

IN THE MATTER OF APPLICATION NO. 2392932 IN THE NAME OF RAZA SYED

AND IN THE MATTER OF OPPOSITION NO. 93936 THERETO BY E.C. DE WITT & COMPANY LIMITED

DECISION

Introduction

1. On 27 May 2005 Raza Syed applied to register the trade mark WITCHCRAFT in class 3 for a specification of goods which was amended during the course of the subsequent opposition proceedings to read “eau de toilette, perfume, deodorant”.
2. The application was opposed by E.C. De Witt & Company Ltd on grounds raised under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994. In support of its opposition the opponent relied upon the following earlier trade marks:

<i>No</i>	<i>Mark</i>	<i>Class</i>	<i>Specification</i>
CTM 1656800	WITCH	3	Pads impregnated with witch hazel for cleansing of the skin and astringent purposes and liquid skin cleanser and astringent containing witch hazel.
		5	Medicated solid stick with witch hazel for treatment of irritated skin and medicated gel with witch hazel for treatment of irritated skin.

CTM 1656834		3	Pads impregnated with witch hazel for cleansing of the skin and astringent purposes and liquid skin cleanser and astringent containing witch hazel.
		5	Medicated solid stick with witch hazel for treatment of irritated skin and medicated gel with witch hazel for treatment of irritated skin.
UK 912985	WITCH DOCTOR	3	Cosmetics in the form of lotions, creams and of gels.
UK 912986	WITCH DOCTOR	5	Medicated preparations for use on the skin and scalp, all in the form of lotions, creams and gels.
UK 968265	WITCH STIK	5	Medicated preparations for use on the skin and the scalp, all in the form of solids and gels and all shaped as rods or sticks.

3. The applicant required the opponent to prove genuine use of the three UK trade marks it relied on within the period of five years ending on the date of publication of the application pursuant to section 6A of the 1994 Act.
4. Only the opponent filed evidence. This consisted of witness statements made by David Fowler, its Marketing Director, and Eleanor Coates of its trade mark attorneys. After a hearing attended only by the opponent and written submissions from the applicant, Mike Reynolds acting for the Registrar upheld the opposition in a written decision dated 9 August 2007 (O/225/07). The applicant now appeals. On the appeal the applicant has restricted his application to “eau de toilette, perfume”.

Relevant provisions of the Trade Marks Act 1994

5. Section 5 of the 1994 Act provides in relevant parts as follows:
 - (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 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

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

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark

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

6. These provisions implement Articles 4(1)(b), 4(3) and 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

7. Section 6A of the 1994 Act provides in relevant parts:

(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered....
- (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.

The hearing officer's decision

8. The hearing officer began by considering the opponent's evidence of use, which he assessed in accordance with the approach advocated in *Pan World Brands Ltd v Tripp Ltd* [2008] RPC 2. In their written submissions to the hearing officer the applicant's trade mark attorneys contended that there had only been use of WITCH DOCTOR in relation to gels containing witch hazel for cleansing and moisturising the skin; and submitted that the evidence did not establish genuine use of WITCH STIK at all.
9. The hearing officer's conclusions on this point were as follows:
 31. [The opponent's witness Mr Fowler] gives an account of the lengthy history of the brand, the sales made and the number of units sold. The opponent enjoys a substantial share of the market in medicated skincare preparations. I do not accept that it is appropriate to restrict the specification to the extent suggested by the applicant. Exhibit DF4 (which in terms of dates shows a © 2004 symbol) clearly indicates that the WITCH DOCTOR product is offered in lotion as well as gel form and for skin treatments. I accept that the products are likely to contain witch hazel.....
 32. In [Case T-126/03 *Reckitt Benckiser (Espana) SL v Office for Harmonisation in the Internal Market* [2005] ECR II-2861] the CFI found that the OHIM Board of Appeal had incorrectly held the earlier trade mark to be registered solely for a "product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)". The relevant subcategory of goods could be adequately captured in the term polish for metals. Having regard to the use shown, Mr Fowler's evidence and the applicant's submissions it would be appropriate to consider the opponent's use as being in respect of skincare preparations. I see no need to further restrict in terms of form (lotions, creams, gels etc) or ingredient (witch hazel). That approach also seems to me to be consistent with the Court of Appeal's guidance

in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 to the effect that the court should inform itself of the nature of the trade and then decide how the notional consumer would describe such use.

