BL0-115-22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK
APPLICATION NO. 3434315

PURITY
HEMP COMPANY
IMPROVING LIFE AS NATURE INTENDED

BY PURITY WELLNESS GROUP LTD
(Applicant/Appellant)

AND

IN THE MATTER OF OPPOSITION NO. 419115 THERETO
BY THE STOCKROOM (KENT) LTD
(Opponent/Respondent)

AND

IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO. O/391/21
OF MR. C J BOWEN DATED
25 MAY 2021

Mr. Nick Zweck of Counsel instructed by Briffa Solicitors appeared for the Applicant/Appellant.

Mr. James Mitchell of JP Mitchell Solicitors appeared for the Opponent/Respondent.

Hearing date: Wednesday 6 October 2021

DECISION

Introduction

1. This is an appeal against a decision (BL O/391/21) of Mr C J Bowen, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 25th May 2021. By that decision the Hearing

Officer upheld Opposition No. 419115 by the Opponent in its entirety. He ordered the Applicant to pay the Opponent £1300 as a contribution towards its costs.

The Application and the Opposition

2. On 7 October 2019 the Applicant filed application No. 3434315 to register the trade mark

Class 3 – Ethereal oils; Natural essential oils; Essential vegetable oils; Essential oils for soothing the nerves; Essential oils for the care of the skin; Essential oils for aromatherapy use; Essential oils for personal use; Skin cream; Body cream.

Class 5 – Dietetic food and substances adapted for medical use; Nutritional supplements; Dietary supplements based on hemp proteins, hemp seed, hemp oil or CBD oil.

Class 35 – Retail and online retail services in relation to essential oils, etheric oils, scented oils, aromatic oils, ethereal oils, essential vegetable oils, emulsified essential oils, blended essential oils, natural essential oils, aromatic essential oils, terpenes [essential oils], essential oils of citron, essential oils of cedar wood, essential oils of lemon, ethereal essences and oils, skin care creams, skin care mousse, essences for skin care, skin care lotions, skin care oils.

The application was published on 18 October 2019.

3. The Opponent filed opposition on 17 January 2020 August 2017. Objection to registration was taken under section 5 (2) (b) of the Trade Marks Act 1994 ("the Act"). Section 5 (2) (b) of the Trade Marks Act 1994 provides that a trade mark shall not be registered if, because 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 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.

4. The opposition was based on the following registered trade mark (the "Earlier Mark"):

Registration No. 3077295

Trade Mark: Purity Gel

Specification of Goods: Class 3 - *"Professional Nail Products; UV Gel; LED Gel; Gel Polish; Non-medicated beauty preparations."*

5. Both parties filed evidence and written submissions in the course of the evidence rounds. No hearing was requested, however, and the Decision was taken "on the papers", only the Opponent filing submissions in lieu.

The Hearing Officer's Decision

Comparison of Goods and Services

6. The Hearing Officer noted at [32] that the Opponent's class 3 specification included "non-medicated beauty preparations" at large. He further determined that, despite the Applicant's submissions to the contrary, all of its class 3 goods fell within that general term and were to be regarded as ***identical,*** citing *Gerard Meric v OHIM* Case T-13/05.

7. Turning to the comparison of the Applicant's class 5 goods with the class 3 goods of the Opponent, notwithstanding the "dietary" nature of the former, at [34] the Hearing Officer determined such goods could in principle be used to improve a consumer's appearance in a way that overlapped with the latter. He concluded that there was a medium degree of similarity between such goods.

8. With regard to the Applicant's class 35 services, since these concerned the retail of goods identical to the Opponent's class 3 goods, at [35] he found there was a medium degree of similarity.

The Average Consumer

9. The Hearing Officer identified the Average Consumer of the goods in issue as being either member of the general public or a professional user of dietary or beauty products, mostly utilizing visual selection without excluding aural considerations. Given the competing goods were topical or oral in application/use the Hearing Officer determined that the Average Consumer would exhibit a higher-than-normal degree of attention.

