

**O-756-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION NO 3577747**

**BY DONGGUAN TIANHAO INTELLECTUAL PROPERTY SERVICE CO., LTD**

**TO REGISTER**

**Tomcare**

**AS A TRADE MARK IN CLASSES 3, 4, 11, 18, 20, 21 & 35**

**AND**

**OPPOSITION THERETO (UNDER NO. 424820)**

**BY**

**TOMMY HILFIGER LICENSING B.V.**

## BACKGROUND

1) On 12 January 2021, Dongguan Tianhao Intellectual Property Service Co., Ltd ('the applicant') applied to register the trade mark **Tomcare** in respect of the following goods and services:

**Class 3:** Air fragrance reed diffusers; Ethereal oils; Extracts of flowers[perfumes];Fumigationpreparations[perfumes];Perfumery;Scented wood; Incense; Air fragrancing preparations; Perfumes for industrial purposes; Aromatic essential oils; Essential oils for soothing the nerves; Lavender oil; Oils for perfumes and scents; Rose oil; Mint essence [essential oil]; Mint for perfumery; Perfume oils for the manufacture of cosmetic preparations; Perfumed soaps; Perfumery, essential oils; Blended essential oils; Amber[perfume];Scented water; Eau de parfum; Cosmetic preparations for the care of mouth and teeth.

**Class 4:** Beeswax; Carnauba wax; Ceresine; Wax [raw material]; Belting wax; Industrial wax; Ozokerite; Paraffin; Wax for skis; Beeswax for use in the manufacture of cosmetics; Paper spills for lighting; Christmas tree candles; Candles; Tapers for lighting; Illuminating wax; Wicks for candles; Lampwicks; Nightlights[candles]; Perfumed candles; Tinder; Petroleum jelly for industrial purposes; Fuel; Charcoal [fuel]; Lanolin for use in the manufacture of cosmetics.

**Class 11:** Light bulbs; Electric lamps; Lamps; Lamp mantles; Lamp shades; Chinese lanterns; Luminous tubes for lighting; Lights, electric, for Christmas trees; Lamps for Christmas trees; Luminoushouse numbers; Electric torches; Solar powered torches; Light-emitting diodes [LED]lighting apparatus; Fairy lights for festive decoration; Lamps for festive decoration; Lighting and lighting reflectors; Candlelamps; Electric candles; Candle lanterns; Flameless light-emitting diode candles.

**Class 18:** Purses; School bags; Travelling trunks; Handbag frames; Rucksacks; Pocket wallets; Attach cases; Handbags; Travelling bags; Briefcases; Travelling sets

[leatherware]; Suitcases; Suitcase handles; Trunks [luggage]; Vanity cases, not fitted; Haversacks; Valises; Bags; Cases of imitation leather; Wallets; Randsels [Japanese school satchels]; Suitcases with wheels; Motorized suitcases; Compression cubes adapted for luggage; Canvas bags.

**Class 20:** Silvered glass [mirrors]; Mirrors [furniture]; Mirror tiles; Hand-held mirrors [toilet mirrors]; Dressing tables; Jewellery organizer displays; Coatstands; Furniture; Display boards; Statues of wood, wax, plaster or plastic; Ambroid bars; Figurines [statuettes] of wood, wax, plaster or plastic; Figurines made of wood; Wind chimes [decoration]; Wardrobes; Display stands.

**Class 21:** Perfume burners [other than electric]; Essential oil burners; Glass bulbs [receptacles]; Glass flasks [containers]; Glass jars [carboys]; Glass stoppers; Glass bowls; Glasses [receptacles]; Painted glassware; Signboards of porcelain or glass; Porcelain ware; Ceramics for household purposes; Candelabra [candlesticks]; Candle jars [holders]; Perfume burners; Incense burners.

**Class 35:** Retail and wholesale services connected with the sale of pillows, mattresses, mattress protectors and bedding; Online retail services and mail order retail services connected with the sale of Candles, Perfumed candles, Scented candles, Fragranced candles, Table candles, Candles in tins, Musk scented candles, Aromatherapy fragrance candles, Special occasion candles; Advertising; Business management; Trade fairs (Organization of -) for commercial or advertising purposes; Organisation, operation and supervision of loyalty and incentive schemes.

