

O/252/18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3178415
BY CALLA CARE LONDON LTD FOR THE TRADE MARK**

CALLA

IN CLASS 10

AND

**THE OPPOSITION THERETO UNDER NUMBER 407852
BY
KESSEL MEDINTIM GMBH**

Background

1. On 4 August 2016 (“the relevant date”), Calla Care London Ltd (“the applicant”) filed trade mark application number 3178415, for the mark shown below, in respect of *menstrual cups*, in Class 10:

CALLA

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 9 September 2016. Kessel Medintim GmbH (“the opponent”) opposes the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). For sections 5(2)(b) and 5(3), the opponent relies upon the following earlier European trade mark registration:

9899841

CAYA

Class 5: Pharmaceutical preparations, Namely contraceptives; Sanitary preparations for medical use; All the aforesaid goods not being for the treatment of rheumatism, joint and muscle disorders.

Class 10: Surgical, medical, dental and veterinary apparatus and instruments, the aforesaid goods not including apparatus and instruments for medical cosmetics but including gels for use with diaphragms; Contraceptives, including diaphragms (pessaries).

Date of filing: 15 April 2011; completion of registration procedure: 20 October 2012.

3. The opponent claims that the marks are similar and that the goods are identical, leading to a likelihood of confusion under section 5(2)(b).

4. For section 5(3) of the Act, the opponent claims a reputation in all the goods for which the earlier mark is registered. The opponent claims that the similarity between the marks is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between them. Further, the opponent claims that use of the applicant's mark would take unfair advantage of the distinctive character, and/or cause detriment to the distinctive character and reputation of its mark.

5. Under section 5(4)(a) of the Act, the opponent claims that use of the applicant's mark is liable to be prevented under the law of passing off, owing to its goodwill attached to the sign CAYA, which it claims to have used throughout the UK since at least 2013, in respect of "sanitary devices, preparations and apparatus; contraceptives; hygienic devices, preparations and apparatus; medical devices, preparations and apparatus; diaphragms. "

6. The applicant filed a defence and counterstatement, denying all the grounds and putting the opponent to proof of use of its mark in relation to "Caya contraceptive diaphragm". The opponent's earlier mark had been registered for less than five years on the date on which the contested application was published. It is not, therefore, subject to the proof of use provisions under section 6A of the Act. The consequence of this is that the opponent may rely upon all the goods specified in the notice of opposition in the registration without having to prove that it has made genuine use of them. However, in order to succeed under sections 5(3) and 5(4)(a) of the Act, the opponent is required to prove, through evidence, that it has a reputation in and goodwill relating to the goods upon which it relies for these grounds.

7. The applicant states:

"1. "CAYA" is not similar to "CALLA": neither A) phonetically, since the "LL" is in the English pronunciation, and sounds like "L" (this is a UK brand, not registered in Spain), nor B) visually, since CALLA AND Caya look dissimilar.

2. The contraceptive diaphragms for which the Opponent owns the trade mark are not an identical product to menstrual cups. They belong to different product classes 5 and 10 respectively. One is for contraception, used for a short amount of time during sexual intercourse, while the other is used for the purpose of collecting menstrual fluid during a woman's period. The products are neither identical nor do they bear much similarity aside from both requiring vaginal insertion. Their consumers are the "same" only to the extent that they are fertile women.

3. "The average consumer" mentioned to by the Opponent refers to the fertile woman. The average woman knows the difference between contraception and menstrual hygiene and there should be no confusion between both products."

8. The opponent is professionally represented by Marks & Clerk LLP, whilst the applicant represents itself. Both sides filed evidence. Neither party chose to be heard. The opponent filed written submissions in lieu of a hearing.

Opponent's evidence-in-chief

9. The evidence comes from Rebecca Müller¹, who has headed the opponent's export department since 2008. Ms Müller states that CAYA contraceptive diaphragms and contraceptive gels ('the goods') were launched in April 2013, since when 10,000 such goods have been distributed in the UK.

