

**O-200-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK APPLICATION 3149319**

**IN THE NAME OF ME TO WE SOCIAL ENTERPRISES INC.**

**FOR THE TRADE MARK:**

**GOOD FOR ME. GOOD FOR WE.**

**AND**

**OPPOSITION THERETO (UNDER No 406689)**

**BY WE BRAND S.A.R.L.**

## **Background and pleadings**

1. The details of the mark the subject of these proceedings are:

Mark: **GOOD FOR ME. GOOD FOR WE.**

Filing date: 11 February 2016

Priority date: 17 November 2015 (from a Canadian trade mark application)

Publication: 26 February 2016

Applicant: Me to We Social Enterprise Inc.

Goods/services:

**Class 3:** Cosmetic products, namely, lip glosses, lotions for cosmetic purposes, cosmetic creams, non-medicated balms for use on skin and lips, non-medicated bath preparations, and soap for hands, body and face.

**Class 6:** Rings of common metal for keys, namely, key chains.

**Class 9:** Computer accessories, namely, mouse pads, compact disc cases, computer carrying cases; pre-recorded CDs containing audio and video recordings in the fields of social justice, philanthropic activities, youth leadership, international development; pre-recorded DVDs containing information in the fields of social justice, philanthropic activities, youth leadership, international development; Magnets, namely, decorative magnets and fridge magnets; cellular phone accessories, namely cellular phone cases and cellular telephone faceplates; Educational software featuring instruction in social justice, philanthropic activities, youth leadership, international development.

**Class 14:** Jewelry, namely, earrings, necklaces, bracelets, rings, and chains.

**Class 16:** Books, namely, novels, children's books, children's activity books, school text books in the field of social justice and civic engagement, coloring books, Series of non-fiction books in the field of self-help, biographies, and lifestyle; Educational books and magazines all in the fields of social justice, philanthropic activities, youth leadership, international development; cards and paper, namely, greeting cards, stickers, writing paper, memo pads, envelopes, diaries, photo albums, notebooks, and wrapping paper; office supplies, namely, pencils, pens, pencil cases, rubber stamps, binders, staplers, adhesive tape dispensers, desk pads and paper weights; Paper lunch bags; Paper shopping bags.

**Class 18:** Bags and wallets; particularly tote bags, luggage, briefcases, gym bags, umbrellas, backpacks, beach bags, diaper bags, duffel bags, fanny packs, handbags, lunch bags, backpacks, key cases, satchels, reusable shopping bags, purses, vanity bags for toiletries sold empty, pocket wallets, and business card holders in the nature of wallets and card cases; pet accessories, namely, bandanas for pets, collars for animals, covers for animals, clothing for pets, and leashes for pets.

**Class 20:** Pet furniture, particularly, nesting boxes for household pets, kennels for household pets, pet cushions, and beds for household pets; baby mats, namely, nap mats.

**Class 21:** Bottles, namely, drinking bottles for sports, and refrigerating bottles sold empty; dishes for pet feeding; Lunch bags not of paper.

**Class 24:** Blankets and towels, namely, baby blankets, baby towels, and baby wash cloths.

**Class 25:** Clothing; particularly yoga pants, long-sleeve shirts, tank tops, t-shirts, golf shirts, polos, scarves, beanies, toques, sweaters, sweatshirts, sweatpants, pants, pajamas, belts, ties, hats, jackets, parkas, coats, bibs, socks, shoes, boots, sandals and athletic pants; baby and infant clothing,

namely, baby and infant pants, baby and infant shorts, baby and infant one piece garment, baby and infant bibs not of paper.

**Class 28:** Domestic pet toys, children's toys, and infant toys, namely, pet rope toys, pet balls, pet tug toys, pet plush toys; infant mobiles; child and infant plush toys, child and infant bath toys, child and infant building block toys, child and infant multiple activity toys, child and infant educational toys for developing cognitive and counting skills, child and infant musical toys, and child and infant drawing toys.

