

**O-425-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No.3364148  
BY GUANGZHOU LIANGBU SCIENCE AND TECHNOLOGY CO., LIMITED  
TO REGISTER IN CLASSES 10 & 21  
THE TRADE MARK**

**T. Smile**

**AND  
IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 416301  
BY  
THE BOOTS COMPANY PLC**

## BACKGROUND

1) On 2 January 2019, Guangzhou Liangbu Science and Technology Co., Limited (hereinafter the applicant) applied to register the trade mark shown on the page above in respect of the following goods:

In Class 10: Tongue scrapers; Oral irrigators.

In Class 21: Dental floss; Dental floss dispensers; Dental floss [floss for dental purposes]; Dental picks for personal use; Dental tape; Toothbrush bristles; Toothbrush cases; Toothbrush containers; Toothbrush holders; Toothbrushes; Toothbrushes, electric; Toothbrushes [non-electric]; Toothpicks; Interdental brushes for cleaning the teeth; Heads for electric toothbrushes; Oral care kits comprising toothbrushes and floss; Floss for dental purposes; Apparatus for cleaning teeth and gums using high pressure water for home use; Water apparatus for cleaning teeth and gums; Oral irrigators, other than for use in dentistry.

2) The application was examined and accepted, and subsequently published for opposition purposes on 15 February 2019 in Trade Marks Journal No. 2019/007.

3) On 16 May 2019 The Boots Company Plc (hereinafter the opponent) filed a notice of opposition. The opponent in these proceedings is the proprietor of the following UK trade mark:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
SMILE	2435807	17.10.06 22.02.08	3	dentifrices; denture cleaners; denture polishes; preparations in the form of tablets for cleaning dentures; preparations in the form of powder for cleaning dentures; preparations in the form of paste for cleaning dentures; preparations for cleaning artificial dentures; breath fresheners; mouthwash preparations for oral hygiene purposes; toothpastes.
			5	denture base materials; breath fresheners; mouthwashes.

			10	handles for dental floss; dental tape.
			21	brushes (except paint brushes); brush-making materials; articles for cleaning purposes; denture baths; denture brushes; dental floss, dental flow in the form of tape; dental floss in the form of thread; dental flossing aids; containers for toothbrushes; electric toothbrushes; holders for toothbrushes; non-electric toothbrushes; toothbrushes containing toothpaste;

- a) The opponent contends that the marks of the two parties are very similar and that the goods applied for are identical and/or similar to the goods for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.
- b) The opponent contends that it has used its mark since August 2002 throughout the UK and as such has built up a goodwill in respect of dental products. Given the similarity of the marks and goods there is a likelihood of misrepresentation which would damage the reputation of the opponent. As such the mark in suit offends against section 5(4)(a) of the Act.
- 4) On 5 August 2019 the applicant filed a counterstatement basically denying all the grounds of opposition. It accepts that there is similarity between the goods of the two parties but does not accept that the marks are similar. It does not put the opponent to proof of use.
- 5) Only the opponent filed evidence; both sides seek an award of costs in their favour. Neither side wished to heard and both sides provided submissions which I shall refer to as and when necessary.

## **OPPONENT'S EVIDENCE**

6) The opponent filed a witness statement, dated 23 December 2019, by Miguel Mendes a Trade Mark Advisor employed by the opponent. He states that the opponent has sold its dental products under the SMILE mark throughout the UK and has in the last five years sold over 24 million units which equates to £26million. The goods are sold through the company's 2465 stores in the UK and also on-line. The mark is applied to the products themselves as well as packaging, point of sale material and promotional material.

## DECISION

7) The first ground of opposition is under section 5(2)(b) which reads:

“5.-(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.”

8) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

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

9) The opponent is relying upon its trade mark shown in paragraph 3 above which is clearly an earlier trade mark. The applicant did not put the opponent to proof of use.

10) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions 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 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.

### **The average consumer and the nature of the purchasing decision**

11) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

12) The goods at issue in these proceedings are oral hygiene such as toothbrushes and dental floss. The average consumer for such goods will be the public at large including children and businesses. Such items may be sold through a range of channels, including dental practices, retail premises such as pharmacies as well as supermarkets (where the goods are normally displayed on shelves and are obtained by self-selection) and on the internet or via catalogues and print media. The selection process will be primarily a visual one, although as discussions may take place with staff and as one might receive a recommendation, aural considerations must also be taken into account. These goods are not particularly expensive and to my mind the consumer will pay no more than an **average level of attention to the selection of such goods.**

## Comparison of goods

13) In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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 *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (GC) stated that:

“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”.

16) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... 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."

17) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

18) As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”



Whilst on the other hand:

“.....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.”

19) I shall first consider the applicant's class 10 specification which consists of “Tongue scrapers; Oral irrigators”. In its pleadings and submissions the opponent specified goods upon which it relied, which were “dental apparatus and instruments”. However, its class 10 specification was subsequently reduced to that shown above, which excluded the items mentioned in its submissions. Of the goods which formed part of the opponent's pleadings I believe that the following from class 3 “mouthwash preparations for oral hygiene purposes; toothpastes” and “electric toothbrushes; holders for toothbrushes; non-electric toothbrushes dental flossing aids;” from its class 21 specification are similar to a **medium degree** to the applicant's tongue scraper. I base this on the fact that a toothbrush can, and indeed should, be used to clean one's tongue just as a scraper does. The uses and users are the same, and I consider it highly likely that the trade channels will also be identical. Moving onto the applicant's “oral irrigators” (which use water to “floss” or clean between one's teeth) these are to my mind **highly similar** to the opponent's “dental flossing aids”. Again, the uses, users and probably trade channels will be identical and/or very similar even if the physical nature is different.