10. The goods are distributed in the UK via "Durbin", "RDO Medical" and "Stress No More Health and Wellbeing". Undated website extracts from these companies are shown in Exhibit 2, including CAYA diaphragms for sale. Exhibit 3 comprises an extract from a Durbin's Sexual Health Supplied 2017 catalogue showing CAYA products offered for sale in the UK (the catalogue is dated after the relevant date). The Durbin website and catalogue indicate that they supply to GPs and clinics, rather than directly to the public. Exhibit 4 comprises two invoices from Durbin to

¹ Witness statement dated 8 May 2017.

customers in Belfast and Coventry, dated in July 2013, for supplying CAYA diaphragms and CAYA gel. Six diaphragms were sold to the Coventry customer, and one gel; and a single diaphragm was sold to the Belfast customer. The customer details and pricing amounts have been redacted. The Stress No More Health and Wellbeing website appears to sell directly to the consumer.

11. Sales figures are given for the UK and EU combined:

Year	Sales
2013	€166,950
2014	€216,300
2015	€259,740
2016	€439,902
2017	€111,402

12. Advertising figures are given for the UK and EU combined:

Year	Marketing spend
2013	€80,000
2014	€120,00
2015	€125,000
2016	€130,000
2017	€185,000

13. Ms Müller states that, since product launch in 2013, over £10,000 has been spent in the UK on advertising the goods. She does not, however, give UK turnover figures. Ms Müller refers to three full page advertisements in the Journal of Family Planning and Reproductive Health Care, which she states to be a quarterly journal published by the highly reputed British Medical Journal, read by medical professionals. Exhibit 5 comprises information about the Journal of Family Planning and Reproductive Healthcare, but does not show the said advertisements. Ms Müller does not say when they were placed.

14. Ms Müller states that the representatives from UK distributors have also exhibited CAYA products at approximately 125 trade shows and professional meetings before and since the launch in 2013. She states that the distributors directly market CAYA products to individual medical professionals in the UK including influential clinicians, a list of which has been targeted through three separate mailing campaigns. No details are given about these.

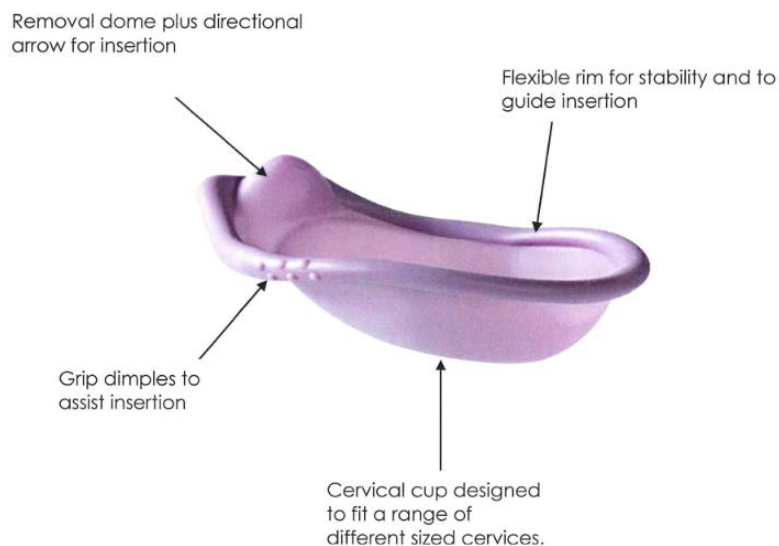
15. The opponent's evidence-in-chief also includes a witness statement from Mr John Ferdinand², the opponent's trade mark attorney. He states that he makes his statement from his own knowledge and belief as well as from his own knowledge and on the basis that the opponent has instructed his firm in these proceedings.

16. Mr Ferdinand refers to the witness statement of Ms Müller and states that, since her witness statement was finalised, the opponent had supplied further information concerning advertising and marketing material specific to the UK and the EU.

