

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2552659
for the mark BOO BOO by Boo Boo Products Ltd**

**AND IN THE MATTER OF Opposition No. 101006
by Wasabi Frog Ltd**

**APPEAL of the Opponent from the decision of
Mr C J Bowen dated 21 June 2011**

DECISION

1. This is an appeal against a decision of Mr C J Bowen, the Hearing Officer for the Registrar, dated 21 June 2011, in which he rejected an opposition to the registration of the stylised mark shown below by Boo Boo Products Ltd (“BB”). The opponent was Wasabi Frog Ltd (“Wasabi”), owner of the earlier mark BOOHOO.

Background

- a. On 12 July 2010, BB applied to register the following stylised word mark:

The image shows the stylised word mark 'Boo Boo' in a brown, cursive font. The letters are connected and have a decorative, flowing appearance.

- There was some debate before me, which I discuss below, as to whether the mark (“the Mark”) is composed of two words: “Boo Boo” or one word: “BooBoo”. The specification of goods in the application covered a range of toiletries in Class 3, and aromatherapy and natural candles in Class 4.
2. The Mark was opposed by Wasabi on the basis of section 5(2)(b) of the 1994 Act, in light of its earlier word mark BOOHOO, which is registered for a wide range of goods in Class 3.

3. The Hearing Officer found that BB's goods in Class 3 were identical and its goods in Class 4 were highly similar to the goods for which the earlier mark is registered. The main issue on the appeal related to the Hearing Officer's assessment of the similarity between the parties' marks, which, Wasabi submitted, was erroneous and led him to the equally erroneous view that there was no likelihood of confusion between them.

Standard of appeal

4. The standard of review for this appeal is helpfully set out at paragraphs 5-6 of the decision of Daniel Alexander QC in *Digipos Store Solutions Group Limited v. Digi International Inc* [2008] RPC 24:

"5... It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (*Reef*, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference."

The decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind mentioned above.

Basis of the appeal

5. The central point on the appeal is the Opponent's contention that the Hearing Officer wrongly assessed the degree of visual similarity of the marks, because he applied the wrong legal test. The Opponent submitted that the Hearing Officer had erred in carrying out a visual comparison of the two marks on the basis that the earlier mark was in plain font and the Mark was stylised in the manner shown above. This, it said, showed that the Hearing Officer had misdirected himself, because the earlier mark is a word mark and word mark registrations cover all permutations of presentation of the registered words.
6. The Opponent relied on a number of authorities and in particular upon the decision of the Court of First Instance in the Case T-346/04, *Sadas SA v OHIM*, 24 November 2005, in which registration of the word mark "Arthur et Félicie" was opposed by the owner of the stylised, figurative earlier mark:



The applicant argued that the marks were not visually similar. The Court said:

"44. The applicant submits that the trade mark for which it seeks registration is a complex mark constituted by three words and lodged in an upright printed font of a simple 'sans-serif' type, whereas the earlier mark is composed of a single word, lodged in the form of a handwritten cursive signature showing a dot between the two stems of the letter 'a'. The different presentation of the common word 'Arthur', being of a weak intrinsic distinctive character, and the presence of the word 'Félicie' within the trade mark applied for constitute essential elements of differentiation. Moreover, the initial position of the word 'Arthur' in the trade mark sought is largely

attenuated by the strong presence of the words 'et' and 'Félicie', even if they are at the end of the sign.

45 Those arguments cannot be accepted.

46 The word element 'Arthur' must be considered the dominant element of the earlier mark, since the figurative elements remain secondary, the dot being negligible and the particular calligraphy giving no indication of the origin of the goods covered independently of the word 'Arthur'. With regard to the trade mark sought, it is made up of the coordinating conjunction 'et' and two words, 'Arthur' and 'Félicie', which, a priori, independently of their position are indistinguishable. Nevertheless, given that the trade mark begins with the word 'Arthur', that could be considered the dominant element of the trade mark sought.

