BL O/0724/23

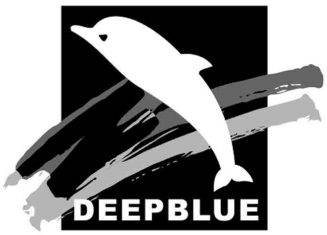
TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3747606

BY

ANHUI DEEP BLUE MEDICAL TECHNOLOGY CO., LTD.

TO REGISTER THE FOLLOWING TRADE MARK:



AND

OPPOSITION NO. 434284 THERETO

BY

DŌTERRA HOLDINGS, LLC

Background and pleadings

1. On 26 January 2022, Anhui Deep Blue Medical Technology Co., Ltd. (the "Applicant") applied to register the figurative trade mark as shown on the cover of this decision, for the following goods:

Class 5 *Chemical reagents for medical or veterinary purposes; drugs for medical purposes; diagnostic preparations for medical purposes; reagent paper for medical purposes; disinfectants for hygiene purposes; dietetic substances adapted for medical use; medicines for veterinary purposes; diagnostic preparations for veterinary purposes; dressings, medical; sanitizing wipes.*

2. The contested application was accepted and published for opposition purposes in the Trade Marks Journal on 22 April 2022.

3. On 16 June 2022, dōTERRA Holdings, LLC ("Opponent") opposed the entirety of application under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). For the purposes of this opposition, the Opponent relied upon the following three earlier United Kingdom Trade Marks (UKTMs), with the respective listed goods being those which the Opponent has chosen to rely upon for each mark:

1) UKTM 912470647 (earlier mark "-647")

Deep Blue Rub

Filing date: 30 December 2013

Registration date: 23 May 2014

Class 3: *Essential oils; scented oils; cosmetic oils; aromatics (essential oils); oil for the body.*

Class 5: *Analgesic preparation.*

2) UKTM 912470712 (earlier mark "-712")

Deep Blue

Filing date: 30 December 2013

Registration date: 23 May 2014

Class 3: *Essential oils; scented oils; cosmetic oils; aromatics (essential oils); oil for the body.*

Class 5: *Analgesic preparation.*

3) UKTM 916447161 (earlier mark "-161").

Deep Blue Polyphenol Complex

Filing date: 9 March 2017

Registration date: 22 June 2017

Class 5: *Dietary supplements; Food supplements; Nutritional supplements; Vitamin and mineral supplements*.

4. Since the filing dates of all three of the earlier marks predate that of the contested application, the Opponent's marks are considered to be "earlier marks" in accordance with Section 6 of the Act. However, as the earlier mark -161 has not been registered for a period of five years or more before the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon any or all of the goods for which the earlier mark -161 is registered without having to show that it has used the mark at all.

5. The Opponent argued that the "logo" in the contested mark is verbally silent, and therefore the marks are phonetically similar due to the sharing of the distinctive words DEEP BLUE. The Opponent also argued that the marks are both visually and conceptually similar due to each mark "indicating a colour or shade or a connection with the sea". In relation to the additional elements of the earlier marks -647 and -161 (i.e., 'Rub' and 'Polyphenol Complex'), the Opponent argued that they are descriptive

and therefore not the distinctive parts of the earlier marks. In relation to the goods at issue, the Opponent submitted that they are identical and similar.

6. On 6 September 2022, the Applicant filed a counterstatement in which it denied the claims made by the Opponent, and put it to proof of use for the earlier marks -647 and -712. The Applicant argued that the contested mark is complex, consisting of "a large number of figurative elements" of which a white dolphin is "particularly noticeable". The Applicant also provided submissions in relation to the goods at issue, which will not be summarised here, save to say that it denied they were identical or similar. The submission in relation to the specifications may be relied upon in further detail if they are found to assist in my own comparison under the heading **Comparison of goods**.

7. Only the Opponent filed written submissions which will not be summarised here, rather they will be referred to as and where appropriate during this decision.

8. No hearing was requested and so this decision is taken following a careful perusal of the papers.

9. Both parties are professionally represented. The Applicant is represented by Jinxu Jia and the Opponent is represented by MW Trade Marks Limited.