2) The application was published in the Trade Marks Journal on 05 March 2021 and notice of opposition was later filed by Tommy Hilfiger Licensing B.V. ('the opponent'). The opponent claims that the trade mark application offends under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ('the Act'). It relies upon the following UK trade mark registration under both of those grounds. Under section 5(2)(b) of the Act, only

the services in class 35 are relied upon; under section 5(3) of the Act, all of the goods and services covered by the earlier mark are relied upon:

**UKTM No: 918219783**

## **TOMMY CARES**

**Class 25:** Clothing including clothing for men, women, children and infants, namely, shirts, golf shirts, t-shirts, polo shirts, knit tops, woven tops, sweatshirts, tank tops, sweaters, hoodies, cardigans, blouses, jerseys, turtle-necks, shorts, sweatpants, warm-up suits, costumes, blazers, sportswear, sport coats, trousers, jeans, jumpsuits, skirts, dresses, wedding dresses, suits, overalls, jumpers, vests, jackets, coats, raincoats, parkas, ponchos; clothing including clothing for men, women, children and infants, namely, swimwear, bikinis, swim trunks, overcoats, rainwear, wind resistant jackets, clothing for dancing namely leotards and ballet suits, sleepwear, pyjamas, bathrobes, shower caps, chasubles, underwear, lingerie, boxer shorts, belts (clothing), belts made of leather (for clothing), ties; headgear, including hats, wool hats, beanies, caps, visors, headbands (clothing), ear muffs (clothing); scarves, shawls, wristbands, cloth bibs; footwear, gym shoes, sneakers, socks, stockings, hosiery, shoes, boots, beach shoes, sandals, slippers, pumps [footwear], high-heeled shoes, espadrilles, slip-on shoes; gloves (clothing); suspenders; layettes (clothing); wet suits for water-skiing; wet suits for surfing; shower caps; sleep masks; wedding clothing.

**Class 35:** Promotional activities for humanitarian aid; recruiting contributors and sponsors for the benefit of funds; the organization of projects as well as the organizational management thereof in the context of humanitarian aid; commercial and administrative management of projects, as well as organizational management in this context, in the context of humanitarian aid; the organization, operation and supervision of loyalty and incentive schemes; advertising and promotional services; provision of business information; Retail store services in connection with perfumery, cosmetics, clothing, footwear,

headgear, linens, leather and imitation leather, leather and imitation leather bags, cases and/or card holders, bags, eyewear, jewellery, watches, horological and chronometric instruments; Operating charitable retail shops and on-line shops in connection with perfumery, cosmetics, clothing, footwear, headgear, linens, leather and imitation leather, leather and imitation leather bags, cases and/or card holders, bags, eyewear, jewellery, watches, horological and chronometric instruments.

**Class 36:** Financing of humanitarian aid; financial advice in the field of humanitarian aid; fundraising; sponsorship; raising funds for charities; organizing collections; issuance of gift and vouchers for making tangible donations; promoting (financially) the welfare of children and humanitarian aid and development; charitable fundraising and financial support services; charitable collections; charitable fund raising; all the aforementioned services also offered via an online platform.

**Filing date: 02 April 2020**

**Date of entry in the register: 01 December 2020**

3) It is claimed that the opponent's services in class 35 are either identical or highly similar to the applicant's goods and services and the respective marks are highly similar such that there exists a likelihood of confusion under section 5(2)(b) of the Act. It is also claimed that the earlier mark enjoys a reputation in the UK in respect of all the goods and services covered by it and that use of the contested mark will take unfair advantage of, or be detrimental to, the reputation and/or distinctive character of the earlier mark.

4) The trade mark relied upon by the opponent is an earlier mark, in accordance with section 6 of the Act. As the earlier mark had not been registered for more than five years at the date the application was filed, the earlier mark is not subject to the proof of use conditions as per Section 6A of the Act.

5) The applicant filed a counterstatement denying the grounds of opposition.

6) The applicant is represented by William Ji; the opponent is represented by HGF Limited. Only the opponent filed evidence which consists of a witness statement from Sine Bramming Platz and seven exhibits thereto. Neither party requested to be heard. Only the opponent filed submissions in lieu. I now make this decision after consideration of the papers before me.

## **DECISION**

### **Section 5(2)(b)**

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

“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.

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.”

### **Case law**

8) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co*

*GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles**

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

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

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

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

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

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

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

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

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

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

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

9) Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

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

10) All relevant factors relating to the goods and services should be taken into account when making the comparison. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU, Case C-39/97, stated at paragraph 23 of its judgment:

“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.”