47 At the visual level, given that the figurative elements of the earlier mark are secondary relative to its word element, the comparison of the signs may be carried out on the basis of the word element alone, whilst still adhering to the principle that an assessment of the likelihood of confusion, with regard to the similarity of the signs, must be based on the overall impression given by them. Accordingly, since the earlier mark Arthur is entirely included in the trade mark sought ARTHUR ET FÉLICIE, the difference linked to the addition of the words 'et' and 'Félicie' at the end of the trade mark sought is not sufficiently large to counter the similarity created by the coincidence of the dominant element of the trade mark applied for, namely the word 'Arthur'. Moreover, since registration of the trade mark ARTHUR ET FÉLICIE was sought as a word mark, nothing prevents its use in different scripts, such as, for example, a form comparable to that used by the earlier mark. As a result, the signs at issue must be considered visually similar."

7. A similar position was adopted by the CFI in Case T-386/07, *Peek & Cloppenburg v OHIM*, 29 October 2009, in which it was the earlier mark which was the unadorned word mark. The Court followed *Sadas*, saying in paragraph 27:

"the Board of Appeal was wrong to take into account the particular font used by the mark applied for in its comparison of the signs at issue. ... since the early mark is a word mark, its proprietor has the right to use it in different scripts, such as, for example, a form comparable to that used by the mark applied for."

8. Further, I note that in Case T-158/07 *Calvin Klein Trademark Trust v OHIM* Case T-158/07 the GC referred to another line of its earlier decisions (mainly relating to marks containing both words and stylisation or graphic elements) and stated:

"48 ... A word mark is a mark consisting entirely of letters, of words or of associations of words, written in printed characters in normal font, without any specific graphic element. The protection which results from registration of a word mark concerns the word mentioned in the application for registration and not the specific graphic or stylistic elements accompanying that mark. The graphic representation which the mark applied for may have in the future must not, therefore, be taken into account for the purposes of the examination of similarity (see to that effect, Case T-211/03 *Faber Chimica v OHIM – Naberska (Faber)* [2005] ECR II-1297, paragraphs 36 and 37; Case T-353/04 *Ontex v OHIM – Curon Medical (CURON)* [2007], not published in the ECR, paragraph 74; and Case T-254/06 *Radio Regenbogen Hörfunk in Baden v OHIM (RadioCom)*, not published in the ECR, paragraph 43)."

9. The Opponent submitted that *Sadas* and *Peek* show that when a registered word mark is to be compared to another mark, the fact that the latter is stylised is irrelevant, because the word mark could be used, even in normal and fair use, in a comparable stylised form. On the appeal before me, that submission was accepted by BB as a matter of law; it did not deny that "word marks protect the words registered, irrespective of format" and no point was taken on the basis that the application describes BB's mark as a "stylised word mark."
10. However, the Hearing Officer did not refer to the principle or the authorities set out above in his decision, and the first issue for me to decide on this appeal is whether

he nevertheless carried out an appropriate comparison of the parties' respective marks. The relevant parts of his decision are these:

“26. Wasabi’s trade mark consists of the letters BOOHOO presented in upper case; as no part of the trade mark is accentuated or emphasised in any way there are, in my view, no distinctive and dominant components, the distinctiveness of Wasabi’s trade mark lies in its totality. Turning to BB’s trade mark, this consists of the words Boo Boo presented as separate words in a cursive script with enlarged letter Bs. Considered in isolation the word Boo is, as far as I am aware, a distinctive component of BB’s trade mark. However, the presentation of BB’s trade mark (where the word Boo is repeated and presented in exactly the same manner), results, in my view, in there being no dominant element. The distinctiveness of BB’s trade mark (like that of Wasabi) lies in the totality that it creates which is, absent evidence to the contrary, distinctive of the goods at issue. I will approach the comparison of the competing trade marks with these conclusions in mind.

...

[Here the Hearing Officer set out the parties’ submissions.]

...

29. I have described the competing trade marks above. In simple terms both trade marks consist of six letters and differ by only one letter (the difference being in the fourth letter of the competing trade marks). However, as BB points out, its trade mark is presented as two separate words (with, I would add, very noticeably enlarged letter Bs), whereas Wasabi’s trade mark is presented as one word in which none of the elements are emphasised in any way. In *Inter-Ikea Systems BV v OHIM* the GC stated:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively

short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low.”