17. Mr Ferdinand exhibits (Exhibit JF1) a review of CAYA products from the Royal College of Obstetricians and Gynaecologists Faculty of Sexual and Reproductive Healthcare. The report is dated August 2014 and provides a summary of the effectiveness and benefits (or otherwise) of the 'new' CAYA diaphragm. Mr Ferdinand states that the report is aimed at both medical professionals and the general public, although it seems likely that medical professionals are more accustomed to reading publications of this nature than the general public. The product summary describes the diaphragm as reusable, made from silicon, contoured with a flexible rim, grip dimples and with a removal dome. It states that it is available in one size only, designed to fit 80% of women. There is limited efficacy data available. The summary states that the product is available to buy over the counter or online. The cost is given as £20.54 (Durbin is quoted as the source), although the report also says that online purchases for personal purchase are £30-£40. The diaphragm is supplied with fitting instructions and a user DVD, although the report cautions that the single size will not be suitable for all women and that

² Dated 10 May 2017.

some women may require assistance from a health professional to ensure correct fitting prior to use. It looks like this:



18. Exhibit JF3 comprises an article, dated 22 July 2014, from NetDoctor.co.uk, focussing on the diaphragm and cervical cap barrier methods of contraception. Mr Ferdinand states that NetDoctor is the UK's leading online platform where medical professionals write content and provide information for the general public to view. He states that, according to the website's publisher (Hearst Magazines UK), over 8.7 people visit the website each month (Exhibit JF4). The article in question is written by Dr David Delvin. He explains that diaphragms are domes made of silicone which are positioned so as to prevent sperm from getting anywhere near the cervix. Dr Devlin also says that use of a diaphragm enables sex to take place while a woman is having her period (with no sign that she is).

19. Dr Delvin refers to a recent survey by the Office of National Statistics which suggests that 3% of women in the UK aged 16 to 49 used diaphragms as contraceptives. He says "It would be unwise to just buy a diaphragm 'off the peg' at a chemist – for the simple reason that women's vaginas come in various sizes (particularly after they've had children). So you need to have your vaginal size assessed by a doctor or family planning nurse". He goes on to refer to the opponent's CAYA product as being a new type of diaphragm, revealed at the European Society of Contraception meeting in Lisbon and that it is alleged that,

being one size only, the user does not need to go to a nurse or a doctor for a fitting. However, Dr Devlin says “Frankly, I think that is a slightly optimistic claim. Women’s vaginas do vary enormously in length and width, particularly after childbirth.”

20. Exhibit JF5 comprises flyers and promotional material, said to be issued by the opponent in the UK and the EU. Mr Ferdinand states that the documents all relate to activity associated with the advertising and marketing expenditure information provided by Ms Müller. Mr Ferdinand states that a review of the electronic document properties of the documents sent to him by the opponent indicates that all the documents were created prior to the filing date of the application.

21. The pages in the exhibit include an exhortation to join the worldwide Caya pilot test. The opponent’s German email address is given as a point of contact. The two website addresses have top level domains of .org and .eu. An advertorial about the first year’s experience of the diaphragm refers to its use in Germany and that it has been launched in ten countries (although does not say what there are). Only 30% of the users in Germany visited a health professional to confirm correct positioning.

Applicant’s evidence

22. The applicant’s evidence comes from Natacha Chossudovsky. Her witness statement is dated 29 November 2017. Ms Chossudovsky states that she is the applicant’s founder and director.

23. Ms Chossudovsky states that CALLA is the name of a flower, the CALLA lily, as shown in Exhibit 1. This exhibit also contains a representation of the applicant’s mark together with a device (or logo) which is said to represent the shape of the calla lily. However, this is not relevant to the issues to be decided because it is the mark as it has been applied for (i.e. just the word) that must be considered, not any extraneous matter which may accompany it in actual use³.

³ *L’Oreal SA v Bellure NV* [2008] RPC 9.

24. Ms Chossudovsky states that, in English, “ll” is pronounced as ‘l’. She also states that ‘y’, “when used as a consonant as in “Caya”, is pronounced as a ‘j’. She refers to Exhibit 2, which is an extract from Wikipedia describing the various pronunciations of ‘ll’ in English, Spanish, Galician, and Catalan, and the pronunciation of ‘y’. I note that the extract gives refers to the use of ‘y’ as a consonant rather than as a vowel (giving ‘city’ as a vowel example). The extract says that use of ‘y’ as a consonant is a palatal approximant to ‘j’, as in ‘year’, which is ‘jahr’ in German.

