

O/1019/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3765777

IN THE NAME OF SHASHI KIRAN GOSSAIN

FOR THE TRADE MARK

DERMAROLLEX

IN CLASS 10

AND

THE OPPOSITION THERETO UNDER NUMBER 436246

BY ROLEX S.A

Background and pleadings

1. On 15 March 2023, Shashi Kiran Gossain (“the applicant”) applied for the trade mark DERMAROLLEX in class 10 for *medical devices* (number 3765777).

2. Following publication, the application was opposed by Rolex S.A (“the opponent”) under section 5(3) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following earlier trade mark registration, dating from 18 May 1931:

(i) 522880

ROLEX

Relying on class 14: *watches; horological and chronometric instruments.*

3. The opponent claims an exceptional reputation in its mark and claims that the relevant public will believe that the applicant’s goods come from the opponent or an undertaking linked to the opponent because of the visual and phonetic similarities between the marks. It states that ROLLEX is the more distinctive part of the mark because DERMA is “generally descriptive of the goods pertaining to the skin or dermatology.” Further, the opponent claims that the contested applications will ‘ride on the coat tails’ of the earlier mark, unfairly benefitting from its repute, including its aura of quality and prestige. The opponent also claims that use of the contested mark will erode the high level of distinctiveness of the earlier mark and damage its repute if used in relation to goods of poor quality.

4. The applicant filed a defence and counterstatement, denying the ground of opposition. They deny that the marks are similar. The applicant puts the opponent to proof that it has made genuine use of the mark in relation to the goods upon which it relies. The applicant denies that the earlier mark has a reputation in the UK for the goods relied upon.

5. The opponent is professionally represented by D Young & Co LLP and the applicant by Murgitroyd & Company. The opponent filed evidence and the applicant filed

submissions during the evidence rounds. Neither party requested a hearing, and only the opponent filed written submissions in lieu of a hearing. I make this decision after a careful consideration of all the papers.

6. Section 5(3) of the Act states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

7. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (“CJEU”): Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12 P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:¹

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

¹ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Proof of use

8. The applicant puts the opponent to proof of use of its earlier mark.² They also deny that the earlier mark has a reputation in the UK. A mark with a qualifying reputation for section 5(3) is almost certain to have been put to genuine use during the five years preceding the relevant date, which is the filing date of the application (15 March 2022). I will therefore start by considering whether the earlier mark has acquired a qualifying reputation for the purposes of section 5(3), which requires evidence of a reputation amongst a significant part of the relevant public, as stated in *General Motors*:

² See section 6A of the Act.

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

9. The opponent’s evidence comes from Robert De Leyser, Managing Director of The Rolex Watch Company Limited, an affiliate company of the opponent.³ I consider it a notorious fact that ROLEX is a famous mark in the UK for luxury watches. I will give below highlights from the opponent’s evidence. I do not consider that the evidence extends generally to horological and chronometric instruments, also relied upon and of which watches are a subset. Although the advertising and sports sponsorship evidence shows clocks and timers, such as those beside the scores at the annual Wimbledon tennis tournament and at Formula 1 motorsport races, this is not evidence of sales and of a reputation in clocks and timers *per se*.⁴

10. Mr De Leyser states that UK turnover figures are in excess of:

³ Witness statement dated 31 January 2023, and exhibits RDL1-14.

⁴ Examples are shown in Exhibit RDL10.

2021: £125 million
2020: £114 million
2019: £100 million
2018: £90 million
2017: £80 million

