

O/0889/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003631323

BY COMFORT CLICK LTD

FOR THE FOLLOWING TRADE MARK:

mysmile



IN CLASS 3

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 504555

BY EZGO GROUP INC AND HONG CHEN

BACKGROUND AND PLEADINGS

1. Comfort Click Ltd (“the proprietor”) applied to register the trade mark shown on the cover page of this decision (“the Contested Mark”) in the UK on 23 April 2021. It was registered on 3 December 2021 for the following goods:

Class 3 Teeth Whitening Kits; Teeth Whitening Gels; Teeth Whitening Charcoal Powder; Teeth Whitening Coconut Oil; Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene (dentifrices); Products for dental hygiene; Cosmetic preparations for cleansing the teeth; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth; Tooth cleaning preparations; Tooth care preparations; Mouthwash; Mouthwashes, not for medical purposes; Non-medicated mouth rinses; Tooth polish; Varnish for teeth; Non-medicated mouth sprays; Breath fresheners; Toothpastes; Day and Night Toothpastes; Teeth Whitening Pen; Dental bleaching gels; Teeth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Tooth whiteners; Teeth whitening strips; Teeth cleaning lotions; Teeth whitening preparations; Teeth whitening strips impregnated with teeth whitening preparations [cosmetics]; Teeth cleaning (Preparations for -); Preparations for cleaning teeth; Preparations for cleaning the teeth; Cleaning preparations for the teeth; Cosmetic preparations for the care of mouth and teeth; Disclosing tablets for personal use in indicating tartar on the teeth.

2. On 1 February 2022, EZGO Group Inc and Hong Chen (“the applicants”) applied to have the Contested Mark declared invalid under section 47 of the Trade Marks Act 1994 (“the Act”). The application is based upon section 5(2)(b) of the Act.

3. The applicants rely on the following trade mark:



UK registration no. UK00003338153

Filing date 13 September 2018; Registration date 28 December 2019.

Relying upon all of its goods for which the earlier mark is registered, namely:

Class 3 Dental bleaching gels; Teeth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Tooth whiteners; Gels for teeth cleaning; Bleaching preparations (decolourants) for cosmetic purposes; Toothpaste; Preparations for dental purposes (dentifrices); Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene (dentifrices); Products for dental hygiene; Cosmetic preparations for cleansing the teeth; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth; Tooth cleaning preparations; Tooth care preparations; Mouthwash; Mouthwashes, not for medical purposes; Non-medicated mouth rinses; Tooth polish; Varnish for teeth; Non-medicated mouth sprays; Breath fresheners.

4. The applicants claim that there is a likelihood of confusion because the marks are visually similar, aurally and conceptually identical, and the goods are identical.

5. The proprietor filed a counterstatement denying the claims made, and put the applicant to proof of use.¹ However, as noted in the Registry's official letter dated 17 November 2022, the earlier right being relied upon by the applicant was not registered

¹ For the sake of completeness, I note that in an official letter dated 9 June 2022, the Registry noted that the proprietor did not file its counterstatement (Form TM8) within the 2 month period allocated, and therefore under Rule 47(6), the registration was declared invalid and directed to be moved from the register. However, the proprietor filed a Form TM55P appealing this decision to the Appointed Person, who directed that the appeal was successful, and the Hearing Officers decision and the order of 9 June 2022 to be set aside, and the applicant's invalidity application to be remitted to the Registrar in decision BL O/847/22. The proprietor therefore proceeded to file its counterstatement on 3 November 2022.

for a period of five years when the application was filed. Consequently, proof of use is not applicable. The proceedings will therefore continue as if the answer to question 7 in its Form TM8 was “No”.

