

O-070-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3152976 BY
THE TOOTHFAIRY LIMITED
TO REGISTER:**



AS A TRADE MARK IN CLASS 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406501 BY THE LITTLE TOOTHFAIRY LTD**

BACKGROUND & PLEADINGS

1. On 3 March 2016, The ToothFairy Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for: “Dental services” in class 44. The application was published for opposition purposes on 18 March 2016.

2. The application is opposed by The Little Toothfairy Ltd (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the services (shown below) in the following United Kingdom trade mark registration:

No. 2474592 for the trade mark: **The Little Toothfairy** which was applied for on 10 December 2007, entered in the register on 16 May 2008 and registered in respect of “Dentistry, cosmetic dentistry” in class 44.

3. The applicant filed a counterstatement in which the basis of the opposition is denied. It argues that the competing trade marks “are not in any similar and/or likely to cause any confusion” and that:

“...the services I provide are in a completely different area and in a localised vicinity in Manchester, miles away from Birmingham/Harborne...”

4. In these proceedings both parties have represented themselves. Both filed evidence and at the conclusion of the evidence rounds both indicated that they were content for a decision to be taken from the papers on file. Neither party elected to file written submissions in lieu of attendance at a hearing.

The opponent’s evidence

5. This consists of a witness statement from one of the opponent’s directors, Takir Mian. Mr Mian explains that he has held his position since 2014 adding that the information in his statement comes from either his own personal knowledge or company records.

6. Mr Mian states that “The Little Toothfairy” trade mark was first used by the opponent in the United Kingdom in relation to the services for which it is registered in 2007. Exhibit TM1 consists of a folder which Mr Mian states exemplifies how the opponent’s trade mark has been used and the services offered under the trade mark. This folder has, he explains, been in use since 2007 and is still in use. On both the front and inside of the folder there appears, inter alia, the following:

The Little Toothfairy Ltd

I shall refer to this as the “Ltd” presentation. It also appears on a business card on the inside of the folder (which refers to “Professional Dental Surgeons”). The business card, the inside flap and the back of the folder contain the following:
www.thelittletoothfairy.com; I shall refer to this as the “website” presentation.

7. Exhibit TM2 consists of a brochure which Mr Mian states has also been used since 2007 and which is still in use. The Ltd presentation appears on both the front page and within the brochure; the website presentation appears throughout the brochure. The following also appears in the brochure:

The Little Toothfairy provides

“its guests with a carefully selected choice of simple easy dental treatments by dental surgeons to help improve your confidence and brighten your smile.”

Mr Mian points out that the brochure also contains the following:

“We travel, so you don’t have to. At work...at rest...at play. Its your own surroundings. Its your call.”

And:

“From the freshness of a professional power clean to brightening your smile through whizz of a polish.

From 40 minute makeover whitening...to visual inspections, preventative advice....

The latest technology.”

8. Exhibit TM3 consists of, inter alia, an unsigned exhibition booking form for the Clothes Show Live/eve Style Show/Wellbeing Show which was held at the NEC Birmingham between 7 and 12 December 2007 and upon which the opponent’s name appears; the cost is shown as £4485. Exhibit TM4 consists of a contract for the opponent’s participation in The National Wedding Show, held at the NEC between 12 and 14 October 2007. The “Exhibitor” is listed as “LITTLE TOOTH FAIRY” and “Little Toothfairy Ltd, The”; the cost of attendance was £2368.80.

9. Exhibit TM5 consists of what appears to be undated photographs of the opponent’s attendance at what appears to be the type of events mentioned above. Mr Mian points to the website presentation which appears in all the photographs. Exhibits TM6-TM10 are described by Mr Mian as illustrating “the way in which the mark is used to promote the services...”. Exhibit TM6 is said to have been used since 2007 and is still in use; it bears references to the Ltd and website presentations. Exhibits 7-10 are undated and only bear a reference to the website presentation.

10. Mr Mian states that annual revenue “for the Little Toothfairy Ltd” for 2014 and 2015 was £162,887 and £196,225 respectively with on average £2k per year spent on promotion. He states that “the mark has been used on services in the following parts of the United Kingdom” – Birmingham, London, Greater Manchester and Cornwall.

The applicant’s evidence

11. This consists of a witness statement from Saher Abbas, the applicant’s director, a position he has held since March 2015. He confirms that the information in his statement comes from his company’s records. He states that the trade mark “Tooth Fairy” was first used by the applicant in the United Kingdom in relation to the services for which registration is sought “early in the year 2015.”

