

**O-628-21**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No. 3480899  
BY THAMEEN LIMITED  
TO REGISTER THE TRADE MARK**

**Heart of Eternity**

**IN CLASSES 3, 4 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 421129 BY  
CALVIN KLEIN COSMETIC CORPORATION**

**BACKGROUND**

1) On 12 April 2020, Thameen Limited (hereinafter the applicant) applied to register the trade mark “Heart of Eternity” in respect of the following goods and services:

In Class 3: Perfumery; perfumes; fragrances; cosmetics; toiletries; make-up; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances; pomades; pomades for cosmetic purposes; hair pomades; lip pomades; essential oils; parts and fittings for any or all of the aforesaid goods in this Class.

In Class 4: Candles, fragranced candles; aromatherapy fragrance candles; parts and fittings for any or all of the aforesaid goods in this Class.

In Class 35: Retail services connected with the sale of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles, including from an Internet website; shop retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; the bringing together, for the benefit of others, of a variety of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles, enabling customers to conveniently view and purchase those goods, including from an Internet website specialising in the same; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; electronic shopping retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; mail order retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.

2) The application was examined and accepted, and subsequently published for opposition purposes on 8 May 2020 in Trade Marks Journal No.2020/019.

3) On 7 August 2020 Calvin Klein Cosmetic Corporation (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade marks:

Mark	Number	Dates of filing & registration	Class	Specification relied upon
ETERNITY	1309022	05.05.87 07.04.89	3	Non-medicated toilet preparations; cosmetics; perfume; eau de colognes; soaps; antiperspirants; deodorants for personal use.
ETERNITY	EU 75945	01.04.96 27.02.98	3	Cosmetics and toiletries, namely, non-medicated toilet and bath preparations; namely, parfum, eau de parfum; eau de parfum spray, eau de toilette and eau de toilette spray; soaps, antiperspirants and deodorants for personal use; body lotions and creams.

4) The grounds of opposition are, in summary:

- a) The opponent contends that its marks above and the mark applied for are very similar and that the goods of the two parties are identical and / or similar. In particular it alleges that perfumes frequently use a variant mark on newer editions of the perfume. As such the mark in suit offends against Section 5(2)(b) of the Act.
  
- b) The opponent also contends that it has a considerable reputation in its marks above. In relation to mark UK 1309022 this reputation resides in perfume and eau de Cologne; in relation to mark EU 75945 this resides in perfume, Eau de parfum, eau de parfum spray, eau de toilette and eau de toilette spray. It states that the similarity between the marks and goods is such that there is a likelihood of consumers assuming a link. It contends that this will enable the applicant to take unfair advantage of the opponent's reputation and free ride on its investment in promoting and advertising the brand. Use of the mark in suit will dilute and tarnish the reputation of the opponent. It contends that the mark in suit offends against section 5(3) of the Act.

5) On 26 October 2020 the applicant filed a counterstatement, in which it puts the opponent to strict proof of use of its marks in respect of all goods relied upon in class 3. The opponent denies the grounds of opposition, stating that the marks and goods / services of the two parties are not similar. It denies that the opponent has the reputation claimed.

6) Both parties are professionally represented, both seek an award of costs in their favour, only the opponent filed evidence, and provided written submissions. Neither side wished to be heard, I shall therefore issue a decision based upon the papers filed by both parties.