Procedural economy

10. For the purposes of this opposition, the Opponent has chosen to rely upon all of the goods of the earlier mark -161, and only some of the goods of the earlier marks -647 and -712 (the list relied upon is identical for each earlier mark). For the purposes of overall comparison it is therefore necessary to consider the earlier mark -161, and at least one out of the earlier marks -647 and -712. It appears to me that of -647 and -712, it is the earlier mark -712 which offers the Opponent a greater chance of success under Section 5(2)(b). This is on the basis that whilst both -647 and -712 are registered for identical goods, the earlier mark -647 has more additional elements which have no counterpart in the contested mark. If the earlier mark -712 is found to be dissimilar to the contested mark then the Opponent will be in no better position under Section 5(2)(b) if it were to rely on a mark which has more additional elements, i.e., earlier mark -647. The opposition shall therefore continue on the basis of comparing the contested mark with the earlier marks -161 and -712.

Proof of use

11. The relevant statutory provisions are as follows:

Section 6A:

"(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed][…]

(6) Where an earlier trade mark satisfies the use conditions in respect of only some 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."

12. Further, Section 100 of the Act states that:

"100. 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.

13. Considering the above statutory provisions, it is incumbent on the Opponent to establish proof of use for the relied upon Class 3 and 5 goods of its earlier mark -712 in the 5-year period ending on the date of application of the contested mark, i.e., between 27 January 2017 and 26 January 2022.

14. The Opponent is not required to file proof of use in relation to the earlier mark -161 as it has not been registered for a period of five years or more before the filing date of the application

Evidence

15. On 14 November 2022, the Opponent filed the witness statement of Mr David Doxey, General Counsel of dōTERRA Holdings, LLC. The witness statement was accompanied by Appendixes 1 – 7.

16. Mr Doxey stated that the earlier mark “Deep Blue” (i.e., -712) has been used in the UK for the goods relied upon since at least 2017. An example of a product sold under the mark -712 was exhibited in Appendix 1:

Deep Blue® *Soothing Blend*

Item: 60204652
Size: 5 ml
PV: 37.00

VAT Included Pricing
Retail: £43.33
Wholesale: £32.50

VAT Excluded Pricing
Retail: £36.11
Wholesale: £27.08

17. Further examples of products sold under -712 were included in Appendixes 5 and 6, whereby “kits” that contained “Deep Blue essential oil” were sold on oilsbyjo.co.uk and doterra.com. Whilst the Appendixes 5 and 6 were not themselves dated, it is clear that they correlate to the period of 2018 based on the specific product description.

18. The witness statement included the following table of total annual turnover for all “Deep Blue goods” sold in the UK:

Year	Deep Blue Sales	Quantity of Deep Blue products sold	Number of customers of Deep Blue products
2022 year to date	£453,989	24,628	12,382
2021	£1,067,489	35,729	18,802
2020	£850,224	35,780	22,428
2019	£728,119	40,332	18,265
2018	£842,901	30,717	15,924
2017	£379,478	19,300	9,022
Total	**£4,322,200**	**186,486**	**96,823**

19. The table was supported by the invoices evidenced in Appendixes 4a – 4f, which showed sales of products sold under -712 in several UK towns and cities, including Colchester, Oxford, Newark, and London [1]. The majority of invoices fell within the specific 5-year period identified in paragraph 13.

20. The Opponent also filed the witness statement of Ms Anne Wong, Chartered Trade Mark Attorney of the Opponent’s chosen representative MW Trade Marks Limited. The witness statement was accompanied by exhibits AW1 – AW4. I understand the

[1] The invoices also referred to products sold under the earlier marks -647 and -161 which shall not be considered, as earlier mark -647 is not being considered and earlier mark -161 is not subject to proof of use.

purpose of Ms Wong's witness statement and exhibits is to support the submissions filed in relation to the argued identity and/or similarity of the goods at issue.

Decision

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

22. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

> "114…The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.
>
> 115. The principles established by these cases may be summarised as follows:
>
> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

Form of use

23. The evidence provided by the Opponent to demonstrate use of the earlier mark -712 includes an image of a bottle and invoices. On the bottle, the mark appears on a blue background/label. In the invoices, the mark appears in conjunction with terms such as 'EU' or 'US', and the liquid content in millimetres. In *Nirvana Trade Mark,* BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person

summarised the test of use in a form differing from the mark as registered with two questions: 1) what sign is presented as the trade mark? 2) does the mark in use differ from the mark as registered in elements that alter the distinctive character of the registered mark? It is clear to me that the earlier mark -712 “Deep Blue” appears in the evidence, and that the additional elements of a background/label colour, and ‘EU’, ‘US’ or ‘ml’ are mere descriptors that do not alter the distinctive character of the earlier mark. I therefore find the evidence provided to include examples which can be considered for assessing whether genuine use has been proven.

