

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 2043826  
BY LINKS (LONDON) LTD  
TO REGISTER A TRADE MARK  
IN CLASSES 3 & 14

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 46724  
BY UNILEVER PLC & ELIDA FABERGE LIMITED

## BACKGROUND

1) On 14 October 1995, Links (London) Ltd, of 48 - 50 Chepstow Place, London, W2 4TB, applied under the Trade Marks Act 1994 for registration of the trade mark LINKS in respect of the following

Class 3: "Soaps, hair lotions, dentifrices; perfumery for men and women; cosmetics."

Class 14: "Jewellery for men and women; horological and chronometric instruments; atomisers; vaporisers; sprayers; coasters; pillboxes; office requisites, paperweights, bookmarks, pens, pencils, pen and pencil holders, pencil sharpener covers, post-it note holders, rulers, eraser covers, calendars; clocks, watches; mirrors; bottle stops; cases for credit cards and business cards; ashtrays; collar stiffeners; luggage tags; notepad holders; match boxes, match holders; key rings; champagne flutes; money clips, tie slides, lapel pins; photograph frames; penknives, paper knives, bottle openers, corkscrews, cutlery; paperweights incorporating horological or chronometric instruments; all being partly or wholly of metal or precious metal or coated with precious metal; silver and glass coasters."

2) The application proceeded because of distinctiveness acquired through use and also honest concurrent use with registration numbers 2027629 and 1213516.

3) On the 22 April 1999 Unilever PLC and Elida Faberge Limited filed notice of a joint opposition to the application. The grounds of opposition are in summary:

a) Unilever Plc (opponent1) is the proprietor of a number of trade marks consisting of or including the word LYNX detailed at annex A. They claim to have significant goodwill and reputation in these marks.

b) The application is said to offend against sections 1(1), 3(1)(a), 3(1)(b), 3(1)(c), 3(1)(d), 3(3)(a), 3(3)(b), 3(4), 3(6), 5(2)(b), 5(3), 5(4)(a) and 32(3) of the Trade Marks Act 1994:

4) The applicants subsequently filed a counterstatement denying the above grounds.

5) Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 10 January 2001, when the applicant was represented by Mr Vanhegan of Counsel instructed by Messrs Lewis & Taylor whilst the opponents were

represented by Mr Hickey of Messrs Castles.

#### OPPONENTS' EVIDENCE

6) The opponents filed a declaration dated 2 February 1998 by Jeremy Kanter, the brand manager for the LYNX range of personal care products for Elida Faberge Limited.

7) Mr Kanter states that the trade mark LYNX was first used in the UK in 1985 in relation to a spray on deodorant, and has been used continuously since on a "range of personal care products for men". The product is available throughout the UK with retailers such as Boots, Tesco, Sainsbury, Asda and Superdrug stocking the product. He provides UK sales figures and estimated values of promotional activity for the mark LYNX as follows:

Year	Sales £millions	Promotion £millions
1992	41.3	10 - 14
1993	47.0	10 - 14
1994	50.7	8 - 12
1995	64.8	8 - 12

8) The LYNX trade mark has been promoted by use of advertisements on television, in-store promotions and magazine advertisements.

9) Mr Kanter states that in his view the mark in suit is confusingly similar to that of his company, claiming in support of this view the Registry's refusal to grant registration to his company for various LYNX marks citing the applicant's mark as being confusing (see exhibit JK7).

10) Mr Kanter also includes the following exhibits:

JK1 : examples of the current range of LYNX personal care products which consists of deodorants, shower gel and after-shave under the mark LYNX INCA, and a shower-gel and shaving -gel under the mark LYNX SKIN SYSTEME

JK2: Copies of trade circulars for the years 1992 -95 which show gift packs of personal care products under the LYNX trade mark.

JK3: A selection of invoices covering the period 1992 - 1997, each of which shows sales of LYNX products.

JK4: A video of television advertising from the years 1986 - 1998, each of which features the LYNX trade mark.