## **OPPONENT'S EVIDENCE**

7) The opponent filed a witness statement, dated 2 November 2021, by Ian McCarthy, the Marketing Vice President of Coty UK Ltd, part of a group which includes the opponent. Mr McCarthy has been in marketing for 20 years and has held his current position for four years. He is authorised to speak on behalf of the opponent and has access to all relevant records. He states that the company has been using the mark ETERNITY upon the goods relied upon in the UK since 1988. He states that the goods relied upon are sold via major UK retailers such as The Perfume Shop, The Fragrance Shop, Boots, Superdrug, Amazon, John Lewis, Next and Very, with sales being on-line and via high street retail outlets. Mr McCarthy states that during the last five years the mark has been used with what he refers to as “added elements”. These consist of the word “eternity” followed by “*Moment*”, “*Now*”, “*Intense*”, “*Air*”, “*Summer*”, “*Flame*”, “*Fresh*”, “*for Men*” and “*for Men Aqua*”. He states that: “It is common practice in the perfumery and cosmetics industry to benefit from a successful existing product by launching new products under the existing mark but with added elements. This is true not only for the [earlier] mark but for very many other perfumes.” Apart from the number of units sold shown below Mr McCarthy states that retail sales in the period January 2020 – December 2020 of goods under its earlier mark were in excess of £6.4 million. He states that the opponent has spent an average of approximately £1million per annum during the period 2017-2020 on marketing of the products relied upon under its earlier mark. The advertising is in the form of print / online advertising, displays in stores and social media. He provides the following exhibits:

- IM01: Copies of pages from the website of Boots which show the products relied upon by the opponent offered for sale, dated 28 January 2021 (after the relevant date 12/4/20).
- IM02: Sample images of the products relied upon sold in the UK dated 28 January 2021.
- IM03: A press release dated August 2020 (after the relevant date 12/4/20) stating that since its launch in 1988 the mark has held “leading positions in most developed markets including the USA, UK Germany and Spain”.

- IM04: Details of the goods relied upon being offered for sale on the website of the retailers listed earlier. None of the sixty-four pages are dated.
- IM05: Images of products with the “added elements”. This page is not dated but does show the word “*Eternity*” with the added elements: “*Now*”, “*Intense*”, “*Air*”, “*Flame*”, “*EDP*” and “*Fresh Cologne*” upon the bottles of fragrance.
- IM06: Lists of 2019 bestselling perfumes from retailers *The Perfume Shop* and *Fragrance Direct*. However, none of the twenty-one pages are dated.
- IM07: extracts from websites which show perfumes being sold with “added elements”. None of the twenty-one pages are dated.
- IM08: A spreadsheet which is said to show sales for the last five years of the goods relied upon under the Eternity mark in the UK. The sheets do not contain obvious sales quantities, simply two “codes” one of which is thirteen digits long the other eleven digits. Nor is it clear what the description actually relates to, as again it appears to be in code. Mr McCarthy states that in the years 2015 – 2017 the opponent sold approximately 430,000 units per annum, whilst during the period July 2017-June 2020 this rose to approximately 500,000 units per annum.
- IM09: A selection of invoices showing sales of goods relied upon under the Eternity mark. These are listed as ETW / ETM =Eternity for Women /Men; EMW = Eternity Moment for Women; and ETFM = Eternity Now for Men. Six are dated 2018, three dated 2019. All have UK at the end of the otherwise redacted address, and show quantities but not values.
- IM10-14 inclusive: There is an example of a display in Debenhams dated 2017 which shows bottles of fragrance with the word “Eternity” upon them. Other photos from 2018 /19 show various Boots, Debenhams and Superdrug stores around the UK again showing use of the mark ETERNITY upon bottles of fragrance, and also ETERNITY FLAME.
- IM15-16 inclusive: examples of advertising for “Eternity” and “Eternity & added matter” products. Page 14 of exhibit 15, dated 2020 shows use of ETERNITY; pages 5 & 6 of exhibit 16 have dates of 24 and 23 March 2019 respectively and show use of ETERNITY FLAME; page 9 of exhibit 17 is dated 27 December 2017 and shows an advertisement for ETERNITY

MOMENT in the Evening Standard; Pages 10-14 are dated between May and December 2017 and show use of ETERNITY EDP & ETERNITY INTENSE on various UK websites. All use in these exhibits is in relation to fragrances.

