

**BL O-449-20**

**TRADE MARKS ACT 1994**

**REGISTRATION NO. 3343894 FOR THE TRADE MARK:**

**DAYE**

**IN THE NAME OF ANNE'S DAY LTD AND A REQUEST FOR INVALIDITY  
THERE TO UNDER NO. 502710 BY SANITARY OWL LTD**

## BACKGROUND & PLEADINGS

1. The trade mark **DAYE** was applied for on 8 October 2018 and was entered in the register on 11 January 2019. It stands registered in the name of Anne's Day Ltd ("the proprietor") for the goods shown in paragraph 13 below.

2. On 8 July 2019, Sanitary Owl Ltd ("the applicant") applied to declare the registration mentioned above invalid in full. The application is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act") with the applicant relying upon all the goods (shown in paragraph 13 below) in the following European Union Trade Mark ("EUTM") registration:

No. 17868690 for the trade mark **DAME**. This trade mark was applied for on 6 March 2018 and was entered in the register on 25 July 2018.

3. In its application, the applicant states:

"Our names are spelled the same apart from 1 letter  
They are pronounced the same apart from 1 letter  
We both make feminine hygiene products  
We have both launched innovative cotton tampons  
Our brands both promise sustainability  
We both offer a subscription service in the UK  
Our brands were launched in the same city and feature in the same publications  
We have had emails and conversations where Daye has been used interchangeably with DAME  
A potential investor has shown concern over the similarity of our names  
We are both design-led, focusing on beautiful branding as a USP."

4. The proprietor filed a counterstatement in which it admits that the goods in its registration are either identical or similar to the goods in classes 3 and 5 for which the applicant's trade mark is registered. It does, however, deny there is a likelihood of confusion.

5. In these proceedings, the applicant is represented by Withers & Rogers LLP and the proprietor by Ashfords LLP. Although only the proprietor filed evidence, both parties filed written submissions during the evidence rounds. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Periods expiring on 9 and 23 April 2020 respectively were allowed for these purposes. Both of these periods fell within the “interrupted days” period implemented by the Intellectual Property Office as a result of the disruption caused by the Covid outbreak. Consequently, the parties were allowed until 30 July 2020 in which to request a hearing and until 27 August 2020 to file written submissions. Neither party requested a hearing or elected to file written submissions in lieu. I shall keep all of the submissions filed in mind, referring to them to the extent I consider it appropriate to do so.

### **The proprietor’s evidence**

6. This consists of a witness statement, dated 18 February 2020, from Daniel Cahill, the proprietor’s trade mark attorney. Mr Cahill explains that:

“4. On 13th and 18th February, I conducted internet research into the use of the word “DAME”...”

7. Attached to his statement are eleven exhibits containing results obtained from google.com, collinsdictionary.com, wikipedia.org, bbc.co.uk, theguardian.com and inews.co.uk, all of which refer to the use of the word “DAME” in a range of different contexts. Although I see no need to summarise this evidence here in any detail, I note that exhibit DPC2 (from collinsdictionary.com), contains the following in relation to the word “DAME”:

- “1. (formerly) a woman of rank or dignity; lady
2. a nun who has taken the vows of her order, esp a Benedictine
3. archaic, mainly British  
a matronly or elderly woman
4. slang, mainly US and Canadian  
a woman

5. Also called: pantomime dame British  
the role of a comic old woman in a pantomime, usually played by a man

Dame  
in British English

NOUN (in Britain)

1. the title of a woman who has been awarded the Order of the British Empire or any of certain other orders of chivalry
2. the legal title of the wife or widow of a knight or baronet, placed before her name Dame Judith  
Compare Lady.”

8. That concludes my summary of the evidence filed to the extent I consider it necessary.

## **DECISION**

9. The relevant legislation is as follows:

“47(1)...

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b)...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2DA)...

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently

distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c)...

(3)...

(4)...

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

10. Section 5(2)(b) of the Act reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the

trade mark is applied for, the application is to be refused in relation to those goods and services only.”