JK5: a copy of an advertisement form 1997.

JK6: Copies of various retail magazine articles dated Oct 1995 - December 1997

which include references to the LYNX trade mark.

JK7: Copies of correspondence from the UK Trade Marks Registry refusing applications from the opponent on the basis of the mark in suit.

#### APPLICANTS' EVIDENCE

11) The applicants filed a declaration dated 26 February 1999 by John Ayton, a Director of the applicant company, a position he has held since its incorporation in May 1989.

12) Mr Ayton states that although his company has not commenced the marketing of Class 3 goods they have been marketing Class 14 goods since 1989. He claims that it is intended to market the Class 3 goods in the same manner as those in Class 14 which have a device of three linked rings. This he claims will assist consumers to differentiate the two parties products. He points out that all the Class 14 products are made of metal and that similar containers would be used on the class 3 products.

13) Mr Ayton states that approximately £70,000 was spent on advertising Class 14 goods in the three years prior to the application date. The advertisements were in magazines such as *Harpers & Queen*, *Marketing Week* and *Square Meal* and also the *Evening Standard* newspaper. He also states that the goods have been exhibited. It is claimed that the applicant's goods are "in a different price bracket to that of the opponent".

14) Mr Ayton states that sales of Class 14 goods rose from £82,000 in 1990 /91 to over £5.5million in 1994/95. These figures relate to wholesale prices with retail figures being considerably higher.

15) Mr Ayton makes a number of comments about the opponent's evidence, however these do not assist me.

16) A number of exhibits were provided, most were either undated or were after the relevant date. Those which were dated prior to 14 October 1995 were:

JA4: A copy of an advertisement dated 13 October 1995 showing a photograph of corporate gifts with the contact point being the company name.

JA7: An invoice for collar stiffeners dated April 1991 for £1092.

JA13: Price list for "Wimbledon range" dated 1995.

#### OPPONENTS EVIDENCE IN REPLY.

17) Mr Kanter filed a second declaration, dated 1 November 1999. He states that the items available under the LYNX trade mark at the relevant date (14 October 1995) were:

"Bodyspray, showergel, aftershave, roll-on-deodorant, deodorant stick, aftershave gel, shaving foam, shaving gel, and moisturiser."

18) Mr Kanter states that the video of advertisements provided with his earlier statement were said to be dated between 1986 and 1998. He provides a document at exhibit JK10 which he states lists the advertisements and has a reference number which includes the date. This shows the majority to be prior to the relevant date.

19) Regarding confusability Mr Kanter states:

“I note that in section 12 of his declaration Mr Ayton makes reference to usage of the trade mark LINKS in relation to goods in Class 14 and the fact that they are all made wholly or partly of, or coated with, a precious metal or an imitation precious metal. Specific reference is made to an atomiser, an oval scent bottle and funnel, and a lipstick cover. I feel that usage in relation to goods of this nature of a trade mark which is phonetically identical to my company’s trade mark LYNX is likely to lead to actual confusion arising.”

20) Of the exhibits included with his declaration I found the following relevant:

Exhibit JK8: A selection of invoices showing sales of the full range of products (shown above) under the LYNX mark. These invoices are all dated prior to the relevant date.

Exhibit JK10: A list of the television advertisements provided at exhibit JK4 which have a date reference, and shows a number that are prior to the relevant date.

21) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

22) At the hearing Mr Hickey withdrew the grounds of opposition relating to Sections 1(1), 3(1)(a), 3(3)(a), 3(3)(b), 3(4), 3(6) and 32(3). He also clarified that the grounds of opposition under Section 5 were in relation to the whole of the applicant’s Class 3 specification and to “atomisers and sprayers” from the Class 14 specification.