6. The applicants are represented by Trademarkit LLP and the proprietor is unrepresented. Neither party filed evidence nor requested a hearing, but both parties filed written submissions. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

7. On 20 March 2023, the proprietor filed a document headed as “Witness Statement”. As noted in the official letter of the Registry dated 31 March 2023, the document does not contain evidence of fact and was not filed in the correct format, i.e. containing a statement of truth nor was it signed by the proprietor. The Registry stated that “it shall therefore be regarded as submissions”. I also note that the proprietor was given the opportunity to refile its submissions or to file a witness statement in the correct format, in which it did not.

DECISION

8. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47. (1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D)-(2DA) [Repealed]

(2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet

acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) [...]

(4) [...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

9. 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 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.

Section 5(2)(b)

10. Section 5(2)(b) reads as follows:

“5(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.”

11. The trade mark upon which the applicants rely qualifies as an earlier trade mark because it was applied for at an earlier date than the proprietor’s mark pursuant to section 6(1)(a) of the Act.

Section 5(2)(b) case law

12. 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:

(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

13. The competing goods are as follows:

Applicants' goods	Proprietor's goods
Dental bleaching gels; Teeth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Tooth whiteners; Gels for teeth cleaning; Bleaching preparations (decolourants) for cosmetic purposes; Toothpaste; Preparations for dental purposes (dentifrices); Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene (dentifrices); Products for dental hygiene; Cosmetic preparations for cleansing the teeth; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth; Tooth cleaning preparations; Tooth care preparations; Mouthwash; Mouthwashes, not for medical purposes;	Teeth Whitening Kits; Teeth Whitening Gels; Teeth Whitening Charcoal Powder; Teeth Whitening Coconut Oil; Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene (dentifrices); Products for dental hygiene; Cosmetic preparations for cleansing the teeth; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth; Tooth cleaning preparations; Tooth care preparations; Mouthwash; Mouthwashes, not for medical purposes; Non-medicated mouth rinses; Tooth polish; Varnish for teeth; Non-medicated mouth sprays; Breath fresheners; Toothpastes; Day and Night Toothpastes; Teeth Whitening Pen;

<p>Non-medicated mouth rinses; Tooth polish; Varnish for teeth; Non-medicated mouth sprays; Breath fresheners.</p>	<p>Dental bleaching gels; Teeth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Tooth whiteners; Teeth whitening strips; Teeth cleaning lotions; Teeth whitening preparations; Teeth whitening strips impregnated with teeth whitening preparations [cosmetics]; Teeth cleaning (Preparations for -); Preparations for cleaning teeth; Preparations for cleaning the teeth; Cleaning preparations for the teeth; Cosmetic preparations for the care of mouth and teeth; Disclosing tablets for personal use in indicating tartar on the teeth.</p>
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14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated 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 für 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.”

Dental care preparations; Non-medicated dental preparations; Non-medicated preparations for the care of the mouth; Non-medicated preparations for oral hygiene purposes; Preparations for oral hygiene (dentifrices); Products for dental hygiene; Cosmetic preparations for cleansing the teeth; Cosmetic preparations for cleansing the mouth; Preparations for the treatment of teeth; Tooth cleaning preparations; Tooth care preparations; Mouthwash; Mouthwashes, not for medical purposes; Non-medicated mouth rinses; Tooth polish; Varnish for teeth; Non-medicated mouth

sprays; Breath fresheners; Dental bleaching gels; Tooth whiteners; Teeth whitening preparations; Teeth whitening articles; Teeth whitening strips; Teeth whitening strips; Teeth whitening preparations.

15. All of the above terms appear identically in both the applicants' and proprietor's specifications.

Teeth Whitening Kits; Teeth Whitening Gels; Teeth Whitening Charcoal Powder; Teeth Whitening Coconut Oil; Teeth Whitening Pen.

16. The proprietor's above goods falls within the broader categories of "teeth whitening preparations" and "teeth whitening articles" in the applicants' specification. They are identical on the principle outlined in *Meric*.

Teeth whiteners.

17. The proprietor's above goods are self-evidently identical to "tooth whiteners" in the applicant's specification.

Teeth whitening strips impregnated with teeth whitening preparations [cosmetics].