10. In contrast, the degree of attention paid in relation to retail services was held to be "medium (normal".

Comparison of Marks

Overall Impression

11. At [41] the Hearing Officer found that the Earlier Mark was dominated by the word "Purity", the word "Gel" being descriptive. In particular, the Hearing Officer held that it was in the word "Purity" "that the overwhelming majority of the distinctiveness lies:"

12. As for the Contested Mark, at [42-43] It was determined that the graphic "stylised hemp leaf" and the word PURITY, given their size and positioning, made an important contribution to its overall impression and distinctiveness. In contrast the words "HEMP COMPANY" would "be regarded by the average consumer as descriptive" and that "any distinctiveness they may possess is likely to be, at best, low". As for the words "IMPROVING LIFE AS NATURE INTENDED" their size, positioning and context meant their contribution to the overall impression and distinctiveness of the Contested Mark was "at best, low".

Similarity of Marks

13. At [45] it was found that taking account of the differences between the marks, the common word PURITY gave rise to a low-medium degree of visual similarity.

14. In contrast, in aural terms, the presence in both marks of the word PURITY would give rise to at least medium aural similarity, with the additional possibility that these would be the only pronounced words on both marks, giving rise to aural identity [46].

15. As to conceptual similarity, the marks shared the concept of "purity", and they were therefore conceptually similar to a medium degree [47].

Distinctive Character of the Earlier Mark

16. Noting the meaning of the word "purity" as being well-known the Hearing Officer concluded at [51] that Earlier Mark had "a low degree of inherent distinctive character".

Likelihood of confusion

17. A likelihood of direct confusion (mistaking one mark for the other) was ruled out at [57].

18. In contrast, however, it was held that the risk of indirect confusion (mistaking the mark as another brand of the Opponent) was made out, "notwithstanding the low degree of inherent distinctive character the opponent's trade mark enjoys" [59].

Overall Conclusion

19. The opposition succeeded in full, with costs for the Opponent [60].

The Appeal

20. The Opponent filed an appeal on 22nd June 2021. The grounds of appeal are:

Comparison of Marks

1. The Hearing Officer erred in his comparison of the marks.

In particular:

a) The word Gel in the Earlier Mark had an independent, distinctive role.

b) By ignoring the word "gel" the Hearing Officer engaged in an unprincipled dissection of the Earlier Mark, treating it simply as a registration for "Purity".

c) The Hearing Officer erred by dissecting the Contested Mark so as to overlook the stylised hemp leaf and its effect in comparing the parties' marks.

d) The Hearing Officer failed to address/give appropriate weight to the composite nature of Purity Gel which gives the mark a different meaning to its components taken separately.

e) The Hearing Officer gave too much weight to the presence in both marks of the word "Purity".

f) As a result, the Hearing Officer should have found only low degrees of aural/visual similarity and that the marks were conceptually different.

Comparison of Goods

2. The Hearing Officer erred in comparing the Applicant's class 5 goods and the Earlier Mark's goods since they are not competitive, are used differently and target different consumers. The Hearing Officer should have found these goods to be dissimilar.

Indirect Confusion

3. The Hearing Officer erred as to the likelihood of indirect confusion, by giving insufficient weight to the finding that the Earlier Mark is of low distinctive character, especially as to the word "Purity". Alternatively, Purity Gel is a single unit with a different meaning to the contested mark. In either case the Hearing Officer should have concluded there was no risk of indirect confusion.

21. There was no Respondent's Notice.

22. At the hearing of the Appeal on 6th October 2021 the Applicant/Appellant was represented by Mr. Nick Zweck of Counsel, instructed by Briffa Solicitors. The Opponent/Respondent was

represented by Mr. James Mitchell of JP Mitchell Solicitors. I am grateful to both parties' representatives for their skeleton arguments and helpful submissions.

Standard of Review

23. Although the parties cited some different authorities, I detected no dispute as to the essential principles and standard to be applied, these being well-settled. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. As regards matters of factual evaluation, appellate tribunals should not interfere unless the disputed conclusion is outside the bounds within which reasonable disagreement is possible. In order to intervene I must be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong - Reef *Trade Mark* [2003] RPC 5; and *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 at [78] to [81].

24. I bear these principles in mind.

Merits of the Appeal

Ground 1

25. Ground 1 has several strands, not all of which were "pushed" equally at the Hearing but all of which, ultimately, came down to the same thing, namely that the Hearing Officer erred in assessing matters which should ultimately have led him to find the marks had only a low degree of visual/aural similarity overall and were conceptually different, as opposed to his actual findings of "low-medium" visual similarity, "at least a medium degree" of aural similarity (subject to a further point I discuss below) and a "medium degree" of conceptual similarity.

