues that the absence of sales figures is no indication that there have been no sales generated and that it does not undermine the fact that the Opponent’s products are stocked in leading pharmacists and supermarkets and have been marketed and advertised. However, in my view what has been filed is very scant, which I can only consider in very general terms. There is very little that I can point to categorically which demonstrates use of the mark throughout the relevant period sufficient for the Opponent to establish that it has created or maintained a share in the market for the goods relied upon (even after the concessions made). The Opponent has chosen not to file sufficiently solid evidence, and from what has been produced, very little weight can be attached to it. I can only assess the matter on the basis of the evidence as filed and not on what I may believe the position to be. I regard the absence of specific evidence in relation to turnover figures, invoices and delivery receipts as significant, as I am unable to determine not only the geographical extent of use of the Opponent’s goods within the UK but whether there has been any use. No advertising or marketing revenue is provided and on the whole the evidence lacks any specificity. A number of references to the images are annotated with such general

dates that it is unclear to me whether they are within the relevant period or not.¹² I have no doubt that a company of this size would have been required to produce accounts and company reports and therefore providing sales/turnover figures would have been a relatively easy task, but for whatever reason the Opponent has chosen not to file such evidence.

49. Assessing the evidence as a whole therefore, at best, the Opponent has produced a handful of images within the relevant period where the mark is used for shampoo conditioner and vaginal cream. Insufficient evidence has been filed to demonstrate that the Opponent has maintained or created a market for hair tonic. Taking into account *Awareness Plymouth* and *Gucci* in the absence of any other corroborative evidence regarding sales, advertising expenditure, the scale and geographical extent of the use, I am not satisfied that the Opponent has discharged the burden of demonstrating genuine use of its mark for the goods relied upon even accepting a relatively low threshold as per the caselaw. The evidence is so stark that I am unable to attach sufficient weight to it.

50. On this basis I consider that the Opponent has not filed sufficient evidence to demonstrate the requisite use for its mark for the goods relied upon (even after the limitation, set out at the hearing) and its opposition fails.

51. If however I am wrong in this assessment and the evidence filed could be regarded as having created or maintained a market for shampoo, conditioner and vaginal cream then it is necessary for me to consider the use by reference to the goods relied upon within the specification, namely “*cosmetics and hair lotion*” in class 3 and “*pharmaceutical preparations and sanitary preparations for medical purposes*” in class 5.

52. Ms Chantrielle made submissions at the hearing regarding what she considered to be included within the terms cosmetics namely that it was “a preparation, the purpose of which is to beautify the face and body”. She regarded the definition to go beyond the face and body and could extend to hair preparations. Whilst accepting

¹² AT 1 pages 4,15; AT2 page 17,18, 28, 29, 30; AT3 page 32, 33.

that the Opponent's products would not be classed as ordinary shampoo and hair care products Ms Chantrielle argued that they were cosmetic hair products assisting with the aesthetic appearance of the hair. In her view they were a specialised type of shampoo and hair product aimed at having a cosmetic impact to the hair. In support of this Ms Chantrielle referred to the definition of a cosmetic within the industry as set out in Article 2 of the EU Cosmetics Regulation (Regulation (EC) No. 1223/2009).

53. Ms Michaels argued at the hearing that it would be wrong to take account of this definition as it was intended for regulatory purposes relying instead on the 1st instance decision in *Thornton*.¹³ In this decision the hearing officer assessed the similarity between *cosmetics* and *hair care preparations, hair lotions and shampoos* finding that they were not identical but rather similar only to a moderate degree. Whilst both parties made lengthy submissions in relation to what should be regarded as being included within the term cosmetic what is key is how the term would be perceived by the average consumer.

54. To my mind shampoo and conditioner would not be regarded as a cosmetic by the average consumer taking the ordinary meaning of the term. The purpose of shampoo is to cleanse hair and the purpose of hair conditioner is to improve or maintain the hair's condition. Many ordinary shampoos on the market have colour or condition enhancing properties for example to enhance curls, give body or provide shine without them being categorised as cosmetics. I see nothing within the evidence filed by the Opponent to support the contention that consumers would regard its products as anything other than a general shampoo and conditioner. In my view I do not consider that the images filed by the Opponent demonstrate use for cosmetics or that the Opponent has created a market for cosmetic goods which I consider would be more akin to such things as mascara, lipstick and makeup facial preparations for example.