**Class 29:** Fruit-based snack food, namely, organic and non-organic foods, namely, dried fruits, snack mix consisting primarily of processed nuts, and also including cereal based snack food, beans, seeds, and fruit; nut and seed-based snack bars, trail mix consisting primarily of processed nuts and dried fruits, kale chips.

**Class 30:** Cereal-based snack foods; particularly preparations made with cereals, namely, energy cereal bars, rice-based snack foods, wheat-based snack bars and snack foods, corn-based snack foods; Tea products, namely, tea, tea-based beverages, flowers or leaves for use as tea substitutes; Sesame sticks.

**Class 31:** Natural foodstuffs, namely, fresh nuts and almonds.

**Class 35:** Online retail and retail store services featuring consumer goods, particularly personal care goods, pet accessories, baby accessories, healthy snacks, jewelry, clothing, bags and wallets, drinking bottles, tea products, key chains, computer accessories, cellular phone accessories; Business services, namely, developing fundraising campaigns for others; Charitable services, namely, organizing and conducting volunteer programs and community service projects.

**Class 36:** Charitable fundraising services.

**Class 39:** Travel services namely, travel reservation, escorting of travelers, arranging travel tours, and booking of seats for travel.

**Class 41:** Educational services, namely, conducting seminars in the field of social justice, philanthropic activities, youth leadership, international development and publishing and distributing educational materials in connection therewith. Educational services, namely, providing incentives to youth leaders to demonstrate excellence in the field of social responsibility through the issuance of awards; provision of facilities for recreational activities for the purpose of developing youth leadership in the field of social responsibility; Charitable services, namely, providing school supplies to children in need.

**Class 43:** Providing temporary accommodation and lodging services in the nature of a holiday camp facility.

2. Registration of the mark is opposed by WE Brand S.a.r.l. (“the opponent”). Its grounds of opposition are based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), relying (for both grounds) on the following five marks:

European Union Trade Mark (“EUTM”) 960021 for the mark  which was filed on 19 October 1998 and registered on 16 July 2007. The opponent relies on its goods in classes 3, 18, 24, 25 & 26 (which I will detail later, to the extent required).

EUTM 11312667 for the same mark as above which was filed on 1 November 2012 and registered on 1 April 2013. The opponent relies on its goods and services in class 9, 14 & 35 (which I will detail later, to the extent required).

International Registration (“IR”) EUTM 1213402 for the mark  which designated the EU for protection on 20 May 2014 and on which protection was

conferred on 23 June 2015. The opponent relies on its goods and services in classes 18, 25 & 35 (which I will detail later, to the extent required).



IR 1243721 for the mark  which designated the EU for protection on 9 January 2015 and on which protection was conferred on 25 February 2016. The opponent relies on its goods and services in classes 9, 25 & 35 (which I will detail later, to the extent required).

IR 1223927 for the mark **WE FASHION** which designated the EU on 20 May 2014 and on which protection was conferred on 29 September 2015. The opponent relies on its goods and services in classes 18, 25 & 35 (which I will detail later, to the extent required).

3. The primary claims under section 5(2)(b) are based on the identity/similarity of the goods/services, together with the fact that the word WE is a dominant and distinctive element of the applied for mark, a word which comprises the entirety of the earlier marks, such that there exists a likelihood of confusion. I note at this stage that none of the opponent's marks consist entirely of the word WE. Three of the marks have stylisation, two have additional words. Under section 5(3), the opponent relies on a reputation for all of the goods/services for which its marks are registered, together with claims for all three heads of damage: unfair advantage, tarnishing and dilution.

4. All of the opponent's marks were filed, or designated the EU for protection, before the applicant's mark was filed (and before its priority date). They all, therefore, qualify as earlier marks in accordance with section 6 of the Act. Save for the first of the opponent's marks listed above, they were all registered (or protection conferred) within the five year period ending on the date the applicant's mark was published. This means that, with the exception of the first mark, they may be relied upon without the opponent having to meet the use conditions set out in section 6A of the Act. The first mark will need to meet the use conditions if it is to be relied upon.

5. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of use in relation to the earlier mark which is subject to the use conditions. The applicant denies that the goods/services are identical or similar, noting that no explanation has been put forward to explain why the goods/services are similar even in the classes which do overlap, let alone for those that do not. It considers that the suffix GOOD FOR ME. GOOD FOR... is sufficient to avoid confusion. It considers the common element WE to be low in distinctiveness. It considers the opponent's marks to already co-exist with other WE based marks. It does not consider that the heads of damage under section 5(3) will arise.

6. The opponent filed evidence accompanied by a set of written submissions. The applicant filed written submissions only. Neither side requested a hearing but both filed written submissions in lieu. The opponent is represented by Nucleus IP Limited, the applicant is represented by James Love Legal Limited.

### **The evidence**

7. The evidence filed by the opponent consists of a witness statement from Mr Benolt Nasr, the opponent's manager. The commentary (in terms of evidence of fact) in his witness statement is brief. I set it out in full below:

2. EUTM No. 960021 WE (stylised) ("the trade mark") was first used in the EU at least by 1999. From 26 February 2011 to 26 February 2016 ("the relevant period") the mark has been used extensively and continuously in Belgium, Netherlands, Luxembourg, France, Austria and Germany.

3. The trade mark has been used in relation to the following goods and services in the EU;

- Class 3 – perfumes
- Class 9 – sunglasses and app. software
- Class 14 – Jewellery and watches
- Class 18 – all kinds of bags, rucksacks, leather products, wallets
- Class 25 – clothing, footwear, headgear
- Class 35 – retail services in relation to fashion goods, online services, website, app. software, loyalty programs

4. The total value of the goods/services provided in the EU under the trade mark during the relevant period is at least €1.425 billion.

5. The annual value of the goods/services provided under the trade mark in the EU during the relevant period is at least as follows;

- Feb 2011-Jan 2012: € 294.5 millions
- Feb 2012-Jan 2013: € 291.3 millions
- Feb 2013-Jan 2014: € 288.6 millions
- Feb 2014-Jan 2015: € 276 millions
- Feb 2015-Jan 2016: € 275.3 millions

6. The trade mark has been promoted in the EU during the relevant period using magazine spreads, outdoor media, instore advertisements, online advertisements on own website, advertisement on WE FASHION app, online advertisement on third party sites, online advertisement on blogs, editorial spreads, printed material, press releases, TV advertisements and advertisements via loyalty program WE IS ME. Now shown to me marked Exhibit **BN1** are examples of campaign visuals, advertisements and exposure in the EU press and online of the WE (stylised) trade mark.

7. The total amount spent on advertising to promote the trade mark in the EU during the relevant period exceeds € 29.2 million.

8. The annual amount spent on advertising to promote the trade mark in the EU breaks down as follows;

- 2011: €7.1 millions
- 2012: €7.4 millions
- 2013: €6.8 millions
- 2014: €7.9 millions
- 2015 and 2016: not available at the date of this witness statement due to data processing.

8. The exhibit referred to Mr Nasr contains a large number of prints showing the use of the mark WE (predominantly in stylised form). The prints come from a range of sources, mainly from lifestyle and fashion magazines, some from the Internet etc. For reasons that will become apparent, and save for recording the fact that none of the prints shows any use that is targeted at the UK average consumer or relevant public, I do not consider it necessary to detail this evidence further.