- IM17-24 inclusive: The opponent's ETERNITY fragrance is mentioned in a number of publications in 2015 - 18 including *GQ magazine*, *Woman's Weekly*, *Daily Star*, *Marie Claire*, *Daily Mail*, *Esprit*, *RED*, *Women*, *Vogue*, *Grazia*, *Vanity Fair*, and *Elle*. There are also numerous mentions on social media.
- IM25: A list of award winners during the last twenty-five years. However, ETERNITY does not seem to have been a recent winner i.e. post 2010.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

12) Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

13) 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.”

14) 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.”

15) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier trade marks. The opponent has put the opponent to strict proof of use. The proof of use requirements state:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16) The application date, and therefore the relevant date, is 12 April 2020. The proof of use period is 13 April 2015 - 12 April 2020. Both of the opponent’s marks were registered before the relevant period and so they have to meet the proof of use requirements. The opponent’s trade marks UK 1309022 & EU 75945 are identical as both are for the word ETERNITY in a plain uppercase font. The specifications relied upon by the opponent are :

Mark	Specification relied upon
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UK 1309022	In Class 3: Non-medicated toilet preparations; cosmetics; perfume; eau de colognes; soaps; antiperspirants; deodorants for personal use.
EU 75945	In Class 3: Cosmetics and toiletries, namely, non-medicated toilet and bath preparations; namely, parfum, eau de parfum; eau de parfum spray, eau de toilette and eau de toilette spray; soaps, antiperspirants and deodorants for personal use; body lotions and creams.

17) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end

user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in

the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18) In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when

supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

19) The opponent has filed a witness statement and a large number of exhibits. Unfortunately, many of the exhibits are either undated or dated after the relevant date of 12 April 2020. Most of the evidence relates to the sale of fragrances. Despite the obvious shortcomings of the evidence I note that the witness has very clearly stated that the opponent has sold the goods relied upon in the UK through retail outlets and on the internet and he provides sales figures for the final year of the period of £6.4 million, and also the number of units sold which averaged at approximately 450,000 units per annum for the five year period in question. The opponent has also spent approximately £1 million per annum on promotion during the period 2017-2020. There are some invoices although these are not particularly convincing other than for fragrances. Similarly most of the publicity and media coverage relates to the fragrances rather than cosmetics, anti-perspirants, body options and creams. However, I note that the applicant has not challenged the evidence and neither has it sought cross-examination, to my mind the opponent’s evidence provides a coherent narrative and is just sufficient for the opponent to be able to rely upon its specification shown at paragraph 3 above.

20) 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.

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

(k) 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;

(k) If 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;

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;

(k) 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

21) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services 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.”

22) The goods at issue in these proceedings are, broadly speaking, cosmetics, perfumes, fragrances, toiletries, candles and retail services relating to the aforementioned goods. The average consumer for such goods will be the public at large (including businesses). Such goods will typically be sold via retail outlets and on the internet, which may include orders being placed by telephone. I must also take into account personal recommendations. The selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will display when selecting the goods. The cost of these goods will vary enormously. The attention span will vary accordingly. The average consumer will be concerned to ensure that they obtain the fragrance that they particularly like or to which they are drawn by advertising. They are likely **to pay at least an average level of attention to the selection of the goods in class 3 and 4 at issue**. The retail services will also be primarily selected visually by reference to the sign outside the shop, although they could be contacted having been searched on the internet, and of course I must also take into account personal recommendations. To my mind, the average consumer will pay an average amount of attention in selecting a retail outlet as the name may reflect upon the level of service and quality of goods to be found inside the outlet.

## Comparison of goods and services

23) 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”.

24) 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.

25) 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."

26) In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*"...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded."*

27) 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 General Court 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”.

28) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. 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.