33. The position in relation to the WITCH STIK is rather less clear as it is not separately dealt with in Mr Fowler's evidence. However, for reasons which will emerge below I do not consider that it adds materially to the opponent's case.
10. Having set out the Registrar's standard summary of the guidance provided by the Court of Justice of the European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881, the hearing officer proceeded to consider the factors relevant to the section 5(2)(b) case under the following headings: similarity of goods, similarity of marks, distinctiveness/reputation, the family of marks case, the average consumer and circumstances of trade and likelihood of confusion.
11. When assessing the similarity between the respective goods, the hearing officer cited *Canon*, Case T-164/03 *Ampafrance v Office for Harmonisation in the Internal Market* [2005] ECR II-1401, *British Sugar plc v James Robertson & Sons Limited* [1996] RPC 281 and Case T-150/04 *Mühlens GmbH & Co KG v Office for Harmonisation in the Internal Market* (unreported, 11 July 2007). Having considered at some length the nature, intended purpose, method of use, competitiveness/complementarity, distribution channels/sales outlets and user of the respective goods and the prevalence of brand extension in this area, the hearing officer's conclusion was as follows:
 46. It will be clear from the above analysis that I consider there are points of similarity as well as points of difference in the respective sets of goods. But consumers are unlikely to compartmentalise the market to the extent that applicant's submissions invite me to accept. Rather, they will in my view regard the respective goods as part of a product continuum for personal grooming and beautification purposes. Taking the matter in the round the similarities outweigh the differences.

12. The hearing officer's assessment of the similarity between the respective marks was as follows:

47. The comparison is between WITCHRAFT and the opponent's marks WITCH, that word in slightly stylised form, WITCH DOCTOR and WITCH STIK taken individually. I must take account of visual, aural and conceptual similarities and differences. In use both the plain word and the stylised version are apparent. In what follows I will consider the matter primarily on the basis of the word only mark.

48. Self evidently, the applied for mark incorporates the whole of the mark WITCH but it is a much longer word. The same considerations come into play from a phonetic standpoint. Conceptually WITCH is likely to be understood to mean a female person who practices magic or sorcery. WITCHRAFT is the art or power of bringing magical power to bear (Collins English Dictionary). As it is the power exercised by a witch there is a strong conceptual association between the marks. I do not forget that WITCH may also be taken to allude to an ingredient in the opponent's products (witch hazel). There is some evidence that this feature of the products is advertised to potential consumers (see DF4) but not universally so on the evidence of DF5. On the other hand it has not been suggested that WITCH is recognised as short form for witch hazel. To the extent that it alludes it does so without in my view losing the underlying natural meaning of the word witch.

49. The European Courts have held that conceptual differences may be sufficient to counteract visual and aural similarity where at least one of the marks has a clear and specific meaning so that the public is capable of grasping it immediately (see *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01 and *Ruiz-Picasso and Others v OHIM*, Case C-361/04 P). Where the marks in question have a strong conceptual linkage it is likely to point to the opposite effect. I find that to be the case here. That finding is also broadly applicable to the stylised version of the WITCH mark.

50. The 'witch' theme is continued in the mark WITCH DOCTOR. One of the meanings of the term is someone who hunts witches though perhaps it is better understood as simply a shaman, someone who, like a witch, is held to possess magical powers. I find it to have a lower degree of similarity to WITCHRAFT than the word WITCH solus but it is best considered further in the context of the family of marks argument dealt with below.

51. The final mark is WITCH STIK which Mr Fernando suggested was another play on the 'witch' theme. That seems to require the element STIK to be read as if it is a reference to 'broomstick'. As this mark is used in relation to products in stick form it seems to me that it is this meaning that is likely to present itself most readily to consumers that is

to say a stick product from the WITCH brand rather than a reference to broomstick.

13. The hearing officer's conclusion with regard to the distinctiveness of the opponent's trade marks, and in particular the WITCH word mark, was as follows:

57. I have little hesitation in concluding that this is a case where a mark of moderate inherent qualities has been elevated through use to being a fully distinctive one. I have not been given market share figures for the opponent's non-medicated skincare products. It is reasonable to assume that the opponent's cosmetic skincare products will have benefited from the standing in the market enjoyed by the medicated equivalents. The dividing line between them is likely to be a fine one (turning on the strength of the formulations) and most of the advertising appears to relate to non-medicated products.