11. UK advertising figures are in excess of:

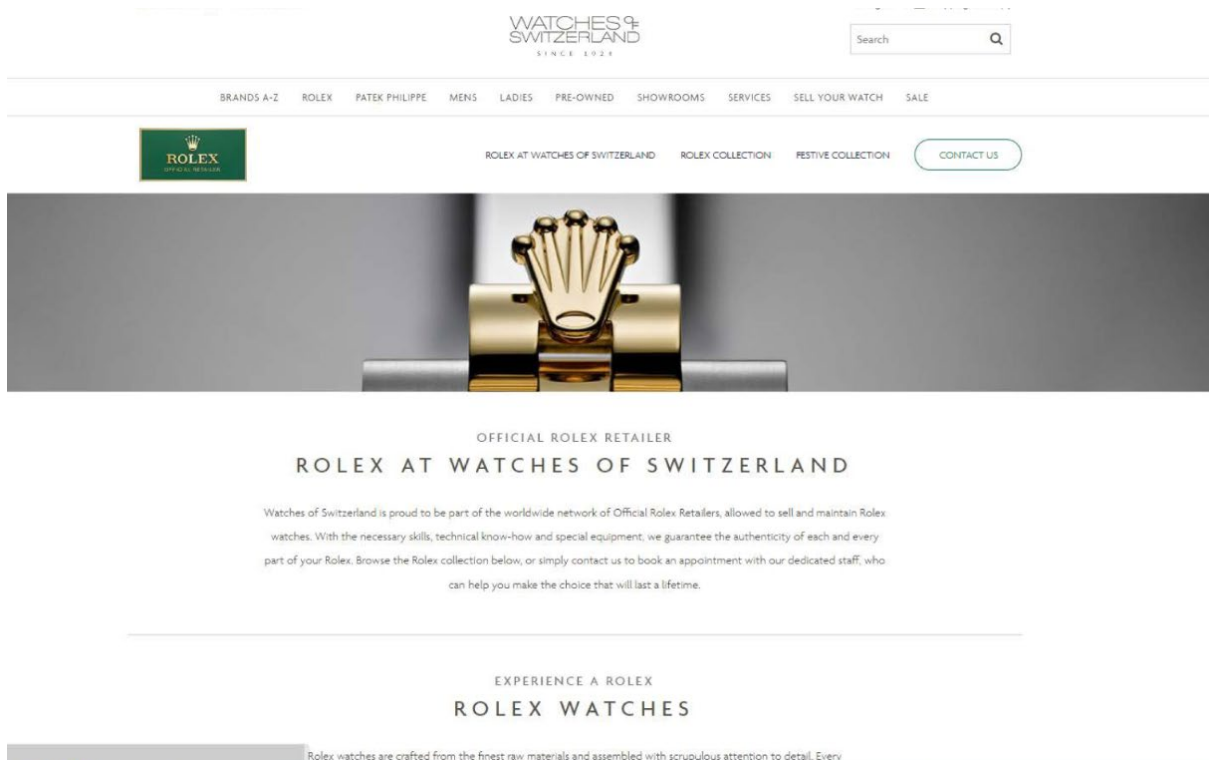
2021: £6 million
2020: £2.8 million
2019: £2.6 million
2018: £3.3 million
2017: £2.8 million

12. The opponent's website had the following number of hits from the UK:

2021: 6.7 million
2020: 5.9 million
2019: 5.2 million
2018: 5.4 million
2017: 4.7 million

13. The opponent sells its watches in the UK through retailers which include Goldsmiths, Watches of Switzerland, Mappin & Webb, and Wempe; for example:⁵

⁵ Exhibit RDL6, Wayback Machine internet archive dated 3 December 2019.



14. There is plenty of use shown in the evidence of ROLEX *per se*, in advertising, as in the above example. The opponent's watches also bear the mark in the following form, which is sufficient for a reputation in ROLEX, solus (and for genuine use):⁶



15. These images are from the opponent's 2020-2021 catalogues which Mr De Leyser confirms were distributed to official Rolex retailers in the UK.⁷

⁶ See *adidas AG v EUIPO*, case T-307/17, EU:T:2019:427 and *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 (CJEU).

⁷ Exhibit RDL9.

16. I agree with the opponent that “as a result of the Opponent’s extensive and exclusive use, the Earlier Mark is synonymous with quality and prestige and benefits from a huge reputation”. As above, the reputation is in relation to watches, and the proof of use burden is satisfied by the evidence in relation to watches.

17. The opponent claims that, on the above basis, and because the mark is entitled to a correspondingly wide scope of protection, the “Earlier Mark is known to a significant part of the public concerned so that when confronted by a similar mark such as the Application, the public is bound to make a mental link between the respective marks.”⁸

18. I do not agree. The marks are visually similar only to a very low degree. DERMAROLLEX consists of eleven letters and ROLEX of five. The only similarity arises from the 6th letter of DERMAROLLEX onwards and, even then, there is a double L which is absent from ROLEX. The opponent submits that the contested mark incorporates the entirety of the earlier mark, which is not correct because the earlier mark has one L, not a double L.

19. The contested mark consists of four syllables, twice as many as the earlier mark. I accept that the third and fourth syllables of the contested mark sound the same as the earlier mark if pronounced with a long ‘O’ sound. Balancing this with the entirely different first two syllables in the contested mark, the parties’ marks are aurally similar to a low degree. If pronounced with a short ‘O’ sound, the marks are less similar still.

20. The marks are not capable of comparison on a conceptual basis. The parties appear to agree about this, although both have made submissions to the effect that DERMA signifies skin or dermatology. If this would be perceived, the marks are still conceptually different. If the word ‘roll’ is evoked in the contested mark, this does not bring the marks any closer conceptually because ‘roll’ will not be evoked in ROLEX.

21. The applicant has made submissions which include facts not given as formal evidence about the goods they actually sell and how much they cost compared to the

⁸ Statement of case attached to its notice of opposition (form TM7).

opponent's watches. Quite apart from such submissions not being acceptable because they have not formally been filed as evidence, they go nowhere because the assessment is based on notional use of the application for all the goods which are covered by the specification.

22. The parties' goods are not similar.

Is there a link?

23. The relevant public comprises the general public for both marks since medical goods cover those used by the public as well as health professionals. If the relevant public calls the earlier mark to mind upon seeing the contested mark, this is sufficient for a link to be made.

24. A factor in the opponent's favour is that its mark is highly distinctive inherently and that this distinctiveness has been elevated to an even higher level by virtue of its long, established use with high levels of turnover and advertising expenditure. ROLEX is a famous mark for watches.