11) Guidance on this issue has also come from Jacob J where, in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, the following factors were highlighted as being relevant:

(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.

12) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06, it was stated:

“It is true that goods are complementary if 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..”

In *Sanco SA v OHIM* Case T-249/11, the General Court (‘GC’) found that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services was very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* (BL-0-255-13):

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

13) I also bear in mind that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

14) Further, in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of

**MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

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

15) Finally, I note the decision in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM Case T-133/05) ('Merica')*, where the GC held 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16) The goods and services to be compared are:

Opponent’s services	Applicant’s goods and services
<p><b>Class 35:</b> Promotional activities for humanitarian aid; recruiting contributors and sponsors for the benefit of funds; the organization of projects as well as the organizational management thereof in the context of humanitarian aid; commercial and administrative management of projects, as well as</p>	<p><b>Class 3:</b> Air fragrance reed diffusers; Ethereal oils; Extracts of flowers[perfumes];Fumigationpreparations [perfumes];Perfumery;Scented wood; Incense; Air fragrancing preparations; Perfumes for industrial purposes; Aromatic essential oils; Essential oils for soothing the nerves; Lavender oil; Oils for</p>

organizational management in this context, in the context of humanitarian aid; the organization, operation and supervision of loyalty and incentive schemes; advertising and promotional services; provision of business information; Retail store services in connection with perfumery, cosmetics, clothing, footwear, headgear, linens, leather and imitation leather, leather and imitation leather bags, cases and/or card holders, bags, eyewear, jewellery, watches, horological and chronometric instruments; Operating charitable retail shops and on-line shops in connection with perfumery, cosmetics, clothing, footwear, headgear, linens, leather and imitation leather, leather and imitation leather bags, cases and/or card holders, bags, eyewear, jewellery, watches, horological and chronometric instruments.

perfumes and scents; Rose oil; Mint essence [essential oil]; Mint for perfumery; Perfume oils for the manufacture of cosmetic preparations; Perfumed soaps; Perfumery, essential oils; Blended essential oils; Amber[perfume];Scented water; Eau de parfum; Cosmetic preparations for the care of mouth and teeth.

**Class 4:** Beeswax; Carnauba wax; Ceresine; Wax [raw material]; Belting wax; Industrial wax; Ozokerite; Paraffin; Wax for skis; Beeswax for use in the manufacture of cosmetics; Paper spills for lighting; Christmas tree candles; Candles; Tapers for lighting; Illuminating wax; Wicks for candles; Lampwicks; Nightlights[candles]; Perfumed candles; Tinder; Petroleum jelly for industrial purposes; Fuel; Charcoal [fuel]; Lanolin for use in the manufacture of cosmetics.

**Class 11:** Light bulbs; Electric lamps; Lamps; Lamp mantles; Lamp shades; Chinese lanterns; Luminous tubes for lighting; Lights, electric, for Christmas trees; Lamps for Christmas trees; Luminous house numbers; Electric torches; Solar powered torches; Light-emitting diodes [LED] lighting apparatus; Fairy lights for festive decoration; Lamps for festive decoration; Lighting and lighting reflectors;

	<p>Candlelamps; Electric candles; Candle lanterns; Flameless light-emitting diode candles.</p> <p><b>Class 18:</b> Purses; School bags; Travelling trunks; Handbag frames; Rucksacks; Pocket wallets; Attach cases; Handbags; Travelling bags; Briefcases; Travelling sets [leatherware]; Suitcases; Suitcase handles; Trunks [luggage]; Vanity cases, not fitted; Haversacks; Valises; Bags; Cases of imitation leather; Wallets; Randsels [Japanese school satchels]; Suitcases with wheels; Motorized suitcases; Compression cubes adapted for luggage; Canvas bags.</p> <p><b>Class 20:</b> Silvered glass [mirrors]; Mirrors [furniture]; Mirror tiles; Hand-held mirrors [toilet mirrors]; Dressing tables; Jewellery organizer displays; Coatstands; Furniture; Display boards; Statues of wood, wax, plaster or plastic; Ambroid bars; Figurines [statuettes] of wood, wax, plaster or plastic; Figurines made of wood; Wind chimes [decoration]; Wardrobes; Display stands.</p> <p><b>Class 21:</b> Perfume burners [other than electric]; Essential oil burners; Glass bulbs [receptacles]; Glass flasks [containers]; Glass jars [carboys]; Glass stoppers; Glass bowls;</p>
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	<p>Glasses[receptacles]; Painted glassware;  Signboards of porcelain or glass;  Porcelain ware; Ceramics for household purposes; Candelabra [candlesticks];  Candle jars [holders]; Perfume burners;  Incense burners.</p> <p><b>Class 35:</b> Retail and wholesale services connected with the sale of pillows, mattresses, mattress protectors and bedding: Online retail services and mail order retail services connected with the sale of Candles, Perfumed candles, Scented candles, Fragranced candles, Table candles, Candles in tins, Musk scented candles, Aromatherapy fragrance candles, Special occasion candles;  Advertising; Business management; Trade fairs (Organization of -) for commercial or advertising purposes; Organisation, operation and supervision of loyalty and incentive schemes.</p>
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17) I will take each of the applicant's classes in turn, beginning with class 03, comparing the goods/services within those classes with the opponent's services. I will also, where appropriate, group the applicant's goods and services together for the purpose of the comparison.