18. The proprietor's above goods are self-evidently identical to "teeth whitening strips" in the applicants' specification.

Toothpastes; Day and Night Toothpastes.

19. The proprietor's above goods are self-evidently identical to "toothpaste" in the applicants' specification.

Teeth cleaning lotions; Teeth cleaning (Preparations for -); Preparations for cleaning teeth; Preparations for cleaning the teeth; Cleaning preparations for the teeth.

20. The proprietor's above goods are self-evidently identical to "tooth cleaning preparations" in the applicants' specification.

Cosmetic preparations for the care of mouth and teeth.

21. I consider that the applicants' "cosmetic preparations for cleansing the mouth" falls within the proprietor's above broader category. They are identical on the principle outlined in *Meric*.

Disclosing tablets for personal use in indicating tartar on the teeth.

22. The proprietor's above goods falls within the applicants' broader category of "preparations for dental purposes (dentifrices)" in the applicants' specification. They are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

23. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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."

24. The average consumer for the goods will be members of the general public, and professionals such as dentists. The price of the goods is likely to vary, for example, with some teeth whitening preparations being quite expensive, whereas some toothpastes are much cheaper. The frequency of purchase is also likely to vary, with

the purchase of toothpastes likely to be a frequent purchase, as they are used twice daily, and the purchase of teeth whitening preparations being less frequent. The average consumer will also take various factors into consideration such as the quality of the goods, and the suitability of them for the user's dental needs. Taking all of this into consideration, I consider it likely that at least a medium degree of attention will be paid during the purchasing process.

25. The goods are likely to be obtained from a dental practice, its online equivalent or following inspection of a specialist catalogue. Alternatively, the goods may be purchased from general retail stores, pharmacies, or following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from medical professionals in a dentistry setting or through word-of-mouth recommendations from friends, family, etc.

Comparison of the trade marks



26. 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 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.”

27. It would be wrong, therefore, to artificially dissect the trade marks, 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.

28. The respective trade marks are shown below:

Applicants' trade mark	Proprietor's trade mark
	

29. The applicants' mark consists of two conjoined words "MySmile" written in a standard black font with the letters M and S capitalised, and the remaining letters in lower-case. This is presented in front of a pale blue smiling lips device, which is slightly opaque in nature. The eye is naturally drawn to the element of the mark that can be read, and therefore, the lips device will play a lesser role in the overall impression of the mark, with the words "MySmile" playing a greater role.

30. The proprietor's mark consists of the conjoined words "mysmile", all presented in lower case, with the word "my" presented in a smaller font, the word "smile" in a larger font, all presented in a lower-case black typeface. I also note that the tail of the letter "e" is presented in a bright blue colour. I consider that as the "smile" element is bigger, it plays a slightly greater role in the overall impression of the mark, with the word "my" playing a slightly lesser role, and the stylisation of the mark (including the blue tail of the letter "e") playing an even lesser role.

31. Visually, the marks overlap in the conjoined words "MySmile/mysmile". This acts as a visual point of similarity. However, the applicants' mark contains the smiling lips device behind the word element, and in the proprietor's mark the word "my" is presented smaller in size, and the letter "e" has a blue tail. I note that these are stylistic elements that act as visual points of difference. Taking all of the above into account, the marks are visually similar to a high degree.

32. Aurally, the smiling lips device in the applicant's mark will not be pronounced. The stylisation of the proprietor's mark, more specifically the blue tail of the letter "e" does

not change the pronunciation of the words “mysmile”. Therefore, as both marks are composed of the words “my” and “smile”, which will be given their ordinary dictionary pronunciation, as submitted by the applicants’, the marks are aurally identical.

33. Conceptually, the words “MySmile” in both marks will be recognised as a smile belonging to or expressed by themselves. The smiling lips device reinforces this concept in the applicants’ mark. The marks are, therefore, conceptually identical.