29) I shall first compare the class 3 goods of the two parties:

<b>Applicant’s goods</b>	<b>Opponent’s UK 1309022</b>	<b>Result</b>
Perfumery; perfumes; fragrances; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances;	perfume; eau de colognes;	Identical
toiletries;	Non-medicated toilet preparations; soaps; antiperspirants; deodorants for personal use.	Identical

cosmetics; make-up; lip pomades	cosmetics;	Identical
pomades; pomades for cosmetic purposes; hair pomades;	Non-medicated toilet preparations; cosmetics;	Identical
essential oils; parts and fittings for any or all of the aforesaid goods in this Class.	Non-medicated toilet preparations; cosmetics; perfume	Highly similar
<b>Applicant's goods</b>	<b>Opponent's EU 75945</b>	<b>Result</b>
Perfumery; perfumes; fragrances; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances;	parfum, eau de parfum; eau de parfum spray, eau de toilette and eau de toilette spray;	Identical
cosmetics; make-up; lip pomades;	Cosmetics	Identical
toiletries;	Toiletries; soaps, antiperspirants and deodorants for personal use; body lotions and creams	Identical
pomades; pomades for cosmetic purposes; hair pomades;	Cosmetics; Toiletries;	Identical
essential oils; parts and fittings for any or all of the aforesaid goods in this Class.	Cosmetics; Toiletries; parfum.	Highly similar

30) In the above table it is clear that many of the words in the applicant's specification appear in that of the opponent, or that the applicant's specification is a sub-set of the opponent's specification such as "make up" to "cosmetics". The only items that need comment are the "pomades" included in the applicant's specification which is merely a form of cosmetic or toiletry for use on one's hair; and essential oils which form a base of perfumes, cosmetics etc. and are sold alongside perfumes, cosmetics etc. in retail outlets.

31) I next turn to consider the goods in class 4 sought to be registered by the applicant. For ease of reference these are: Candles, fragranced candles; aromatherapy fragrance candles; parts and fittings for any or all of the aforesaid goods in this Class. The opponent's specification for both its earlier marks are set out in paragraph 12 above.

32) The opponent contends in its submissions that goods such as candles are more attractive when perfumed, and that such goods “are frequently marketed by reference to an established perfume name”. However, no evidence of candles, fragranced with a well-known perfume, being marketed by reference to said perfume has been provided. I also note that if the similarity between the goods is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

33) Thus, where the similarity between the respective goods / services is not self-evident, the opponent must show how, and in which respects, they are similar. The opponent has failed to meet this requirement. Clearly, the uses and physical nature are very different. It is by no means obvious that the users or indeed that the trade channels will be the same. In my opinion the applicant’s goods in class 4 are not similar to the opponent’s class 3 specifications.

34) I next turn to the applicant’s services in class 35. These all relate to the goods in classes 3 & 4 and the opponent contends in its submissions that although the nature, purpose and method of use of these goods and services are not the same, they display similarities and are complimentary and that “the services are generally offered in the same places as those where the goods are offered for sale. Furthermore, they are directed at the same public”. The opponent contends that the services in class 35 are similar to an average degree to the goods it relies upon in class 3. It refers me to a number of EU cases which come to this conclusion. I note that in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

35) Whilst in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

36) However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

37) I note that the opponent, in its evidence, stated that its goods were sold via major UK retailers such as *The Perfume Shop, The Fragrance Shop, Boots, Superdrug, Amazon, John Lewis, Next* and *Very*. The average consumer will therefore be used to a retail outlet offering a range of fragrances for sale from a vast number of manufacturers and will not assume that the outlet is in any way connected with said manufacturers. I note that a number of the retail services relate to the sale of class 4 goods (candles) which I found earlier were not similar to the opponent's class 3 goods. To my mind, the retail services in class 35 in relation to class 3 goods are not similar to the opponent's class 3 goods.

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

38) 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).”

39) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

40) The opponent’s two marks consist of the same word “ETERNITY” therefore I shall carry out a single comparison test. The opponent’s goods in class 3 are broadly speaking perfumes, cosmetics and toiletries. The term “ETERNITY” is a well known dictionary word meaning “infinite” or “unending” and as such has no meaning in relation to the opponent’s goods, other than to perhaps allude that the perfume lingers for some time. To my mind the mark is inherently distinctive to an average degree. The opponent has filed evidence of use but has not provided market share figures. I am aware that the UK market for perfume, cosmetics and toiletries runs into the £billions, so although the opponent’s sales figures are not shabby it cannot, in my opinion, **benefit from enhanced distinctiveness through use.**

### **Comparison of trade marks**

41) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by 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.”

42) 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 marks to be considered are as follows:

Opponent's earlier mark	Applicant's Mark
ETERNITY	Heart of Eternity

43) The opponent submitted:

“37. The Applicant in its Statement of Defence claims that the marks are different because the Earlier Marks do not contain the words “heart” or “of”. Nonetheless, they are highly similar. ETERNITY is the distinctive and dominant element of the mark, the “HEART OF” element being less distinctive and semantically subsidiary to the ETERNITY element.

38. Any slight visual and phonetic differences do not outweigh the conceptual identity or strong similarity.

39. The established industry practice of variant marks (IMWS paragraph 12, Exhibit IM06) must also be taken into account. If it is established in an industry for, say, POISON perfume to

be followed by TENDRE POISON, or GOOD GIRL to be followed by VERY GOOD GIRL, it is natural for the consumer to perceive HEART OF ETERNITY as so similar to ETERNITY that they must originate from the same proprietor.

40. Taking everything into account, there is a high degree of similarity visually and phonetically, and a very high degree of similarity conceptually. Both marks will be recalled by the consumer, taking into account imperfect recollection, as ETERNITY marks.”

44) The opponent’s mark consists of the single well-known dictionary word ETERNITY which also appears in the mark in suit. There are obvious visual and aural differences as the mark in suit also contains the words “Heart of” at the start of the mark. To the best of my knowledge the words in the mark in suit do not have a particular meaning other than their dictionary meaning. The marks have a medium degree of visual and aural similarity. Conceptually the mark in suit does not mean anything as I do not believe you can have a heart or middle of something which is unending. The marks have a conceptual difference. **Overall the marks are similar to a medium degree.**

#### **Likelihood of confusion**

45) 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 services 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 this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the services, 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 selection will be predominantly a visual one for all the goods and services applied for by the applicant, although aural considerations must be taken into account.. The average consumer will be concerned to ensure that the goods in class 3 & 4 meet their aesthetic requirements and will pay an average level of attention to the selection of the goods in these classes. Similarly, when looking for a retail service in class 35 the average consumer will pay an average amount of attention to the selection.



- Overall, the marks of the two parties are similar to a medium degree.
- The opponent's marks are inherently distinctive to an average degree, neither of the marks can benefit from enhanced distinctiveness through use.
- The applicant's goods in class 4 and its services in class 35 are not similar to the opponent's class 3 goods. The following goods in the applicant's class 3 specification are identical to the class 3 goods of both of the opponent's marks: "Perfumery; perfumes; fragrances; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances; toiletries; cosmetics; make-up; lip pomades; pomades; pomades for cosmetic purposes; hair pomades; parts and fittings for any or all of the aforesaid goods in this Class". The remainder of the applicant's class 3 specification, namely "essential oils; parts and fittings for any or all of the aforesaid goods in this Class" are highly similar to the opponent's class 3 goods under both its marks.

46) I take into account the views expressed in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where Mr Iain Purvis Q.C., as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

47) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

48) I also note that a degree of similarity in the goods of the two parties is essential. This was stated in *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU) and also in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

50) From the above it is clear, in respect of both of the opponent’s marks, that where I have determined that there is no similarity between the goods and services of the two parties the opposition must fail. In my opinion there will not even be any indirect confusion. However, where there is identity or a high degree of similarity between the goods and allowing for the concept of imperfect recollection, 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. The opposition under section 5(2)(b) therefore succeeds against all of the goods applied for in class 3 but fails in relation to the goods and services applied for in classes 4 and 35.