23) Section 3(1) of the Act is in the following terms:

*3 (1) The following shall not be registered -*

*(a) ..,*

*(b) trade marks which are devoid of any distinctive character,*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) trade marks which consist exclusively of signs or indications which*

*have become customary in the current language or in the bona fide and established practices of the trade.*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

24) There is no suggestion that the mark is not represented graphically so the objection relates to the inherent capacity of the mark to distinguish the applicant's goods. The question is whether the word "LINKS" can perform the function of a trade mark. In considering this question I have regard to the comments of Aldous L.J. in *Philips Electronics NV v. Remington Consumer Products Ltd* [1999 RPC 809 at 818]:

"The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's mesh from another trader's welded mesh."

25) I also have regard to the comments of Morritt L.J. in the *Bach and Bach Flower Remedies Trade Marks* case [2000 RPC 513 at page 526 line 10]:

"The question is whether or not the word BACH had, by 1979, acquired such a meaning so as to be incapable, without more, of affording the requisite distinction. If it had then section 1(1) is not satisfied, the word BACH cannot be a capricious addition so that registration of the sign would be in breach of paragraph (a); if it had not then the word BACH is an addition to the words FLOWER REMEDIES which is 'capricious' because it is not purely descriptive, so that both the expression BACH FLOWER REMEDIES and the word BACH are capable of affording the necessary distinction. Accordingly I accept the submission that it is both permissible and necessary in considering the application of paragraph (a) to determine the meaning of the word as used at the time of the application for registration. I do not understand Aldous L.J. in *Philips v. Remington* in the passage I have quoted, to have been considering the relevance of use to the meaning of the word."

"The usage in question must be by those engaged in the relevant trade or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schuhfabrik* [European Court of Justice, *Lloyd Schuhfabrik Meyer v. Klijsen Handel BV* 1999 ETMR 690]. Obviously the evidence on that question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such as manufacturers, wholesalers and retailers."

26) At the hearing Mr Hickey contended that the mark in suit was a generic term within the field of jewellery and so was unsuitable for items such as chains, bracelets and watches in Class 14. Whilst I accept that chains and bracelets do have links within them it is not, in my opinion, a descriptive term for jewellery per se or chains, bracelets or watches in particular. Further, the opponent did not provide any evidence to corroborate their contention. The opposition under Section 3(1)(b), (c) & (d) therefore fails.

27) I next turn to the ground of opposition under Section 5(2)(b) which is as follows:

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

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

28) An earlier right is defined in Section 6, the relevant parts of which state

*6.- (1) In this Act an ‘earlier trade mark’ means -*

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

29) I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 rpc 117]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that: -

(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 / 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;

(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 therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

30) I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

31) The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a strong reputation, is not a valid ground for opposition to a trade mark.

32) At the hearing Mr Vanhegan contended that the goods in Class 3 were not identical although he admitted that “I cannot say they are not similar.” In my opinion the applicant’s specification is entirely subsumed by the opponent’s specifications for the mark LYNX registered under number 1179394 and 1392091. The goods are therefore identical. At the hearing Mr Vanhegan offered the following limitation to the specification:

“In relation to the Class 3 products, the containers for those products will be made partly or wholly from precious metal, or will be coated partly or wholly with precious metal.”

33) In my view this limitation does not affect the fact that the goods in Class 3 are identical.

34) Regarding the class 14 specification in the application the opposition relates solely to two items, “atomisers & sprayers”. I must therefore consider whether these goods are similar to the opponent’s goods in Class 3. In this I have regard to the decision by Jacob.J. in the *British Sugar Plc v James Robertson & Sons* [“TREAT” 1996 RPC 281]. In that case the court stated that:

“The following factors must be relevant in considering whether there is or is not similarity:

- 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 the 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”.

35) In utilising the same test and applying it to this case it is clear that the respective uses are related in that the applicant’s goods in Class 3 are used to deliver the type of goods covered by the specification of the opponent. The users would be the same. It is doubtful that the trade channels would be shared and the goods are not likely to be found on the same shelf. No evidence has been submitted on this aspect. The goods are not in direct competition. The applicant’s goods in Class 14 do bear only a very slight similarity to the opponent’s goods in Class 3.

36) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

37) As is clear from the Annex to this decision the opponents are relying on a number of registrations, some of them consisting of the word LYNX alone, others LYNX with additional words. At the hearing Mr Hickey for the opponent considered that the opponent’s strongest case was under registration 1392091 (Lynx).

38) When comparing the mark in suit to LYNX, visually the respective marks have the first letter in common, both contain an N and are short words, but are otherwise different. Aurally the words are identical. Conceptually the marks conjure quite different images, the opponent’s being the name of a feline mammal sometimes called a bobcat, whereas the applicant’s mark is a common dictionary word used in a number of ways when referring to connections.

39) I must also consider whether the opponent’s mark has a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of it. The evidence of use of the marks filed shows that LYNX is normally used solus or with a fragrance name such as Inca. The volume of sales relates to the mark LYNX, albeit with



fragrance variations. Although figures are not put into the context of the UK market for Class 3 type products, sales averaging over £50million per annum at the material date must be considered substantial. Mr Vanhegan also contended that the opponent had only used the mark on a black dome capped aerosol or deodorant type stick with the three banding or the parallel banding and the LYNX named going vertically up the side. As such this is the normal and fair use that the opponent's have made if their mark. He contrasted this with the way that the applicant intends to use their mark, as set out in their evidence. Further, he contended that the applicant's products were expensive in comparison to the mass market products of the opponent.

40) However, I must take account of all forms of normal and fair use of the respective marks, not just those which the parties may have used to date.

41) It was also contended that the absence of confusion should be taken into account. However, I note that the applicant has not used the mark in suit on products in either Class 3 or 14. Instead they have used a mark which incorporates a device of a set of rings. In any event the mere absence of instances of actual confusion cannot be regarded as conclusive.

42) Whilst the average consumer is likely to exercise some care when selecting goods for themselves in either Class 3 or 14, these are goods which are commonly purchased as presents. In such circumstances the purchaser may well have merely asked for the name of the product normally used by the recipient or have been given a word of mouth recommendation.

43) With all of this in mind I come to the conclusion that there was a realistic likelihood of confusion at 14 October 1995 in relation to the applicant's goods in Class 3. However, I do not believe that there was a likelihood of confusion at the relevant date in relation to the applicant's "Atomisers & sprayers" in Class 14, due to the low level of similarity between the goods. Consequently, the opposition under Section 5(2)(b) succeeds for Class 3 goods, but fails for the Class 14 goods.

44) I next consider the ground of opposition under Section 5(3) which reads:

*5 (3) A trade mark which -*

*(a) is identical with or similar to an earlier trade mark, and*

*(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*

*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*

45) Section 5(3) of the Act is identical in all material respects to Section 10(3) of the Act. Throughout my decision I therefore intend to look to the comments of Neuberger J. dated 21 January 2000 in the case of Premier Brands UK Ltd v Typhoon Europe Ltd [2000] FSR 767, hereinafter referred to as "Typhoon".

## **CONFUSION**

46) The issue of whether it was necessary to show confusion was raised at the hearing. In Typhoon Neuberger J stated:

“It appears tolerably clear to me from the terms of Section 10, that confusion is not a necessary ingredient to establishing infringement under Section 10(3). Indeed, this now seems to be established by authority: see Sabel [1998] RPC 199 at 223: the same view was taken by Advocate -General Jacobs in General Motors [1999] All ER (EC)865 when he said at 870 (paragraph 26)

‘[T]he issue was resolved by the [ECJ] in its judgment in Sabel....., which made it clear, when ruling on Article 5(1)(b) that Article 5(2) did not require confusion.’

(This is also consistent - or at least not inconsistent - with the view expressed obiter by Aldous LJ in British telecommunications Plc v One in a million Ltd [1999]FSR 1 at 25.)”

47) The absence of instances of actual confusion in the opponent’s evidence is not therefore fatal to their case.