12. Exhibit TF1 consists of undated photographs “of the surgery from the inside and out” in which the trade mark applied for can be seen. Exhibit TF2, consists of screen shots from the applicant’s website dated 25 September 2016 (i.e. after the date of the application for registration) in which the trade mark applied for appears and which describes the services provided as, inter alia, “General and cosmetic dental services.” Exhibit TF3 shows the trade mark applied for being used on Instagram, Twitter and YouTube. There is also an extract from Facebook, but this does not appear to show the trade mark applied for; a number of these entries appear to be from after the date of the application for registration. Mr Abbas states:

“4(3) These social media platforms have been established to build the brand and all of them have an extensive number of followers who recognise the mark as providing services in the Manchester area...”

13. Exhibits TF4 to TF6 consist of undated photographs of the trade mark applied for appearing on: (i) staff uniforms (which Mr Abbas states have been used since the applicant was formed), (ii) business cards (which Mr Abbas states have been handed out at several events in the Manchester area), (iii) a gift voucher (which Mr Abbas states

has been given as a prize at events and through the facebook page) and (iv) what Mr Abbas describes as a “pull up banner” which he further explains has been placed in “several places for advertising purposes”

14. Mr Abbas states that annual revenue “for TheToothFairy Limited” was £73,120 in 2015 and £86,198 in 2016 with the trade mark being used on services provided in Manchester and Greater Manchester.

15. That concludes my summary of the evidence filed to the extent I consider it necessary.

DECISION

16. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because -

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

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

17. An earlier trade mark is defined in section 6 of the Act, which states:

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

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

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

18. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which qualifies as an earlier trade mark under the above provisions. As this trade mark had been registered for more than five years at the date when the application was published, it is subject to proof of use, as per section 6A of the Act. In its Notice of opposition, the opponent indicated that its earlier trade mark had been used upon all the services upon which it relies, and in its counterstatement, the applicant asked the opponent to make good this claim. The relevant sections of the Act read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

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

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Section 100 of the Act is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Proof of use

19. In reaching a conclusion, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of the publication of the application for registration i.e. 19 March 2011 to 18 March 2016. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He stated:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

20. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that

person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

21. In its submissions accompanying its evidence, the applicant made a number of criticisms of the opponent's evidence. It stated that:

- the website identified in the opponent's evidence "does not work";
- there is no proof that the opponent has been using its earlier trade mark since 2007;
- there is no proof that the opponent has used its trade mark in Greater Manchester.

22. It further states:

"I also want to emphasise that the nature of dental services is to be provided in a localised region or area, and does not tend to cross over cities. Even though [the

opponent] has mentioned a national event, this was in 2007 and is only a booking form, not confirmation. There is also no recent evidence of any exhibitions, or even annual revenue information between 2007-2014.”

23. In an official letter of 5 October 2016, the opponent was given an opportunity to indicate if it wished to file evidence-in-reply; the opponent did not respond to that letter.

24. In his statement (which is accompanied by a statement of truth), Mr Mian states that the opponent’s trade mark was first used in 2007. Exhibits TM3 and TM4 consist of a booking form and a contract relating to exhibitions held at the NEC in Birmingham in October and December 2007, both of which Mr Mian states were national events. Although exhibit TM3 is unsigned, in his statement Mr Mian states that “the trademark was used...” [at the exhibition mentioned]. Exhibit TM4 is accompanied by an e-mail dated 12 July 2007 from Sarah Tanner (an employee of the event organiser) to o.mian@btinternet.com in which she states:

“It was lovely to speak with you today! I am really excited about having The Little Tooth Fairy exhibiting at the show. As discussed, I have attached the stand contract for your reference. As you have made full payment over the phone the stand is confirmed for you...”

25. Although both events took place before the relevant period began, at the very least these exhibits appear to support the first use date claimed. In his statement, Mr Mian states that exhibits TM1 (the folder), TM2 (the brochure) and TM6 (the leaflet) have been in use since 2007, adding that they were still in use at the date of his statement i.e. August 2016; these exhibits indicate that the opponent conducts a business in relation to dentistry with, it appears, a focus on cosmetic dentistry. The exhibits mentioned show the words “The Little Toothfairy” in use in a range of formats i.e. the Ltd and website presentations and also in the format shown in paragraph 7 above (the latter of which clearly constitutes use of the trade mark in the form in which it registered). That is, however, the only use of the trade mark in that format. While that

alone may be considered sufficient, as section 6A(4)(a) of the Act indicates that: “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”, I will, for the sake of completeness, go on and consider whether the Ltd and website presentations constitute use of the trade mark as registered.