Genuine use

24. The relevant period for proving genuine use in accordance with Section 6A, 1A is 27 January 2017 and 26 January 2022. The majority of evidence submitted falls within this period.

25. It is clearly established that the burden of furnishing the Registrar with sufficient proof of use lies with the proprietor of the earlier mark. [2] It is also clearly established that the assessment of genuine use is multifactorial and must be restricted to analysing the evidence presented before me. It is therefore incumbent on the Opponent to provide evidence that will satisfy the decision taker with regard to whatever it is that falls to be determined on the balance of probabilities.[3] Having analysed the submitted evidence, I find that the examples provided constitute ‘actual use’[4] of the earlier mark in the form as registered.

26. One of the factors to be proven is that the use of the earlier mark is more than merely token,[5] i.e., more than serving solely to preserve rights. Whilst the evidence is not particularly voluminous and is restricted to a selection of invoices and a few images that pertain to the relevant mark, I nevertheless do not consider it to represent sporadic or totemistic use with the aim of merely maintaining a (false) position in the market. Instead, it is my opinion that the small amount of evidence provided should be recognised for what it is – the apparent extent of use of the earlier mark, which is sufficient for demonstrating that the use has been in accordance with the commercial

[2] *Plymouth* BL O/236/13
[3] *CATWALK* Trade Mark, BL O/404/13
[4] *Ansul* paragraph 35.
[5] *Ibid* paragraph 36.

raison d'être of the mark, i.e., to create or preserve an outlet for the goods that bear the mark.[6] I also do not discount the fact that whilst the amount of evidence provided is limited, the Opponent gave a general account of their activity which implied greater use in the period 2017-2022, including referring to sales of 186,486 units to 96,823 customers, equating to sales of £4,322,200.[7]

Fair specification

27. I must now consider whether, or the extent to which, the submitted evidence shows use of the earlier mark -712 in relation to the Class 3 and 5 goods relied upon. I bear in mind that any use must relate to goods which are already marketed or are about to be marketed, and for which preparations to secure customers are under way.[8]

28. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

29. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair

[6] *Reber* paragraph 29.
[7] *Daily Ritual* BL O/005/21
[8] *Ansul* paragraph 37

specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in Pa*n World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been ddused and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

30. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may

contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

31. The invoices in Appendixes 4a – 4f refer simply to the sale of 'Deep Blue', with no additional information given as to what type of good is sold under the name. My discovery as to the type of good sold under the earlier mark -712 is therefore limited to an analysis of Appendixes 1, 5 and 6.[9] Appendix 1 says of 'Deep Blue Soothing Blend' that it "brings together eight essential oils known to comfort and cool joints and muscles", whilst Appendix 6 refers to 'Deep Blue' as an "Essential Oil Blend". Although Appendix 5 refers to 'Deep Blue' products in its "kits", it does not offer specific information as to what type of products are contained therein, other than to indicate that they are part of a "Home Essentials Enrollment Kit". Further, the size of the image in Appendix 5 prevents a clear rendering. Based on the limited evidence before me, it seems to me that 'Deep Blue' has been genuinely used only in relation to a type of essential oil product that is used for muscle and joint relief.

32. Whilst it is my finding that genuine use of the earlier mark -712 is limited to the particular product of *essential oils*, I do not intend to restrict the Opponent's specification to this narrowest possible term.[10] Rather, I consider it to accord with the perception of the average consumer that use in relation to *essential oils* could realistically also extend to use in relation to the more general category of therapeutic and cosmetic oils.[11] As such, I consider a fair specification to be the protection for all of the therapeutic and cosmetic oils in Class 3 of the earlier mark -712, i.e., *Essential oils; scented oils; cosmetic oils; aromatics (essential oils); oil for the body.*

33. Although I consider it fair to acknowledge protection for the more general categories of therapeutic and cosmetic oils based on the exclusive use in relation to *essential oils*, I do not consider it to be fair to extend the protection to the goods in Class 5 of the earlier mark also. No evidence has been provided that demonstrates use of the earlier mark -712 in relation to *analgesic preparations*. I note the Opponent's submissions that analgesics are used in diagnostic preparations and are medicinal