### **Without due cause?**

48) In Typhoon Neuberger J stated:

“The purpose of Section 10(3) is, as I have indicated, to protect the value and goodwill of trade marks, particularly in cases where they are well known, from being unfairly taken advantage of or unfairly harmed. I accept, of course, that, as the very use of the word “unfairly” demonstrates the section is not intended to confer absolute rights on trade mark proprietors in all circumstances. However, it does not appear to me likely that it could have been envisaged that the use of a sign for goods which may in practice very heavily damage the value of a mark, whose development and exposure has been the subject matter of considerable effort and expense by the proprietor, should be immune from attack by the proprietor of the mark simply because the sign was innocently adopted. Such a construction of Section 10(3) would not only be capable of producing an unfair, even capricious, result so far as the proprietor of the trade mark is concerned, it would also encourage those considering adopting new signs to carry out a minimum amount of research, and could fairly be said to be conferring an advantage on the ignorant and lazy over the well-informed and careful. Furthermore, it seems to me undesirable that the outcome of a case where the court is satisfied that the allegedly infringing sign will seriously damage the reputation of the registered mark should depend on the view which the court forms as to the knowledge, subjective intentions, and even the unconscious desires, of the owner of the allegedly infringing sign.”

“Secondly, although I accept that the words “being without due cause” are somewhat opaque in their effect, I consider that they have to be read as not merely governing the words “the use of the sign”, but also as governing the words “takes unfair advantage of, or is detrimental to”. Section 10(3) must be read in a commercially sensible way.

Bearing in mind its overall purpose, it appears to me that (without at this stage intending to indicate where the burden of proof lies) it requires the defendant to show not merely that the use of the allegedly infringing sign in connection with the defendant's goods is "with due cause", it also requires him to show that although the use of the sign might otherwise be said "to take unfair advantage of or is detrimental to" the mark, the advantage or detriment are not "without due cause".

"Thirdly, it appears to me that this conclusion is consistent with the view of the Benelux Court in *Lucas Bols* [1976] IIC 420 at 425, where, when discussing the meaning of "without justifiable reason" which appeared in a similar context in the Uniform Benelux Trade Mark Act as "without due cause" in Section 10(3), the Court said this:"

"What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark....".

"On the same page, the court went on to suggest that a 'justifiable reason' may be 'if the user can assert an older right than that of the [registered proprietor]' but went on to emphasise that whether the alleged infringer can establish a 'justifiable reason' must be 'resolved by the trial judge according to the particular facts of each case.'."

49) The applicant claims that the mark in suit is merely use of the distinctive part of its own company name. However, the applicant has not shown evidence that it has used the mark LINKS solus. All of the evidence provided shows the company to use the full name of the company LINKS OF LONDON and a device. In contrast the opponent had, by the relevant date, used its mark for ten years.

50) In order to bring an action under Section 5(3), the opponent needs to show that the goods are dissimilar and that they have a reputation in their earlier mark. I have found earlier in this decision, see paragraph 39, that the opponent's mark has a reputation for mens fragrances in Class 3. If atomisers and sprayers are dissimilar goods then the second leg of Section 5(3) is satisfied.

51) In these circumstances I have no hesitation in reaching the conclusion that, if Unilever Plc can otherwise succeed in its claim under 5(3) the applicant can obtain no assistance from the words "without due cause" in that section.

### **Taking unfair advantage**

52) This was not covered in their evidence and at the hearing Mr Hickey made no reference to this.

### **Detriment**

53) In summary, the opponent's case that the applicant's use of the LINKS mark causes and

will cause detriment to the distinctive character or repute of the LYNX trade mark is as follows:

- 1) The identical phonetic nature of the trade marks will, despite the differences in the goods, result in members of the public associating the goods of the applicant with those of the opponent.
- 2) The use of the mark by the applicant on the goods covered by its specification will lead to tarnishing, as the mark's brand image is, to quote Mr Hickey, "full of quirky funky appeal". Whereas the applicant's goods are "serious gifts" which could become "somewhat staid or unfashionable".
- 3) The image of the opponent's mark is overtly masculine, whereas atomisers in particular are for female use. Should the opponent ever decide to use the mark to encompass the ladies perfumery market then the mark could have been tarnished by an "inappropriate user".
- 4) The applicants use of the mark LINKS which is aurally identical to the LYNX mark, in relation to atomisers and sprayers will erode the uniqueness of the LYNX mark in relation to fragrances and associated goods in Class 3.