30. Both trade marks begin with the same three letters i.e. BOO, and I accept that as a rule of thumb the beginnings of trade marks are generally more important than their endings. However, **the manner in which the competing trade marks are presented i.e. one word as opposed to two, together with the difference in the visual impact created by the cursive script and enlarged letter Bs**, results, in my view, and **keeping in mind the comments of the court in the case mentioned above**, in only a low to moderate degree of visual similarity between them....” (*emphasis added*)

11. Dr Lawrence submitted on behalf of Wasabi that this passage demonstrated that the Hearing Officer misdirected himself in a number of ways:
 - a. He appears in the first line of paragraph 26 to have treated the earlier mark as being limited to use in upper case letters;
 - b. He appears in the fourth line of paragraph 26 to have treated the Mark as consisting of 2 separate words, whereas the mark shown above has no gap in the middle – the Mark consists of one word;
 - c. He appears to have ignored the point of principle discussed above, although it was specifically raised in Wasabi's written submissions to him. I have not set out above the Hearing Officer's quotation of the parties' written submissions to him, but he set out paragraph 12 and paragraphs 14-16 and 19-22 of Wasabi's submissions. Paragraph 13, which he did *not* set out, said: “The Opponent's Trade Mark is a word only mark. It thus covers all possible fonts and typefaces in which the Opponent's Trade Mark could be visually presented including that used by the mark covered by the Applicant's T M Application. Since the earlier mark is a word only mark, its proprietor has the

right to use it in different scripts, such as, for example, in a form comparable to that used by the mark applied for.”

The Opponent cited *Sadas* and *Peek & Cloppenburg* to the Hearing Officer in support of that submission.

- d. In paragraph 29 of the decision, the Hearing Officer appears to have placed reliance on the "very noticeably enlarged letter Bs."
- e. Dr Lawrence suggested that it was clear from paragraph 30 of the decision that the Hearing Officer had relied upon "the visual impact created by the cursive script and enlarged Bs" in assessing the visual similarity between the marks, and that such reliance was wrong in the light of *Sadas* etc. He ought to have compared the Mark with the earlier mark in a form comparable to that used by the Mark. The differences relied upon by the Hearing Officer were irrelevant and should not have been taken into consideration.
- f. In addition, in paragraph 29, the Hearing Officer referred to the decision of the General Court in *Inter-Ikea* and in paragraph 30 he appears to have relied upon the comments of the Court which he had cited in paragraph 29, in making his finding that there was only a low to moderate degree of visual similarity between the parties' marks. However, Dr Lawrence submitted that the summary of *Picasso* in *Inter-Ikea* is wrong.

Inter-Ikea suggested that *Picasso* had ruled that for short word marks "even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them." It is certainly surprising that guidance of this type should be expressed in such absolute terms, as cases must be assessed on their particular facts and I accept that the decision in *Picasso* did not purport to lay down a rule in the terms indicated in *Inter-Ikea*. In paragraph 54 of the judgment in *Picasso* the Court had said:

“As regards visual and phonetic similarity, the applicants rightly point out that the signs at issue each consist of three syllables, contain the same vowels in corresponding positions and in the same order, and, apart from the letters ‘ss’ and ‘r’ respectively, also contain the same consonants, which moreover occur in corresponding positions. Finally, the fact that the

first two syllables and the final letters are identical is of particular importance. On the other hand, the pronunciation of the double consonant 'ss' is quite different from that of the consonant 'r'. It follows that the two signs are visually and phonetically similar, but the degree of similarity in the latter respect is low."

That paragraph does not make a ruling in the terms reflected in the *Inter-IKEA* decision; it merely compared the signs at issue in that case. How or why the Court in *Inter-IKEA* summarised paragraph 54 of *Picasso* in such a way is unclear, but what is clear is that it was mistaken when it suggested that the Court had already made a finding in the terms set out at the end of paragraph 54 of the later decision. In the circumstances, it is difficult to read the later case as actively seeking to make such a ruling itself and it appears to me that the passage in that case must be treated with a great deal of caution.