11. The trade mark relied upon by the applicant at paragraph 2 qualifies as an earlier trade mark under the provisions of section 6 of the Act. As this trade mark had not been registered for more than five years at the date the application for invalidation was filed, it is not subject to the proof of use provisions. In those circumstances, the applicant is entitled to rely upon all the goods for which the trade mark is registered without having to establish that genuine use has been made of it.

### **Case law**

12. The following principles are 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 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 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

13. The competing goods are as follows:

Applicant's goods	Proprietor's goods
<p><b>Class 3</b> - Toiletries; body cleaning and beauty care preparations; tampon applicators.</p> <p><b>Class 5</b> - Feminine hygiene products; sanitary preparations and articles.</p> <p><b>Class 21</b> - Household or kitchen utensils; kitchenware; tableware, cookware and containers; cosmetic and toilet utensils and bathroom articles; articles for cleaning purposes; articles for the care of clothing and footwear; brushes; cleaning articles.</p>	<p><b>Class 3</b> - Cosmetics; toiletries; make-up; make up foundations; make-up primers; make-up powder; eyeliner; eye shadow; mascara; blusher; moisturisers; moisturising creams; anti-ageing creams; beauty care preparations; beauty care products; beauty creams; beauty tonics for application to the body; skin creams, lotions and serums; non-medicated balms, lotions and serums; bath and shower preparations; bath and shower creams; non-medicated body care preparations; non-medicated skin care preparations; non-medicated beauty preparations; non-medicated skin care beauty products; hair care preparations; bath salts; bath and shower gels; bath oils; soaps; body oils; body lotions; hand lotions; body creams; hand creams; hand and body butter; scented oils; essential oils; bath and shower preparations; bath and shower oils; bath and shower soaps; bath bombs; bath foams; bubble baths; bath pearls; bath cubes [soaps]; foaming bath liquids; scented moisturising skin cream; shampoos; conditioners; hair gels; hair</p>

	<p>spray; hair care products; hair mousse; hair wax; hair care serums; hair styling preparations; styling paste for hair; deodorants and antiperspirants.</p> <p><b>Class 5</b> - Tampons; sanitary tampons; tampons for medical purposes; sanitary towels; sanitary pads; absorbent sanitary articles.</p>
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14. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23:

“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”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

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

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

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

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

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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 where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. Although in its counterstatement the proprietor admits that its goods are either identical or similar to the applicant’s goods in classes 3 and 5, I shall, for the sake of completeness, conduct a comparison.

### **Class 3**

19. As both parties' specifications include the terms "toiletries" and "beauty care preparations", these goods are literally identical. The terms "toiletries", "body cleaning and beauty care preparations" in the applicant's specification are broad and encompass a wide range of goods. In my view, all of the remaining goods in the proprietor's specification are either synonyms of these terms or are encompassed by them and, as a consequence, are to be regarded as identical on the principles outlined in *Meric*. However, even if I am wrong in that regard, given the similarity in, inter alia, the nature, intended purpose, method of use, users and trade channels, if not identical, the remaining goods are similar to the applicant's goods to a high degree.

### **Class 5**

20. As all of the proprietor's goods would be included within the term "sanitary preparations and articles" in the applicant's specification, the goods are, once again, to be regarded as identical on the *Meric* principle.

### **The average consumer and the nature of the purchasing act**

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

22. In its counterstatement, the proprietor stated:

“14. Furthermore, whilst an average consumer of the class 3 goods in issue will pay an average degree of attention (as they are general consumer items), an average consumer of the class 5 goods in issue will pay an above average degree of attention, on the basis that the products are purchased with the health and wellbeing of the end consumer in mind.”

23. In its written submissions, the applicant, by reference to a decision of this tribunal in BL O-753-18, concludes:

“25. It follows that the consumer’s degree of attention for the respective goods...will not be more than average as these goods are general consumer items. The nature of the purchasing act is likely to be predominantly visual in nature with consumers of these goods being attracted by print advertising or on the Internet.”