## **My approach**

9. Although the first earlier mark must meet the use conditions in order for it to be relied upon, I will not conduct a proof of use assessment at this stage. This is because, even upon the basis of Mr Nasr's assertions, there has been use in just three of the classes (3, 18 and 25) for which the mark is registered. Of those three classes, two (18 and 25) are covered by the other earlier marks, including the third mark I listed above, which consists of a reversed out version of the first mark. Consequently, the mark subject to the use conditions can only improve the opponent's position to the extent that it relies on its goods in class 3 (the asserted use being in relation to perfume). I will, consequently, focus on the marks which are not subject to the use conditions, albeit, I will also take the first mark's perfume into account and assume, for the time being, that the asserted use in relation to perfume represents genuine use. If reliance on perfume is critical to my decision, I will formally consider if the use conditions are met later in this decision.

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

10. Section 5(2)(b) of the Act states that:

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

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

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

11. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

*Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

### **Comparison of goods/services**

12. Goods and services may be considered identical if one term in a specification falls within the ambit of something in the competing specification, as per the guidance provided by the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”):

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

13. In terms of similarity, when making a comparison of goods/services, all relevant factors relating to them should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“the CJEU”) 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.”

14. 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.”

15. 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

16. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

17. Both the applied for specification, and those of the earlier mark, cover a broad range of goods/services in multiple classes. The opponent did not set out which goods/services were similar to which, nor explained why the goods/services are similar. It simply asserts that the goods/services are identical or highly similar. The applicant denies this and highlights the absence of reasoning/detail on the part of the opponent. Whilst I will go through the specifications making an assessment, in the absence of any form of reasoning from the opponent, I will only make findings of identity/similarity if such similarity/identity is apparent and obvious.

Class 3: Cosmetic products, namely, lip glosses, lotions for cosmetic purposes, cosmetic creams, non-medicated balms for use on skin and lips, non-medicated bath preparations, and soap for hands, body and face.

18. The opponent's mark which is subject to the use conditions is the only one that covers any class 3 goods. Mr Nasr asserts that the mark has been used in relation to perfume. Even if this were to be established, the use of "namely" in the above list means that the applied for goods cover the various preparations listed, none of which are perfume. Indeed the nature and methods of use of those goods differ from perfumes. Any similarity in purpose is at a general level as they are all goods for personal care. There is nothing to suggest that the goods are sold in particularly close proximity to each other. I consider any similarity to be low.

19. In terms of anything else which has obvious potential for similarity, I note that the opponent's class 18 specifications cover bags (1213402 & 1223927) which, notionally speaking, would cover vanity/toiletry bags for cosmetic products. However, whilst there may be a degree of complementarity, there is nothing to suggest how strong such a relationship is and whether it is the type of relationship whereby consumers may think that the responsibility for those goods lies with the same undertaking. Given this, any similarity is low at best.

Class 6: Rings of common metal for keys, namely, key chains.

20. Earlier mark 11312667 covers goods in class 14 made of precious metal, which could, therefore, also be key chains. This means, in my view, that there is a high degree of similarity between the goods, the only difference being the type of metal (common/precious). Marks 1231402 & 1332397 cover goods made from leather which could include key fobs, with which there is a medium degree of similarity given the similarity in purpose, methods of use, channels of trade etc.

**Class 9:** Computer accessories, namely, mouse pads, compact disc cases, computer carrying cases; pre-recorded CDs containing audio and video recordings in the fields of social justice, philanthropic activities, youth leadership, international development; pre-recorded DVDs containing information in the fields of social justice, philanthropic activities, youth leadership, international development; Magnets, namely, decorative magnets and fridge magnets; cellular phone accessories, namely cellular phone cases and cellular telephone faceplates; Educational software featuring instruction in social justice, philanthropic activities, youth leadership, international development.

21. The above can be broken down to computer accessories, pre-recorded CDs and DVDs, decorative/fridge magnets, phone accessories and software. The opponent's earlier mark 1243721 covers the following specification [its other class 9 goods put in in no better position]:

Software, especially downloadable user programs (apps), including apps for installation on telephones, mobile telephones and communications and wireless communication devices, downloadable music files, downloadable files, downloadable movies; eyewear, including sunglasses; spectacle frames; pouches and cases for eyeglasses.