25. Pulling in the other direction is the very low (visual) and low (aural) degree of similarity between the parties' marks and the complete lack of similarity between the goods. The goods will largely be purchased visually, and the visual similarity is lower than it is aurally. The opponent submits that because DERMA invokes skin it is less distinctive than ROLLEX and will cause more focus to be placed on the latter element. Even if I were to accept this, I still consider that there will be no link because of the lack of any meaningful similarity between the marks overall and the total lack of similarity between the goods. Whilst it is not necessary that the goods be similar, the relative distance between them is one of the factors which must be assessed in deciding whether the relevant public will make a link between the marks.

26. The opponent points out that, in paragraph 20 of its submissions, the applicant says:

“Given the ordinary meaning of all the elements of the Applicant’s mark, the Opponent’s mark may be brought to the mind of the consumer in passing only. Taking into consideration the clear dissimilarity of the goods, the mark applied for does not take unfair advantage of the Opponent’s mark.”

27. The opponent submits that this is a concession by the applicant that there will be a link made between the parties’ marks. Paragraph 20 of the applicant’s submissions is somewhat contradictory to paragraph 16 where the applicant says “...neither the marks nor the goods are sufficiently similar to create such a link in the minds of the relevant public”. However, paragraph 16 was in the context of the applicant’s erroneous submissions about what goods the applicant actually sells and how much they cost. Paragraph 20 appears to submit that if there is a link, it will be in passing only and not enough to give rise to unfair advantage.

28. The applicant’s submissions are unsatisfactory because they are unclear as to whether the applicant concedes a link will be made, bearing in mind that even a ‘passing’ bringing to mind is enough for a link. Without the applicant’s submissions, my own view is that there will not be a link for the reasons given above. However, since the applicant’s submissions look as though they might have made a concession, I will proceed on this basis, which gives the opponent its best case.

29. I find that the link will be too passing, or fleeting, to cause any of the types of damage alleged by the opponent, even taking into account the strength of reputation enjoyed by the opponent’s mark. I agree that the opponent’s mark has a reputation for luxurious and prestigious watches. The opponent claims that the image of the mark includes precision engineering of its watches. I consider that if so, such an image is part and parcel of the image of its luxury Swiss watches and that there is no separate image for precision engineering. Even assuming that the link made is more than fleeting, it is far-fetched to stretch this image as attaching itself to medical devices, even if they are precision instruments.

30. However, my primary finding is that the bringing to mind will be too weak; it will be gone almost as soon as it was there and will not cause a change in the economic behaviour of the applicant’s customers and make them more likely to buy the

applicant's goods because of the earlier mark. Similarly, the fleeting nature of the link will not cause the hold of the opponent's mark in the minds of its consumers to weaken and make them less likely to buy the opponent's watches. The claim that the reputation of the opponent's mark will be tarnished is purely speculative and unsustainable.⁹ In short, the link will be so inconsequential that it will not lead to any of the claimed heads of damage, including the opponent's claim that the relevant public will believe that the applicant's goods come from the opponent or an undertaking linked to the opponent because of the visual and phonetic similarities between the marks.

31. The opponent refers to *Environmental Manufacturing LLP v OHIM*, submitting that it does not need to submit evidence of actual detriment to distinctive character but that it is enough for it to show evidence of a serious future risk of detriment, which can be done on logical deductions.¹⁰ I note that, at paragraph 37 of its judgment, the Court also said that the "mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment...". With regard to the section of the judgment upon which the opponent bases its submissions, the Court said:

"43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'."

32. Detriment to the distinctive character arising from use of the contested mark is inherently improbable and the opponent's case is based on mere suppositions, not logical deductions, which include the very low degree of visual similarity between the marks for visual purchases, the differences between the marks overall, and the completely different goods.

⁹ See *Unite The Union v The Unite Group Plc*, Case BL O/219/13, Ms Anna Carboni sitting as the Appointed Person.

¹⁰ Case C-383/12 P, CJEU.

33. The ground of opposition is not made out because even if there is a link, there is no damage of any type claimed by the opponent.

Outcome

34. The opposition fails.

Costs

35. The applicant has been successful and is entitled to a contribution towards the costs of the proceedings. Costs are based upon the scale of costs published in Tribunal Practice Notice 2/2016, the scale allowing for the range of procedural and substantive issues that are generally found in cases before this Tribunal. I have reduced the award for the applicant's submissions in lieu of a hearing in view of the procedurally irregular inclusion of 'evidence' and the submissions tied to that. The award for considering evidence is less than the scale minimum of £500 which envisages evidence filed by both parties. The breakdown of the cost award is as follows:

Considering the opposition and filing the counterstatement	£400
Considering the opponent's evidence	£300
Submissions in lieu of a hearing	£150
Total	£850

36. I order Rolex S.A to pay Shashi Kiran Gossain the sum of **£850**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of November 2023

Judi Pike
For the Registrar