

O-258-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3325550  
BY AVRUPA İLAÇ VE KOZMETİK SAN. VE TİC A.  
TO REGISTER:




AS A TRADE MARK IN CLASS 5

AND

OPPOSITION THERETO (UNDER NO. 60000989) BY  
HENDEL LIMITED LIABILITY COMPANY

## Background and pleadings

1. The subject proceedings relate to an opposition against the registration of the above trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), with the opponent relying on one earlier mark. Consequently, the question to be determined is whether there is a likelihood of confusion between the following marks:

The application	The earlier mark
	<p><b>Titan gel</b></p>
<p>Class 5: Penis Enhancement Gel</p>	<p>Class 3: Douching preparations for personal sanitary or deodorant purposes [toiletries], suitable for intimate use; sanitary preparations being toiletries, suitable for intimate use; massage gels, including massage gels suitable for intimate use; non-medicinal preparations for the care of intimate parts of the body.</p> <p>Class 5: Sexual stimulant gels; lubricant gels for personal use; creams and lotions for sexual health and / or enhancing sexual arousal; medicinal creams, namely supplements for sexual health and / or enhancing sexual arousal; vaginal lubricants; hygienic lubricants; personal sexual lubricants; medical lubricants; water-based personal lubricants; silicone-based personal lubricants; pharmaceutical</p>

	preparations for inducing erections; sanitary preparations for medical purposes; hygienic preparations for medical purposes.
Filed on 18 July 2018  Published for opposition purposes on 21 September 2018	Filed on 19 December 2017  Registered on 19 July 2019
<b>Applicant</b> <sup>1</sup> : Avrupa ilaç Ve Kozmetik San. Ve Tic A.	<b>Opponent</b> : Hendel Limited Liability Company

2. The opponent used the fast track opposition procedure. It contends that the marks are highly similar, the goods identical, and that there exists a likelihood of confusion. The applicant filed a counterstatement denying the grounds of opposition.

3. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013/2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

4. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track proceedings. The opponent sought leave to file evidence of what it says are counterfeiting activities on the part of the applicant. The applicant responded stating that it had consent to use the mark and that it would like to file reply evidence to any evidence filed by the opponent. Leave was refused. This was on the basis that it was not necessary to take such evidence in the subject

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<sup>1</sup> The application was actually made by Mr Guy Lochner, who assigned it to Ms Sibel Ralphs (on 15 October 2018) who subsequently assigned it towards the end of the proceedings to the current applicant, on 13 March 2019.

proceedings, which were capable of determination without it. Whilst the Tribunal's letter refusing leave was not as clear as it could have been, it is implicit that there was also no need for reply evidence from the applicant as there was nothing to reply to. Both parties were given an opportunity to contend this view at a case-management conference – neither elected to do so.

5. Later in the proceedings, the applicant sought a short extension (due mainly to a change in instruction) for filing written submissions and that in the extended period it may also seek leave to file late evidence, albeit without specifying what that evidence might be. Whilst the extension was granted, the Tribunal indicated that leave would not be granted, referring back to its previous directions and the relevant Tribunal Practice Notice which states that requests for leave to file evidence in fast track proceedings ought to be made within 14 days of the filing of the defence.

6. In terms of the applicant's position, I am conscious that it has mentioned that it had consent to use the mark (which the opponent denies in its written submissions). However, as the opponent points out, consent to use, even if this were true, does not equate to consent to registration. In any event, the applicant did not challenge at any point, either at the start of the proceedings or when its extension was sought, the directions that leave to file evidence was not to be given.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. Neither side requested a hearing. The opponent filed written submissions, which I bear in mind. As noted above, the applicant sought an extension for filing written submissions, which was granted, but none were forthcoming.

8. The opponent has been represented by Harrison IP Limited. The applicant was unrepresented when the proceedings were launched, but Swindell & Pearson Limited were appointed shortly thereafter.

## Decision

9. 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.

10. An “earlier trade mark” is defined in section 6 of the Act:

6(1) In this Act an “earlier trade mark” means –

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

11. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the earlier mark was registered within the five years before the date on which the applicant’s mark was published, it is not subject to proof of use. The opponent is therefore entitled to rely upon its mark for all the goods for which it is registered.

### Section 5(2)(b) case law

12. The following principles are gleaned from the decisions of the courts of the European Union 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

13. The applicant seeks registration in relation to:

Class 5: Penis Enhancement Gel

14. Although the opponent's mark covers various other goods, I note that it covers the following class 5 goods:

Sexual stimulant gels;

pharmaceutical preparations for inducing erections

15. In my view, the opponent's sexual stimulant gels would include within its ambit gels for penis enhancement. Further, the opponent's pharmaceutical preparations could be in gel form, which, given that they are for inducing erections, they too would also cover penis enhancement. Given that goods can be held identical on an

inclusion basis<sup>2</sup>, one term falling within the ambit of another, I hold that the goods are identical in this case. If they are not identical, they must be similar to the very highest degree.