Class 03

*Ethereal oils; Extracts of flowers[perfumes]; Fumigation preparations [perfumes]; Perfumery; Scented wood; Incense; Air fragrancing preparations; Perfumes for industrial purposes; Aromatic essential oils; Essential oils for soothing the nerves;*

*Lavender oil; Oils for perfumes and scents; Rose oil; Mint essence [essential oil]; Mint for perfumery; Perfume oils for the manufacture of cosmetic preparations; Perfumed soaps; Perfumery, essential oils; Blended essential oils; Amber[perfume]; Scented water; Eau de parfum; Cosmetic preparations for the care of mouth and teeth. (my emphasis)*

18) All of the applicant's non-underlined goods listed above appear to be items of perfumery. On the same basis as in *Oakley*, I find that the opponent's 'Retail store services in connection with perfumery...' are complementary to the above non-underlined goods of the applicant. The opponent's 'Retail store services in connection with...cosmetics...' are complementary to the applicant's underlined goods. However, the respective nature, method of use and purpose differs and there is no competitive relationship in play. I find a medium degree of similarity between the aforementioned goods and services.

*Air fragrance reed diffusers.*

19) As the case law above indicates, the fact that the applicant's goods are not identical to the goods which are the subject of the opponent's retail services does not preclude a finding of similarity between the respective goods and services. The applicant's 'Air fragrance reed diffusers' are not perfumery per se. However, it is an item used to diffuse perfume through the air. The applicant's 'Air fragrance reed diffusers' may be sold alongside items of perfumery. The applicant's goods may therefore be the subject of the same retail services as perfumery. The opponent's 'retail store services in connection with perfumery...' may therefore be important for the sale of the applicant's 'Air fragrance reed diffusers'. Consequently, it is plausible that the average consumer may believe that an undertaking selling 'Air fragrance reed diffusers' is the same, or connected to, an undertaking that provides 'retail store services in connection with perfumery...'. There is therefore a degree of complementarity in play between those goods and services. Nevertheless, the nature, purpose and method of use differs and there is no competitive relationship. I find that there is a low degree of similarity between the opponent's 'retail store services in connection with perfumery...' and the applicant's 'Air fragrance reed diffusers'.



#### Class 04

*Beeswax; Carnauba wax; Ceresine; Wax [raw material]; Belting wax; Industrial wax; Ozokerite; Paraffin; Wax for skis; Beeswax for use in the manufacture of cosmetics; Paper spills for lighting; Tapers for lighting; Illuminating wax; Wicks for candles; Lamp wicks; Tinder; Petroleum jelly for industrial purposes; Fuel; Charcoal [fuel]; Lanolin for use in the manufacture of cosmetics.*

20) I can see no similarity between any of these goods and the opponent's class 35 services. Their respective nature, methods of use and intended purpose are different, it is not obvious to me that there would be any convergence of trade channels and they are not in competition or complementary. I find no similarity between the above goods of the applicant in class 04 with the opponent's class 35 services.