26. Prior to commencing his assessment under S. 5 (2) (b) of the Act the Hearing Officer reminded himself at [9] of the general principles gleaned from long-standing case law, including:

"…(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 the public by a composite trade mark may be dominated by one or more of its components;"

27. Before moving on to specifically assessing the similarity of marks the Hearing Officer reminded himself, at [39-40], of the need to avoid "artificial dissection" of the marks:

"39. 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 them, 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."

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

28. It is worth noting here that in its skeleton argument the Applicant conceded that the word PURITY was, if nothing else, the dominant element in the Earlier Mark.

29. The main line of attack was, in essence, that in comparing both marks the Hearing Officer dissected them to give undue weight to the common word PURITY. The high point of this is his assessment of aural similarity at [46] where he states:
"As all of the words in the competing trade marks will be well-known to the average consumer the manner in which they will be articulated is entirely predictable. It is, of course, also well-established that when a trade mark consists of a combination of words and figurative components, it is by the word components that it is most likely to be referred to. ***As the word "Gel" in the opponent's trade mark is descriptive, it is highly likely that the average consumer***

will not articulate it. *Given its size and positioning and as it is in the nature of a strap-line,* ***the same is, in my view, likely to be true of the words "IMPROVING LIFE AS NATURE INTENDED" in the applicant's trade mark***. ***As the words "HEMP COMPANY" qualify the word which appears above them, it is possible they will not be articulated by the average consumer***. *However, even if they are, the aural comparison is, from the applicant's perspective, at best between "Purity Gel" and "PURITY HEMP COMPANY". As the word "Purity"/ "PURITY" would be the first word articulated in both scenarios, there is at least a medium degree of aural similarity between the competing trade marks. However,* ***it is equally likely given the descriptive nature of the words which follow them that the competing trade marks will be pronounced simply as "Purity"/ "PURITY", i.e. they will be aurally identical."*** (Emphasis added)

30. In my view there is something in the Applicant's complaint of unprincipled dissection, at least when it comes to the aural comparison. As the Hearing Officer reminded himself, the case law is clear that *"the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details" and "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 element. (Emphasis added).***

31. Whilst it is a reasonable conclusion as regards the barely visible "strap" or "puff" phrase **"**IMPROVING LIFE AS NATURE INTENDED" in the Applicant's mark, it is self-evident that neither Gel in Purity Gel nor HEMP COMPANY in the Contested Mark can be regarded as "negligible". Descriptiveness does not of itself render an element negligible or aurally invisible. Furthermore, the terms Purity Gel and PURITY HEMP COMPANY each have a unitary character that extends beyond the individual elements.

32. Thus, insofar as the Hearing Officer concluded that these elements could be simply ignored in the aural comparison because they were descriptive, giving rise to a finding of potential identity based on the common element PURITY, I find he went too far and engaged in an unprincipled dissection of the parties' trade marks.

33. However, it must be noted that the Hearing Officer insulated himself by considering the alternative that these terms *would* be articulated:

However, even if they are (articulated), the aural comparison is, from the applicant's perspective, at best between "Purity Gel" and "PURITY HEMP COMPANY". As the word "Purity"/ "PURITY" would be the first word articulated in both scenarios, there is at least a medium degree of aural similarity between the competing trade marks.

34. In that respect, and as regards the Hearing Officer's other findings as to the similarity of the marks, I recall the observation of Mr Iain Purvis QC sitting as the Appointed Person in BL O/106/20 *GREYBOX* at [23]:
"I do not consider there is any great value in debating differences between 'fairly low' and 'medium' degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise 'weight' to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal."

35. That applies equally here. Notwithstanding my finding that the Hearing Officer erred in excluding aural elements of the marks in pursuit of a finding of identity, his alternative finding of a medium degree of aural similarity is properly reasoned. The same is true for his findings as to visual similarity (between low and medium) and conceptual similarity ((at least medium). The arguments to the contrary are just a debate about "weight".