20) Moving onto the applicant's class 21 specification, the goods seem to split into two distinct types. The following terms all appear to my mind to involve dental floss or tape or items which perform the same functions as dental floss “Dental floss; Dental floss [floss for dental purposes]; Dental picks for personal use; Dental tape; Oral care kits comprising floss; Floss for dental purposes; Apparatus for cleaning teeth and gums using high pressure water for home use; Water apparatus for cleaning teeth and gums; Oral irrigators, other than for use in dentistry; Toothpicks.” In my opinion, the opponent's class 21 specification of “dental floss, dental flow in the form of tape; dental floss in the form of thread; dental flossing aids;” seem to be **either identical or highly similar** to the applicant's goods.

21) The second part of the applicant's specification of “Toothbrush bristles; Toothbrush cases; Toothbrush containers; Toothbrush holders; Toothbrushes; Toothbrushes, electric; Toothbrushes [non-electric]; Interdental brushes for cleaning the teeth; Heads for electric toothbrushes; Oral care kits comprising toothbrushes” to my mind must be regarded as **identical or highly similar** to the following items in the opponent's class 21 specification “containers for toothbrushes; electric

toothbrushes; holders for toothbrushes; non-electric toothbrushes; toothbrushes containing toothpaste". This leaves, "Dental floss dispensers" which **do not appear to be similar** to any of the opponent's goods.

### **Comparison of trade marks**

22) 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 them, 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."

23) It would be wrong, therefore, to artificially dissect the trade 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 them. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
<b>SMILE</b>	<b>T. Smile</b>

24) The applicant's submissions revolve around the fact that they do not believe that consumers will confuse the marks particularly as the opponent's mark tends to be used alongside the opponent's house mark "Boots". Of course, it is the marks as registered, not as used, which must be compared. The opponent's point out that their mark appears in the applicant's mark and, they contend, must be regarded as the distinctive and dominant element of the mark in suit as the letter "T" does not alter the meaning of the word SMILE. Neither mark has an actual meaning for any of the goods in question. The only visual difference between the marks is the presence of a letter "T" and a full stop at the start of the applicant's mark. Aurally, the only difference is the letter "T" at the start of the applicant's mark. Visually and aurally the marks are highly similar. Conceptually the letter "T" and full stop in the applicant's mark has no meaning in and of themselves and neither do they alter the meaning of the well-known English word SMILE which follows them. The marks are conceptually identical or highly similar. **Overall the marks have a high degree of similarity.**

#### **Distinctive character of the earlier trade mark**

25) 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).”

26) The opponent’s mark consists of the word SMILE which has no direct meaning in respect of the goods at issue in the instant case, although it alludes dental health via a white line of teeth when one smiles. To my mind, **it has an average degree of inherent distinctiveness**. The opponent has provided evidence of use of its mark, but in a very cursory fashion and has failed to put the evidence of turnover into context of market share. Given that the mark is registered for a wide range of goods and the mark is said to have been used upon them all the level of turnover is very modest and so **the opponent cannot benefit from an enhanced degree of distinctiveness through use in relation to the goods for which it is registered**.

### **Likelihood of confusion**

27) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive the trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public (including businesses) who will select the goods by predominantly visual means, although I do not discount aural

considerations and that they are likely to pay no more than an average degree of attention to the selection of the goods in question.

- the marks of the two parties have a high degree of similarity.
- the opponent's mark has an average degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the goods of the two parties are similar to at least a medium degree with most being highly similar or identical.

28) In view of all of the above, and allowing for the concept of imperfect recollection, when the applicant's mark is used on goods which are similar to a medium degree there is a likelihood of consumers being directly confused into believing that the goods applied for and provided by the applicant are those of the opponent or provided by an undertaking linked to it. It stands to reason therefore that the goods which are highly similar or identical will also cause confusion. **The opposition under Section 5(2) (b) therefore succeeds in respect of all the goods applied for by the applicant, except for "Dental floss dispensers".**

29) The last ground of opposition is under section 5(4)(a) which reads:

"5.(4) 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, where the condition in subsection (4A) is met

aa) .....

(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."

Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

30) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

31) Whilst Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

32) The opponent is relying upon its sign SMILE which is said to have been used in relation to oral hygiene and dental products in the UK. Earlier in this decision I found that whilst the opponent had provided turnover figures for its mark, given the absence of context in terms of market share and the wide range of goods for which the mark is registered that the opponent has not shown that it has goodwill in its mark in relation to a particular category of goods. The mark is registered for, inter alia, bleaching and cleaning products, pharmaceutical preparations, Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, Household or kitchen utensils and containers, glassware, porcelain and earthenware not included in other classes. The opponent has failed to get

over the first hurdle of showing that it has goodwill under its mark in relation to a particular group of goods. Had the opponent succeeded in satisfying this requirement then undoubtedly the result would have been that the opposition would fully succeed under this ground because given my earlier findings I would have found misrepresentation and damage. As it has failed to prove it has goodwill **the opposition under Section 5(4)(a) of the Act must fail in relation to all of the goods sought to be registered.**

## **CONCLUSION**

33) The opposition under section 5(2)(b) is completely successful, with the exception of “Dental floss dispensers” in Class 21, but the opposition under section 5(4)(a) fails.

## **COSTS**

34) The opponent has mostly succeeded in full under one ground and is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement	£200
Expenses	£200
Evidence	£500
Submissions	£200
<b>TOTAL</b>	<b>£1100</b>

35) I order Guangzhou Liangbu Science and Technology Co.,Ltd to pay The Boots Company Plc the sum of £1100. This sum to be paid within twenty- one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 7th day of September 2020**

**George W Salthouse**  
**For the Registrar,**  
**the Comptroller-General**