25. Ms Chossudovsky states that it is compulsory to teach sex education in schools from the age of 11 (Exhibit 3 is an extract from the ‘gov.uk.’ website to this effect) and that, therefore, UK woman of reproductive age at the relevant date would know the difference between periods and sexual intercourse:

“Therefore, despite both the menstrual cap and the diaphragm being concave silicone objects that are inserted into the vagina, it is safe to conjure that women across the UK have enough of an understanding of their own bodies so as to know the difference between sanitary protection for their periods, and contraception for the purpose of having sex.”

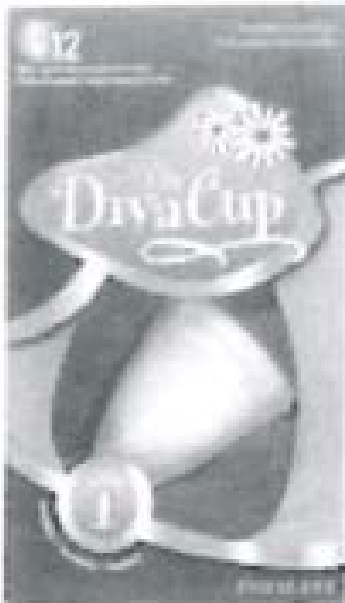
26. Exhibit 4 comprises prints from the applicant’s website providing information about the CALLA menstrual cup. It looks like this (together with its packaging):



Opponent's evidence-in-reply

27. Evidence-in-reply has been filed by Martin Kessel, who has been the opponent's President and CEO since 2008. His witness statement is dated 26 January 2018.

28. Mr Kessel states that the opponent sells, via its online store, a variety of products relating to contraception, fertility, hygiene and sexual education. Exhibit 2 is an extract from the opponent's German website (printed on 23 January 2018) showing, *inter alia*, the CAYA diaphragm and a reusable menstrual cup called DivaCup, priced at €24.99:



29. Exhibit 3 comprises prints from the UK Stress No More website. These are not dated. The point of the prints is to show that the opponent's CAYA diaphragm is sold from the same online store as menstrual cups (of various brands). Mr Kessel maintains that women who are unfamiliar with diaphragms and menstrual cups may confuse the products. Exhibit 4 includes prints from the opponent's website. One of the FAQs is "Can the Caya diaphragm also be used during menstruation?" The answer is provided as "The use of the diaphragm is possible." Exhibit 4 also contains an article from a website called parent.guide/best-menstrual-cup-the-ultimate-guide/. It is not clear from which country this website originates, but the dating style suggests it is a US website (March 28, 2017). The pictures of various

menstrual cups show that they are all very similar in form. It is written in the first person singular, but the writer and their level of expertise are not explained. It appears that menstrual cups have been available since 1932.

30. A second article is also included in Exhibit 4, this is simply headed 'Romper'. Again, the dating style suggests it is from the US (July 29 2017). The article is called "Can you use a menstrual cup as a form of birth control? Not Exactly". The writer says that because of the similarity of menstrual cups and diaphragms, women may wonder if you can use the former as a form of birth control. However, the writer goes on to say that while the design of both is similar, menstrual cups should never be used as a method of birth control.

31. Mr Kessel answers the applicant's evidence about pronunciation of 'll' by stating that Spanish language and culture is prominent in the UK and that consumers who only speak English are familiar with the pronunciation of Spanish words such as 'tortilla'. Exhibit 6 comprises an article published in 2014 by the British Council describing the prevalence of Spanish in the UK.

Decision

Section 5(2)(b) of the Act

32. 5(2)(b) of the Act states:

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

(a) ...

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

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

33. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

34. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

35. ‘Complementary’ was defined by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“82 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...”.

36. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

37. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

38. The goods and services to be compared are shown in the table below.

Earlier mark	Application
<p data-bbox="188 248 746 560">Class 5: <i>Pharmaceutical preparations, Namely contraceptives; Sanitary preparations for medical use; All the aforesaid goods not being for the treatment of rheumatism, joint and muscle disorders.</i></p> <p data-bbox="188 636 767 1003">Class 10: <i>Surgical, medical, dental and veterinary apparatus and instruments, the aforesaid goods not including apparatus and instruments for medical cosmetics but including gels for use with diaphragms; Contraceptives, including diaphragms (pessaries).</i></p>	<p data-bbox="809 636 1190 672">Class 10: <i>menstrual cups.</i></p>

39. The opponent's goods in Class 5 are not similar to menstrual cups. Although sanitary protection for menstruation is in class 5 (i.e. pads and tampons), these goods are not covered by the terms in the opponent's class 5 specification.