36. Consequently, **whilst the Applicant has been successful on the isolated finding of aural identity through unprincipled dissection, in all other respects Ground 1 fails and the Hearing Officer's remaining findings as to the similarity of the marks, stand.**

Ground 2

37. In essence, the Appellant challenges the Hearing Officer's findings on the comparison of the class 3/class 5 goods, going so far as to suggest the Hearing Officer should have concluded there was no similarity at all, rather than that there was medium similarity.

38. No specific error of principle was identified by Mr Zweck for the Applicant, either in his skeleton or before me. Instead, it was said the Hearing Officer was "plainly wrong" in his conclusions.

39. The Hearing Officer dealt with this at [34]:

"34. The evidence shows, unsurprisingly in my view, that large UK undertakings such as Boots and Holland & Barrett conduct a trade in a wide range of goods which fall within classes 3 and 5. There is, therefore, likely to be an overlap in the trade channels of the applicant's and opponent's goods as there will in the users. The nature of the competing goods and their methods of use are, however, likely to differ. I also note that the opponent's evidence contains a references [sic] to, inter alia, "Vitabiotics Perfectil Plus…Tablets", the packaging of which contain references to "Skin, Hair and Nails." Thus it appears that the average consumer may, for example, chose to correct what it considers to be deficiencies in those areas of his/her body and improve their outward facing appearance by using either the opponent's goods externally or by ingesting the applicant's goods, resulting in an overlap in the intended purpose of the competing goods as well as creating a likely competitive relationship between them. However, in the sense outlined in the case law, there is, at least as far as I can tell, no meaningful degree of complementarity between the goods. Weighing the relative importance of the various similarities and differences I have identified, results in what I consider to be a medium degree of similarity between the applicant's goods in class 5 and the opponent's goods."

40. It will be seen that in support of his finding on similarity the Hearing Officer referred to evidence showing that ingestible class 5 products aimed at improving one's appearance were available. It is not suggested that he should not have relied on that evidence.

41. The core of the Appellant's argument was that the finding of "medium similarity" resulted from the analysis being pitched at too high a level of generality. As Mr Zweck put it, it led to *"the extreme conclusion that multivitamin pills are in direct competition with face creams or nail polish"*. He went so far as to submit that *"it defies common sense to suggest that the average consumer in the market for some moisturizing cream might buy some multivitamins instead"*.

42. Of course, in the context of similarity of goods (as opposed to marks) that ignores the possibility the consumer might buy such goods *as well as*, rather than instead of, each other, to do (ultimately) the same or a similar thing. It also ignores the fact that the Hearing Officer was referring to those pills as an example and that he was tasked with comparing the full specifications of the marks, such as the Applicant's Class 5 goods:

    Dietetic food and substances adapted for medical use; Nutritional supplements; Dietary supplements based on hemp proteins, hemp seed, hemp oil or CBD oil

    With the Opponent's widest goods in class 3:

"…Non-medicated beauty preparations".

43. Mr Zweck also likened the comparison to whisky versus wine, saying "*There are decisions where courts have said wine is not similar to whisky and Whyte & MacKay* (which we shall come to later) *was one such case".* In fact, it was not – in *Whyte & MacKay* the finding was that these were goods of low similarity and this was not challenged on appeal. In any event, the similarity, or lack of it, as between goods is often nuanced and something on which the courts and tribunals may - and do – frequently disagree within reasonable bounds. The assessment is precisely the sort of evaluative, weight-based exercise which Appellate bodies are urged to leave well alone. As far as I can see, the Hearing Officer discharged his obligations properly.

44. Thus, the Applicant's arguments are, in essence, mere disagreements with the Hearing Officer's conclusions. That is not a basis for Appellate intervention. Without more, there is certainly nothing that was "plainly wrong" about the Hearing Officer's approach or conclusions.

45. The outcome is that **Ground 2 fails entirely**.

Ground 3

46. This challenge is directed to the Hearing Officer's findings on indirect confusion (there was no appeal as to direct confusion). The main thrust is that the Hearing Officer failed to take into account the implications of the low distinctive character of the common element PURITY. Alternatively, insufficient weight was given to the composite nature of PURITY GEL as a single unit. At the Hearing, Mr Zweck focussed very much on the former point.