55. In relation to the Opponent's Vagisan products Ms Chantrielle argues that the Opponent's product is a pharmaceutical preparation or sanitary preparation for

¹³ BL O-511-12

medical use and as such is a medically related product. In the alternative however if there is found to be insufficient evidence that these preparations are for medical purposes then Ms Chantrielle submits that they are a product that effectively is a dry skin lotion for the vagina which would be covered by the term cosmetics. Ms Michaels argues that *pharmaceutical preparations* is far too wide a term that the Opponent can rely on it in its entirety and at best Vagisan would be regarded as a medicated vaginal cream. In addition, Ms Michaels submits that the term *sanitary preparations for medical purposes* has not been sufficiently explained to suggest that the Opponent's Vagisan would be covered by this term. I do not accept that the Opponent's Vagisan cream would be regarded by consumers as a cosmetic and find that they would regard it as a medicated product.

Fair specification

56. Notwithstanding my assessment regarding the evidence, if I am wrong regarding the consumer's perception of the term cosmetics then in any event I do not consider that the Opponent has sufficiently established use for *cosmetics* at large or for that matter *hair lotion*. The same applies in relation to the Opponent's specification for *pharmaceutical preparations* and *sanitary preparation for medical use* where the Opponent's use appears to be restricted to its Vagisan product. The Opponent should not be allowed to monopolise the use of a trade mark in relation to a broad category of goods if it has only demonstrated use in relation to a narrow subcategory. This must be balanced against not limiting the Opponent's specification too far so that the specification is unduly restrictive or overly specific. It is necessary to consider therefore what a fair specification would be to reflect the use shown.

57. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

58. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), 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

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.”

59. In my view *sanitary preparations for medical use* would be perceived as those ordinarily associated with feminine hygiene and health and therefore would include such products as medicated vaginal cream. However, this is too broad a term for the Opponent to be able to rely upon it.

60. If I am to consider that the Opponent has demonstrated some use, for the reasons outlined earlier in my decision, it has only done so for a limited number of goods. On this basis I will proceed to consider the opposition under section 5(2)(b) based on a fair specification upon which the Opponent may rely namely:

Class 3: Hair shampoo and conditioner.

Class 5: Medicated vaginal cream.

Section 5(2)(b)

61. Section 5(2)(b) of the Act states as follows:

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

(a)

(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.

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

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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 on the goods

63. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

64. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

65. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

Applicant relies on those goods as listed in paragraph where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

66. In light of my findings as outlined above the Opponent’s goods have been limited to its field of activity therefore it may only rely upon hair shampoo and conditioner in class 3 and medicated vaginal cream in class 5.

67. The Applicant seeks registration for the following:

Class 3: Hair care preparations; hair care products, namely shampoos, hair conditioners, hair gels, hairsprays, hair masques and hair treatments; beauty care products, namely lotions and creams for hair; body wash; body creams; beauty creams; topical comfort creams; CBD infused hair care preparations; CBD infused hair care products, namely shampoos, hair conditioners, hair gels, hairsprays, hair masques and hair treatments; CBD infused beauty care products, namely lotions and creams for hair; CBD infused body wash; CBD infused body creams; CBD infused beauty creams; CBD infused topical comfort creams.

Class 5: Topical comfort creams; CBD infused hair care preparations; CBD infused hair care products, namely shampoos, hair conditioners, hair gels, hairsprays, hair masques and hair treatments; CBD infused beauty care products, namely lotions and creams for hair; CBD infused body wash; CBD infused body creams; CBD infused beauty creams; CBD infused topical comfort creams.

68. Some of the contested goods i.e. *hair care products namely shampoos, hair conditioners and topical comfort cream* are identical to the goods on which the opposition is based either because the identical wording is used or because they are covered by the other’s broader term according to the principles in *Meric*. For this reason, I will not undertake a full comparison of the goods above. The examination of the opposition will proceed on the basis that the contested goods are identical to those

covered by the earlier IR. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

Average consumer and the purchasing process

69. When considering the opposing marks the average consumer is deemed reasonably informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.¹⁴

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

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

71. Both parties have accepted that the goods in question are directed at the general public and I agree with this assessment but would also consider that in relation to the goods in class 5, the relevant public may include medical professionals and pharmacists. Ms Chantrielle submitted in her skeleton argument and at the hearing that a low to average degree of care will be undertaken for the goods at large whereas Ms Michaels argued that the level of care would differ for the goods between the two classes; average for hair products and slightly higher for medical preparations.

¹⁴ *Lloyd Schuhfabrik Meyer*, case c- 342/97.

72. In my view where goods are to be used for medical purposes, a medium to high degree of attention would be paid since these goods are required to treat an ailment or to relieve discomfort and therefore it is essential for the right product to be selected. For the general public the goods in class 5 are purchased visually where they select the pharmaceutical product themselves or aurally following a consultation with a medical professional or as recommended by a pharmacist for example. The general public is likely to pay a medium to high degree of attention when selecting pharmaceutical products or medical related products as depending on the seriousness of the condition to be treated they will be careful to obtain the correct medicine especially for those to be applied to sensitive areas. Equally pharmacists or medical professions are likely to pay a medium to high level of attention when selecting pharmaceutical products for patients or customers, even if they are ones to be purchased without a prescription as it goes without saying that the consequences of making a mistake could be a serious one.