58. Rather different considerations apply in relation to the mark WITCH DOCTOR which in my view is an inherently stronger mark than WITCH solus. It too has been used on a significant scale and has been around for rather longer (than WITCH solus) with use having commenced in the UK in 1970.

59. The position on WITCH STIK is less clear. No separate sales figures have been given. Mr Fowler does not develop the claim in relation to this mark. As I have already indicated it seems likely that consumers will simply see this as a stick product from WITCH (and treat the misspelling as being not untypical within the context of advertising usage). In other words it is probably best considered as simply a variant use of the WITCH brand rather than a separate mark such as WITCH DOCTOR.

14. So far as the opponent's argument that it had a family of WITCH marks which this strengthened the likelihood of confusion is concerned, the hearing officer did not accept this save as follows:

64. That leaves the mark WITCH DOCTOR. There is some substance to the opponent's claim that there has been lengthy and extensive use of the mark. It is in fact used on a more concentrated formulation of the basic products. It is true that there are fewer examples of this mark in use but there is invoice evidence in DF1 and website material at DF4 in support of the claims in Mr Fowler's witness statement. Its use goes back to 1970. I accept the 'family' argument to this limited extent.

15. The hearing officer's assessment of the average consumer and the circumstances of the trade was as follows:

65. I have already commented on the profile of the average consumer for products of the kind at issue in this case. Cosmetics and perfumery items can vary considerably in price. The level of care exercised by consumers in purchasing such goods will vary accordingly. Goods of this kind can be purchased from a variety of outlets. In the case of the opponent this includes the leading supermarket chains as well as major high street retailers such as Boots and Superdrug. The applicant has not said how he intends to trade. In the absence of evidence to the contrary I take the view that perfumes, deodorants and cosmetics/skincare preparations are purchased primarily on the basis of a visual inspection of the goods though there may be some word of mouth recommendations or requests including where such goods are being bought as presents. On the whole visual considerations outweigh oral/aural ones.

16. After referring to *esure Insurance Ltd v Direct Line Insurance plc* [2007] EWHC 1557 (Ch), [2008] RPC 6, the hearing officer expressed his conclusion as to the likelihood of confusion as follows:

68. The marks at the heart of this case, WITCHCRAFT and lined up against it WITCH and WITCH DOCTOR, are well known words of the language. I think it unlikely that, despite the common element, consumers would confuse the applied for mark with either of the opponent's marks or imperfectly recollect them to that extent. I, therefore, rule out direct confusion.

69. I have held that the opponent enjoys a significant reputation particularly in the skincare market. That reputation had its origins in medicated skincare products (and the opponent still enjoys a significant market share and position in that market) but extends into the cosmetic skincare market. It is clear from *Marca Mode* that the mere existence of a reputation does not give grounds for presuming a likelihood of confusion simply because an association is made between the earlier trade mark(s) and the mark applied for. But if the association that is made induces the public to think that products offered for sale under the new mark come from the same or an economically linked trade source then the claim under Section 5(2)(b) will have been made out.

70. I have come to the conclusion that, in the light of the strong conceptual association between WITCH and WITCHCRAFT, coupled with the reputation attaching to the former and the rather greater similarity between the goods than I think the applicant's written submissions

allow, there is a likelihood of confusion. It arises because the relevant public will assume that goods sold under the mark WITCHCRAFT represent an extension in trade of the WITCH brand.

71. That finding in itself is sufficient to determine the opposition. However, the opponent's position is further strengthened if the family of marks claim is brought into the equation (though my decision does not rely on it). It serves to reinforce in consumers' minds that there is already a variation on the WITCH theme in the market place but coming from the same trade source. Consumers would in these circumstances consider that the opponent was using another WITCH suffix mark to indicate an extension of the basic brand into a related area of trade.
17. The hearing officer went on to hold that the section 5(3) objection was also established, but this was explicitly based on his previous conclusion that there was a likelihood of confusion.