47. Mr Zweck took me first to *Whyte and Mackay Ltd v Origin Wine UK Ltd* [2015] F.S.R. 33. For present purposes, the key passage in the judgment of Mr Justice Arnold (as he then was) is at [44]:

"…what can be said with certainty is that, if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion."

48. Next Mr Zweck took me to *Nicoventures Holdings Limited v The London Vape Company Limited* [2017] EWHC 3393 (coincidentally, also an appeal from a decision of the Hearing "Officer in the

instant case). At [27] Mr Justice Birss (as he then was), having agreed with Arnold J's statement of principle cited above, said this:

"*…If the only similarity between two marks arises from common elements which have low distinctiveness (alone and as a combination) then that tends to weigh against a finding of likelihood of confusion. Such a situation does not preclude a finding of likelihood of confusion but it is a relevant factor and in an appropriate case it may be decisive."*

49. Further on, at [31] the learned judge said:

"The nature of the common elements needs to be considered and in a case like this, in which the common elements are elements which themselves are descriptive and non-distinctive (as the Hearing Officer found in paragraph 34), it is necessary somewhere to focus on the impact of this aspect on the likelihood of confusion. As has been said already it does not preclude a likelihood of confusion but it does weigh against it. There may still be a likelihood of confusion having regard to the distinctiveness and visual impact of the other components and the overall impression but the matter needs to be addressed."

50. Since in the case before me the Hearing Officer based his ultimate finding on the presence in both marks of the word PURITY, in the light of the above-mentioned principles his task included giving consideration to the degree to which the word was descriptive/non-distinctive and the impact of that assessment on his multifactorial evaluation. The Applicant's case is that the Hearing Officer failed to carry out this task.

51. In order to assess that, it is necessary to review the various "waypoints" within the Decision where the Hearing Officer reached conclusions which would inform his ultimate assessment.

52. Starting at [41], considering the overall impression of Earlier Mark, the Hearing Officer said:

"The opponent's trade mark consists of the words "Purity" and "Gel" presented in title case in standard characters; both words and their meanings will be very well-known to the average consumer. When considered in relation to the goods for which the opponent's trade mark is registered, the word "Gel" is likely to be regarded as descriptive in nature (indeed it actually appears in the opponent's specification). That being the case, and as "Purity" appears as the first word in the opponent's trade mark, means that it is that word which will dominate the overall

impression the trade mark conveys and it is in that word the overwhelming majority of the distinctiveness lies."

Mr Zweck, for the Applicant, took no issue with the finding that PURITY was dominant or was the site of the Earlier Mark's distinctiveness, such as it was, but noted that there was a failure to consider the extent of the distinctiveness of PURITY, which he submitted was very low.

53. It is notable that the Hearing Officer readily accepted that '*both words and their meanings will be very well-known to the average consumer",* which indicates he was at least aware that PURITY had a relevant meaning. However, whilst the Hearing Officer makes a point of analysing the descriptive nature of "Gel", he says nothing here about any descriptive nature of "Purity". It may well be that this is where "the overwhelming majority of the distinctiveness lies" but it begs the question of how much distinctiveness there actually is, either in that word or the mark as a whole. Indeed, the maximalist reference to an "*overwhelming*" majority of distinctiveness could suggest that the word "Purity" is being seen as having an inherently high distinctive character.

54. The Hearing Officer moved on to consider the impression of the Contested Mark at [42-43]:

42. This consists of a number of components. The first, is a device presented in the colours yellow, blue and orange which the opponent describes as a "stylised hemp leaf"; that, I think, is a fair characterisation. The second component consists of the word "PURITY" presented in capital letters in the colour yellow in a conventional typeface. The third component is smaller than the word "PURITY" which appears above it and consists of the words "HEMP COMPANY" presented in capital letters in the colour blue in a conventional typeface. The fourth and final component is much smaller again and consists of the words "IMPROVING LIFE AS NATURE INTENDED" presented in capital letters in a conventional typeface in the colour yellow.

43. Given its size, positioning, colouring and stylisation, the first component will make an important contribution to both the overall impression conveyed and the trade mark's distinctiveness. I reach the same conclusion in relation to the second component. While the words "HEMP COMPANY" will contribute to the overall impression conveyed, given their size, positioning and as they are likely to be regarded by the average consumer as descriptive in nature (describing as they do the nature of some of the goods in which the undertaking concerned conducts a trade), any distinctiveness they may possess is likely to be, at best, low. Finally, even if the words "IMPROVING LIFE AS NATURE INTENDED" have any inherent distinctive character (which, in my view, is arguable), given their size and positioning in the context of the

trade mark as a whole, any contribution they may make to the overall impression and distinctiveness will, once again, be, at best, low.