[9] Appendix 2 relates to -647 'Deep Blue Rub', which is the earlier mark not being considered. Appendix 3 relates to -161 'Deep Blue Polyphenol Complex', which is the earlier mark not subject to proof of use.
[10] *Property Renaissance Ltd*
[11] *Euro Gida*

(AW2). It seems to me that such goods are of a different nature and intended purpose to the therapeutic and cosmetic oils in Class 3 of the earlier mark -712, and that further they would have different trade channels and end users. In my opinion, extending the genuine use of *essential oils* to *analgesics* would be allowing the Opponent to monopolise its use of the earlier mark -712 in relation to goods that the average consumer would not perceive to be related.[12]

34. Based on an assessment of the evidence before me, I find that the Opponent can rely on the following fair specification for the earlier mark -712:

Class 3 *Essential oils; scented oils; cosmetic oils; aromatics (essential oils); oil for the body.*

35. The Opponent can also rely on the entire specification of the earlier mark -161, as this earlier mark was not subject to proof of use, i.e.:

Class 5: *Dietary supplements; Food supplements; Nutritional supplements; Vitamin and mineral supplements*.

Section 5(2)(b)

36. Section 5(2)(b) of the Act is as follows:

> "(2) A trade mark shall not be registered if because-
>
> (a) …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

37. 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

[12] *Property Renaissance Ltd*

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods

Earlier mark -712	Earlier mark -161	Application
Class 3: *Essential oils; scented oils; cosmetic oils; aromatics (essential oils); oil for the body.*		
	Class 5: *Dietary supplements; Food supplements; Nutritional supplements; Vitamin and mineral supplements.*	Class 5: *Chemical reagents for medical or veterinary purposes; drugs for medical purposes; diagnostic preparations for medical purposes; reagent paper for medical purposes; disinfectants for hygiene purposes; dietetic substances adapted for medical use; medicines for*

		veterinary purposes; diagnostic preparations for veterinary purposes; dressings, medical; sanitizing wipes.

38. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

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

> (a) The respective uses of the respective goods or services;
>
> (b) The respective users of the respective goods or services;
>
> (c) The physical nature of the goods or acts of service;
>
> (d) The respective trade channels through which the goods or services reach the market;
>
> (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
>
> (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

40. It has also been established by the GC in *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

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

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

42. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e., chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

> "...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

Earlier mark -712

43. In its submissions, the Opponent made several comparisons between the contested goods and the *analgesic preparations* in Class 5 of the earlier mark, arguing that they are either identical or at least similar. Further to my analysis of the submitted evidence of use, I have found that genuine use of *analgesic preparations* in Class 5 has not been demonstrated. With this in mind, I shall only consider the submissions of the Opponent that compare the contested goods with the fair specification in Class 3 of the earlier mark -712, i.e., *Essential oils; scented oils; cosmetic oils; aromatics (essential oils); oil for the body.*

44. The Opponent described the goods in Class 3 of the earlier mark as being used to "soothe, relieve, warm and cool joints and muscles and act as an analgesic or have an analgesic effect". The Opponent then provided specific reasoning as to how such analgesic goods are similar to the contested goods, which the Opponent also described as being analgesic, e.g., *diagnostic preparations for medical purposes*, and *disinfectants for hygiene purposes*.[13] I do not agree that the goods in Class 3 of the earlier mark are analgesic. According to the Nice Classification System, goods in Class 3 tend to be non-medicinal, cosmetic or cleaning products.[14] Whilst I have summarised the goods in Class 3 of the earlier mark -712 as including therapeutic oils, this does not equate to them having medicinal or analgesic effects. In fact, goods which provide pain relief (i.e., analgesic) are exclusively those which are captured by Class 5 of the Nice Classification System,[15] for which proof of use has not been found.

[13] The Opponent did not compare the Class 3 goods of the earlier mark -712 with the contested *dietetic substances adapted for medical use*.
[14] Nice Classification (wipo.int)
[15] Nice Classification (wipo.int)

I do not discount the possibility that consumers may use therapeutic oils to relief stress or anxiety, but in my opinion the alleviation of a psychological feeling is not similar to the alleviation of physical pain. The difference between the contested goods and the *cosmetic oils* of the earlier mark is even greater, as cosmetics do not offer any apparent pain relief. In my opinion, the therapeutic or cosmetic oils in Class 3 of the earlier mark would likely have a different intended purpose, nature, end user and trade channel to all of the contested goods which the Opponent identified as being designed to have analgesic preparations.

45. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

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

46. Considering that I have found the goods in Class 3 of the earlier mark -712 to be dissimilar, and the goods in Class 5 of the earlier mark -712 to not be genuinely used, there can subsequently be no likelihood of confusion between contested mark and the earlier mark -712.

Earlier mark -161

47. The Opponent submitted that the contested *dietetic substances adapted for medical use* are identical to the *dietary supplements; food supplements; nutritional supplements;* and *Vitamin and mineral supplements* of the earlier mark -161. Considering the principle of *Meric*, I agree with the submission, especially insofar as the respective dietetic and dietary supplements are concerned. Although the Opponent made no further submissions in relation to the *dietary supplements; food supplements; nutritional supplements;* and *Vitamin and mineral supplements* of the earlier mark -161, I nevertheless consider them to be highly similar to the contested

drugs for medical purposes and *medicines for veterinary purposes*. Dietary (and food) and nutritional (and vitamin) supplements, whether medicated or not, may be used together with pharmaceutical preparations (i.e., drugs and medicines) in the treatment or prevention of illnesses. They therefore frequently serve the same purpose, namely the restoration or preservation of health, target the same relevant public, and are equally sold via pharmacies or chemist's shops.

48. I note that the Opponent did not make any further submissions as to the similarity, or lack thereof, between the supplements in Class 5 of the earlier mark -161 and the remaining contested goods. Having conducted my own analysis, and having not been provided reason to find otherwise, I consider it self-evident that the contested reagents, diagnostics, disinfectants and sanitizers are of a different nature and intended purpose to the supplements of the earlier mark. Further, the respective goods would likely have a different end user and trade channel, and would neither be in competition nor be complementary.

49. Following a comparison of the goods at issue, I have found the contested *Chemical reagents for medical or veterinary purposes; diagnostic preparations for medical purposes; reagent paper for medical purposes; disinfectants for hygiene purposes; diagnostic preparations for veterinary purposes; dressings, medical;* and *sanitizing wipes* to be dissimilar to the goods of the earlier mark -161. As identified in *eSure Insurance,* there can be no likelihood of confusion between goods which are dissimilar. Consequently, I will continue with the assessment only in relation to the following contested goods, which have been found to be either identical or highly similar, i.e.:

> *drugs for medical purposes; dietetic substances adapted for medical use;* and *medicines for veterinary purposes*.

Comparison of marks

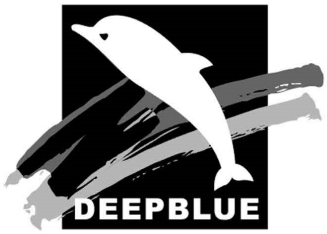
50. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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

Court of Justice of the European Union 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."

51. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

52. The respective trade marks are shown below:

Earlier mark -161	Contested mark
Deep Blue Polyphenol Complex	

53. The earlier mark consists exclusively of the English-language words 'Deep Blue Polyphenol Complex', presented in a plain, non-stylised font. The first word 'Deep' is an adjective that has several meanings, including referring to a large distance between surface and ground (e.g., the depth of something); or referring to seriousness or importance (e.g., level of admiration); or referring to a level of concentration (e.g., deep in conversation); or referring to the strength and darkness of a colour (e.g., deep blue).

The second word ‘Blue’ is a noun, referring to a colour. Based on the grammatical structure of the combination whereby an adjective is followed by noun, I consider the first two words ‘Deep Blue’ to most likely be perceived as hanging together to create the concept of a dark colour blue. Although neither the Opponent nor Applicant has given a precise definition for the word ‘Polyphenol’, each party has nevertheless stated that the combination ‘Polyphenol Complex’ “refer(s) to chemical compounds”. Considering the nature of the goods at issue, I find it likely that the consumer will perceive ‘Polyphenol Complex’ to be directly descriptive of a certain characteristic of the goods, namely an ingredient or essential compound contained therein.