Standard of review

18. This appeal is a review of the hearing officer's decision. The applicant's counsel accepted that the hearing officer's decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

A decision does not contain an error of principle merely because it could have been better expressed.

Grounds of appeal

19. The applicant appeals on three grounds. First, the applicant contends that the hearing officer wrongly assessed the opponent's evidence of use of its UK trade marks. Secondly, the applicant contends that the hearing officer was wrong to find that the similarities between the respective goods outweighed

the differences. Thirdly, the applicant contends that the hearing officer was wrong to conclude that the conceptual similarities between the respective marks outweighed the other differences. For these reasons the applicant contends that the hearing officer was wrong to conclude that there was a likelihood of confusion.

Use of the opponent's UK trade marks

20. Counsel for the applicant argued that the hearing officer had made three errors of principle in his assessment of the opponent's evidence of use. First, he failed to distinguish between use which might support the class 5 specifications from use which might support the class 3 specification. Secondly, he failed to give effect to his finding that all the goods were likely to contain witch hazel and should have restricted the specifications accordingly. Thirdly, in finding that the use extended to skincare preparations without limit as to form, he went beyond the specifications of the marks.

Class 3 versus Class 5

21. So far as I can tell, the first argument is not one that was advanced before the hearing officer. The opponent did not object to it being raised on the appeal, however. The starting point for the argument is that the class 5 specifications are for "medicated" preparations whereas the class 3 specification is not. Counsel for the applicant pointed out that it was Mr Fowler's evidence that "the WITCH brand" (which he said "incorporates products under the WITCH and WITCH DOCTOR brands") was the number three leading brand in the "medicated skincare market". Furthermore, Mr Fowler exhibited certain promotional materials produced by the opponent containing references to "Medicated skin care brand Witch" and to its position within the "medicated skincare market". Counsel argued that these statements showed that goods in relation to which the UK trade marks had been used were "medicated" goods rather than "non-medicated" ones.

22. In *SHS International Ltd v Maximuscle Ltd* (O/016/04) at [13] I said in relation to a specification of goods in class 5 which included the word “medicated”:

The dictionary definition of “medicated” is “impregnated with a medicinal substance” and “treated or mixed with drugs or other substances” (*New Shorter Oxford English Dictionary*). In my view the inclusion of the word “medicated” means that the goods are ones that would be subject to regulation by the Medicines and Healthcare Products Regulatory Agency under the Medicines Act 1968, and therefore, even on the assumption that they are sold over-the-counter, they would be sold through the same or at least similar trade channels to pharmaceutical preparations and substances.

With the benefit of hindsight, I am prepared to accept that the statement that medicated goods are ones that would be subject to regulation by the MHRA goes too far. While “medicated” goods within class 5 are likely to be ones that fall within the definition of “medicinal product” in section 130 of the Medicines Act 1968, this is not necessarily so.

23. Even on this basis, I consider that “medicated” goods in class 5 must at least be goods which have, or are claimed to have, some medicinal property. It seems to me that this is reflected in the distinction between the class 5 and the class 3 specifications of the opponent’s CTMs: the class 3 goods are “for cleaning of the skin and astringent purposes” whereas the class 5 goods are “for treatment of irritated skin”.
24. I consider that the evidence of Mr Fowler which the applicant relies on must be treated with some care, because it is not necessarily the case that Mr Fowler and his company were using the word “medicated” in its dictionary sense. In fact, in context it appears that both Mr Fowler and his company were using the expression “medicated skincare” to embrace products for cleaning of the skin and astringent purposes as well as for treatment of irritated skin. In other words, they were using the word “medicated” somewhat loosely.
25. The question remains whether the opponent’s evidence demonstrates use during the relevant period of the mark WITCH DOCTOR in relation to “cosmetics in the form of lotions, creams and gels” in class 3 as opposed to

“medicated preparations for use on the skin and scalp, all in the form of lotions, creams and gels” in class 5. The hearing officer did not address this question because the applicant did not raise it before him.

26. Mr Fowler asserts in paragraph 2 of his statement that WITCH DOCTOR has been used in relation to cosmetics in the form of lotions, creams and gels. In paragraph 4 of his statement, however, he says this:

The WITCH range is intended for everyday use for cleansing and moisturizing the skin and the WITCH DOCTOR range is a more concentrated formula for use as the need arises.