55. Again, there is an analysis of the distinctive character of some elements, but *not* of the shared, and crucial, component PURITY, notwithstanding it is acknowledged to make an "important contribution" to the mark.

56. Going forward to [51] it is here that the Hearing Officer addresses the distinctive character of the Earlier Mark:

"51. As I mentioned earlier the word "Purity" and its meaning will be well-known to the average consumer. However, for the avoidance of doubt, I note that collinsdictionary.com defines "purity" as "the state of being pure". It further defines "pure" as "a pure substance is not mixed with anything else" and "something that is pure is clean and does not contain any harmful substances." The word "Gel" in the opponent's trade mark will be regarded as descriptive in nature. Considered in that context, as a totality, the opponent's trade mark is likely to be understood as meaning, for example, goods in the form of gel which do not contain any harmful substances. Given the obvious desirability in many areas of trade to indicate to a potential consumer that goods are free from harmful substances, but particularly in relation to those to be applied to the body, absent use, the opponent's trade mark has, in my view, a low degree of inherent distinctive character."

57. From this passage it is clear the Hearing Officer had in mind at this point that PURITY has some meaning in relation to the goods/services in issue. It is also notable that, whilst repeating that Gel is descriptive, for some reason the Hearing Officer does not consider whether PURITY is also descriptive, despite setting out its definition. He *does* comment – understandably - that "*as a totality, the opponent's trade mark is likely to be understood as meaning, for example, goods in the form of gel which do not contain any harmful substance"* and concludes that consequently the Earlier Mark has a low degree of distinctive character.

58. Mr Zweck submitted that, to be fair to the Hearing Officer, in order to reach the conclusion in [51] that he did, he must have considered that that PURITY was at least a "weak" element, given that he had already found that GEL had no distinctiveness to speak of. I agree, but what is crucial is whether this consideration, even if it is implicit, is carried through and this is all the more important given that the word PURITY is said to make an "important contribution" to both marks.

59. That brings us to the evaluation of the likelihood of indirect confusion. The Hearing Officer set out the general approach at [52-53] and this is uncontroversial. He then set out (at [54] the conclusions he has previously reached, and which will feed into his multi-factorial evaluation of the likelihood of confusion:

"54. Earlier in this decision, I concluded that:
• the applicant's goods in class 3 are identical to the opponent's "non-medicated beauty preparations" also in class 3.
• the applicant's goods in class 5 are similar to the opponent's goods to a medium degree.
• the applicant's services in class 35 are similar to the opponent's goods to a medium degree.
• the average consumer of the goods and services at issue is either a member of the general public or a professional user such as a beautician or dietician.
• whilst not ignoring aural considerations, the average consumer will select the goods and services at issue by predominantly visual means whilst paying, in the main, a higher-than-normal degree of attention to the selection of the goods and a medium (normal) degree of attention when selecting the services;
• the competing trade marks are visually similar to between a low and medium degree, aurally similar to at worst a medium degree (and potentially aurally identical) and conceptually similar to at least a medium degree.
• absent use, the opponent's earlier trade mark has only a low degree of inherent distinctive character.

60. Mr Zweck pointed out that nowhere is there an appreciation of the distinctiveness of the common component PURITY, the only comment being that the Earlier Mark has low distinctive character (last bullet point).

61. Next, at [55] the Hearing Officer quoted *L'Oréal SA v OHIM,* Case C-235/05 P:

"55. In L'Oréal SA v OHIM, Case C-235/05 P, the CJEU found that:
"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of

the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

62. Taken alone, *L'Oreal* confirms that the mere fact a prior mark is weak/of low distinctive character does not preclude a finding of a likelihood of confusion with a later mark containing the same or a similar element of equally low distinctive character. That is uncontroversial. However, it is not the whole story, and the application of the case's principle needs to be tempered by *Whyte and Mackay* (*ibid.* [49]) and, of course, by the individual facts of each case.