26. In approaching this issue, I bear in mind the guidance provided by Mr Richard Arnold Q.C. (as he then was) as the Appointed Person in *Nirvana Trade Mark*, BL O/262/06 in when he summarised the test under the equivalent provisions of section 46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

27. With the exception of the one example of use mentioned above, all of the use is of the Ltd and website presentations; that is the answer to the first question. Insofar as the first part of the second question is concerned, the distinctive character of the registered trade mark lies in its totality. As to the second part of the second question, the trade marks used differ to the extent that they include either the letters “Ltd” or “www” and “.com.” Finally, the answer to the third part of the second question. Although the additional elements mentioned point to either a limited company or website address,

these are conventional forms in which trade marks are routinely presented and will be very familiar to the average consumer. In my view, these elements do nothing to alter the distinctive character of the trade mark as registered which, as I mentioned above, lies in the words "The Little Toothfairy". As a consequence, these variant uses count as use of the trade mark as registered and are uses upon which the opponent is entitled to rely.

28. As to the quantum of use, the opponent has only provided annual revenue for the years 2014 and 2015 (both of which fall within the relevant period). This amounts to some £358k with the opponent stating that it spends on average £2k per year promoting the trade mark. In addition, the opponent indicates that its trade mark has been used on services provided in Birmingham, London, Greater Manchester and Cornwall. As the applicant points out, however, in relation to the latter no evidence has been provided. However, there is nothing inherently improbable about this claim, particularly as the opponent's evidence indicates that it provides its services at locations of its client's choosing. However, even if as the applicant appears to suggest the opponent had only provided its services in the Birmingham area, given the size of that city in the context of the United Kingdom as a whole (I take judicial notice of the fact that Birmingham is the United Kingdom's second largest city after London) that alone would be sufficient to constitute use of the trade mark in the United Kingdom.

Conclusion on proof of use

29. In reaching a conclusion on genuine use, it is necessary for one to view the evidence as a whole. Having done so, I am satisfied that within the relevant period the opponent has made genuine use of its earlier trade mark (either in the form in which it is registered or in a form which does not alter its distinctive character) and that such use has been in relation to the services for which its stands registered.

Section 5(2)(b) – case law

30. The following principles 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.

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

31. The applicant seeks registration for “Dental services”; the opponent has made genuine use of its earlier trade mark in relation to “Dentistry, cosmetic dentistry”; the competing services are identical.

The average consumer and the nature of the purchasing act

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

33. The average consumer of dental services is a member of the general public. As the evidence shows, the services are likely to be selected having reviewed publicity material (in hard copy and on-line) and on signage on the high street; all of which points to visual considerations playing an important part in the selection process. However, as dental services are also likely to be the subject of word-of-mouth recommendation, aural considerations must also be kept in mind. As the services at issue involve, inter alia, invasive procedures (of one degree or another) on the average consumer's person combined with what may well be a not insignificant cost, suggests a fairly high degree of attention during the selection process.

Comparison of trade marks

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

35. It would be wrong, therefore, artificially to 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 they create. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
The Little Toothfairy	

36. The opponent’s trade mark consists of the words shown above presented in title case. These words form a “unit”, the meaning of which is different to the individual words of which the trade mark is composed. That is the overall impression the trade mark will convey and where its distinctiveness lies.

37. The applicant's trade mark consists of a number of components. The first, is a turquoise coloured square; although it will contribute to the overall impression the trade mark conveys, its distinctiveness is limited, serving as it does as a background upon which the contrasting elements are placed. The second component is the device of a tooth presented in white in which appears a silhouette of a fairy presented in the same colour as the background. Although the device of a tooth will make a contribution to the overall impression the trade mark conveys, given the services for which registration is sought, it will be a non-distinctive contribution. As to the silhouette of a fairy which appears within the device of a tooth, I think it is entirely possible that it will go unnoticed (it certainly was by me). However, if it is noticed and although it is distinctive, given its relative size its contribution to the overall impression conveyed by the trade mark will be limited. The third component consist of the words "THE TOOTH FAIRY" presented in white in block capital letters and in which the words "TOOTH FAIRY" are presented in a much larger and heavier font than the word "THE" which appears above them. Like the words in the opponent's trade mark the words "THE TOOTH FAIRY" form a unit. Given the size and positioning of this unit in the context of the trade mark as a whole, it will make the dominant and distinctive contribution to the overall impression conveyed by the trade mark. The final component consists of two white lines which radiate to the left and right of the word "THE". They are likely to go largely unnoticed and will play little or no role in the overall impression conveyed.

