BL O/0964/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003789655
BY DONGGUAN BINXING TOYS & GIFTS CO., LTD
TO REGISTER THE TRADE MARK:

IN CLASS 28

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 435370
BY CHARISMA BRANDS, LLC

BACKGROUND AND PLEADINGS

1. On 19 May 2022, Dongguan Binxing Toys & Gifts Co., Ltd. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 3 June 2022. The applicant seeks registration for the following goods:

Class 28 Toys for pets; Toys; Stuffed toys; Dolls' houses; Dolls; Dolls' clothes; Ball-jointed dolls [BJD]; Action figures; Fishing tackle; Play tents.

2. The application was opposed by Charisma Brands LLC ("the opponent") on 2 August 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark:

Comparable trade mark (IR) registration no. UK00801254989[1]
Filing date 16 May 2015; Registration date 11 May 2016.
Relying upon all of the goods for which the earlier mark is registered, namely:

Class 28 Doll clothing; dolls; porcelain dolls; vinyl dolls.

3. The opponent claims that there is a likelihood of confusion because the marks are visually and phonetically similar, and the goods are identical or similar.

[1] Following the end of the transition period of the UK's withdrawal from the EU, all international (EU) trade mark designations registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (IR)' retains the same designation date (filing date), priority date (if applicable) and registration date of the international (EU) trade mark designation.

4. The applicant filed a counterstatement denying the claims made, putting the opponent to proof of use.

5. The opponent is represented by Kilburn & Strode LLP and the applicant is represented by Pawel Wowra. Neither party requested a hearing, however, the opponent filed evidence in chief and written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

EVIDENCE

6. The opponent's evidence consists of the witness statement of Ruby Alice Vinsome dated 23 February 2023. Ms Vinsome is a Chartered Trade Mark Attorney at Kilburn & Strode LLP, the representatives for the opponent. Ms Vinsome's statement is accompanied by 24 exhibits (RAV1-RAV24).

7. I have taken all of the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

8. 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

DECISION

Section 5(2)(b)

9. 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."

10. The opponent's mark qualifies as an earlier mark in accordance with section 6(1)(a) and 6(1)(ab) as its filing date is an earlier date than the filing date of the applicant's mark. As the opponent's mark had completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

11. I will begin by assessing whether there has been genuine use of the earlier marks. The relevant statutory provisions are as follows:

12. Section 6A of the Act states:

"(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), (aa) 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 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."

13. As the opponent's earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union".

14. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicant's mark, i.e. 20 May 2017 to 19 May 2021.

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

"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 I9223, 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 establihed 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]."

Evidence of use

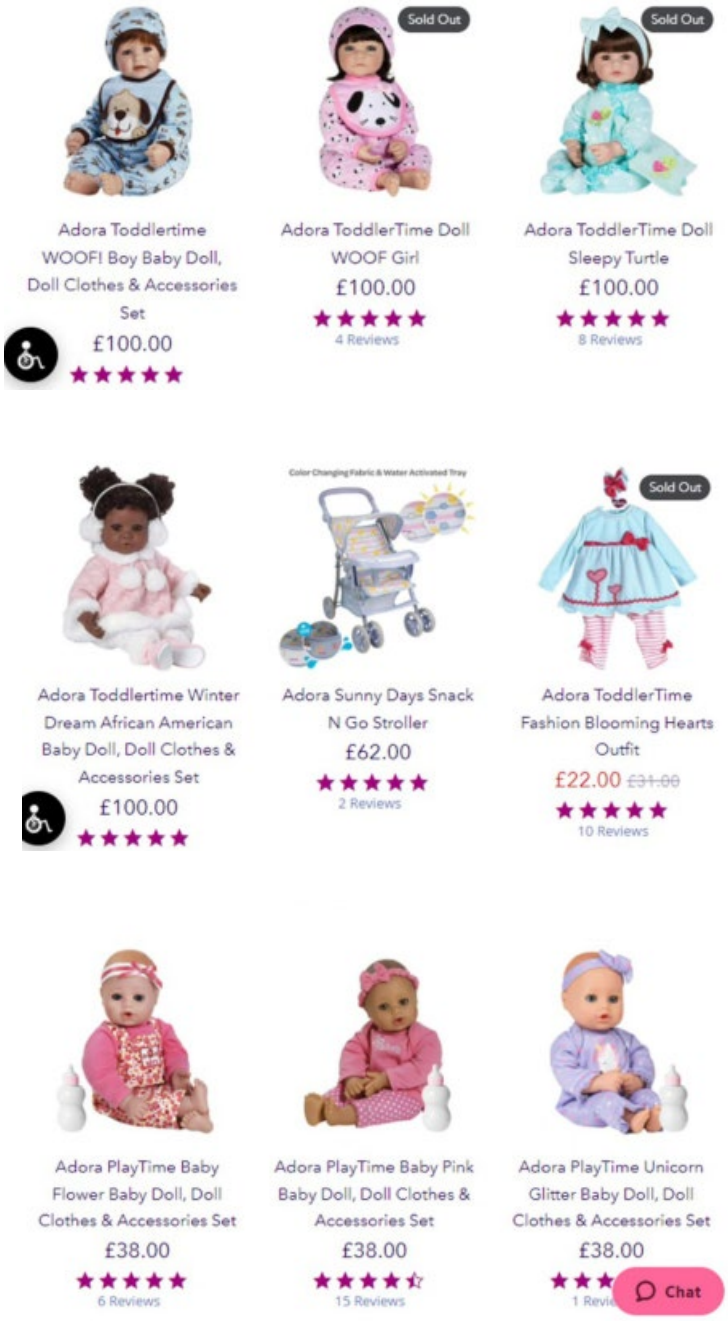
16. I note the following from the opponent's evidence:

a) **Exhibits RAV4, RAV7, RAV11, RAV13,** and **RAV15** contain screenshots of extracts from the opponent's Spring and Fall 2017, 2018, 2019, 2020 and 2021 catalogues. The 2017, 2018 and 2019 catalogue screenshots show the opponent's "PlayTime Babies" and "Adoption Babies" as well as their accessories such as clothing, high-chairs and strollers. The 2020 and 2021 catalogue screenshots are the front pages only. I note that there are no prices contained within the brochures, however, they do show product codes.

b) The 2017 catalogues clearly use the following mark on the front cover:

c) The 2018 to 2021 catalogues clearly use the following mark on the front cover:

d) **Exhibit RAV6** contains a series of screenshots dated 12 December 2022, from the opponent's website showing its various baby dolls names, which start with the word "Adora". The exhibit also shows its baby dolls accessories. The PlayTime babies are priced at £38, with some of the other dolls, such as "WOOF!" and "Preppy" being priced at £100. Ms Vinsome has provided this exhibit to cross-reference with the product names contained within the distributors invoices exhibited in **RA5, RA8** and **RA10.** For reference **exhibit RAV6** contains some of the following depictions of the opponent's goods:



e) **Exhibit RA5** contains 1 invoice dated 16 September 2017 to the opponent's EU distributor Toizz BV, located in the Netherlands. I note that the opponent is located in the US and therefore the prices are presented in US dollars. It shows that 30 WOOF! dolls were ordered, amounting to $1,320.00 and 342 PLAYTIME BABY dolls were ordered, amounting to $5,472.00.

f) **RAV8** contains 2 invoices to Toizz BV dated 12 June 2018 showing the sale of 110 PLAYTIME babies amounting to $2,400.00 and 100 Cat's Meow baby dolls amounting to $4,400.00.

g) **RAV10** contains 1 invoice to Toizz BV dated 27 September 2019 showing the sale of the following baby dolls: PLAYTIME BABY, WOOF GIRL, KITTY KAT, COSMIC GIRL/BOY, OVER THE RAINBOW, PREPPY, WINTER WONDER/DREAM, SLEEPY TURTLE, THE CAT'S MEOW, DAISY DELIGHT and SWEET CHEEKS. The sale of the 430 dolls amounts to $16,320.00.

h) **Exhibit RAV18** contains the following picture of Toizz BV's catalogue advertising the opponent's goods, which Ms Vinsome states was in circulation between 2015 and 2020:

i) **Exhibits RAV9, RAV12** and **RAV14** contains a selection of 10 invoices dated between 1 September 2019 to 6 January 2021 to customers based across the UK (including Newport, Glasgow, Leeds, Scunthorpe and Kent) showing the sale of "Adora" baby dolls and their "Adora" accessories including car seats, strollers, diaper bags and cots.