40. The opponent submits that its goods in class 10 cover the applicant's goods and are, therefore, identical. As menstrual cups are not contraceptives, and are not dental or veterinary apparatus and instruments, the only terms that can be considered are surgical and medical apparatus and instruments.

41. The ordinary and natural meaning of surgical does not cover goods for menstruation protection. Surgical signifies used in surgery; i.e. medical procedures or operations. The applicant's evidence shows that its goods are made from medical silicone. This means medical-grade silicone (silicone is used in a variety of industrial applications, such as bakeware and vehicle tyres). This does not make menstrual cups *medical* goods. The ordinary and natural meaning of medical relates to the practice of medicine; i.e. involving treatment. Menstruation is a natural monthly occurrence for women for about 40 years of their lives. Women would not describe

this regular occurrence as needing treatment. The average consumer for the applicant's goods will be used to buying other types of menstruation protection which are sold under signage in supermarkets and other retail outlets as either sanitary products or feminine hygiene products. I therefore find that the goods are not identical. I still need, however, to assess whether they are similar. As the opponent has focussed upon the similarities between the applicant's goods and its own diaphragms, which are covered by its class 10 term *contraceptives, including diaphragms (pessaries)*, I will limit my comparison to these goods which, in any event, appear to represent the opponent's best case. It has not identified any other goods covered by the terms in its specification which it considers to be similar.

42. I will assess the similarities in terms of nature, intended purpose, trade channels, method of use, users, complementarity and competition, as follows:

(i) Nature: as can be seen from the pictures of the goods, a menstrual cup is deeper than a contraceptive diaphragm. (The evidence shows that the shapes of menstrual cups do not vary greatly between different manufacturers.) However, there is some degree of similarity in that the goods are made from medical grade silicon and are concave.

(ii) Intended purpose: the opponent's evidence contains material which refers to the use of a diaphragm during menstruation and the use of menstrual cups as contraception. The material is in the form of an FAQ from the opponent's own website, the article from NetDoctor.co.uk and an undated article from an unspecified source, probably emanating from the US. In the case of the FAQ, which is "Can the Caya diaphragm also be used during menstruation?" the answer is "The use of the diaphragm is possible". This does not suggest that the diaphragm can be used as sanitary protection, i.e. as a substitute for a menstrual cup, it merely confirms that a diaphragm can be used during menstruation (presumably, if sexual intercourse takes place). This is confirmed by the 2014 article on the NetDoctor website. There is no suggestion that women might wear a contraceptive diaphragm as they go about their day-to-day business during several days of menstruation, simply that it can be used as contraception during menstruation, which is short-term

use. The other article says that whilst the design of menstrual cups and diaphragms is similar, menstrual cups should never be used as a method of birth control. The comparison is to be made on the basis of intended purpose. So, as the opponent's own evidence shows, although a diaphragm can be used during a period, it is not intended to be used as sanitary protection; and although a menstrual cup has a similar nature (design) to a diaphragm, it should never be used as contraception. The parties' goods do not share a similar intended purpose.

(iii) Trade channels: the opponent's evidence shows that its goods are distributed to medical clinics in the UK, but its evidence in reply also includes material to show that the UK Stress No More website sells the CAYA diaphragm and menstrual cups directly to the general public. The opponent's German website shows that the opponent sells both products (under different trade marks) online. There does not appear to be a reason why that could not also be the case in the UK. I conclude that the goods can be obtained via the same trade channels, although this is not always the case.

(iv) Method of use: there is a reasonable degree of similarity in that the evidence shows that both products are folded in order to insert them. However, the evidence also shows that there are also differences. A menstrual cup is used throughout a period (with twice-daily emptying, according to the evidence). A contraceptive diaphragm is to be inserted shortly prior to sex taking place, and must be accompanied by use of a spermicidal gel (according to the evidence).

(v) Users: as accepted by the applicant, the users are the same, being fertile women (i.e. women who have periods and are capable of getting pregnant).

(vi) Complementarity: there is no level of complementarity. Neither party's goods are important, let alone indispensable, for the use of the other's.