73. In relation to the goods in class 3 I consider that they are relatively inexpensive, consumable items, purchased on a fairly frequent basis from shelves of retail premises or their online equivalents. Visual considerations would therefore dominate as a result of exposure to the brand labels themselves or following television or magazine advertisements. I also do not discount aural considerations, however I accept that the goods may be purchased following discussions with sales staff in a retail setting for example. I do not consider that the level of attention is at the lowest degree as argued by Miss Chantrielle since consumers are likely to take into account such things as price and suitability especially by those that have sensitivity to certain ingredients or chemicals. On this basis I consider that at least an average level of attention will be paid in the purchasing process.

Comparison of the marks

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

CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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.”

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

76. The respective marks are as follows:

The Applicant's mark	The Opponent's mark
WOLF	Dr. Wolff

77. The Opponent submits that visually and aurally the marks are similar to a moderate to high degree and conceptually that they are similar to a medium degree. In her skeleton argument Ms Chantrielle submitted that the Opponent's mark will be seen as a last name but that the wild canine animal will also be brought to mind giving the example of other similar names such as Dr Fox and Dr Bird that would bring to mind an animal or bird.

78. The Applicant on the other hand submits that the level of visual similarity is very low and that the inclusion of the Dr element and the second f has an impact on the level of aural similarity such that they would also be regarded as low in similarity. Conceptually the marks are not similar.

79. The Applicant's mark consists of the four letter word WOLF presented in capitals. There are no other elements to contribute to the overall impression which is contained in the word itself.

80. The Opponent's mark consists of the words Dr. and Wolff. The distinctive and dominant character of the mark and thus the overall impression resides in the two words in combination as there are no other elements to contribute to the mark.

Visual Comparison

81. Since notional and fair use allows for any font or case the difference in casing has no bearing on the visual similarity assessment. The marks are similar in so far as the entirety of the applied for mark is included within the Opponent's mark. They differ in so far as the Opponent's mark includes the letters Dr (immediately regarded as an abbreviation for the title doctor) and the additional letter f. On this basis I consider that the marks are similar to a low to medium degree.

Aural comparison

82. The Applicant's mark will be given its ordinary English pronunciation namely as WOOL-PH. The Opponent's first element will be seen as an abbreviation for the word doctor, whereas, since no difference in pronunciation will be afforded to the double ff at the end of the Opponent's second element, the Opponent's mark will be pronounced as DOCK-TER-WOOL-PH. I do not discount that the double FF may give rise to a short "o" sound, which would mean that the Opponent's mark will be pronounced as DOCK-TER- WALL-PH, however, I do not consider that this is a strong possibility for UK consumers. In the first scenario weighing the similarities and the differences I consider that the marks are aurally similar to a medium degree; however in the latter scenario I consider that only a low degree of similarity exists between the marks.

Conceptual Comparison

83. I do not accept Ms Chantrielle's submissions that the Opponent's mark will be seen as either a name or a wild animal, as I do not consider that the mark will be separated into two distinct parts such that the elements will be regarded independently. The letters "Dr." will clearly be seen as an abbreviation for the title doctor and the element Wolff directly following this will be regarded in my view as a Germanic surname as a result of the double FF (or if not precisely Germanic then at least European or non-English). In combination the Opponent's mark will be regarded as the name of an individual from the medical profession named Wolff. In so far as the Applicant's mark is concerned, the ordinary meaning will be given to it. There is a distinct conceptual difference therefore between Dr Wolff and the word wolf, the former clearly regarded as a doctor whose surname is Wolff, the latter giving rise to the concept of a wild canine animal.

Distinctive Character of the Earlier IR

84. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

85. Registered trade marks possess varying degrees of inherent distinctive character; some being purely descriptive thus possessing a low degree of distinctiveness and others being invented with high inherent characteristics. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The distinctive character of a mark can be enhanced by virtue of the use made of it.

86. At the hearing Ms Chantrielle argued that the distinctiveness of the Opponent’s mark had been enhanced through the use made of it although accepting that it had not been greatly enhanced but gave “rise to a somewhat enhanced distinctive character because the average consumer would have been educated as to Dr. Wolff”. The Opponent filed no evidence however which supported such an argument. No sales figures or invoices were produced and no evidence was filed either as to the extent consumers were aware of the mark via social media or otherwise. There was no evidence of the number of views the Opponent’s Plantur 39 and Vagisan websites had achieved or the number of orders placed for the products in question which would have given an indication as to the extent the mark was known within the UK by UK consumers. Whilst Ms Chantrielle referred to the Opponent’s advertisements displaying that the goods were available in mainstream retailers such as Boots and Lloyds no further evidence was produced. On this basis the Opponent has not sufficiently demonstrated that its mark has achieved an enhanced level of distinctive character as a result of the use made of it and therefore I am only able to consider the position based on inherent characteristics.