51) I next turn to the ground of opposition under section 5(3) which reads:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

52) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Addidas-Salomon*, Case C-487/07, *L’Oreal v*

*Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

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

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

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

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

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

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

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

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV, paragraph 40*.

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

53) I must first consider whether the opponent has shown it has the requisite reputation. In *General Motors, Case C-375/97*, the CJEU held that:

“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.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the

Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

54) The evidence filed by the opponent is far from overwhelming but they have provided turnover figures, copies of invoices as well as details of retail outlets stocking their fragrances and media coverage of same. **The opponent therefore clears the first hurdle of reputation for fragrances.**

55) I next turn to consider whether a significant part of the relevant public will make the necessary link between the marks of the two parties. In carrying out this comparison I am aware that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion (*Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P). Earlier in this decision I determined that the marks of the two parties had a medium degree of similarity, I also determined that the goods in class 3 were at least highly similar whilst the applicant's goods in class 4 and its services in class 35 were not similar to the opponent's class 3 goods. Even though the opponent only has reputation in fragrances the applicant's goods in class 3 would still be either identical or similar to at least a medium degree. To my mind a significant part of the relevant public will form a link between the businesses of the two parties if the mark in suit is used on goods in class 3. However, I am equally sure that the applicant's goods in class 4 and services in class 35 are so different to the opponent's fragrances that a substantial part of the relevant public will not form a link between the two parties.

56) Moving onto the question of damage, detriment and unfair advantage I take into account the comments in *Argos Limited v Argos Systems Inc.* [2018] EWCA Civ 2211, where the Court of Appeal held that a change in the economic behaviour of the customers for the goods/services offered under the later trade mark was required to establish unfair advantage.

57) This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited and Anor*, [2019] EWHC 2003 (IPEC).

58) In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) pointed out that the alleged detriment to the distinctive character of the earlier mark must be connected to the mark's reputation. The judge stated that:

“122. The requirement that the registered trade mark has a reputation therefore underpins and is intimately tied to the possibility that the mark may be injured. Put another way, if and in so far as the registered mark is not known to the public then, in a case in which there is no likelihood of confusion, it is very hard to see how it can be injured in a relevant way. This presents no conceptual difficulty in a case in which it is alleged that the use of the later mark will take unfair advantage of or tarnish the reputation attaching to the registered mark. Self evidently both of these kinds of injury can only be inflicted upon the registered mark to the extent that it has a reputation. But in my judgment just the same must apply to the third kind of injury, that is to say, damage to distinctive character by, for example, dilution or blurring. Just as in the case of the other kinds of injury, there must be some connection between the reputation and the damage.”

And

“140. Finally, and most importantly for present purposes, in assessing whether there is detriment to the distinctive character of the earlier mark, it must be considered whether the mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of the mark is weakened (see *Intel* at paragraph [29], set out above).”

59) Accordingly, section 5(3) only covers detriment to the distinctiveness of the mark in relation to the categories of goods/services for which the mark is registered and has a reputation. I accept that use of the mark in suit upon the goods listed in class 3 of the application will cause detriment to the distinctive character of the opponent’s mark and indeed it will take unfair advantage of the advertising investment in the earlier mark.

60) The opposition under section 5(3) succeeds in full in respect of the class 3 goods sought to be registered by the applicant. The opposition fails in respect of the goods in class 4 and the services in class 35 sought to be registered by the applicant.

## **CONCLUSION**

61) The opposition under Sections 5(2)(b) and 5(3) is partly successful in respect of all of the goods sought to be registered in class 3. The opposition under sections 5(2)(b) and 5(3) fail in respect of all the goods and services sought to be registered in classes 4 and 35.

## **COSTS**

62) As both sides have achieved a measure of success, I do not propose to favour either side with an award of costs.

**Dated this 24th day of August 2021**

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