54. I do not consider it to be either likely or logical for the consumer to perceive the first combination ‘Deep Blue’ as describing the colour of the second combination ‘Polyphenol Complex’, given the nature of its concept as an ingredient. I also do not consider it likely that the consumer would perceive ‘Deep Blue’ as describing a characteristic of the goods at issue, especially in light of the fact that neither party has submitted it is normal practice to describe the colour of the goods. Instead, I believe the consumer would perceive the combination ‘Deep Blue’ as being abstract, in which case it is the more dominant and distinctive element in the earlier mark.

55. The contested mark is a combination mark, containing the figurative element of a white dolphin imposed on top of a graphic element which has the appearance of brush strokes, along with the term ‘DEEPBLUE’ beneath it. All three elements are imposed on top of a black square background. Whilst the graphic element and black background are certainly noticeable and undoubtedly contribute to the overall impression of the contested mark, I consider these elements to be less dominant than the larger white dolphin and ‘DEEPBLUE’ elements. The term ‘DEEPBLUE’ has no apparent meaning in the English language, and neither party has offered a definition for the term as a whole. Whilst the term ‘DEEPBLUE’ is not separated into two words by the use of a space, for example, it nevertheless seems to me most likely that ‘DEEPBLUE’ will be perceived and pronounced as the combination of English-language words ‘Deep’ and ‘Blue’, the definitions of which have been identified above. I consider it unlikely that the consumer would perceive the term ‘DEEPBLUE’ as describing a characteristic of the goods at issue, and would instead perceive it in the abstract as a term that is distinctive to a medium degree. The figurative element of a

white dolphin has no apparent relationship to the goods at issue either, and is therefore considered to be distinctive to a medium degree also. As such, the term ‘DEEPBLUE’ and figurative element of a white dolphin are co-dominant and equally distinctive.

Visual similarity

56. The marks are visually similar insofar as they share the eight letters D-E-E-P-B-L-U-E-‘. These letters represent the only word element contained in the contested mark, which is contained wholly within the earlier mark. The marks differ visually due to the inclusion in the contested mark of the white dolphin figurative element, graphic brush strokes and black square background, none of which have a counterpart in the earlier mark. In addition, the earlier mark contains the words ‘Polyphenol Complex’, which have no counterpart in the contested mark.

57. Overall, the marks are considered to be visually similar to a medium degree.

Aural similarity

58. The marks are aurally similar insofar as they share the sound created by the two words consisting of two syllables ‘Deep Blue/DEEPBLUE’. This sound constitutes the entire aural aspect of the contested mark and the first two audible elements of the earlier mark. The marks differ aurally due to the inclusion of the two words ‘Polyphenol Complex’ in the earlier mark, which consist of the six syllables POL-Y-FEN-OL-COMP-LEKS. This aural element has no counterpart in the contested mark.

59. Overall, the marks are considered to be aurally similar to a medium degree.

Conceptual similarity

60. Despite the word element of the contested mark containing the single term ‘DEEPBLUE’, I am of the opinion that it will most likely be perceived by the consumer as consisting of the two conjoined words ‘Deep’ and ‘Blue’. The combination ‘Deep Blue/DEEPBLUE’ hangs together to create the concept of a dark, rich colour. Such a concept is contained in each mark.

61. The marks differ conceptually to the extent that the contested mark contains the additional concept of a white dolphin. The marks further differ conceptually due to the

inclusion of the words ‘Polyphenol Complex’ in the earlier mark, which have no counterpart in the contested mark.

62. Overall, the marks are considered to be conceptually similar to between a low and medium degree.

Average consumer and the purchasing act

63. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

64. 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.”

65. The goods at issue include everyday goods, i.e., goods that are purchased and used on a daily basis by the average consumer (e.g., *vitamin supplements*). The level of attention of such goods may be slightly heightened in comparison to other everyday goods, such as bread or milk for example, as they are potentially being purchased for general health reasons. That having been said, the level of attention will not be especially high as such goods are not prescribed and can be purchased in most stores. The goods at issue also include specialist goods that have been prescribed by a medical or pharmaceutical professional (e.g., *drugs for medical purposes*), as well as goods that have been purchased for a specific dietary or nutritional need (e.g., *dietary supplements*). In *Olimp Laboratories sp. z o.o. v EUIPO*, Case T-817/19,

EU:T:2021:41, the General Court considered the average consumer for, and level of attention which would be paid in, the selection of pharmaceutical and medical products in class 5. It said:

> "39 Where the goods in question are medicinal or pharmaceutical products, the relevant public is composed of medical professionals, on the one hand, and patients, as end users of those goods, on the other (see judgment of 15 December 2010, *Novartis* v *OHIM – Sanochemia Pharmazeutika (TOLPOSAN)*, T-331/09, EU:T:2010:520, paragraph 21 and the case-law cited; judgment of 5 October 2017, *Forest Pharma* v *EUIPO – Ipsen Pharma (COLINEB)*, T-36/17, not published, EU:T:2017:690, paragraph 49).
>
> 40 Moreover, it is apparent from case-law that, first, medical professionals display a high degree of attentiveness when prescribing medicinal products and, second, with regard to end consumers, in cases where pharmaceutical products are sold without prescription, it must be assumed that those goods will be of concern to consumers, who are deemed to be reasonably well informed and reasonably observant and circumspect where those goods affect their state of health, and that these consumers are less likely to confuse different versions of such goods. Furthermore, even assuming that a medical prescription is mandatory, consumers are likely to demonstrate a high level of attentiveness upon prescription of the goods at issue in the light of the fact that those goods are pharmaceutical products. Thus, medicinal products, whether or not issued on prescription, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect (see judgment of 15 December 2010, *TOLPOSAN*, T-331/09, EU:T:2010:520, paragraph 26 and the case-law cited).
>
> 41 …]
>
> 42 In the present case, having regard to the nature of the goods concerned, namely medical or pharmaceutical products in Class 5, the Board of Appeal acted correctly in finding in paragraphs 18 to 21 of the contested decision – which, moreover, is not disputed by the applicant – that, in essence, the

relevant public was made up of medical professionals and pharmacists and consumers belonging to the general public with a higher than average degree of attentiveness.”.

66. The majority of goods at issue would likely fall into the category of being specialist. The goods which are not specialist will nevertheless also receive a relatively heightened degree of attention considering their nature of providing health benefits. Overall, the level of attention is considered to be on the higher end of the scale.

67. Based on the nature of the goods at issue, I consider the purchasing process to be dominated by the visual aspect. In the circumstances where the consumer is the medical professional, it is essential that they pay a high degree of attention to the product they are prescribing and will therefore closely scrutinise the mark presented. Similarly, in the circumstances when the consumer is the patient (end consumer/general public) buying the goods themselves, they too are more likely to pay attention and closely read the marks presented (see *Olimp Laboratories* paragraph 40). In relation to the everyday goods such as *vitamin supplements*, the purchase process will also be visually dominated as the consumer will analyse the mark on the product on the store-shelf. I am aware that prescriptions and pharmaceutical preparations are often requested orally in a pharmacy (and advice can be orally requested in relation to *vitamin supplements*, too), and so I do not discount the possibility that there may be an aural element to the purchasing process.

Distinctive character of the earlier trade mark

68. Whilst the Opponent has filed evidence for the purposes of proving use in relation to the earlier marks -712 and -647, the evidence neither indicates nor suggests that the earlier mark -161 possesses an enhanced degree of distinctive character. My assessment of the degree of distinctive character of the earlier mark -161 at issue is therefore to be made only on the basis of its inherent features.

69. In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

70. The earlier mark consists of the plain words 'Deep Blue Polyphenol Complex', without any additional stylisation or figurative elements. As such, any inherent distinctive character rests exclusively in the meaning of these words. In my view, the combination 'Deep Blue' will most likely be perceived to hang together to create the concept of a colour, whilst the combination 'Polyphenol Complex' will most likely be perceived to hang together to create the concept of a chemical compound, as argued by the Opponent. In such circumstances, it seems to me that the average consumer would perceive the combination 'Deep Blue' as the indicator of trade origin, or "House mark", with the combination 'Polyphenol Complex' being considered as entirely descriptive of a characteristic of the goods. As a result, the combination 'Deep Blue' will be perceived as abstract and nonsensical in relation to the goods, and therefore distinctive to a medium degree.

Likelihood of confusion

71. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and/or services down to the responsible undertakings being the same or related.

72. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle, whereby a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa (see *Canon*, C-39/97, para 17). Further factors to keep in mind include the distinctive character of the Opponent's trade mark, the nature of the purchasing process, and the average consumer for the goods and/or services. As regards the average consumer, I must also be alive to the fact that the consumer rarely has the opportunity to make direct comparisons between trade marks, and must instead rely upon the imperfect picture of them that he has retained in his mind.

73. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.[16] Having conducting a comparison of the marks at issue, I have determined that it is the visual consideration which is of primary importance due to the purchasing process of the respective goods being visually dominated.[17] With this in mind, I refer to my finding that the marks are visually similar to a medium degree. It is important to reaffirm that I did not rule out the possibility that the marks may also be spoken in certain purchasing environments, in which case it is worth considering that I found the marks to be aurally similar to a medium degree also.

74. The earlier mark consists exclusively of the words Deep Blue Polyphenol Complex, with no additional stylisation or figurative elements. In my opinion, the average

[16] *New Look Limited v OHIM,* joined cases T-117/03 to T-119/03 and T-171/03
[17] *Quelle AG v OHIM,* Case T-88/05

consumer will perceive the element 'Polyphenol Complex' to be descriptive of a characteristic of the goods. In the *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253 the GC pointed out that generally speaking the average consumer will not consider a descriptive or weakly distinctive element within a composite mark to be either distinctive or dominant. Also, in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU found that elements of a mark which are either descriptive or non-distinctive must be given less weight when comparing marks. With this in mind, the dominant and distinctive element of the earlier mark is the word combination 'Deep Blue'.

75. The word combination 'DEEPBLUE' is also contained in the contested mark, albeit in a conjoined form. Therefore, the element of the earlier mark which gives it its distinctive character is contained wholly within the contested mark. As indicated in *Kurt Geiger v A-List Corporate Limited*, the likelihood of confusion is increased if the distinctive character resides in the element of the marks that are identical or similar.[18] By virtue of both marks containing the distinctive element Deep Blue/DEEPBLUE, I consider it likely that the consumer would assume they belong to the same or economically linked trade origin. However, I do not discount the fact that the contested mark contains the figurative element of a white dolphin. Because the white dolphin is itself inherently distinctive and co-dominant with the element DEEPBLUE in the contested mark, I am unable to find that the consumer would simply mistake one mark for the other. I therefore do not find a likelihood of direct confusion.

76. Having found there to be no likelihood of direct confusion, any likelihood of confusion would now be dependent on a finding of indirect confusion. It should be borne in mind that finding a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.[19] In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., (as he then was) as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

[18] *Kurt Geiger v A-List Corporate Limited*, BL O-075-13
[19] *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017,* paragraph 13.

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:

(c) 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.).

I 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)."

77. Whilst the categories above do not represent an exhaustive list,[20] they nevertheless do represent a fair reflection of instances where indirect confusion "tends to fall". The marks at issue share the common element Deep Blue/DEEPBLUE, which I have found to be inherently distinctive to a medium degree. In relation to the goods

[20] *Liverpool Gin Distillery Limited*

at issue, I am of the opinion that the consumer would assume that no-one else but the brand owner would be using this common element. I therefore find a likelihood of indirect confusion.

78. I am cogent of the fact that I have found a certain number of the goods at issue will be purchased by the specialist consumer, who invariably pays a higher degree of attention. With this in mind, it could be said that such a consumer would notice the differences between the marks at issue. However, it must be acknowledged that even a consumer with a higher degree of attention relies upon imperfect recollection, and as such they are equally susceptible to misremembering differences between marks. As such, I find it likely that upon seeing the contested mark both the average and specialist consumers would recall having previously seen the distinctive element DEEPBLUE used in relation to identical or highly similar goods.

Conclusion

79. Based on the earlier mark -161, the opposition is partially successful under Section 5(2)(b). The Opponent would not enjoy any greater success relying on either of its other two earlier marks, as the goods at issue have been found to be dissimilar.

80. Subject to an appeal, the contested application will be refused for the following goods:

Class 5 *Drugs for medical purposes; dietetic substances adapted for medical use;* and *medicines for veterinary purposes*

81. Also subject to an appeal, the application shall proceed to registration for the following goods:

Class 5 *Chemical reagents for medical or veterinary purposes; diagnostic preparations for medical purposes; reagent paper for medical purposes; disinfectants for hygiene purposes; diagnostic preparations for veterinary purposes; dressings, medical; sanitizing wipes.*

Costs

82. Neither party has been wholly successful, with both parties having achieved some measure of success. As a result of this, I decline to make an award of costs in favour of one particular party and I direct each party to bear their own costs.

Dated this 27th day of July 2023

Dafydd Collins
For the Registrar
The Comptroller-General