*Christmas tree candles; Candles; Nightlights[candles]; Perfumed candles.*

21) All of the applicant's various candles may contain perfume and be used to make a room smell pleasant. Given their similarity in purpose and their complementary relationship, perfume and perfumed candles may therefore be sold alongside each other and be the subject of the same retail service. The opponent's 'retail store services in connection with perfumery...' may therefore be important for the sale of the applicant's various candles. Consequently, it is plausible that the average consumer may believe that an undertaking selling the applicant's candles is the same, or connected to, an undertaking that provides 'retail store services in connection with perfumery...'. There is therefore a degree of complementarity in play between those goods and services. Nevertheless, the nature, purpose and method of use differs and there is no competitive relationship. I therefore find that there is a low degree of similarity between the opponent's 'retail store services in connection with perfumery...' and the applicant's various candles.

#### Class 11

*Light bulbs; Electric lamps; Lamps; Lamp mantles; Lamp shades; Chinese lanterns; Luminous tubes for lighting; Lights, electric, for Christmas trees; Lamps for Christmas trees; Luminous house numbers; Electric torches; Solar powered torches; Light-emitting diodes [LED]lighting apparatus; Fairy lights for festive decoration; Lamps for festive decoration; Lighting and lighting reflectors; Candle lamps; Electric candles; Candle lanterns; Flameless light-emitting diode candles.*

22) I can see no similarity between any of these goods and the opponent's class 35 services. Their respective nature, methods of use and intended purpose are different, it is not obvious to me that there would be any convergence of trade channels and they are not in competition or complementary. I find no similarity between the applicant's class 11 goods with the opponent's class 35 services.

#### Class 18

*Purses; School bags; Travelling trunks; Handbag frames; Rucksacks; Pocket wallets; Attach cases; Handbags; Travelling bags; Briefcases; Travelling sets [leatherware]; Suitcases; Suitcase handles; Trunks [luggage]; Vanity cases, not fitted; Haversacks; Valises; Bags; Cases of imitation leather; Wallets; Randsels [Japanese school satchels]; Suitcases with wheels; Motorized suitcases; Compression cubes adapted for luggage; Canvas bags.*

23) On the same basis as in *Oakley*, I find that the opponent's 'Retail store services in connection with... leather and imitation leather bags, cases and/or..., bags,' are complementary to the applicant's goods in class 18. However, the respective nature, method of use and purpose differs and there is no competitive relationship in play. I find a medium degree of similarity between the aforementioned goods and services.

#### Class 20

*Silvered glass [mirrors]; Mirrors [furniture]; Mirror tiles; Hand-held mirrors [toilet mirrors]; Dressing tables; Jewellery organizer displays; Coatstands; Furniture; Display boards; Statues of wood, wax, plaster or plastic; Ambroid bars; Figurines*

*[statuettes] of wood, wax, plaster or plastic; Figurines made of wood; Wind chimes [decoration]; Wardrobes; Display stands.*

24) I can see no similarity between any of these goods and the opponent's class 35 services. Their respective nature, methods of use and intended purpose are different, it is not obvious to me that there would be any convergence of trade channels and they are not in competition or complementary. I find no similarity between the applicant's class 20 goods with the opponent's class 35 services.

#### Class 21

*Perfume burners [other than electric]; Essential oil burners; Perfume burners; Incense burners.*

25) I find that similar considerations apply to the above goods as for the applicant's 'Air fragrance reed diffusers'. For similar reasons to those given in paragraph 19, I find a low degree of similarity between the opponent's 'retail store services in connection with perfumery...' and the above goods of the applicant.

*Glass bulbs[receptacles]; Glass flasks[containers]; Glass jars [carboys]; Glass stoppers; Glass bowls; Glasses[receptacles]; Painted glassware; Signboards of porcelain or glass; Porcelain ware; Ceramics for household purposes; Candelabra [candlesticks]; Candle jars [holders].*

26) I can see no similarity between any of these goods and the opponent's class 35 services. Their respective nature, methods of use and intended purpose are different, it is not obvious to me that there would be any convergence of trade channels and they are not in competition or complementary. I find no similarity between the above goods of the applicant in class 21 and the opponent's class 35 services.

#### Class 35

*Retail and wholesale services connected with the sale of mattress protectors and bedding.*

27) The opponent's specification includes 'Retail store services in connection with... linens...'. Mattress protectors are a type of bed sheet used to protect mattresses and are therefore a specific kind of 'linens'. 'Bedding' is also broad enough to cover linens such as bed sheets etc. I therefore find that the opponent's services are identical to the applicant's services because the latter fall within the former, as per *Meric*.