22. The use of the word "especially" does not limit the goods, consequently, its software encompasses the software applied for, and, so, identity must be found. In terms of computer accessories, this is different in nature, purpose and methods of use, to the opponent's software. There may, though, be some similarity in channels of trade and some degree of complementarity. I consider there to be a low degree of similarity. I see nothing similar at all to magnets. Some of the themes of the applied for CD/DVDs could be similar to themes in the opponent's downloadable movies, so there is a high degree of similarity here. Finally, in terms of the applied for phone accessories, I see no reason for concluding that this would be similar to software, even for mobiles.

**Class 14:** Jewelry, namely, earrings, necklaces, bracelets, rings, and chains.

23. Mark 11312667 covers goods made from precious metals. This encompasses all the above and, so, are identical.

**Class 16:** Books, namely, novels, children's books, children's activity books, school text books in the field of social justice and civic engagement, coloring books, Series of non-fiction books in the field of self-help, biographies, and lifestyle; Educational books and magazines all in the fields of social justice, philanthropic activities, youth leadership, international development; cards and paper, namely, greeting cards, stickers, writing paper, memo pads, envelopes, diaries, photo albums, notebooks, and wrapping paper; office supplies, namely, pencils, pens, pencil cases, rubber stamps, binders, staplers, adhesive tape dispensers, desk pads and paper weights; Paper lunch bags; Paper shopping bags.

24. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 18:** Bags and wallets; particularly tote bags, luggage, briefcases, gym bags, umbrellas, backpacks, beach bags, diaper bags, duffel bags, fanny packs, handbags, lunch bags, backpacks, key cases, satchels, reusable shopping bags, purses, vanity bags for toiletries sold empty, pocket wallets, and business card holders in the nature of wallets and card cases; pet accessories, namely, bandanas for pets, collars for animals, covers for animals, clothing for pets, and leashes for pets.

25. 1223297 covers:

Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, leather handbags, wallets, purses and briefcases; umbrellas and parasols; trunks and traveling bags; bags not included in other classes.

26. Other than pet accessories, the above goods are encompassed by the above specification or are highly similar to the above goods, even taking into account that only the named goods are covered by the specification. Earlier mark 1213402 covers a similar range of goods so the same finding applies. I see nothing similar in any of the specifications to the applied for pet accessories.

**Class 20:** Pet furniture, particularly, nesting boxes for household pets, kennels for household pets, pet cushions, and beds for household pets; baby mats, namely, nap mats.

27. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 21:** Bottles, namely, drinking bottles for sports, and refrigerating bottles sold empty; dishes for pet feeding; Lunch bags not of paper.

28. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 24:** Blankets and towels, namely, baby blankets, baby towels, and baby wash cloths.

29. I see no obvious similarity with any of the opponent's goods/services. Whilst the earlier mark which is subject to the use conditions covers goods in classes 24 and 26, no use has even been asserted here so the goods in these classes cannot be relied upon. I need say no more.

**Class 25:** Clothing; particularly yoga pants, long-sleeve shirts, tank tops, t-shirts, golf shirts, polos, scarves, beanies, toques, sweaters, sweatshirts, sweatpants, pants, pajamas, belts, ties, hats, jackets, parkas, coats, bibs, socks, shoes, boots, sandals and athletic pants; baby and infant clothing, namely, baby and infant pants, baby and infant shorts, baby and infant one piece garment, baby and infant bibs not of paper.

30. Earlier marks 1213402, 1243721 & 1332927 all cover clothing, footwear and headgear (although the headgear in the latter two cover just certain types of headwear). All of the above are identical or highly similar.

**Class 28:** Domestic pet toys, children's toys, and infant toys, namely, pet rope toys, pet balls, pet tug toys, pet plush toys; infant mobiles; child and infant plush toys, child and infant bath toys, child and infant building block toys, child and infant multiple activity toys, child and infant educational toys for developing cognitive and counting skills, child and infant musical toys, and child and infant drawing toys.

31. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 29:** Fruit-based snack food, namely, organic and non-organic foods, namely, dried fruits, snack mix consisting primarily of processed nuts, and also including cereal based snack food, beans, seeds, and fruit; nut and seed-based snack bars, trail mix consisting primarily of processed nuts and dried fruits, kale chips.

32. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 30:** Cereal-based snack foods; particularly preparations made with cereals, namely, energy cereal bars, rice-based snack foods, wheat-based snack bars and snack foods, corn-based snack foods; Tea products, namely, tea, tea-based beverages, flowers or leaves for use as tea substitutes; Sesame sticks.

33. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 31:** Natural foodstuffs, namely, fresh nuts and almonds.

34. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 35:** Online retail and retail store services featuring consumer goods, particularly personal care goods, pet accessories, baby accessories, healthy snacks, jewelry, clothing, bags and wallets, drinking bottles, tea products, key chains, computer accessories, cellular phone accessories; Business services, namely, developing fundraising campaigns for others; Charitable services, namely, organizing and conducting volunteer programs and community service projects.

35. I see no similarity with the opponent's goods and services when compared to the above charitable services. The only overlap in terms of the retailing would be with:

- The retail of personal care products which is identical to the retail services relating to cosmetics in earlier mark 11312667.
- The retail of jewelry and key chains which is identical to the retail services relating to jewelry in earlier mark 11312667.
- Retail of clothing which is identical to the retail services relating to clothing in earlier marks 11312667 & 1223927 and also identical to the retailing of class 25 goods covered by earlier mark 1243721.
- Retail of bags and wallets which is identical to the retail services relating to leather products in earlier marks 11312667 & 1223927.

**Class 36:** Charitable fundraising services.

36. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 39:** Travel services namely, travel reservation, escorting of travelers, arranging travel tours, and booking of seats for travel.

37. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

**Class 41: Educational services, namely, conducting seminars in the field of social justice, philanthropic activities, youth leadership, international development and publishing and distributing educational materials in connection therewith. Educational services, namely, providing incentives to youth leaders to demonstrate excellence in the field of social responsibility through the issuance of awards; provision of facilities for recreational activities for the purpose of developing youth leadership in the field of social responsibility; Charitable services, namely, providing school supplies to children in need.**

38. I see no obvious similarity with any of the opponent's goods/services. I need say no more.

### **Average consumer and the purchasing act**

39. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

40. Even discounting the applied for goods/services for which I have found no similarity, the conflicting goods/services are still varied. They range from cosmetic preparations and perfumes, to leather goods such as bags, to clothing, to media items and software, to retail services. Whilst this may be simplifying the goods/services

concerned, having regard to all of them, I am content to find that they are all fairly standard consumer items likely to be purchased by the general public. None strike me as having a materially higher or lower level of care and consideration than the norm. Whilst the purchasing process will not be identical in respect of them all, it seems to me that there will be a slight skew towards the visual impacts of the marks in the overall assessment as they will be selected at point of sale, or perused on websites or brochures etc. However, I will not ignore the aural impacts of the marks from the assessment.

### **Comparison of marks**

41. 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.”

42. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. I will first compare the applicant's mark with the first three I listed at the beginning of the decision, albeit I only depict two because the first and the second were identical. The marks to be compared are:

## GOOD FOR ME. GOOD FOR WE.

v



43. In terms of the overall impression, whilst I cannot agree with the applicant that its marks comprises solely the word WE, it is fair to say that the word strongly dominates the overall impression of both earlier marks. The stylisation does though contribute to their look and feel, but only to a minimal (but more than negligible) extent.

44. The applied for mark comprises six words, split into two sets of three. However, the rhythmic quality is indicative that the mark will be seen and understood as a whole phrase. I do not consider than any of the words dominate the overall impression. They all play a role.