63. Having dismissed a likelihood of direct confusion, the Hearing Officer went on to assess the likelihood of indirect confusion. He set out the relevant principles at [57-58] and, again, this is uncontroversial. The next step was to draw all the relevant matters together and reach a conclusion, which he did at [59]:

"59. The word "Purity"/ "PURITY" is a distinctive component in both parties' trademarks and the competing goods and services are either identical (class 3) or similar to a medium degree (classes 5 and 35). Notwithstanding the low degree of inherent distinctive character the opponent's trade mark enjoys, even a consumer paying a higher-than-normal degree of attention during the purchasing process (who is, as a consequence less prone to the effects of imperfect recollection) is likely, in my view, to conclude that the applicant's trade mark is, for example, a variant brand being used by the opponent to indicate, for example, that its goods contain hemp. As that mistake on the consumer's part will result in indirect confusion, the opposition to all of the applicant's goods and services succeeds."

64. What is missing from this is any obvious application of the principle set out in *Whyte and Mackay/Nicoventures,* namely that "*if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion".*

65. In *Nicoventures* at [30], and in a point echoed before me by Mr Zweck, it was said this omission may not matter so much if it has obviously been addressed elsewhere in the decision. However, even though the meaning of PURITY is acknowledged, nowhere is the term expressly considered

to be anything other than "distinctive" even where, as at [51] the low distinctive character of other elements is being analysed.

66. For the Respondent, Mr Mitchell urged on me that the *Whyte and Mackay* principle had not been "lost sight of" as it was in *Nicoventures* (see *[29]* therein, for example) and that consequently the decision was sound. I suggested his main point was that the marks were both, in effect, "Purity" marks and he agreed.

67. It is correct that the Hearing Officer reached his conclusion based on the entirety of the earlier mark when he takes into account, at [59] "*the low degree of inherent distinctive character the opponent's trade mark enjoys"* (emphasis added). It might be said this implicitly recognises that PURITY, as a component, is of low distinctive character. However, if the distinctive character of PURITY has not been separately assessed it cannot be said with any certainty that the same conclusion would have been reached if it had been. Furthermore, the same form of analysis – focussing on the entirety of the Earlier Mark in lieu of its elements – occurred in the Hearing Officer's decision in *Nicoventures,* about which Birss J had this to say*:*

> *[29] It is true, as the respondent submits, that when the assessment of likelihood of confusion takes place in these paragraphs the Hearing Officer does refer to a very low degree of distinctive character. However that reference is at the start of paragraph 41 and is referring to the opponent's trade mark itself. What the Hearing Officer does not do in this section is consider whether the common elements between the two marks – that is VAPE and CO – are themselves elements with a low distinctiveness either alone or in combination.*

68. Had the Hearing Officer addressed that issue expressly, and applied *Whyte and Mackay*, it might have tipped the balance of his thinking and the outcome might have been different – or not. In such a situation his decision might have been impervious to appeal. All that can be said, though, is that the Hearing Officer ought to have clearly applied the *Whyte and Mackay* principle but that there is no nothing to show that he did so. Rather, the decision seems to proceed on the basis that whatever distinctiveness PURITY has, is sufficient to satisfy *L'Oreal*, and that is enough to give rise to a finding of a likelihood of confusion. In my judgment, the low distinctive character of PURITY and the principle of *Whyte and Mackay* were not so much "lost sight of" as not considered at all, in the final analysis

69. To be fair to the Hearing Officer, it does not appear that either party made any effort to draw his attention to *Whyte and Mackay*, or indeed to any specific authority, on the comparison of marks at first instance.

70. To sum up, in my judgment the Hearing Officer erred in assessing the likelihood of indirect confusion by failing to apply the principle of *Whyte and Mackay.* It follows that **Ground 3 is successful** and the matter needs to be re-assessed taking that into account.

71. I understood the parties to be content that if I upheld a ground of appeal I should (subject to my discretion) determine the matter myself rather than remit it back to the Registrar. I am satisfied that it is appropriate for me to proceed to determine the matter myself.