12. Mr Brandreth, whilst accepting the point of law based on *Sadas*, etc, submitted on BB's behalf that the Hearing Officer had not in fact relied upon the stylisation of the Mark in coming to his conclusion as to the level of its visual similarity to the earlier mark. He said that the points above took the Hearing Officer's comments out of context and he pointed to the Hearing Officer's references in paragraphs 29 and 30 to the fact that the Mark is composed of two words, whilst the earlier mark is one word only, and to the visual impact of the capitalisation of the second word. He submitted that these were the substantive factors underlying the Hearing Officer's conclusions on visual similarity and that the reference in paragraph 30 to the cursive script of the Mark was merely "unhappily phrased."
13. I cannot accept Mr Brandreth's submissions on this point. It appears to me that most of Dr Lawrence's criticisms above are justified. It seems to me that
 - a. Her points set out at 11 (a), (c), (d), (e) and (f) are all correct. In my judgment, the passage in paragraph 30 of the Hearing Officer's decision which I have highlighted where I have set it out above shows clearly that in assessing visual similarity the Hearing Officer contrasted the manner in which the Mark is presented (the cursive script, the capital Bs) with the earlier mark as if the

latter were only to be used in a plain font, and in capital letters. Despite Wasabi's written submissions, the Hearing Officer appears not to have considered the rule in *Sadas* and not to have turned his mind to the points raised in paragraph 13 of Wasabi's written submissions. In my view that approach was erroneous.

- b. As to the point about *Inter-IKEA* and *Picasso*, it seems to me (given what he said in paragraph 30 of his decision) that the Hearing Officer did rely upon the purported summary of the *Picasso* decision in paragraph 54 in *Inter-IKEA*. In my view he was wrong to do so for the reasons set out above, however understandable it may have been for him to rely what the Court had said about its own earlier judgment. If in reliance on *Inter-IKEA* the Hearing Officer took the view that he could not find that the marks in issue in this case had a high degree of visual similarity, he was wrong to do so.
- c. Dr Lawrence's remaining argument was that the Mark really consists of one word, not two words. That submission seems to me to have some force, looking at the Mark as applied for. However, Dr Lawrence and I seem to be the only ones involved in the application process to view the Mark as consisting of only one word. Plainly the Hearing Officer did not do so; equally, Wasabi's Grounds of Opposition, BB's Counterstatement and the written submissions which *both* parties made to the Hearing Officer all referred to the mark as consisting of two words, "Boo Boo". This may, therefore, be a matter on which reasonable people can disagree, and I do not consider that it can be said that the Hearing Officer was wrong to analyse the Mark and its similarity to the earlier mark on that basis.

- 14. In the circumstances, it appears to me that the Hearing Officer made a material error in his assessment of the visual similarity between these two marks. My own view of the visual similarity between them is that it is of a high level. Whether the marks are compared both in a plain font (as set out in Mr Brandreth's skeleton argument) or in the same or a similar stylised font (as set out in the annex to the Notice of Appeal) it is my view that the two marks have a high level of visual similarity. The difference between the 4th letters of the marks (B as opposed to H) is not visually very striking.

Viewing the Mark as composed of two words rather than one enhances the difference between them but does not, in my view, prevent there being a high level of visual similarity between them.

15. Wasabi submitted that once one concluded that there was a high degree of visual similarity, a likelihood of confusion between the marks was inevitable. Dr Lawrence relied upon a number of factors which she said pointed towards there being a likelihood of confusion in this case, of which the most significant in my view are:
 - a. The identity or high level of similarity of the goods, which may offset a lesser degree of similarity between the two marks;
 - b. The distinctive character of the earlier mark, which again may lead to a greater likelihood of confusion;
 - c. The high level of visual and aural similarity between the marks, and the importance of the fact that both start with the same syllable "boo"; and
 - d. The type of goods concerned, which are likely to be self selected so that visual similarities are important. In addition they are in many cases inexpensive goods which will be purchased without a high level of attention.