(vii) Competition: my comments in relation to intended purpose apply here. The goods are not substitutable and are therefore not in competition.

43. Putting these factors together, I find that there is no more than a low degree of similarity between the goods. Although there are degrees of similarity as regards nature and methods of use, there are more differences here than similarities. The users are the same, but at a high level of generality. The highest point of similarity is trade channels but, even then, there is evidence showing that one of the opponent's three UK distributors, Durbin, from where the bulk of the opponent's evidence of sales appears to emanate, sells the opponent's contraceptive diaphragms to GPs and clinics, rather than directly to the consumer. The opponent's evidence of distribution of its goods must be taken to be paradigm; therefore, I infer that, notionally, contraceptive diaphragms are sold via similar trade channels.

The average consumer and the purchasing process

44. 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*.

45. I note that the opponent's experience of its product's use in Germany indicates that 70% of women using it do not seek professional medical assistance. However, there is little UK evidence that this is the case in the UK. In fact the opponent's evidence points towards the opposite. The opponent's evidence includes an extract from a report about the CAYA diaphragm by the Royal College of Obstetricians and Gynaecologists. This may be taken to be an authoritative account by experts in the field. The report cautions that the single size will not be suitable for all women and states that some women may require assistance from a health professional to ensure correct fitting. If this is the case for the opponent's single size product, the advisability of getting a professional to fit a diaphragm applies *a fortiori* to diaphragms which are available in a variety of sizes. The advisability of seeking professional assistance is reinforced elsewhere in the opponent's evidence, such as the NetDoctor website (the article was written by a doctor). Further, the only evidence of actual sales provided in the evidence comes from Durbin, which

distributes only to GPs and clinics, not directly to the consumer. I conclude that the usual purchasing process in the UK involves a visit to the GP or family planning clinic in order to obtain a diaphragm (whether a CAYA one or a third party's product) in order to ensure the correct fit. This means that aural use of the mark, during discussion between patient and medical professional, is likely to feature more heavily than for other consumables which are bought off the shelf or online by the end consumer. However, I do not ignore the visual perception of the mark as a) there is some evidence of direct availability and b) it is likely that packaging will be on display during consultation with a medical professional.

46. That this is the usual purchasing process for a diaphragm seems even more likely when one considers the consequences of incorrect fitting, i.e. an unplanned pregnancy. The point of using a contraceptive of any description is to avoid unplanned pregnancy. It will be very important to a woman to have confidence in the efficacy of the product. The level of attention paid to the purchasing process is therefore high.

47. In the case of the applicant's goods, the consequences of incorrect use are not as far-reaching as for the opponent's goods. However, a woman choosing sanitary protection will have clearly in mind the efficacy of the product in terms of preventing leaks. One of the key benefits of a menstrual cup is that it reduces waste going to landfill because it is reusable. It will therefore be an infrequent purchase and one to which the consumer will pay close attention in addition to the level of efficacy and because of the internal method of use. That close level of attention will be overwhelmingly visual because menstrual cups are bought directly by the consumer who will examine packaging and written information before arriving at a purchasing decision.

Comparison of marks

48. 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.”

49. 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. The marks to be compared are:

Earlier mark	Applicant's mark
CAYA	CALLA

50. The distinctiveness of each mark resides in the single element of which each mark is composed.

51. The marks are four and five letters in length. There are visual similarities in that both marks begin and end with the letters C and A, and have an A as the second letter in each mark. However, the middle of the marks are visually quite different, being the letters Y and LL. The marks are short, which means that a difference in the middle letters (such as this) creates more of a visual distance between the marks, proportionately, than if they were longer words. In *Max Mara Fashion Group Srl v. Mackays Stores Ltd*, T-272/13, the GC considered the comparison between MAX&Co. and M&Co, finding “that it is precisely because the signs are short that the relevant public will perceive the differences between them more clearly” (paragraph

47)⁴. The fact that the application is in colour has no impact on the comparison because the opponent's mark is not represented in colour, meaning it notionally covers use in all colours, including the colour of the applicant's mark⁵. On balance, the marks are visually similar to a medium degree.