As the hearing officer rightly observed in paragraph 31 of his decision, Mr Fowler’s exhibit DF4 clearly shows use of WITCH DOCTOR in relation to gel and lotion for skin treatment. More specifically, these products are promoted as caring for irritated skin, and in particular the effects of bites, stings, rashes and sunburn. In my judgment this use falls within the opponent’s class 5 specification and not its class 3 specification. I therefore conclude that the opponent has not satisfied the use conditions in relation to UK ‘985.

Containing witch hazel

27. There is no dispute that the opponent’s goods all contain witch hazel. The applicant argues that it follows that the opponent’s class 5 specification should be notionally restricted to goods containing witch hazel, in the same way as its CTM specifications are. The hearing officer considered and rejected this argument. I can see no error of principle in his approach. Moreover, his conclusion is supported by the reasoning and decision of the Court of First Instance in Case T-256/04 *Mundipharma AG v Office for Harmonisation in the Internal Market* [2007] ECR II-449: see the discussion in *Pan World v Tripp* at [52]-[55].

Form of the goods

28. The hearing officer concluded in paragraph 32 that it was “appropriate to consider the opponent’s use as being in respect of skincare preparations” and that he saw “no need to further restrict in terms of form (lotions, creams, gels etc)”. The application argues that he thereby treated the opponent’s use as extending beyond the boundaries of the specifications so as to encompass e.g. powders. I do not accept this argument. In context I think it is clear that what the hearing officer meant was that it was not appropriate notionally to restrict the specifications to some of the forms specified rather than others, and particular to gels as opposed to creams and lotions. I again see no error of principle in this, particularly since, as I have noted above, the opponent’s evidence does demonstrate use of WITCH DOCTOR in relation to a lotion as well as a gel.

A point not argued

29. The hearing officer said that the position regarding WITCH STIK was less clear. He does not appear to have reached any conclusion because, as he said, he did not consider that this registration added materially to the opponent’s case. Neither side has challenged his decision in this regard. I note in passing, however, that my reading of Mr Fowler’s evidence is that there has been no use of WITCH STIK, but there has been use of WITCH STICK in relation to an anti-bacterial spot treatment stick. It could be argued that this constitutes use of UK ‘265 pursuant to section 46(2) of the 1994 Act, but since the point was not argued before me I shall not express any view about this.

Does it make any difference?

30. I have concluded that the hearing officer was in error in finding that the opponent had satisfied the use conditions in relation to UK ‘985. Does this make any difference to the remainder of his decision? In my judgment it does not. As I read his decision, his conclusion was based on the opponent’s CTM ‘800. This was not subject to proof of use. Moreover, even if it had been, it is

clear from the hearing officer's findings with regard to the distinctiveness of this mark that he would have held that the use conditions were satisfied in relation to the class 3 specification. Furthermore, the hearing officer expressly stated at paragraph 71 that his conclusion did not depend on the opponent's family of marks argument.

Similarity of goods

31. Although counsel for the applicant formally maintained that there was no similarity at all between the applicant's goods as now limited on appeal and the opponent's goods, his real argument was that the hearing officer had overstated the degree of similarity. In support of this he argued that the hearing officer had considered each of these various factors at such a high level of generality as to eliminate or conceal the differences between them. I do not propose to go through the individual points which he made in this regard. It suffices to say that I am wholly unpersuaded that the hearing officer made any error of principle in a careful and detailed assessment.

Similarity of marks

32. Counsel for the applicant argued that the hearing officer had acknowledged that there were visual and aural differences between the respective marks and wrongly treated the conceptual similarity between them as outweighing these differences. Again, I can deal shortly with this argument. I see no error of principle at all in the hearing officer's assessment which was one that he was clearly entitled to make.

Conclusion

33. The appeal is dismissed.

Costs

34. The hearing officer ordered the applicant to pay the opponent the sum of £2000 as a contribution to its costs. I shall order the applicant to pay the additional sum of £1000.

6 March 2008

RICHARD ARNOLD QC

Michael Edenborough, instructed by Barlin Associates Ltd, appeared for the applicant (appellant).

Giles Fernando, instructed by Murgitroyd & Co, appeared for the opponent (respondent).