j) **Exhibit RAV20** contains a spreadsheet of all the goods sold to Toizz BV between 2014 and 2019. Again using the baby dolls names contained in **exhibit RAV6** (PLAYTIME BABY, WOOF!, KITTY KAT, COSMIC GIRL/BOY, OVER THE RAINBOW, PREPPY, WINTER WONDER/DREAM, SLEEPY TURTLE, THE CAT'S MEOW and DAISY DELIGHT), allows me to determine that 3,745 of these dolls were sold for $106,392.

k) **Exhibit RAV21** contains a spreadsheet showing the opponent's sales between 2018 to 2021 of its goods on Amazon within the UK, including the sale of 161 THE CAT'S MEOW baby dolls and 36 WOOF! baby dolls, which amounted to $20,841.

Form of the mark

17. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that (my emphasis):

> "31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.
>
> 32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestle, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> 33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be

fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

18. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

19. Where the opponent’s mark has been used as registered this will, clearly, be use upon which the opponent can rely.

20. However, as highlighted above, the mark has been used in the following variants:

1) Adora

2) 

a) 

21. I consider that the word “adora” is where the distinctive character of the earlier mark lies. Therefore use as a word on its own will continue to indicate origin of the goods. Variant 1 is, therefore, acceptable use of the opponent’s mark.

22. I note that variant 2 is use of the mark as registered, with the only differences being the heart presented in the colour purple, and the allusive strapline “spreading love & joy” has been removed. I consider that the use of colour and the removal of the words “spreading love & joy” does not alter the distinctive character of the mark, nor does it do not prevent the opponent’s mark from continuing to indicate origin. The above variant is, therefore, acceptable use of the opponent’s mark.

23. Variant 3 still uses the heart device as registered, presented in the colour purple, however, it presents the word “adora” in a less stylised lower-case typeface, and below the heart device uses the strapline “made for play”. As highlighted above, at paragraph 16 in *Lactalis McLelland Limited*, the addition of descriptive or suggestive words is unlikely to change the distinctive character of the mark. I therefore consider that the change in typeface, and the addition of the new descriptive strapline “made for play” does not alter the distinctive character of the mark, nor does it prevent the opponent’s mark from continuing to indicate origin within the composite mark. The above variant is, therefore, acceptable use of the opponent’s mark.

Assessment of genuine use

24. As I have found the mark used in the evidence to be accepted, I will now consider an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[2]

25. As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as "warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark".

26. As the opponent's IR is a comparable mark, the relevant territory for the period before IP Completion Day (31 December 2020) is the EU, and for the remainder of the period is the UK.

27. Clearly, there are some issues with the opponent's evidence. For example, the opponent has not been provided me with an overall breakdown of sales figures by year and product, nor have I been provided with any advertising figures. However, I have been provided with invoice evidence to consumers in the UK during the relevant period. I note that the consumer invoices demonstrate sales to Newport, Glasgow, Leeds, Scunthorpe and Kent and are therefore not geographically limited within the UK. I have also been provided with invoice evidence for the opponent's EU distributor (Toizz BV) which shows a sale of 924 dolls were made to Toizz BV, totalling to $31,352.00. However, I note that all of the invoices show the same address for the distributor, which is based in the Netherlands. I have also been provided with examples of the opponent's brochures used during the relevant period. Therefore, taking all of the evidence as a whole, I am satisfied that the earlier mark has been put to genuine use in relation to baby dolls during the relevant period in the EU and UK.

[2] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

Fair specification

28. I must now consider whether, or the extent to which, the evidence shows use of the goods and services relied upon. 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:

> "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 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 *Pan 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 used 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. The goods for which the earlier mark is registered and upon which the opponent relies are class 28 doll clothing, dolls, porcelain dolls and vinyl dolls.

31. Clearly, based on the evidence above, the opponent sells baby dolls and their accessories. However, as the majority of the evidence pertains only to baby dolls, (specifically all of the distributor invoice figures and amazon UK figures which were obtained by cross-referencing the list of dolls that the opponent sells in **exhibit RAV6**), I consider that this is the only term they have shown use for. Therefore, the broader term "dolls" needs to be narrowed down to reflect the opponent's baby doll goods only.