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

16. In accordance with the case law cited in paragraph 12, I must determine who is the average consumer and the nature of the purchasing act. 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 in question<sup>3</sup>.

17. The average consumer will be a member of the general public, as the opponent submits. They may purchase the goods simply for sexual pleasure, or potentially to deal with some form of relevant medical problem. As some of the goods could be medicated, a health care professional could also be an average consumer.

18. The goods (if purchased as opposed to prescribed) are unlikely to be expensive. They do not strike me as everyday purchases, although for those that do avail themselves of such products, they will represent an occasional purchase. Given the intimate nature of application and their purpose, the goods are not a completely casual purchase. That said, I do not consider that the goods will be subject of a high level of care and consideration. Consequently, an average level of care will be applied. The goods are likely to be selected through a range of visual media such as websites, advertisements, on the shelf etc. This suggests that the visual impression of the marks takes on greater importance, although, I will not ignore in the comparison the aural impacts of the marks as the goods may still be subject to oral request.

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<sup>2</sup> See, for example, Case T- 133/05 of the General Court

<sup>3</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, C-342/97, para. 26



## Comparison of marks

19. 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 in *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.<sup>4</sup>

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

21. The respective marks are shown below:



v Titan gel

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<sup>4</sup> C-591/12P, para. 34

22. The earlier mark comprises the words Titan Gel. Given the obviously descriptive nature of the word Gel, it is the word Titan that will dominate the mark. In terms of the applied for mark, it comprises a picture of a container which will clearly be seen as a receptacle for the goods, the words TITAN GEL (one above the other), the words SPECIAL GEL FOR PENIS towards the bottom of the mark, above which is a highly stylised graphic element which, in the context of the goods, will be recognised as a penis. There is also a more or less rectangular element at the top of the mark containing some red geometric shapes. Given the respective sizes and the roles the various elements play in the mark, it is the words TITAN GEL and the stylised penis that have most relative weight in the overall impression, both making a roughly equal contribution. The other elements have less significance given that they are either just decorative (the rectangular border), are descriptive (the words at the bottom of the mark) or consist of a receptacle for the goods. I bear in mind, though, that all of the elements still play a role in the overall impression.

23. The marks share the words TITAN GEL/Titan Gel which comprise the totality of the earlier mark and an element of the applied for mark which has equal dominance in the overall impression. Notwithstanding the visual differences that clearly exist on account of the additional aspects of the applied for mark, there is still a medium degree of visual similarity.

24. It is unlikely that the applied for mark will be articulated on the basis of all of the verbal elements in the mark. It will likely be articulated as TI-TAN-GEL, which is therefore identical to the way in which the earlier mark will be articulated.

25. Both marks share a concept based on the known word TITAN (old Greek gods or something of great strength/importance)<sup>5</sup>. Although there are additional concepts in the applied for mark (the concept of a penis for example), there is still a reasonably high degree of conceptual similarity.

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<sup>5</sup> See Oxford Dictionaries online

## Distinctive character of the earlier trade mark

26. It is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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).

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).<sup>6</sup>

27. I have only the inherent characteristics of the mark to consider, based upon the distinctiveness of the words TITAN GEL. Whilst the use of the word TITAN could arguably make a suggestive nod towards the goods, such as them having a strong effect upon application, such allusion is mild. I consider the earlier mark to have a medium degree of inherent distinctiveness.

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<sup>6</sup> C-342/97, paras. 22-23

## Conclusions on likelihood of confusion

28. I have so far considered the factors that need to be taken into account when assessing the likelihood of confusion and now come to a global assessment. As the CJEU stated:

A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.<sup>7</sup>

29. There are two types of confusion that must be considered:

- direct confusion, where one mark is mistaken for another; and
- indirect confusion, where the similarities lead the consumer to believe that the goods or services come from the same, or a related, undertaking.

30. Whilst not ruling out the possibility of the marks being directly confused, I believe the better prospect of success for the opponent lies in indirect confusion. In my view, confusion of this nature will clearly follow. The goods are identical. Within both marks the words TITAN GEL send a message of trade origin, it being an independently distinctive element within the applied for mark. The average consumer will assume that the applied for mark is merely an example depiction of the packaging for the

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<sup>7</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97, para. 17

Titan Gel product and will assume that it comes from the same or economically related undertaking. The opposition under section 5(2)(b) succeeds.

## **COSTS**

31. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced on or after 1 July 2016 are governed by Tribunal Practice Notice (TPN) 2/2016. For fast track opposition proceedings, costs are capped at £500, excluding the official fee.<sup>8</sup>

*Official fee - £100*

*Preparing a statement and considering the other side's statement - £200*

*Written submissions - £200*

***Total: £500***

32. I therefore order Avrupa İlaç Ve Kozmetik San. Ve Tic A. to pay Hendel Limited Liability Company the sum of £500. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 16<sup>th</sup> day of May 2019**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**

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<sup>8</sup> TPN 2/2015