52. It is the applicant who has introduced to the proceedings the question over possible Spanish pronunciation of LL as a 'y' sound (as in tortilla). The opponent has taken this up by producing evidence that Spanish is widely spoken in the UK. This may be so, but it is the average UK, anglophone, consumer which must be considered. These are not goods specifically aimed at or patronised by Spanish-speakers (as, for example, food or drink emanating from Spain). There is no evidence that CAYA or CALLA have meanings in Spanish, causing a variation in pronunciation from that which is natural for the average English-speaking UK consumer. CALLA will be pronounced either with short As, or as C-AR-LLA, whilst there are also two possibilities for CAYA: the middle AY will be approximated either to an 'eye' sound (C-EYE-A, or a long A sound (C-AY-A). None of these possibilities goes further than creating a low degree of aural similarity between the marks.

53. The applicant has provided evidence that CALLA is a variety of lily. I am doubtful that, without the word 'lily' to give context, this concept will be brought immediately to mind, especially in relation to goods which have nothing to do with plants. It is more likely to be seen as an invented word. The opponent's mark has no meaning and is also an invented word. The marks are conceptually neutral.

54. I will bring forward these points when I make the global assessment as to whether there is a likelihood of confusion.

⁴ See also the comments of Mr Iain Purvis QC, sitting as the Appointed Person, in *Hachette Filipacchi Presse S.A. v Ella Shoes Limited*, BL O/277/12, at paragraph 20.

⁵ Kitchin LJ stated in *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24 at [96]: "A mark registered in black and white is, as this court explained in *Phones 4U* [2007] R.P.C. 5, registered in respect of all colours."

Distinctive character of the earlier mark

55. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*⁶ 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).”

56. CAYA is an invented word. Invented words, usually, sit at the very top of the scale of distinctiveness because they do not describe or allude to any characteristic of the goods and services. I consider CAYA to be highly distinctive, *prima facie*, for the opponent's goods. One of the principles which must be taken into account in deciding whether there is a likelihood of confusion is that 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. With this in mind, I need to assess

⁶ Case C-342/97

whether the use made by the opponent of CAYA has improved the distinctiveness of the mark. The relevant date for this assessment is the filing date of the contested application, 4 August 2016.

57. The only use that has been shown is in respect of diaphragms and the accompanying spermicidal gel. As the opponent's better case lies with diaphragms rather than gel, I will restrict the assessment of the use to diaphragms.

58. The evidence is not compelling. At the date of Ms Müller's witness statement, 8 May 2017, she states that 10,000 items (which might not be solely diaphragms, but also include gel) had been distributed in the UK, but this is some time after the relevant date. The Durbin catalogue is dated in 2017, after the relevant date. If Ms Müller is able to state that 10,000 diaphragms (rather than gel) had been distributed and that £10,000 had been spent in the UK on advertising since the launch in 2013, then why are there no UK-specific turnover figures in evidence? There are only two invoices, to two customers, with total sales of only 7 diaphragms. The invoices were from Durbin which only supplies to professional intermediaries; although the pricing has been redacted, elsewhere the evidence shows that clinic prices for a diaphragm were about £20.

59. There is no dating for the advertisements in the Journal of Family Planning and Reproductive Health Care. Ms Müller states that goods have been exhibited at approximately 125 trade shows and professional meetings, but there are no details of where and when these were. Given that she also states that the UK distributors directly market the product to individual medical professionals, I am left to wonder if 'professional meetings' means sales representatives visiting individual GPs. If this is the case, then 125 such meetings is not many. Further, a figure of £10,000 UK marketing spend over 4/5 years does not strike me as very much, and in the context of the number of sexually active women of reproductive age in the UK, a distribution figure of 10,000 over four years seems on the small side.

60. I find that, if it were possible to elevate the already high level of distinctiveness through use, then the opponent's evidence does not support a claim to enhanced distinctiveness.

Likelihood of confusion

61. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that there is no more than a low degree of similarity between the goods. I have found the marks to be conceptually neutral because neither has a meaning which will be perceived immediately by the average consumer for the goods. The level of aural similarity is low. This has significance because the opponent's evidence shows that third party expert advice is that its goods, and therefore notionally diaphragms in general, are fitted by a health professional. The opponent only has three UK distributors and the bulk of its evidence comes from the distributor which sells only to health professionals. There will be oral use of the mark in discussions between the health professional and the patient. I find that the aural aspect of the mark comparison has equal (if not more) weight than the level of visual similarity (see *Quelle AG v OHIM* Case T-88/05 GC, paragraph 68).

