

O-063-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2492199  
BY  
UKANDU LIMITED  
TO REGISTER THE TRADE MARK**



**IN CLASS 03**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 99525  
BY  
RIWAX-CHEMIE AG**

**Trade Marks Act 1994  
In the matter of application 2492199  
by UKANDU Limited  
to register the trade mark**



**in class 03  
and the opposition thereto  
under no 99525  
by Riwax-Chemie AG**

**BACKGROUND**

1. On 9 July 2008, Ukandu Limited (hereafter UL) applied to register the above mark as a trade mark for the following goods in class 3 of the Nice Classification System<sup>1</sup>:

‘Waxes and creams.’

2. The application was published on 12 June 2009 in Trade Marks Journal No. 6789.

3. On 11 September 2009, Riwax-Chemie AG (hereafter RC) filed a notice of opposition, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). It relies on some of the goods in class 3 of its earlier Community trade mark registration 3386042, as follows:

**RIWAX**

Bleaching preparations and other substances for cleaning, polishing, in particular waxes, cleaning fluids, cleaning foam, polishing creams, glazes, preservatives, care preparations; soaps.

4. RC’s mark was applied for on 7 October 2003, its registration procedure was completed on 15 November 2005. UL’s application was published for opposition purposes on 12 June 2009. Therefore, RC’s mark is an earlier mark not subject to proof of use as at the date of publication of the application it had not been registered for five years.<sup>2</sup>

5. The opposition is directed at ‘waxes and creams other than those for personal use.’ RC claims that these goods are identical and/or similar to the goods of interest

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

covered by its registration and that visual and aural similarities would cause a likelihood of confusion. On 25 November 2009, UL filed a counterstatement denying any similarity between the goods or the marks. Both sides filed evidence; neither side requested a hearing or filed written submissions in lieu of a hearing, both being content for a decision to be made from the papers on file.

## EVIDENCE

### RC's evidence

6. The opponent's evidence consists of a witness statement in the name of Jenny Loeffler, a trade mark attorney at Marks & Clerk LLP, acting on behalf of RC. For the most part this takes the form of submissions, which again I will not summarise here but will refer to where appropriate. Attached exhibits consist of extracts from Collins English Dictionary<sup>3</sup> and Oxford Compact English Dictionary<sup>4</sup> (Exhibit SJL1) showing pronunciation guides for the letter 'Y' and an internet search and forum discussion relating to speech impediments (Exhibit SJL2).

### UL's evidence

7. The applicant's evidence consists of a witness statement in the name of Edwin McNamara. For the most part this takes the form of submissions, which I will not summarise here but will refer to where appropriate. Attached exhibits consist of a letter between the parties dated 22 July 2009 (Exhibit 1), prints of internet searches relating to the meaning of the letter 'Y' and its use (Exhibits 2-6 and 8), a report of the fragrance content of the product (Exhibit 7) and marketing information relating to a sister product, not the subject of these proceedings (Exhibit 9).

## DECISION

8. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994, which states:

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

*....*

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

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

9. The leading authorities pertinent to this ground are from the European Court of Justice (ECJ), namely: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales*

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<sup>3</sup> 21<sup>st</sup> Century Edition

<sup>4</sup> Edition not provided.

*Germany & Austria GmbH C-120/04 and Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO).*

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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: *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components: *Sabel BV v. Puma AG*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element: *Shaker di L. Laudato & Co. Sas (C- 334/05)*, paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element: *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa: *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it: *Sabel BV v. Puma AG*, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2): *Sabel BV v. Puma AG*, paragraph 26;
- (j) further, 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: *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section: *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

### **The average consumer**

10. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. Neither side has put forward comments in this regard, other than as part of an analysis of the aural similarity between the marks, which I will consider when making a full comparison of the marks later in this decision.

11. The average consumer for waxes and creams in UL's application is the general public and may also include businesses. There is a wide range of goods within the class which can include waxes and creams for personal use as well as cleaning and polishing products, which are the subject of RC's earlier mark. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. Expensive industrial cleaning products are likely to afford a higher level of attention than would be evident during the purchase of a hair styling product, which could be a fairly frequent and inexpensive occurrence. Overall, a reasonable, but not the highest, level of attention will be paid by the relevant consumer when purchasing waxes and creams.

12. Given the nature of the goods the purchasing process is, for the most part, visual as it is likely to involve self selection from a shelf or website.

### **Comparison of goods**

13. UL's application is made in respect of '*waxes and creams*' in class 3 while the goods relied on in the earlier mark are '*bleaching preparations and other substances for cleaning, polishing, in particular waxes, cleaning fluids, cleaning foam, polishing creams, glazes, preservatives, care preparations; soaps*'. '*Waxes and creams*' are broad terms which encompass '*waxes*' and '*polishing creams*' in RC's earlier registration. Therefore, in line with the decision in *Gérard Meric v OHIM*, Case T-133/05, the goods are identical.<sup>5</sup>

### **Comparison of trade marks**

14. The trade marks to be compared are:

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<sup>5</sup> The General Court said in *Gérard Meric v Office for Harmonization in the Internal Market (OHIM)* at paragraph 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 the trade mark application, case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53, or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark, case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33."