45. All the marks contain the word WE. It is the element which strongly dominates the earlier marks, but it is just a single word out of six in the applied for mark and is a word that does not stand out any more than the other words in the mark. I consider any visual similarity to be very low.

46. The above follows through to the aural comparison with the same “WE” sound coming at the end of the applied for mark. It could be said that there is greater aural similarity than visual because the word WE also rhymes with ME. However, this is marginal. Any aural similarity is low at best.

47. Conceptually, the applied for mark suggests something along the lines of something which, whilst being good for the individual, is also good for some form of collective group. The word WE alone simply refers to a group of which the referring person also belongs. Given the quite specific concept of the applied for mark, any similarity on the basis of the word WE is superficial in the extreme. Any conceptual similarity must, therefore, be extremely low.

48. I next compare the following marks:

## **GOOD FOR ME. GOOD FOR WE.**

v



49. I have already described the overall impression of the applicant's mark. In terms of the opponent's mark, this consists of the words WE IS ME, with the words stacked above each other, in an unremarkable font, within a contrast rectangular background. None of the words have any greater impact than the others. The stylisation is minimal, but the orientation of the words gives a particular look and feel, albeit the words still have by far the greatest relative weight in the overall impression.

50. Visually, both marks have the words ME and ME in them, albeit in different positions. However, the marks also have a number of other words which are not in common and the opponent's mark also has a particular form of presentation. The applied for mark is much longer than the earlier mark. I consider any visual similarity to be low.

51. Aurally, both marks have a WE and ME sound in them, albeit in different positions and both have a certain rhyming quality based on those words. That said, the applied for mark has a much longer form of articulation and the marks have additional sounds that are not present in both. I consider the degree of aural similarity to be low.

52. Conceptually, I find it difficult to pin down the precise concept of WE IS ME. If some form of concept were to be perceived, it is unlikely to share the concept of the applied for mark. Any similarity in concept based on the inclusion in the marks of the words ME and WE is therefore superficial and, consequently, any similarity is low.

53. The final comparison is between:

**GOOD FOR ME. GOOD FOR WE.**

v

**WE FASHION**

54. The opponent's mark comprises two words, neither of which are present in a way which makes either of them stand out above the other. The word FASHION will immediately be perceived as descriptive in relation to certain of the goods and services, so from that perspective the word WE will likely have greater focus placed upon it.

55. Based on my findings in relation to the (slightly) stylised WE marks, I come to the same findings as I made there. If there is any difference in the assessment, the outcome would be of less similarity not more because of the additional word FASHION in this earlier mark which is absent from the applicant's mark.

#### **Distinctiveness of the earlier mark(s)**

56. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

57. The marks which comprise essentially of the word WE are dominated by that word. It is a very common, known word in the English language. That said, it does not follow that this equates to the mark having a low level of distinctiveness. Used alone, if it is difficult to pin down any strong allusive or suggestive quality. I consider the mark to have a moderate (between low and medium) level of inherent distinctive character. The same applies to WE FASHION. In terms of the WE IS ME mark, the words are all known common English ones, but the concept as a whole is difficult to pin down. I consider this mark to have a medium level of inherent distinctive character.

58. In terms of the use made, it is apparent from the evidence that such use has not been in, or otherwise directed, towards the UK. The question before this tribunal relates to the likelihood of confusion from the perspective of the UK average consumer. If there has been no use in the UK, it is difficult to see why the distinctiveness of the earlier marks will have been enhanced. There is no evidence to suggest that consumers in the UK will have been exposed to the use made in other EU Member States. Given all this, the distinctiveness of the marks is not enhanced from the perspective of the UK average consumer.

## Likelihood of confusion

59. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted 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).

(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).”

60. Looking first at direct confusion, it seems to me, notwithstanding the concept of imperfect recollection, and whilst bearing in mind that some of the goods/services are identical (which can offset a lower degree of similarity between the marks), the degrees of visual, aural and conceptual similarity are so low that there is no likelihood of the average consumer directly mistaking one mark for the other. Put simply, there is too great a difference between the marks for any of them to be mis-remembered or mis-recalled as each other.