62. The high point of similarity between the marks is on a visual basis, and this is no more than medium. The low level of aural similarity and its weight in the mark comparison pulls towards lack of confusion. When the high/higher level of attention paid by the average consumer is added to the mix, this points even further away from confusion. Although the earlier mark has a high degree of inherent distinctive character, this factor is not enough to offset the other factors in the global assessment, all of which point strongly away from confusion.

63. Further, if I am wrong about the conceptual comparison; i.e. that, contrary to my finding, the average consumer will see the 'lily' meaning in CALLA, then this points even further away from confusion. Moreover, if I am wrong about the level of similarity between the goods and that the opponent's term 'medical' covers the

applicant's goods, making them identical⁷, the lack of similarity between the marks and the high average consumer attention level during the purchasing process will militate against a likelihood of confusion.

Section 5(2)(b) outcome

64. There is no likelihood of confusion. The section 5(2)(b) ground fails.

Section 5(3) of the Act

65. Section 5(3) states:

“(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 Community trade mark or international trade mark (EC), 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.”

66. 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, *Adidas-Salomon*, [2004] ETMR 10 and Case 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.

⁷ The law requires that goods and services be considered identical where one party's description of its goods or services encompasses the specific goods or services covered by the other party's descriptions (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC.

(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 on 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*).

67. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that CAYA has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods and services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

68. The first condition is reputation. For its section 5(3) ground, the opponent relies upon all the registered goods of its earlier mark. However, it is clear from the evidence that the use extends only to contraceptive diaphragms and spermicidal gels. The CJEU gave guidance in relation to assessing reputation in *General Motors*:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

69. The earlier mark is a European trade mark registration and I must take into account the use made in the EU⁸, in contrast to the assessment under section 5(2), where it is only relevant whether use of the mark has enhanced its distinctive character in the eyes of the UK average consumer. However, even if there is sufficient use in the EU in order to satisfy the reputation threshold, it is still necessary to establish that there is enough knowledge on the part of the UK relevant public that a link would be made. In my view, the evidence does not establish that fact. Furthermore, I do not think that the evidence shows that at the relevant date that the knowledge threshold in the EU had been met. The sales figures appear to show a drop in the ocean when the number of women requiring contraception in the EU is considered.

⁸ *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, case C-301/07, CJEU.

70. Without a reputation, there will be no link made. As the conditions are cumulative, the section 5(3) ground must fail. For the sake of completeness, I also observe that even if a reputation had been established, it would not have been a strong one, certainly not strong enough to overcome the lack of similarity between the marks and the goods to cause a link to be made.

Section 5(3) outcome

71. The section 5(3) ground fails.

Section 5(4)(a) of the Act

72. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

73. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

74. As said earlier, the evidence shows use only in relation to contraceptive diaphragms and spermicidal gels. In assuming a finding of goodwill, this ground nevertheless suffers from the defects identified under the section 5(2)(b) ground. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, in the Court of Appeal, Jacob LJ said:

"16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of Kerly contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to

confuse lawyers and their clients) whereas, if in answer to the question: 'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the Buttercup case. A more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

75. The use of the application would not cause a substantial number of the opponent's customers to be misled into purchasing the applicant's goods, believing that they are provided by the opponent. Use of the applicant's mark at the relevant date was not liable to be prevented under the law of passing off.

Section 5(4)(a) outcome

76. The section 5(4)(a) ground fails.

Overall outcome

77. The opposition fails under all grounds. The application may proceed to registration.

Costs

78. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. As the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs, including providing

accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the proceedings. It was made clear to the applicant that if the pro-forma was not completed “no costs, other than official fees arising from the action and paid by the successful party...will be awarded”. The applicant did not respond to that invitation within the timescale allowed (nor has any response been received from it prior to the date of the issuing of this decision). It did not incur any official fees in the proceedings and so I make no award of costs.

Dated this 25th day of April 2018

**Judi Pike
For the Registrar,
the Comptroller-General**