Distinctive character of the earlier trade mark

34. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

35. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

36. As the applicants have not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

37. As highlighted above, the applicants' mark consists of two conjoined words "MySmile" presented in front of a pale blue smiling lips device. I consider that the mark as a whole is highly allusive of the applicant's class 3 goods, which are all in regard to improving the patient's teeth, and therefore their smile. The applicants' mark is, therefore, inherently distinctive to a low degree.

Likelihood of confusion

38. 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 down to the responsible undertakings being the same or related. 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. 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 goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

39. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to a high degree.
- I have found the marks to be aurally identical.
- I have found the marks to be conceptually identical.
- I have found the applicants' mark to be inherently distinctive to a low degree.
- I have identified the average consumer to be members of the general public and professionals including dentists who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical.

40. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

41. Taking all of the factors listed in paragraph 39 into account, considering the principle of imperfect recollection, and bearing in mind that both marks consists of the identical words "My" and "Smile", I consider that the marks are likely to be mistakenly recalled or misremembered as each other. The differing elements between the marks are all stylistic, including the blue smiling lips device in the applicants' mark, and the slight difference in presentation; MySmile vs mysmile, with the "my" element in the proprietor's mark smaller in size and the letter "e" having a blue tail. I therefore consider that these stylistic elements would be easily overlooked by the average consumer, especially as they play a lesser role, or even lesser role, in the overall impression of the marks. Furthermore, I also consider that the marks will be mistakenly recalled or misremembered as each other given the high degree of visual similarity between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the aural identity of the marks will have the same result. Lastly, I also consider that in the absence of a differing conceptual hook between the marks, the average consumer will conceptualise them in the exact same way. This results in a likelihood of direct confusion, on all of the parties' goods, which are identical.

42. For the sake of completeness, I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he was then), 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.”

43. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

44. I also bear in mind the recent appeal decision by Philip Harris, sitting as the Appointed person, in *Natural Pure NATURAL PURE WATER*, Case BL-O/0331/23, stated that:

“23. Accordingly, I think *Whyte & Mackay* goes much further than *Nicoventure*. I read the former case as holding that where the first mark is of low distinctiveness overall, and it is replicated (even wholly replicated) in a second mark, this suggests against a likelihood of confusion provided there is at least

one element in the second mark which is sufficiently more distinctive than the element consisting of the first mark. This view also seems to me to be consistent with the extract from the *L'Oreal* judgment above.”

45. In this instance, and as highlighted above, the differences between the marks are all stylistic; the blue smiling lips device in the applicants’ mark (which reinforces the overall meaning of the words “MySmile”), and the slight difference in presentation; MySmile vs mysmile, with the “my” element in the proprietor’s mark smaller in size and the letter “e” having a blue tail. As highlighted in paragraphs 29 and 30, these elements play a lesser role, or even lesser role, within the marks. Consequently, these elements are not “sufficiently more distinctive” than the MySmile/mysmile element.

46. Therefore, I consider that the shared common use of the words MySmile/mysmile in both marks will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that if the average consumer notices the stylistic differences between the parties marks, they will perceive it as an updated version of the same mark, and therefore indicative of re-branding. I consider there to be a likelihood of indirect confusion.

CONCLUSION

47. The application for invalidation is successful and the Contested Mark is hereby declared invalid in respect of all goods for which it is registered.

48. Under section 47(6) of the Act, the registration is deemed never to have been made.

COSTS

49. The applicants have been successful and are entitled to a contribution towards their costs based upon the scale set out in Tribunal Practice Notice 2/2016.

50. In the circumstances, I award the applicants the sum of £700, calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£200
Filing written submissions	£300
Official fee	£200
Total	£700

51. I therefore order Comfort Click Ltd to pay EZGO Group Inc and Hong Chen the sum of £700. This sum is to 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 19th day of September 2023

L FAYTER
For the Registrar