61. That then leads to indirect confusion. Here the issue would be whether the common presence of the word WE (and additionally ME in WE IS ME) in all of the marks would lead the average consumer to assume that this is indicative of the same (or related) undertaking being responsible for the goods. Put simply, I can see no rationale for the average consumer coming to such a conclusion. In *The Cheeky Indian* case (BL O-219-16) Mr Mellor QC, sitting as the appointed person, highlighted that:

“..one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion”

and

“...in my view it is necessary to be specific as to the mental process involved on the part of the average consumer. Whilst the categories of case where indirect confusion may be found is not closed, Mr Purvis’ three

categories are distinct, each reflecting a slightly different thought process on the part of the average consumer”

62. I can see no logical process that would lead the average consumer to be indirectly confused. This is certainly the case with the WE (stylised marks) and WE FASHION. Even if WE IS ME WE (stylised) could be said to be slightly closer, the similarity is still low. Despite the commonality of ME and WE being used as part of the respective phrases in both marks, this is not enough, even for the identical goods/services concerned, to indicate the same (or shared) economic origin.

63. In reaching the above finding, I have placed no weight on the applicant’s points about other WE marks on the register. This, as has been stated many times, tells the tribunal nothing. Nevertheless, the opposition under section 5(2)(b) fails.

### **Section 5(3) of the Act**

64. Section 5(3) states:

“5(3) A trade mark which (a) is identical with or similar to an earlier trade mark, 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 European Union trade mark or international trade mark (EC), in the European Union) 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.”

65. The relevant case-law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a

characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

66. In terms of the requisite reputation under section 5(3), the earlier marks are either EUTMs or IRs for which protection has been conferred in the EU. Therefore, the relevant test is to establish a reputation in a substantial part of the EU. It is not, therefore, a necessary requirement for any form of reputation to be established in the UK in order to meet this hurdle. I highlight this because it is apparent from Mr Nasr's evidence, and as stated earlier, that the earlier marks have not been used in the UK. They have though, been used in a number of other EU Member States.

67. However, the problem faced by the opponent is that even if I were to hold that the earlier mark had a reputation on account of its EU use, the necessary link must be made by the relevant public in the UK. I take account of the judgment of the CJEU in *Iron & Smith Kft v Unilever NV* C-125/14, where it stated:

“However, even if the earlier Community trade mark is not known to a significant part of the relevant public in the Member State in which registration of the later national mark has been applied for, it is conceivable that a commercially significant part of the latter may be familiar with it and make a connection between that mark and the later national mark.”

68. Having regard to the fact that no sales/promotion has taken place in the UK, the opponent is in a very difficult position to establish that a “commercially significant” part of the relevant public in the UK even know of the mark, let alone make the requisite link. Indeed, I can see nothing in the evidence that gets close to this. I should add that even if the reputation of the earlier mark (which would be limited to the WE marks) had been known by a commercially significant part of the UK relevant public, the low level of similarity between the marks would not have created a link in the mind of the relevant public even in relation to identical goods/services. **The claims under section 5(3) of the Act are dismissed.**

### **Conclusion**

69. The opposition fails. Subject to appeal, the application may proceed to registration in respect of all of the applied for goods/services.

### **Costs**

70. The applicant has been successful and is, therefore, entitled to a contribution towards costs. My assessment, from the published scale, is set out below:

*Considering the statement of case and preparing a counterstatement - £300*

*Considering evidence and submissions and filing written submissions - £500*

*Written submissions in lieu of a hearing: - £300*

71. I order WE Brand S.a.r.l. to pay We To Me Social Enterprise Inc. the sum of £1100 within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of March 2018**

**Oliver Morris**

**For the Registrar**

**the Comptroller-General**