24. As the parties suggest, the goods at issue in these proceedings are “general consumer items.” The average consumer for such goods is a member of the general public. As such goods are most likely to be the subject of self-selection from the shelves of a bricks and mortar retail outlet or the equivalent pages of a website, I agree that visual considerations are likely to dominate the selection process. However, aural considerations in the form of, for example, oral requests to sales assistant or word-of-mouth recommendations must not be ignored. As to the degree of care that will be paid by the average consumer when selecting such goods, the cost is, for the most part, likely to be fairly low and such goods are likely to be selected fairly frequently. However, as all of the goods are for personal use, I would expect the average consumer to pay at least a medium degree of attention to their selection.

## Comparison of trade marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, 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.”

26. It would be wrong, therefore, artificially to dissect the trade 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 they create.

<b>The applicant's trade mark</b>	<b>The proprietor's trade mark</b>
DAME	DAYE

27. Both parties' trade marks consists of a single word presented in block capital letters. Consisting of single words in which no part is empahsised or highlighted in any way, the overall impression they convey and their distinctiveness lie in the single words of which they are composed.

## Conceptual comparison

28. In its written submissions, the applicant drew my attention to the comments of the Appointed Person, Ms Anna Carboni, in *Chorkee Ltd v Cherokee Inc.*, BL O/048/08, concluding:

“20...In this case, as the word DAME is not common, and is completely meaningless in connection with the respective goods, in the absence of evidence to the contrary, it would be wrong to conclude that its meaning is known by the average consumer. DAYE has no meaning and is an invented word. Consequently, both marks will be perceived as having no obvious meaning for the goods. Therefore, they are neither conceptually similar nor different.”

29. In its written submissions, the proprietor states:

“7. As the Witness Statement evidences, the word “DAME” is understood by average consumers of the goods in issue as either a reference to (a) a mature/older lady/female; (b) a formal honours title given to a woman; or (c) a pantomime dame (i.e. a comic old woman in a pantomime, usually played by a man). In other words, it has a clear and specific meaning.

8. Conversely, the Proprietor’s Mark is an invented word, with no dictionary meaning (albeit some average consumers might regard it as a misspelling of the modern-day English word “day” (i.e. a reference to the 24 hour period of time)).”

30. In *Chorkee*, Ms Carboni stated:

“36...While the Applicant contended in its Counterstatement that the earlier marks would be recognised to refer to the Cherokee tribe and that the tribe was well known to the general public, no evidence was submitted to support this. By accepting this as fact, without evidence, the Hearing Officer was effectively taking judicial notice of the position. Judicial notice may be taken of

facts that are too notorious to be the subject of serious dispute. But care has to be taken not to assume that one's own personal experience, knowledge and assumptions are more widespread than they are."

31. In that case Ms Carboni found that although the Hearing Officer was entitled to take judicial notice of the fact that CHEROKEE was the name of a tribe of native Americans, he was not entitled to attribute this knowledge to the average UK consumer of clothing.

32. While I am conscious of the concerns expressed by Ms Carboni in relation to the approach adopted by the Hearing Officer in relation to the word "Cherokee", in my view, none of those concerns can realistically be said to apply to the word "DAME". I say this because the proprietor's evidence simply confirms my own initial impression (which I do not regard as atypical) i.e. that the word "DAME" and a number of its meanings is highly likely to be well known to the average consumer. Proceeding on that basis, the applicant's trade mark is, in my view, likely to convey a concrete conceptual message to the average consumer.

33. Although the parties appear to agree that the proprietor's "DAYE" trade mark should be treated as an invented word, its obvious visual similarity and aural identity to the well-known word "DAY" is, in my view, unlikely to escape the average consumer's attention. Considered overall, the applicant's trade mark will send a clear conceptual message to the average consumer whereas the proprietor's trade mark will either convey no message or a different conceptual message.

### **Visual comparison**

34. Both parties' trade mark consist of a four letter word in which the first two letters and final letter are identical. However, the third letter in each trade mark differs and bears no visual similarity to one another. While I accept that as a rule of thumb the beginning of words tend to have more impact than their endings, bearing in mind that in short words a difference of a single letter can be significant, it results in what I regard as a medium degree of visual similarity between the competing trade marks.