54) I shall consider these contentions in turn.

### **Association**

55) The opponents contend that most of the relevant public, young males, seeing the applicants' mark will think of them. Mr Hickey, if I understood him correctly, contends that this, of itself, takes unfair advantage of the opponent's goodwill and reputation. Mr Hickey pointed to the substantial sales and advertising figures for the four years prior to the relevant date. These figures are said to relate to the sale of men's personal care products under the LYNX mark in the UK. In the four years prior to the relevant date sales averaged over £50million per annum. Evidence of promotions averaging over £9million per annum was provided. No figures are given for the total male personal care products or the opponent's market penetration

56) At first glance the products of the parties seem to have little in common. The opponent's contend that there are similarities in that their products are sold in containers which have a similar function to the applicant's product. Similarly the applicant's product is designed solely to be used in the delivery of perfumes and other toiletry items.

57) I am prepared to accept that the applicant's mark may remind some people of the opponent's mark. Others may think of the dictionary definition of the word, whilst others will be reminded of both.

58) I do not consider that simply being reminded of an identical trade mark with a reputation for dissimilar goods necessarily amounts to taking unfair advantage of the repute of that mark. The opponent has to establish that the association is such as to be "detrimental as to the character or repute of the [LYNX] mark". I must therefore consider the opponent's contention that the applicant's use of LINKS on atomisers and sprayers will, by association,

tarnish the opponent's brand image for male personal care products.

### **Tarnishing**

59) The concept that use of a similar or identical sign on dissimilar goods could damage or tarnish, due to potentially damaging connotations, an earlier mark is not an unfamiliar one. In the case of *Claeryn / Klarein* [Benelux Court of Justice 1.3.1975 NJ 1975,472] a mark for gin was said to be damaged by an identical sounding mark for detergent.

60) Similarly, in *Hack's application* (1941 RPC 91) the proprietors of a well known mark (BLACK MAGIC) which was registered for chocolate and chocolates succeeded in opposing an application to register the same mark for "laxatives other than laxatives made with chocolate". Morton J. found in favour of the proprietors of the earlier mark under Section 11 of the Trade Marks Act 1938 on the basis that there might be confusion in the sense that people might be 'caused to wonder' whether there was a connection in trade between the parties. The circumstances appear similar to those in the *Claeryn / Klarein* case. In both cases the potential for damage to the reputation of the earlier trade mark with consequent damage to its ability to add value to the goods in respect of which the mark had been used is manifest.

61) In this case the opponent has spent a considerable amount of money in creating a particular image for their mark. The copies of advertisements provided show that the mark is intended to appeal to what might be termed the "laddish" market. There are clear sexual overtones in the advertisements and the reader is encouraged to link the use of the opponent's products with sexual conquest. The applicant's products, far from being "quirky or funky" are more staid, traditional and at times whimsical. The opponent claims that such values would not be regarded as attractive by the average consumer of the opponent's goods. However, I regard such epithets to be harmless and I am not persuaded that they would cause such a negative reaction. This case is clearly not on all fours with the above quoted cases and any association which did occur would not cause the value of the LYNX brand to be diminished.

### **Blurring**

62) Unilever's contention in this connection is that the applicant's use of a sign, LINKS, which is aurally identical to their LYNX mark, in relation to fragrances and associated goods will inevitably erode the uniqueness of the LYNX mark in relation to fragrances and associated goods in Class 3.

63) I accept that, by virtue of the close similarity between the marks and the rather more tenuous similarity between fragrances and sprayers / atomisers, there will be members of the public who will associate the two marks. It will cause them to bring to mind the earlier mark, not in the abstract but in the context of a trade in complementary goods.