*Retail and wholesale services connected with the sale of pillows, mattresses.*

28) The opponent contends that pillows and mattresses are also items of linens. I disagree. Such an interpretation is, in my view, to construe the term 'linens' too widely. Linens, in my view, is a term used to describe items made from cloth such as sheets, towels, tablecloths etc. but does not extend to items such as pillows and mattresses. It is not obvious to me that there is any real similarity between the opponent's 'Retail store services in connection with... linens...' and the applicant's services owing to their different nature, methods of use and intended purpose and that they are unlikely to be in competition or complementary in the sense described in the case law. I find no similarity between the above services of the applicant and the opponent's 'Retail store services in connection with... linens...'

*Online retail services and mail order retail services connected with the sale of Candles, Perfumed candles, Scented candles, Fragranced candles, Table candles, Candles in tins, Musk scented candles, Aromatherapy fragrance candles, Special occasion candles.*

29) It seems to me that there is some similarity between these services of the applicant and the opponent's 'retail store services in connection with perfumery...'. Both parties' services concern the bringing together of various items that contain perfume and may be used to provide a pleasant scent in a room. As such, there may be a certain degree of competition between the services. There is therefore some overlap in intended purpose and the average consumer may believe that a retailer

providing perfume may also provide perfumed candles. I find a medium degree of similarity between the respective services.

*Advertising; Trade fairs (Organization of -) for commercial or advertising purposes.*

30) These services of the applicant are identical to the opponent's 'advertising and promotional services'.

*Business management.*

31) The opponent's services include 'commercial and administrative management of projects, as well as organizational management in this context, in the context of humanitarian aid; provision of business information.' The trade channels, users and intended purpose of these services may overlap with the applicant's services. I find a medium degree of similarity between them.

*Organisation, operation and supervision of loyalty and incentive schemes.*

32) These services of the applicant are identical to the opponent's 'the organization, operation and supervision of loyalty and incentive schemes'.

33) There cannot be a likelihood of confusion where there is no similarity between the respective goods and services<sup>4</sup>. The ground under section 5(2)(b) must therefore fail, at this point, against the following goods and services of the applicant:

**Class 4:** Beeswax; Carnauba wax; Ceresine; Wax [raw material]; Belting wax; Industrial wax; Ozokerite; Paraffin; Wax for skis; Beeswax for use in the manufacture of cosmetics; Paper spills for lighting; Tapers for lighting; Illuminating wax; Wicks for candles; Lampwicks; Tinder; Petroleum jelly for industrial purposes; Fuel; Charcoal [fuel]; Lanolin for use in the manufacture of cosmetics.

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<sup>4</sup> Waterford Wedgewood v OHIM Case C-398/07

**Class 11:** Light bulbs; Electric lamps; Lamps; Lamp mantles; Lamp shades; Chinese lanterns; Luminous tubes for lighting; Lights, electric, for Christmas trees; Lamps for Christmas trees; Luminous house numbers; Electric torches; Solar powered torches; Light-emitting diodes [LED] lighting apparatus; Fairy lights for festive decoration; Lamps for festive decoration; Lighting and lighting reflectors; Candle lamps; Electric candles; Candle lanterns; Flameless light-emitting diode candles.

**Class 20:** Silvered glass [mirrors]; Mirrors [furniture]; Mirror tiles; Hand-held mirrors [toilet mirrors]; Dressing tables; Jewellery organizer displays; Coatstands; Furniture; Display boards; Statues of wood, wax, plaster or plastic; Ambroid bars; Figurines [statuettes] of wood, wax, plaster or plastic; Figurines made of wood; Wind chimes [decoration]; Wardrobes; Display stands.

**Class 21:** Glass bulbs [receptacles]; Glass flasks [containers]; Glass jars [carboys]; Glass stoppers; Glass bowls; Glasses [receptacles]; Painted glassware; Signboards of porcelain or glass; Porcelain ware; Ceramics for household purposes; Candelabra [candlesticks]; Candle jars [holders].

**Class 35:** Retail and wholesale services connected with the sale of pillows, mattresses.

### **Average consumer and the purchasing process**

34) It is necessary to determine who the average consumer is for the respective goods and services (which I have found to be identical or similar) and the manner in which they are likely to be selected. 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.”