Re-assessment of the likelihood of indirect confusion

72. With an allowance for the partial success of Ground 1 of the Grounds of Appeal, I adopt the following findings of the Hearing Officer:
    - the applicant's goods in class 3 are identical to the opponent's "nonmedicated beauty preparations" also in class 3.
    - the applicant's goods in class 5 are similar to the opponent's goods to a medium degree.
    - the applicant's services in class 35 are similar to the opponent's goods to a medium degree.
    - the average consumer of the goods and services at issue is either a member of the general public or a professional user such as a beautician or dietician.
    - whilst not ignoring aural considerations, the average consumer will select the goods and services at issue by predominantly visual means whilst paying, in the main, a higher-than-normal degree of attention to the selection of the goods and a medium (normal) degree of attention when selecting the services;
    - the competing trade marks are visually similar to between a low and medium degree, aurally similar to at worst a medium degree and conceptually similar to at least a medium degree;
    - absent use, the opponent's earlier trade mark has only a low degree of inherent distinctive character.

73. The similarity between the marks, such as it is, arises from the common word PURITY. This is a term of very low distinctive character - if any - for both marks, connoting (as the Hearing Officer recognised) "the state of being pure", "a pure substance (which)is not mixed with anything else" and "something that is pure is clean and does not contain any harmful substances."

74. The Earlier Mark "Purity Gel" is unitary, describing a "gel of purity" or a gel which is pure. The key words in the Contested Mark are PURITY HEMP COMPANY, a unitary term denoting an undertaking dealing in hemp of purity or hemp which is pure, an impression emphasised to at least some consumers aware of such things by what the Hearing Officer called a "stylised hemp leaf".

75. The Hearing Officer correctly set out the principles applicable to indirect confusion at [57-58]:

"57.That leaves indirect confusion to be considered. In L.A. Sugar Limited v By Back Beat Inc, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:
"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are 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."

58. In Duebros Limited v Heirler Cenovis GmbH, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion."

I adopt and apply those principles.

76. The word PURITY in both marks is the only element that could give rise to a conflict. However, it is, as I have noted, of low distinctive character. Notwithstanding the Applicant conceded the word does have *some* distinctive character I would go so far as to say that in the Opponent's mark it has only the bare minimum of distinctive character commensurate with the fact it is embodied in a registered trade mark.

77. Given that the common element in the marks is of low inherent distinctive character, applying the *Whyte and Mackay* principle that points away from a likelihood of confusion.

78. Furthermore, both marks contain additional features which modify their impression, and which will not go unnoticed. "Purity Gel" suggests a gel-based product. PURITY HEMP COMPANY suggests a corporate entity and the mark is highly stylised including a prominent figurate hemp leaf design. All of these features help to differentiate the marks.

79. This means that the only point of similarity is a term PURITY which is of low distinctive character both of itself and in combination with the other unitary/combinatorial elements of each mark.

80. Thus, given *"The later mark is different from the earlier mark, but also has something in common with it"* will the average consumer nevertheless *"conclude that it is another brand of the owner of the earlier mark."*? I do not think so. The point about weak distinctiveness is that consumers will be less likely, depending on context, to jump to the conclusion the term is functioning in a distinctive, origin indicative way. I consider that to be the case here. The overall differences outweigh the similarity, which is entirely due to the weak components.

81. Even if the Contested Mark should call to mind the Opponent's mark, which I regard as highly unlikely, in my view this would amount to no more than "mere association".

82. Thus, I do not consider there is a likelihood of indirect confusion. It follows that the Appeal succeeds, and the opposition fails in full.

Conclusion

83. **Thus, the appeal is allowed, the opposition fails, and the contested mark may proceed to registration.**

Costs

84. As the successful party the Applicant is entitled to an award of a contribution to its costs. Neither party argued that I should depart from the usual scale of costs.

85. The Hearing Officer made an award of £1,300 against the Applicant as a contribution towards the costs of the Opponent. The Appeal having succeeded, that order is set aside. Instead, and

recognising that the Applicant did not make written submissions in lieu below, I order that the Opponent pay the Applicant the amount of £1100 as a contribution to its costs in the Opposition.

86. So far as the costs of the Appeal are concerned, I order the Opponent to pay £1300 by way of contribution to the costs incurred by the Applicant in dealing with this Appeal.

87. Therefore, the Opponent must pay to the Applicant or its representatives the total sum of £2,400 within 21 days of the date of this decision.

Philip Harris
Appointed Person
10 February 2022