38. Both parties' trade marks contain the words "The"/"THE" and "Toothfairy"/"TOOTH FAIRY". Although the opponent's trade mark also contains the word "Little" and the applicant's trade mark the additional components described above, given the lack of distinctiveness and limited relative weight of a number of these components in the overall impression the applicant's trade marks conveys, the shared presence of the words mentioned in both trade marks leads, in my view, to at least a medium degree of visual similarity between them.

39. It is well settled that when trade marks consist of a combination of words and devices, it is by the words that the trade marks are most likely to be referred.

Considered on that basis, the opponent's trade mark will be referred to as "The Little Toothfairy" and the applicant's trade mark as "THE TOOTH FAIRY". It is fairly obvious that the competing trade marks are aurally similar to a high degree.

40. Finally, the conceptual comparison. The concept of the tooth fairy i.e. a fantasy figure who replaces a lost baby tooth placed under a child's pillow with money, will be very well-known to the average consumer in this country. Although the opponent's trade mark characterises the "Toothfairy" as "Little, this, in my view, does nothing to change the concept conveyed. The overall concept conveyed by both trade marks (reinforced by the presence of the silhouette of a fairy in the applicant's trade mark) is identical; if not conceptually identical, the competing trade marks are conceptually similar to the highest degree.

Distinctive character of the earlier trade mark

41. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. Although the opponent has filed evidence sufficient to constitute genuine use of its earlier trade mark, it falls a long way short of establishing that it benefits from an enhanced distinctive character. Considered from an inherent perspective, it is, in my view, a trade mark possessed of a normal degree of distinctive character.

Likelihood of confusion

42. 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:

- within the relevant period the opponent has made genuine use of its earlier trade mark in relation to the services for which it is registered;
- the competing services are identical;
- the average consumer is a member of the general public who will select the services at issue by predominantly visual means paying a fairly high degree of attention during that process;
- the competing trade marks are visually similar to at least a medium degree, aurally similar to a high degree and conceptually identical;
- the opponent's earlier trade mark is possessed of a normal degree of inherent distinctive character which has not been enhanced by the use made of it.

43. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists

between the trade marks/services down to the responsible undertakings being the same or related. Indirect confusion was described in the following terms by Mr Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

I note that the categories identified by Mr Purvis are not exhaustive (see *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at [29]).

44. I remind myself that identical services are involved. Despite the various differences between the competing trade marks I have identified above, given the relative weights of these differences in the context of the trade marks as a whole and notwithstanding the fairly high degree of attention that will be paid by the average consumer during the selection process, I do not rule out the possibility of direct confusion (particularly from an aural perspective). However, even if I am wrong in that respect, the degree of visual, aural and conceptual similarity between the competing trade marks will, in my view, combine to lead the average consumer to assume the applicant’s trade mark is, for example, a variant or updated version of the opponent’s trade mark i.e. they will assume that services provided under the applicant’s trade mark are in some way connected to the opponent i.e. there will be indirect confusion.

Conclusion

45. As a consequence of the above conclusion the opposition succeeds and, subject to any successful appeal, the application will be refused.

The applicant’s evidence

46. In reaching the above conclusion I have not overlooked the applicant’s evidence. In some circumstances evidence of this type may establish that notwithstanding what may initially appear to be a likelihood of confusion, the competing trade marks have been used in the same market place for a sufficient length of time for the average consumer to have been exposed to both and to distinguish between them. In these proceedings

that is likely to be particularly difficult to prove given the identity in the services and the high degree of overall similarity in the competing trade marks. In addition, the applicant's trade mark had (at best) only been used for approximately fourteen months prior to the filing of the application. In short, the evidence filed by the applicant does not assist it in these proceedings.

Costs

47. As the opponent has been successful it is, in principle, entitled to a contribution towards its costs. As both parties are unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate if they intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of activities relating to the prosecution of the opposition; it was made clear to the parties that if the pro-forma was not completed "no costs will be awarded"; neither party responded to that invitation. While the opponent has not sought costs in relation to the prosecution of the opposition, it is, of course, entitled to recover the official fee for filing the opposition i.e. £100.

48. I order The Toothfairy Limited to pay to The Little Toothfairy Ltd the sum of **£100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of February 2017



C J BOWEN
For the Registrar
The Comptroller-General