35) I have no submissions from either party regarding the average consumer or the degree of attention that is likely to be afforded during the purchase of the goods and services at issue. In my view, the average consumer for retail services relating to perfumery, cosmetics, candles, linens and bags and the applicant’s goods (e.g. perfumery, oils/incense, bags, candles, bedding items) is the general public. The purchasing act will be primarily visual for all those goods and services as they will be sought out through signage on the high street/on-line or are likely to be selected after perusal of racks/shelves in retail establishments, or from photographs/images on Internet websites or in catalogues. That is not to say though that the aural aspect should be ignored since the goods and services may sometimes be the subject of discussions with sales representatives, for example. The cost of those goods and services is likely to vary. However, insofar as the goods are concerned, factors such as scent, size, material, aesthetics or suitability for purpose are likely to be taken account of by the consumer and, in relation to the relevant retail services, factors such as the range of goods on offer are likely to be taken into account. Generally speaking, I find that a medium degree of attention is likely to be paid during the purchase for the aforementioned goods and services.

36) Turning to the respective ‘advertising and promotional services; business management; provision of business information; organisation, commercial and administrative management of projects, as well as organizational management in this context, in the context of humanitarian aid;’ and ‘operation and supervision of loyalty and incentive schemes’, the average consumer for these services is likely to consist primarily of businesses. However, I acknowledge that the general public may also use some of those services such as advertising services. The cost of the services at issue is likely to vary but they are, generally speaking, unlikely to be inexpensive or the subject of an impulse purchase. Rather, I would expect the purchase to be a reasonably considered one, whether by a business or a member of

the general public. On the whole, I would expect a medium to high degree of attention to be paid during the purchase. The services are likely to be sought out primarily by eye using the internet or brochures. However, I do not discount that some may be the subject of aural recommendations.

### **Comparison of marks**

37) 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.”

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

38) The marks to be compared are:

**TOMMY CARES v Tomcare**



The opponent's mark consists of the two words TOMMY CARES which combine to form a unit with neither word carrying more weight in the overall impression than the other. The applicant's mark is presented as a single word, Tomcare. The opponent argues that the applicant's mark will be perceived as the two words 'Tom' and 'care'. Regardless of whether the mark is perceived as those two words conjoined or whether it is perceived as a single word, I find that the overall impression rests in the mark as a whole.

39) Visually, both marks contain 'TOM' at the beginning (the difference between the marks being upper and lower case is immaterial). This is an important point of coincidence because it is the beginnings of marks which tend to have the greater impact upon the consumer's perception. Both marks also contain 'CARE'. However, the opponent's mark also contains 'MY' at the end of 'TOM' and an 'S' at the end of 'CARE' which are absent from the applicant's mark. In my view, the latter differences give rise to conspicuous point of visual contrast between the marks. Overall, I find a medium degree of visual similarity between them.

40) Aurally, the opponent's mark will be pronounced TOM-MEE C-AIRS. The applicant's mark will be pronounced TOM-C-AIR. The opponent's mark therefore consists of three syllables; the applicant's consists of two syllables. The first syllable of the marks is identical, the second syllable of the opponent's mark is absent from the applicant's mark and the last syllable of the marks is highly similar. Overall, I find a medium degree of aural similarity between the marks.

41) Conceptually, the opponent argues that the marks are identical owing to both containing the words 'TOM' and 'CARE' (the former being a male forename which is a common abbreviation for TOMMY and the latter being a well-known English word meaning to feel concern or affection for someone or something). I disagree. I accept that the opponent's mark will immediately be perceived as a person named Tommy who cares about something/someone. The applicant's mark, on the other hand, does not immediately evoke such a meaning. In my view, the most likely way in which the applicant's mark will be perceived will be as a single, meaningless, invented word. I consider it highly unlikely that the average consumer would break the applicant's mark down into the two separate words 'Tom' and 'care'. However, even allowing for

that possibility (I put it no higher than a mere ‘possibility’, as I do not consider that it would be ‘probable’), the applicant’s mark would still, in my view, send a meaningless concept overall. This is because the word Tom does not naturally combine with the word care (as opposed to the word cares) to form a phrase which makes sense; those two words do not send an immediately recognisable concept<sup>5</sup>. It follows that whether the applicant’s mark is perceived as a single word or whether it is broken down into two words, the respective marks would be conceptually different because the opponent’s mark sends an immediate and clear conceptual message and the applicant’s mark does not.

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

42) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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

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<sup>5</sup> It has been highlighted in numerous judgments that for a conceptual meaning to be relevant it must be one capable of immediate grasp by the average consumer. See, for example, *The Picasso Estate v OHIM*, Case C-361/04 P.