32. The remaining terms are "doll clothing", "porcelain dolls" and "vinyl dolls". Firstly, albeit there is evidence within the opponent's brochures and on its website list in **exhibit RAV6** that they produce dolls clothing, as there is no specific sales figures or invoice evidence to support that dolls clothing was sold during the relevant period, I do not consider that the evidence is strong enough to justify the opponent relying on

the term “doll clothing”. Secondly, I do not have any evidence that confirms what materials the opponent’s baby dolls are made from, and therefore I do not consider that use has been shown for the terms “porcelain dolls” and “vinyl dolls”. Taking all of the above into account, I consider a fair specification of the earlier mark to be:

Class 28 Baby dolls.

Section 5(2)(b) - case law

33. In making this decision, I bear in mind the following principles 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

34. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 28 Baby dolls.	Class 28 Toys for pets; Toys; Stuffed toys; Dolls' houses; Dolls; Dolls' clothes; Ball-jointed dolls [BJD]; Action figures; Fishing tackle; Play tents.

35. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

36. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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

37. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM),* 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 Lernsysterne 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."

38. 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 the responsibility for those goods lies with the same undertaking."

Dolls; Toys.

39. The opponent's "baby dolls" falls within the broader categories of "dolls" and "toys" in the applicant's specification. They are identical on the principle outlined in *Meric*. Even where the applicant's terms cover goods other than baby dolls, there will be an overlap in user, method of use, purpose, nature and distribution channels and the goods will be highly similar.

Stuffed toys.

40. I consider that the opponent's "baby dolls" would include stuffed soft-toy baby dolls, which would fall within the applicant's above broader category. They are therefore identical on the principle outlined in *Meric*. Even where the applicant's term covers goods other than stuffed soft-toy baby dolls, there will be an overlap in user, method of use, purpose, nature and distribution channels and the goods will be highly similar.

Ball-jointed dolls [BJD]; Action figures.

41. The applicant's above goods are similar to the opponent's "baby dolls". The goods overlap in user, nature, method of use and purpose, as they are all types of dolls which are played with primarily by children. The goods will also overlap in distribution channels, being sold within the sale aisle in toy stores and general retail outlets. The goods are not complementary; however, they may be in competition. I therefore consider that the goods are similar to a high degree.

Dolls' clothes.

42. I consider that the applicant's above goods would include baby dolls clothing and therefore are similar to the opponent's "baby dolls". The goods will overlap in trade channels as the same undertaking would produce all of the goods, which will also be distributed in the same aisle of a toy store, or general retail outlet. The goods will also overlap to some extent in purpose and method of use, as they are all generally played with by children. I also consider that the goods are complementary. I therefore consider that they are similar to a medium degree.

Dolls' houses.

43. I consider that the applicant's above goods are similar to the opponent's "baby dolls". The goods overlap in purpose and user, and to some extent method of use, as they are all toys generally played with by children. I also consider that there would be an overlap in distribution channels as they would be sold in close proximity within a toy store, or general retail outlet. However, the nature of the goods differ, and they are

neither in competition nor complementary. I consider that the goods are similar to between a low and medium degree.

Toys for pets.

44. The applicant's above goods will have limited similarity with the opponent's "baby dolls". As highlighted above, the opponent's "baby dolls" could include stuffed soft-toy baby dolls, and therefore the goods would overlap in nature. I note that all of the goods are types of toys, and therefore will have limited overlap in purpose. However, the applicant's goods are used and played with by pets, whereas the opponent's goods are used and typically played with by children. Therefore, the goods do not overlap in user, nor do I consider that there would be an overlap in trade channels as pet undertakings will sell the applicant's goods, and doll undertakings or children toy specialists will sell the opponent's goods. They may both be sold in general retail stores; however, they will not be located in close proximity. The goods are neither in competition nor complementary. I consider that the goods are similar to a low degree.

Play tents.

45. The applicants above goods are tents which are played with by children inside or outside the home. I therefore do not consider that these goods will overlap in nature and method of use with the opponent's "baby dolls". I note that Ms Vinsome provides undated screenshots exhibited within **RAV22** of "Hamleys" and "Toys R Us" selling both play tents and dolls. Whilst I appreciate that toy stores are likely to sell all of the goods, they will neither be sold in the same aisle or in close proximity. Albeit the goods will also overlap in purpose and user, to the extent they are used for recreational purposes by children, I do not consider that this is enough to establish similarity as they are used in significantly different ways. The goods are neither in competition nor complementary. Taking all of the above into account, the goods are dissimilar.

Fishing tackle.