Earlier Mark	Application
RIWAX	

15. In making a comparison between the marks, I must consider each mark’s visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components,<sup>6</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

16. RC’s mark, RIWAX, does not split into separate distinctive and dominant components. It will be viewed as the single word RIWAX which is its only constituent part; consequently, the distinctiveness of the mark trade mark rests in its entirety.. UL’s mark is made up of the word YWAX with the first and last letters enlarged and a device element of a brush stroke underlining the word. The stylisation, to some extent, reveals the word ‘wax’, which is descriptive in the context of the goods;; however, the degree of stylisation does not prevent the word being read as YWAX and it is this element which has greater prominence within the overall mark. The device element d has a degree of distinctiveness but is not dominant within the mark.

Visual similarity

17. UL states that visually:

*“one is clearly a graphic with highly stylised lettering..., a mixture of stylised capitalisation of lettering, coloured, with a brushstroke feature/device underneath, both a consonant and a phoneme away from the opponent’s mark, four letters in length...”*

18. In their submissions RC say:

*“There are obvious similarities in the marks since they both share the common element ‘wax’. There is some degree of stylisation in the Contested Application but it is extremely limited to the extent that most consumers would simply view the mark as being in a fairly ordinary typeface.”*

19. UL refers to the colouring of its mark as one of the elements which distinguishes it from RC’s mark. This does not have a bearing on the issue of similarity as the

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<sup>6</sup> Sabel v Puma AG, para. 23

applicant's mark is not limited to any particular colour. The matter must be assessed on the similarity between the respective words without regard to colour.<sup>7</sup>

20. RC's mark consists of the five letter word RIWAX presented in upper case. UL's mark consists of the four letter word YWAX presented in a stylised form with a line underneath, described by the applicant as a '*brushstroke feature/device*'. The opponent's mark does not isolate or accentuate any aspect of the mark. UL's mark enlarges the first and last letters.

21. The significant visual difference between the marks is that the applicant's mark begins with 'Y', while the opponent's mark begins with 'RI'.<sup>8</sup> Small differences between marks can make a big difference, particularly in the case of short word marks,<sup>9</sup> and in my view, this is the case here. Taking all of these factors into account, I find there to be a low level of visual similarity.

### Aural similarity

22. The opponent in these proceedings has focused the majority of its submissions on the issue of aural similarity between the marks. RC's exhibits, in their entirety, relate to the pronunciation of the letter 'Y' and include a report on speech impediments in children. RC submits:

*"The average consumer is accustomed to companies using strange and bizarre spellings, which nevertheless produce identical phonetic results. In comparing the marks phonetically, each possible pronunciation of the marks must be considered"*.

23. The applicant submits:

*"It is not the ability of an able mind to conjure up all possible pronunciations, regardless of likelihood of use, that needs to be tested but the likelihood of the use of particular pronunciations combined with that use leading to a likelihood of confusion within the relevant public (in relation to goods or services)."*

24. However, as stated above, at paragraph 14, I must consider each mark's visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. Both marks end with 'wax', resulting in the second syllables being the same aurally. UL's mark begins with 'Y', which is most likely going to be pronounced 'WYE', meaning that the mark, in its entirety, will be pronounced 'WYE-WAX'. RC's mark begins with 'RI' which could be pronounced 'REE' or 'RYE', resulting in the overall mark being pronounced 'REE-WAX' or 'RYE-WAX'. There is some distance between WYE-WAX and REE-WAX aurally which would result in a lower level of aural similarity. However, the second possible pronunciation is somewhat closer. RYE-WAX has a soft open consonant at the beginning, as does WYE-WAX, the main difference being

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<sup>7</sup> . "If the registered mark is unlimited as to colour then it is registered for all colours." *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch) Mann J, paragraph 119.

<sup>8</sup> The importance of the beginnings of words is discussed in detail at paragraph 32.

<sup>9</sup> Case T-112/06 *Inter-Ikea Systems BV v OHIM*

the 'W' sound when pronouncing the letter Y. In most cases I think the second pronunciation it is more likely but the alternative cannot be disregarded. On balance, in my view, there is a moderate degree of aural similarity between the marks.

### Conceptual similarity

25. RC claims, inter alia, that, "...most consumers would simply regard the Contested Application as consisting of the word YWAX."

*"Both marks share the same recognisable word WAX and will therefore convey the same concept. However, in their totality, the Earlier Right and the Contested Application are invented words without any meaning."*

26. In contrast UL states, inter alia, that the, 'Y' element of its mark has "the capacity for two separate meaningful interpretations..."