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).”

43) TOMMY CARES is neither descriptive nor allusive in relation to the opponent’s services. I find that it has a normal degree of inherent distinctiveness. As to enhanced distinctiveness, the overwhelming majority of the evidence before me shows use of TOMMY HILFIGER, TOMMY JEANS and/or TOMMY.COM. Evidence going to the use of the mark relied upon, TOMMY CARES, is extremely thin.<sup>6</sup> It comes nowhere near establishing that the inherent distinctiveness of TOMMY CARES has been enhanced through use.

#### **Likelihood of confusion**

44) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

45) I will first consider the likelihood of direct confusion. I have found that some of the respective services are identical, some are similar to a medium degree and others are similar to a low degree. The earlier mark also has a normal degree of distinctive character. As regards the similarity between the marks, there is a medium degree of visual and aural similarity. However, they are conceptually different.

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<sup>6</sup> See paragraphs 32 - 34 of the witness statement of Mr Platz and exhibit SBP07.

Weighing all these factors, I find that, the average consumer paying at least a medium level of attention, is unlikely to mistake one mark for the other in relation to the relevant goods and services, even allowing for imperfect recollection and despite some of the services at issue being identical. There is no likelihood of direct confusion.

46) I now turn to consider whether there is a likelihood of indirect confusion. The opponent draws my attention to the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10<sup>7</sup>, where 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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

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<sup>7</sup> The opponent’s submissions in lieu, at paragraph 36.

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

47) I also note that in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

48) Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

49) The opponent submits:

'37. As can be seen from the Platz Statement, the Opponent has a number of sub-brands (see Platz Statement, paragraphs 29 – 32). We submit that there are scenarios where the Applicant's Contested Trade Mark could be seen as a brand extension, rebranding, or indeed collaboration with the Opponent. Consequently, we submit that there is a likelihood of indirect confusion.'

I note that the evidence of 'sub-brands' in the 'Platz Statement' shows use in relation to clothing and/or the retail services in connection with clothing. Those goods and services are not relevant to my assessment of the likelihood of confusion in the instant case. The retail services which I have found to be similar to the applicant's goods and services are retail services in connection with perfumery, cosmetics, linens and [various kinds of] bags. There is no evidence before me in relation to those particular

services and therefore no evidence that the opponent uses a number of sub-brands in relation to them. The evidence before me therefore does not assist the opponent in this regard.

50) Keeping in mind the normal degree of distinctiveness of the earlier mark, the medium degree of attention (at least) that is likely to be paid during the purchase and that the marks are visually and aurally similar to a medium degree but conceptually different, I do not consider that there is a likelihood of indirect confusion. The circumstances of this case do not fall into Mr Purvis' categories a) or b); the common element between the marks at issue is far from "so strikingly distinctive" and the later mark does not simply add a non-distinctive element to the earlier mark. As to Mr Purvis' category c), I also do not consider that one mark would be perceived as an "entirely logical and consistent" brand extension of the other bearing in mind, in particular, the conceptual difference between them. I, of course, bear in mind that the categories highlighted by Mr Purvis do not constitute an exhaustive list of all the ways in indirect confusion can occur. However, I cannot see that there is likely to be any other kind of mental process on the part of the consumer, falling outside of those categories, that is likely to lead them to believe that the respective goods and services come from the same or linked undertaking(s). **The ground under section 5(2)(b) of the Act fails.**

### **Section 5(3)**

51) I can deal with this ground swiftly. As I mentioned earlier in this decision, when assessing the distinctiveness of the earlier mark, the evidence before me showing use of the mark TOMMY CARES is extremely thin. It comes nowhere near establishing that that mark had the requisite reputation at the relevant date. Without a reputation, there can be no link or damage. **The ground under section 5(3) of the Act fails.**

### **OUTCOME**

52) **The opposition fails.**

### **COSTS**

53) As the applicant has been successful, it is entitled to a contribution towards its costs. Using the guidance in Annex A of Tribunal Practice Notice 2/2016, I award the applicant costs on the following basis:

Preparing a statement and considering the opponent's statement	£300
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54) I order Tommy Hilfiger Licensing B.V. to pay Dongguan Tianhao Intellectual Property Service Co., Ltd the sum of **£300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2nd day of September 2022**

**Beverley Hedley**  
**For the Registrar,**  
**the Comptroller-General**