46. The applicant's above goods are used for fishing purposes, and are not toy versions of fishing tackles. I note that at **exhibit RAV24**, Ms Vinsome provides an

undated screenshot from “Hamleys” which shows a fishing rod for sale. However, I do not consider that this is strong nor compelling enough to establish that it is usual for the same trade channels to distribute both the applicant’s fishing tackles and the opponent’s “baby dolls”. The applicant’s goods are more likely to be sold and distributed by specialists in the field of fishing. The goods clearly do not overlap in nature, method of use, purpose or user. The goods are neither in competition nor complementary. The goods are therefore dissimilar.

47. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.[3] The opposition under section 5(2)(b) fails for the following goods:

Class 28 Fishing tackle; Play tents.

The average consumer and the nature of the purchasing act

48. 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 (as he then was) 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.”

[3] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

49. The average consumer for the goods will be members of the general public, specifically children. However, given that children encapsulates a younger age group, it is more likely that adults would be making the purchase. The cost of purchase will likely be relatively low and the goods will be purchased reasonably frequently. Various factors are still likely to be taken into consideration during the purchasing process, such as the aesthetic, durability, safety and suitability for particular age groups. Consequently I consider that a medium degree of attention will be paid during the purchasing process.

50. The goods are likely to be obtained by self-selection from the shelves of a toy store, general retail outlet, or their online equivalents. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. 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 sales assistants or word of-mouth recommendations.

Comparison of the trade marks

51. 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."

52. 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.

53. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	

54. The opponent's mark consists of an uneven black heart device, which contains the word "adora" written in a stylised white lower-case font. Underneath this, in smaller white letters, is the strapline "spreading love & joy". The eye is naturally drawn to the element of the mark that can be read, and therefore I consider that the background heart device will play a lesser role in the overall impression of the mark. Moreover, and for reasons I will come to discuss in the conceptual comparison, the word "adora" is the dominant and distinctive element of the mark, which plays a greater role in the overall impression, with the strapline and stylisation playing lesser roles.

55. The applicant's mark consists of a baby or child device holding the letter "A" of the stylised word "Aidor", with the tittle of the "i" being a heart, which are all underlined. I bear in mind that the average consumer tends to pay more attention to the beginning of the marks.[4] However, the baby/child device is allusive of the user of the goods and the eye is also naturally drawn to the element that can be read. Therefore, and for reasons I will come to discuss in the conceptual comparison, the word "Aidor" is the dominant and distinctive element of the mark, which plays a greater role in the overall

[4] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

impression, with the baby/child device, the stylisation and the heart device all playing lesser roles.

56. Visually, both marks coincide in the letter A at the beginning of the marks, and the letters D, O and R, which all appear next to each other, but in different positions within the marks. They also both contain heart devices and their dominant and distinctive word elements are both 5 letters in length. These are all visual points of similarity. However, the opponent's word element ends in the letter A, has the strapline "spreading love & joy", and the heart device is larger in size, acting as the background of the mark. The applicant's mark contains the baby/child device positioned at the beginning of the mark and the second letter of the applicant's mark is the letter "i" with the little heart tittle device, and the whole mark is underlined. Lastly, I note that the words within the marks are presented in different stylised typefaces. Therefore, taking all of the above into account, I consider that the marks are visually similar to a medium degree.

57. Aurally, the applicant's mark is likely to be pronounced as AID-OR. The opponent's mark is likely to be pronounced as ADD-OR-AH. The marks therefore aurally overlap in the A and D elements, and the "OR" syllable. I consider that the strapline is unlikely to be pronounced, however, if it was, the words would be given their ordinary pronunciation. Therefore if the opponent's mark is pronounced as the former, the marks are aurally similar to a medium degree, and if the opponent's mark is pronounced as the latter (with the strapline), they are aurally similar to between a low and medium degree.

58. Conceptually, I note that in its submissions in lieu, the opponent states that "ADORA in the Opponent's mark will be viewed as a female first name". In its counterstatement, the applicant states that "conceptually, the Applicant notes that ADORA is a female name meaning bellowed one or adored". I note that albeit the parties agree on this conceptual meaning, they have not made any submissions on whether this meaning would also be recognised and understood by the UK average consumer. In this instance, I do not consider that they will recognise it as a girl's name. There is no evidence before me to establish that this is well-known girls name in the

UK. I consider that, instead, they will perceive “adora” as an invented word with no conceptual meaning, which makes it the dominant and distinctive element of the mark.

