

O/0745/23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3795533
BY HENAN PENGYIDA TRADING CO LTD**

TO REGISTER:

Reborn Baby Doll

AS A TRADE MARK IN CLASS 35

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 435958 BY
HOHHOT MIYANG TRADING COMPANY**

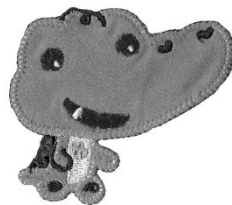
BACKGROUND AND PLEADINGS

1. On 6 June 2022, Henan Pengyida Trading Co Ltd (“the applicant”) applied to register **Reborn Baby Doll** as a trade mark in the United Kingdom in respect of the following services:

Class 35

Bill posting; Advertising; Advertising agency services; Pay per click advertising; Online advertising on a computer network; Layout services for advertising purposes; Commercial information agency services; Providing business information; Import-export agency services; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses]; Marketing; Provision of an online marketplace for buyers and sellers of goods and services; Targeted marketing; Marketing in the framework of software publishing; Personnel management consultancy; Registration of written communications and data; Book-keeping; Sponsorship search; Wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

2. The application was opposed by Hohhot Miyang Trading Company (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and concerns all the services for which registration is sought. The opponent is relying on UKTM No. 3667947, shown below:



Reborn Baby

3. This mark was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and so retains its EU filing date of 25 November 2020. It was registered on 25 February 2022 in respect of the following goods, all of which are relied upon:

Class 28

Toy furniture; Bath toys; Toy animals; Bath playthings; European style dolls; Toys for dogs; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy cars; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle.

4. UKTM No. 3667947 qualifies as an earlier mark under section 6(1) of the Act by virtue of its earlier filing date. As it had completed its registration procedure less than five years before the date of application for the contested mark, the opponent is not required to prove that it has made genuine use of the mark and so may rely on all the goods listed above.

5. The opponent claims that the marks are highly aurally and conceptually similar, as they both contain the words "REBORN Baby", and that any visual differences would be outweighed by these similarities. It claims that the contested services are "*either identical or highly similar*" to the goods of the earlier mark "*because all of the services of the later Mark could encompass such services connected with the goods of the earlier mark*". Consequently, it asserts that there exists a likelihood of confusion on the part of the relevant public in the UK.

6. The applicant filed a defence and counterstatement denying the claims made. In particular, it claims that the goods and services are dissimilar.

7. Neither party filed any evidence or written submissions beyond the contents of their statement of grounds and counterstatement; neither did they request a hearing.

8. In these proceedings, the opponent is represented by IPEY and the applicant by Marcin Ociepka.

DECISION

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

"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.”

10. In considering the opposition, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):¹

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

¹ Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts, although the UK has left the EU.

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; and

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 goods and services

11. Section 60A of the Act is as follows:

“(1) For the purposes of this Act goods and services-

- (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;
- (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

12. It is settled case law that I must make my comparison of the goods and services on the basis of all relevant factors. These may include the nature of the goods and services, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. Goods and services are complementary when

“... 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.”²

² *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82.

13. The goods and services to be compared are shown in the table below:

Contested services	Earlier goods
	<p><u>Class 28</u></p> <p><i>Toy furniture; Bath toys; Toy animals; Bath playthings; European style dolls; Toys for dogs; Dolls for playing; Talking dolls; Puppets; Dolls; Dolls' clothes; Jigsaw puzzles; Stuffed toys; Masks [playthings]; Toy cars; Toy telescopes; Artificial Christmas trees; Candle holders for Christmas trees; Fish hooks; Fishing tackle.</i></p>
<p><u>Class 35</u></p> <p><i>Bill posting; Advertising; Advertising agency services; Pay per click advertising; Online advertising on a computer network; Layout services for advertising purposes; Commercial information agency services; Providing business information; Import-export agency services; Sales promotion for others; Procurement services for others [purchasing goods and services for other businesses]; Marketing; Provision of an online marketplace for buyers and sellers of goods and services; Targeted marketing; Marketing in the framework of software publishing; Personnel management consultancy; Registration of written communications and data; Book-keeping; Sponsorship search; Wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.</i></p>	

14. The fact that the goods and services are in different classes does not in itself mean that they are dissimilar. The opponent submits that the contested services could

encompass services associated with the earlier goods. However, I remind myself that I must look at the core meaning of these terms and having considered the relevant factors set out above, I can find no areas of similarity between the goods and services. The contested services are, for the most part, targeted towards businesses, the exception being *Provision of an online marketplace for buyers and sellers of goods and services*. The users of the earlier goods are different: for example, the user of toys is different from the user of advertising services for toys. The purposes of the goods and services also differ, as do the method of use, nature and trade channels. The average consumer would not, in my view, expect the same undertaking to be providing the goods and the services. I do not consider that they are in competition or complementary.

15. The opponent submits that:

“It is established jurisprudence from *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* that a lesser degree of similarity between the services may be offset by a greater degree of similarity between the marks and vice-versa. Hence, any dissimilarity of the goods are offset by the highly similar nature of the Trade Marks and the fact that all goods and services would be encountered by the same end users. Likewise, any dissimilarity of the Trade Marks are offset by the highly similar nature of the goods and services.”³

16. However, a finding of confusion under section 5(2)(b) requires the goods and services to have some degree of similarity. In *eSure Insurance Limited v Direct Line Insurance Plc*, [2008] EWCA Civ 842 CA, Lady Justice Arden stated that:

“... 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

³ Statement of grounds, paragraph 2.2.2.

has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”⁴

17. I have found no similarity between the goods and services, and so the opposition must fail.

OUTCOME

18. The opposition has failed and Application no. 3795533 will proceed to registration.

COSTS

19. The applicant has been successful and under the circumstances is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice No. 2/2016. I therefore make an award of costs to the applicant as follows:

Preparing a statement and considering the other side’s statement: £200

TOTAL: £200

20. I therefore order Hohhot Miyang Trading Company to pay Henan Pengyida Trading Co Ltd the sum of £200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 3rd day of August 2023

**Clare Boucher,
For the Registrar,
Comptroller-General**

⁴ Paragraph 49.