16. All of those matters, in my view, would indeed point towards there being a likelihood of confusion between the marks. However, the likelihood of confusion cannot in my view be said to be inevitable, given another factor of real significance: whether the marks are conceptually similar. The Hearing Officer addressed this point at paragraphs 31-34 of his decision. Wasabi had submitted that neither mark had a clear and identifiable meaning in connection with the relevant goods, whilst BB had submitted that both marks had such a meaning, Boo Boo meaning a mistake or minor injury, or recalling the cartoon character Yogi Bear's side-kick, BooBoo, whilst Boohoo means the sound of someone crying. The Hearing Officer referred to the *BASS/Pash* case: Case T-292/01, *Phillips-Van Heusen v OHIM*, [2003] E.C.R. II-4335. Paragraph 54 of that decision contains the following much cited passage:

"Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out ... above. For there to be such a

counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. ... that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. ... The fact that one of the marks at issue has such a meaning is sufficient—where the other mark does not have such a meaning or only a totally different meaning—to counteract to a large extent the visual and aural similarities between the two marks.”

As a result, despite the similarity between the marks, and some overlap of goods, the Court found no likelihood of confusion in *BASS/Pash*.

17. Here, the Hearing Officer found that at the least the meaning of “Boohoo” would be well known to the average consumer and he thought that its meaning would counteract to a large extent any visual and aural similarities between the marks. He also thought that the meaning of “Boo Boo” (as a mistake) would also be known to the average consumer, so that the marks were in fact “conceptually dissonant”. In his summary of the factors to be weighed in determining whether there is a likelihood of confusion, Mr Bowen concluded at paragraph 38:

“notwithstanding, inter alia, the identity/high degree of similarity in the competing goods, but keeping in mind the importance of the visual aspects of the competing trade marks to the selection process, I have come to the conclusion that the low to moderate degree of visual similarity between the competing trade marks combined with the very different conceptual images the competing trade marks are likely to convey to the average consumer ... are sufficient to avoid the average consumer either confusing one parties' [sic] trade mark for the other ... or assuming that the goods come from undertakings which are economically linked.”

18. Dr Lawrence sought to persuade me that the marks are not conceptually dissonant at all, because both carry the concept of something going wrong or of some element of distress. Alternatively, she said, Boo Boo might be perceived by some consumers as a term of endearment, so that it has no specific meaning to distinguish it from Boohoo. I do not accept either of those submissions. I think that Boohoo at the least has a clear meaning and it is not the same as any likely meaning of Boo Boo. Hence, I think that the Hearing Officer was entitled to find that the marks are “conceptually dissonant.”

19. Nevertheless, the question which I must resolve is whether the Hearing Officer’s conclusions as to the likelihood of confusion are vitiated by the error which I have identified above as to the level of visual similarity of the marks, and, if so, whether there is in my own view a likelihood of confusion. As Mr Bowen viewed the visual aspects of the trade marks as of importance to the selection process, his view that they were only similar to a low to moderate degree clearly was a significant factor in his conclusions. As explained above, my view is that the Hearing Officer was wrong in his assessment of the visual similarity and the marks are highly visually similar. I therefore consider that I must revisit the question of whether there is a likelihood of confusion.

20. I must bear in mind all of the factors identified by Dr Lawrence (see paragraph 15 above) all of which seem to me to be correct in this case, and indeed (save for the level of visual similarity) to have been accepted by Mr Bowen. I take into account the factors listed by the Hearing Officer in paragraph 37 of his decision, none of which were subject to any challenge on the appeal save as discussed above. In my view, even allowing for the conceptual differences between the marks, those factors when considered in the light of the high level of visual similarity between the marks, do indicate that there is a likelihood of confusion in this case. In particular, in my view the conceptual differences between the marks do not offset the high degree of visual and aural similarity between them.

21. In the circumstances, I find that the opposition under section 5(2)(b) succeeds and the application to register the Mark should be rejected in its entirety.

22. The parties accepted that costs should follow the event and should be on the usual scale. I will order BB to pay Wasabi the sum of £1250 as a contribution towards its costs of the appeal. BB should also contribute towards Wasabi's costs below, in the sum of £750. I allow more than the Hearing Officer did to BB, because Wasabi was obliged to consider the evidence filed by BB, even though the Hearing Officer found it irrelevant. The total of £2000 is to be paid within 14 days after the date of this decision.

Amanda Michaels
8 November 2011

Dr Heather Lawrence (instructed by Messrs Ashfords LLP) appeared on behalf of the Appellant/Opponent.

Benet Brandreth (instructed by Messrs Saunders & Dolleymore LLP) appeared on behalf of the Applicant/Respondent.