59. The opponent also submits that the “Aidor” element of the applicant’s mark will also be perceived as a female first name, however, the applicant submits that it “is simply a made-up word”. I consider that the average consumer will view the word “Aidor” as an invented word, with no conceptual meaning, also making it the dominant and distinctive element of the mark.

60. As the words “Adora” and “aidor” evoke no conceptual meaning, they are conceptually neutral. However, I also note that both marks contain heart devices which evoke the concept of love. The applicant’s mark also contains the baby/child device at the beginning of the mark, which will contribute conceptually, however I note that it is allusive of the user of the applicant’s goods which are typically babies/children. Therefore, taking all of the above into account, that the marks overlap in the connotation of love, I consider that the marks are conceptually similar to between a low and medium degree.

Distinctive character of the earlier trade mark

61. 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 1-2779, 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)."

62. 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.

63. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

64. The only figures provided by the opponent which pertain to the UK are those which are found within the 10 UK invoices in **exhibits RAV9, RAV12** and **RAV14**. For its dolls only, I note that 2019 invoice in **RAV9** amounts to £68.00. The 2020 and 2021 invoices in **RAV12** and **RAV14** amount to $493.43. **Exhibit RAV21** also contains a spreadsheet showing the opponent's sales between 2018 to 2021 on amazon UK which shows that 197 dolls were sold for $20,841. I consider that these sales amount to an extremely small proportion of the doll market, which would be significant in size in the UK. The opponent has provided brochure evidence; however, Ms Vinsome does not confirm whether, and how many of these, were distributed in the UK. Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

65. As highlighted above, the opponent's mark consists of an uneven black heart background device, which contains the stylised word "adora" written in white, with the

strapline “spreading love & joy” underneath in a smaller white typeface. The word adora will be recognised as an invented word with no meaning. On this basis, I consider that the opponent’s mark is inherently distinctive to a high degree.

Likelihood of confusion

66. 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. This includes 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.

67. 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 medium degree.
- I have found the marks to be aurally similar to a medium degree, or between a low and medium degree, depending on how the opponent’s mark is pronounced.
- I have the distinctive and dominant elements of the parties marks, the invented words “adora” and “Aidor”, to be conceptually neutral. However, as the marks both share heart devices which will evoke the concept of love, I consider that they are conceptually similar to between a low and medium degree.
- I have found the opponent’s mark to be inherently distinctive to a high degree.

- I have identified the average consumer for the goods to be the general public, specifically children (with adults most likely purchasing the goods), who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods vary from being identical to similar to a low degree.

68. Therefore, taking all of the above into account, bearing in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind, I find that there is direct confusion.

69. The dominant and distinctive elements of the parties marks are the invented words "adora" and "Aidor", which are conceptually neutral. This results in the opponent's mark being inherently distinctive to a high degree, and it means that there is no conceptual hook in order to assist in differentiating between the invented words. The words "adora" and "Aidor" are both composed of 5 letters and overlap in the letters A, D, O and R. The marks also both contain heart devices. I note that the applicant's mark consists of the baby/child device at the beginning of the mark, however, considering that the goods are for children/babies, this device is somewhat allusive, and therefore could be easily overlooked. Consequently, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the overall level of visual similarity between the marks, the predominantly visual purchasing process, and the identity and the similarity of the goods, will lead the average consumer to mistake one mark for the other.

70. Therefore, taking all of the above into account, I consider there to be a likelihood of direct confusion, even where there is a low degree of similarity between the goods, due to the effect of the interdependence principle.

CONCLUSION

71. The opposition is partially successful in respect of the following goods, for which the application is refused:

Class 28 Toys for pets; Toys; Stuffed toys; Dolls' houses; Dolls; Dolls' clothes; Ball-jointed dolls [BJD]; Action figures.

72. The application can proceed to registration in respect of the following goods, for which the opposition has been unsuccessful:

Class 28 Fishing tackle; Play tents.

COSTS

73. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the opponent's only partial success. In the circumstances, I award the opponent the sum of **£1,050** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing and filing evidence	£450
Preparing and filling written submissions in lieu	£300
Official Fee	£100
Total	**£1,50**

74. I therefore order Dongguan Binxing Toys & Gifts Co., Ltd. to pay Charisma Brands LLC the sum of £1,050. 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 10th day of October 2023

L FAYTER
For the Registrar