*"The ordinary consumer would read the 'wax' concept and then make sense of the capitalised 'Y' as a letter before making the connections, of 'why wax ?' and 'Y' representing the Y chromosome and therefore wax for men rather than for women..."*

27. Both trade marks consist, in my view, of invented words. However, both invented words contain the word 'wax'. YWAX is the word WAX preceded by the letter 'Y', while RIWAX is the word WAX preceded by 'RI'. There is an evocative effect in relation to the word wax. I have considered the comments of the General Court in *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 353/04* in relation to evocative effects when it said:

*91 This evocative effect is independent of whether or not the word mark EURON designates a characteristic of the goods for which registration of the earlier mark was made, since that fact does not influence the ability of the relevant public to make an association between that word mark and the words 'euro' and 'Europe' (see, by way of analogy, Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS) [2003] ECR II-4335, paragraph 54). In the same way, the evocative force of the earlier mark cannot be altered by the fact that it is supposedly 'made up'. Even a made-up word may carry conceptual weight."*

28. It is possible that the average consumer may dissect the mark in the manner suggested by UL, particularly as the letter 'Y' is larger than the following two letters. However, I am not persuaded that even if this were the case, they would be likely to consider the 'Y' to be representative of a Y chromosome or the word 'WHY'. It will simply come across as an invented word which contains the word 'wax'. Consequently, there is a degree of conceptual similarity between the trade marks but in the context of the overall marks, which are invented words, this does not go beyond an evocation of wax.

29. Overall, balancing the visual, aural and conceptual similarities, the degree of similarity is reasonably low.

## Likelihood of confusion

30. In order to make an overall global assessment of the likelihood of confusion, I must also assess the distinctive character of RC's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public.<sup>10</sup> In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings.<sup>11</sup> No evidence of use has been filed by RC, so I have only to consider the inherent level of distinctiveness.

31. Despite the evocation of 'wax', the mark is an invented word and, as such, enjoys a reasonably high level of distinctive character, although not the very highest level.

34. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind.<sup>12</sup>

32. The general rule, that the average consumer tends to place most importance on the start of a word,<sup>13</sup> is exactly that - a general rule, which can be mitigated depending on the circumstances of the case.<sup>14</sup> In this case I am not able to find that 'RI' or 'Y' have any meaning which might cause the relevant consumer's focus to move to the remainder of the mark and so must conclude that the fact that the beginning of both marks is different, in words which are only five and four letters in length, is a significant factor.

33. I also take into account the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa. In this case the goods are identical, while the similarity between the marks visually is at a reasonably low level. I acknowledge that, depending on pronunciation, there is a moderate degree of aural similarity and conceptually both marks are invented words which contain the word wax, so have a degree of conceptual similarity. The average consumer will pay a normal, neither high nor low, level of attention to the selection of the goods. The purchasing process will be primarily visual; it is necessary to assess the effect of the primarily visual purchasing process on the potential for confusion. In this regard, I bear in mind the

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<sup>10</sup> Rewe Zentral AG v OHIM (LITE) [2002] ETMR 91

<sup>11</sup> Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585

<sup>12</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>13</sup> Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03

<sup>14</sup> Castellani SpA v OHIM, T-149/06 and Spa Monopole, compagnie fermiere de Spa SA/NV v OHIM, T-438/07

comments of the General Court in *Cordorniu Napa, Inc v OHIM*<sup>15</sup> case in which it stated:

*“The significance of similarities or differences between signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the signs are marketed. If the goods covered by the marks in question are usually sold in self-service stores where consumers choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, a visual similarity between the signs will as a general rule be more important (NLSPORT, NLJEANS, NLACTIVE and NLCollection, paragraph 49, and el charcutero artesano, paragraph 80). If, however, the product is primarily sold orally, greater weight will usually be attributed to any phonetic similarity between the signs (Quelle v OHIM – Nars Cosmetics (NARS); not published in the ECR, paragraph 68).”*

And also the comments of the Court in *Mülhens GmbH & Co KG v OHIM* Case C-206/04 P:

*“21. It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, Lloyd Schuhfabrik Meyer, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.*

*22. Therefore, one cannot deduce from paragraph 28 of the judgment in Lloyd Schuhfabrik Meyer that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”*

34. In conclusion, the marks at issue share a moderate degree of aural similarity but, in my view, this is not sufficient to outweigh the visual differences, particularly where the purchase will be largely a visual one. Taking into account all of the relevant factors, and in particular the low level of visual similarity, **I find that the opposition fails in respect of all the goods opposed.**

## **Costs**

35. Both parties have requested an award of costs in their favour in the event of being the successful party. Neither side has requested costs off the published scale.

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<sup>15</sup> Case T-35/08

36. The opposition having failed the applicant, UKANDU Limited, is entitled to a contribution towards its costs on the following basis:

Considering the other side's statement and preparing a statement: £200

Considering the other side's evidence and filing evidence: £500

**Total: £700**

37. I order Riwx-Chemie AG to pay UKANDU Limited the sum of £700. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 22 day of February 2011**

**Ms Al Skilton  
For the Registrar,  
the Comptroller-General**