87. As I have already noted I consider that the earlier IR will be seen by the average UK consumer, as a name of an individual from the medical profession but which does not describe any characteristic of the goods other than as Ms Michaels argues, having

some allusive connection to the Opponent's goods in class 5 as "denoting a medical or scientific aspect to the source of the goods". In my view the mark would be more indicative of the surname of the founder of the business or of the manufacturer of the goods. Names be they first names or surnames are commonly used as trade marks; the more common the surname the less distinctive the mark. Whilst I do not consider that the name Dr. Wolff will be regarded as a particularly common surname for a doctor within the UK, neither would I consider it as being particularly unusual that it elevates the mark's level of distinctive character. Overall, I place the level of inherent distinctive character of the mark as a whole at no higher than average.

Likelihood of confusion

88. When considering whether there is a likelihood of confusion between the marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods and services originate from the same or related source.

89. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison and that the purpose of a trade mark is to distinguish the goods and services of one undertaking from another. In doing so, I must consider that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

90. Earlier in my decision I found that the respective marks were visually similar to a low to medium degree and aurally similar to either a low or at its highest a medium degree. However, I found that the marks had different concepts such that they were conceptually distinct. In so far as the goods in class 3, I considered that the average consumer would select the goods via visual means paying an average level of

attention and a medium to high degree for the respective goods in class 5 irrespective of whether the consumer was a medical professional or a member of the public. I also accepted that there was an aural aspect to the purchasing process. I considered that the earlier IR had an average degree of inherent distinctiveness and for the purposes of this assessment I regarded the goods to be identical.

91. In terms of direct confusion, I do not consider it likely that the average consumer will mistake one mark for the other. There are sufficient differences between the visual characteristics of the marks to ensure that the average consumer distinguishes between them, particularly when the conceptual differences are so pronounced. Whether the goods are selected visually or aurally, the differences will not go unnoticed.

92. Moving on to indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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, I conclude that it is another brand of the owner of the earlier mark.”

93. Furthermore, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that the finding of indirect confusion should not be made merely because a mark brings to mind another mark; this is association rather than confusion.

94. It does not necessarily follow therefore that a likelihood of confusion arises just because the Applicant's mark is included within the Opponent's second element. Whilst the respective marks are similar to the extent that they both include the word Wolf/WOLF, the comparison must be made by looking at the marks as wholes.¹⁵ In addition account must be taken as to the contribution of each element to the distinctiveness of the respective marks. In my view the distinctive character of the Opponent's mark lies in the combination of the two elements Dr. and Wolff, making up a name of an individual. The element Wolff in the Opponent's mark has not retained an independent and distinctive role. Removing the "Dr" element and the additional letter "f" from the Opponent's mark would not be a natural brand extension or sub brand, such that consumers would consider that the Applicant's goods are provided by the Opponent or vice versa. I see no reason for consumers to consider that the goods would be provided by the same or related undertaking. At best if the average consumer goes through this mental process in my view it would merely bring to mind the other's mark as envisaged in *Duebros*.

95. In addition in *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

96. In my view there is such a pronounced contrast between the conceptual characteristics of the respective marks that it creates a difference such that consumers would not believe they were one and the same undertaking. The conceptual

¹⁵ *Whyte & Mackay Ltd. v Origin Wine UK Ltd* [2015] EWHC 1271(Ch)

differences are so clear and distinct that they override any visual or aural similarities, even where the goods are identical.¹⁶

97. Having found no confusion in relation to goods that were considered identical there is no need to consider the remaining goods as this does not place the Opponent in a stronger position. Therefore, even if I were to have found that the Opponent had successfully demonstrated use of its mark for the full extent of the goods relied upon, the opposition based on section 5(2)(b) of the Act also fails.

Conclusion

98. Subject to appeal the opposition fails in its entirety and the application may proceed to registration.

Costs

99. As the Applicant has been successful it is entitled to a contribution towards its costs. Ms Michaels made an application for a costs award on the standard scale as set out in Tribunal Practice Note 2 of 2016. Applying this guidance, I award costs to the Applicant on the following basis:

Preparing a defence and Counterstatement:	£200
Considering the Opponent's evidence and submissions:	£300
Preparing for and attending a hearing including drafting skeleton arguments:	£1000

¹⁶ *Wolf Oil v EUIPO*, C-437/16 P, EU:C:2017:737

Total:

£1500

100. I order Dr. August Wolff GmbH & Co. KG Arzneimittel to pay Flow Beauty Care Inc the sum of £1500 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this day of August 2020

Leisa Davies

For the Registrar