## **Aural comparison**

35. As the average consumer will, in my view, be very familiar with the word “DAME” its pronunciation is entirely predictable. Given its obvious visual similarity to the word “DAY”, that is how the average consumer is most likely to pronounce the proprietor’s “DAYE” trade mark. Weighing the similarities and differences results in a medium degree of aural similarity between the competing trade marks.

## **Distinctive character of the earlier trade mark**

36. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

37. As the applicant has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its written submissions, the applicant states:

“27. The earlier registration does not contain any descriptive elements. It has no discernible meaning in connection with cancellation applicant’s goods. The mark will be perceived as a fanciful word in connection with the goods, with no immediately discernible meaning, resulting in the mark having a high level of inherent distinctive character.”

38. As I mentioned earlier, the average consumer will, in my view, be familiar with the word “DAME” and many of its meanings, all of which refer to the female sex. Considered in that context, the applicant’s trade mark alludes to goods in classes 3

and 5 which are, for example, designed for, or particularly suited for, use by women. Rather than having a “high level of inherent distinctive character” as the applicant suggests, its trade mark is, in my view, possessed of, at best, a medium degree of inherent distinctive character.

### **Likelihood of confusion**

39. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. 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 the distinctive character of the applicant’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact 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 he has retained in his mind.

40. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

41. Earlier in this decision I concluded that:

- If not identical, the competing goods in class 3 are similar to a high degree;
- The competing goods in class 5 are identical;
- The average consumer is a member of the general public who, whilst not ignoring aural considerations, is most likely to select the goods by predominantly visual means, whilst paying at least a medium degree of attention during that process;

- The competing trade marks are visually and aurally similar to a medium degree;
- While the applicant's trade mark will convey a clear conceptual message to the average consumer, the proprietor's trade mark will either convey no conceptual message or a different conceptual message;
- The applicant's trade mark is possessed of, at best, a medium degree of inherent distinctive character.

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

“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.”

43. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

44. The fact that the competing goods are identical or similar to a high degree is a point in the applicant's favour. However, notwithstanding the degree of visual and aural similarity in play, in my view, the very clear conceptual message which will be conveyed by the applicant's trade mark will, despite its submissions to the contrary in paragraph 30 of its submissions, fix itself in the mind of the average consumer and act as a “hook” to prompt their recall. Consequently, even if the proprietor's trade mark does not convey any conceptual message and even if an average consumer

pays a low degree of attention during the selection process (thus making him/her even more prone to the effects of imperfect recollection), the very clear conceptual message sent by the applicant's trade mark is, in my view, sufficient to counteract the visual and aural similarities between the competing trade marks. That conclusion is, of course, even stronger if the average consumer conceptualises the proprietor's trade mark as it would the word "DAY" and/or if such a consumer pays the at least medium degree of attention I mentioned earlier when selecting the goods. In short, there is no likelihood of direct confusion.

45. That leaves indirect confusion to be considered. 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 recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

46. Even if the proprietor's trade mark creates no conceptual picture in the mind of the average consumer, given the very clear conceptual message sent by the applicant's trade mark, I see absolutely no reason why an average consumer who has noticed the trade marks are different, would assume that the proprietor's trade mark was connected with the applicant, simply because its trade mark shares three letters in the same position. There is no likelihood of indirect confusion.

## Overall conclusion

**47. The application has failed and, subject to any successful appeal, the proprietor's trade mark will remain registered.**

## Costs

48. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. As the proprietor has been successful, it is entitled to a contribution towards the costs it has incurred. Keeping the guidance in that TPN in mind, I award costs to the proprietor on the following basis:

Reviewing the application for invalidation, and preparing the counterstatement:	£300
Preparing evidence:	£500
Written submissions:	£100
<b>Total:</b>	<b>£900</b>

49. I order Sanitary Owl Ltd to pay to Anne's Day Ltd the sum of **£900**. 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 16th day of September 2020**

**C J BOWEN**  
**For the Registrar**