64) However, I do not believe that the existence of such an association would result in a lessening of the capacity of the LYNX mark to identify and distinguish fragrances and associated goods. Nor do I consider that it would impinge upon the reputation of the earlier mark acquired through considerable sales and promotional activity.

65) In my opinion use of the mark LINKS on "Atomisers and sprayers" would not be detrimental to the distinctive character and repute of the earlier trade

66) I therefore find that the opposition fails on the ground under Section 5(3).

67) I do not propose to consider the opposition under Section 5(4) as it was accepted at the hearing that the arguments under this heading were no stronger than those under Section 5(2) and 5(3).

68) The opposition to the applicants mark in relation to the whole of the Class 3 specification under Section 5(2)(b) has been successful, whilst the opposition to the goods in Class 14 has failed on all grounds. As grounds for refusal exist only in respect of Class three products the application will be allowed to proceed to registration if, within one month of the end of the appeal period for this decision, the applicants file a TM21 restricting the specification solely to the goods under Class 14 and excluding all Class 3 goods.

69) If the applicants do not file a TM21 restricting the specification as set out above the application will be refused in its entirety.

70) The opposition having succeeded the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £1435. This sum to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21<sup>ST</sup> day of March 2001

George W Salthouse  
For the Registrar  
The Comptroller General

## ANNEX A

Trade Mark	Number	Class	Journal	Specification
LYNX	1179394	3	5542/3087	Soaps; perfumes, colognes, cosmetics, essential oils; dentifrices; anti-perspirants; non-medicated toilet preparations, but not including preparations for the hair.
LYNX	1392091	3	5844/5967	Detergents; soaps; perfumes; eau de colognes; cosmetics; toilet waters; sprays for use on the body; essential oils; non-medicated toilet preparations for the care of the skin, scalp and the body; talcum powders; shower gels; shaving foams; shaving gels; pre-shaving and after shaving lotions; preparations for the hair; shampoos, conditioners, styling gels; dentifrices; non-medicated mouth washes; anti-perspirants; deodorants for use on the person; skin care preparations; moisturisers; skin toners; facial scrubs and washes; non medicated preparations for application to the skin for suntanning and/or sunscreening purposes; after sun moisturisers; sun tan lotions and sun blocking preparations; all included in Class 3.
LYNX NEVADA	1471051	3	5957/151	Body sprays; soaps; perfumes; essential oils; cosmetics; non-medicated toilet preparations; preparations for the hair; dentifrices; anti-perspirants; deodorants for use on the person; skin care preparations; all included in Class 3
LYNX TEMPEST	1509697	3	5978/3723	Soaps; perfumery; eau de cologne; essential oils; cosmetics; oils, creams and lotions for the skin; preparations for the hair and teeth; bath and shower gel; bath oils and foams, talcum powder, non-medicated toilet preparations; anti-perspirants; deodorants for personal use; body sprays; dentifrices; all included in Class 3.

LYNX SYSTEME	1566459	3	6056/8121	Perfumery; cosmetics; essential oils; creams, oils and lotions, all for the skin and hair; soap, non-medicated toilet preparations; deodorants for personal use; anti-perspirants; shaving foam; shaving gel; preshaving and after-shaving lotions; preparations for the skin and hair; bath and shower gel; bath oil; bath foam; all included in Class 3.
LYNX PATAGONIA	2030262	3	6109/320	Deodorants; soaps; perfumes; eau de colognes; cosmetics; toilet waters; sprays for use on the body; essential oils; non-medicated toilet preparations for the care of the skin, scalp and the body; talcum powders; shower gels; shaving foams; shaving gels; pre-shaving and after-shaving lotions; preparations for the hair; shampoos, conditions, styling gel; dentifrices; non-medicated mouthwashes; anti-perspirants; deodorants for use on the person; skin care preparations; moisturisers; skin toners; facial scrubs and washes; non-medicated preparations for application to the skin for suntanning and/or sunscreening processes; after sun moisturiser; sun tan lotion and sun blocking preparations