

O-133-20

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3325735  
BY DIPTYQUE S.A.S.  
TO REGISTER**

**TEMPO**

**AS A TRADE MARK  
IN CLASS 3  
AND OPPOSITION THERETO (UNDER NO. 415074)  
BY  
ESSITY HYGIENE AND HEALTH AKTIEBOLAG**

## Background & Pleadings

1. Diptyque S.A.S. ('the applicant') applied to register the trade mark TEMPO on 19 July 2018. The mark was published in the Trade Mark Journal on 12 October 2018 in class 3 for *perfumery, eau de parfum, colognes and toilet waters; room perfume sprays, room scenting sprays, room perfume diffusers*.

2. Essity Hygiene and Health Aktiebolag ('the opponent') filed a notice of opposition on 11 January 2019 under section 5(1)(a) on the basis of its earlier EU TM No.637751 and under section 5(2)(b) of the Trade Marks Act 1994 ('the Act') on the basis of its earlier EU TM Nos. 12259561 and 8431744. The opposition grounds have been claimed for some of the goods registered under the three EU trade marks. The details of the marks and goods are set out below.

<p>EU TM No. 637751</p> <p><b>TEMPO</b></p> <p>Filing date: 24 September 1997 Registration date: 18 June 1999</p>	<p><u>Goods relied on:</u></p> <p>Class 3: wet wipes made of paper, cellulose or non-woven synthetic fibres for cosmetic purposes.</p> <p>Class 16: Paper articles, namely tissues; handkerchiefs, wipes and toilet paper, all made of paper and/or cellulose</p>
<p>EU TM No. 12259561</p> <p><b>TEMPO PROTECT</b></p> <p>Filing date: 28 October 2013 Registration date: 28 March 2014</p>	<p>Class 3: Soaps, cleaning preparations, towels impregnated with cosmetic lotions, make-up removing preparations, lotions for cosmetic use, tissues impregnated with cosmetic preparations for make-up and care purposes, paper products for household and hygienic purposes (as far as they</p>

	<p>are contained in class 3), namely moist toilet paper; cosmetic wipes soaked with liquid; handkerchiefs soaked with liquid.</p> <p>Class 5: disinfectants.</p> <p>Class 16: Paper, cardboard and goods made from these materials, not included in other classes, being scented; perfumed drawer liners of paper; hand towels of paper, face towels of paper, handkerchiefs of paper, toilet paper, make-up removing napkins of paper.</p>
<p>EU TM No. 8431744</p>  <p>Filing date: 16 July 2009 Registration date: 14 April 2010</p>	<p>Class 3: tissues impregnated with cosmetic preparations for make-up and care purposes; paper or cellulose handkerchiefs, also coated with plastic foils, impregnated with cosmetic substances; toilet paper impregnated with skin treating or cosmetic substances (namely toilet paper impregnated with liquid or creams).</p> <p>Class 5: paper or cellulose handkerchiefs, also coated with plastic foils; toilet paper</p>

	<p>impregnated with liquids or creams.</p> <p>Class 16: paper or cellulose handkerchiefs, not impregnated with cosmetic or pharmaceutical substances; toilet paper not impregnated with skin treating or cosmetic substances paper or cellulose towels, also coated with plastic foils</p>
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3. The opponent's above trade marks all have filing dates that are earlier than the publication date of the application and, therefore, they are all earlier marks, in accordance with Section 6 of the Act. As the registration procedure for EU TM Nos. 637751 and 8431744 was completed more than 5 years prior to the publication date of the contested application, they are subject to the proof of use conditions, as per section 6A of the Act. EU TM No. 12259561 is not subject to proof of use, having not been registered for five years prior to the publication date of the contested application. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed a counterstatement in which it denied the opposition grounds and put the opponent to proof of use for EU TM Nos. 637751 and 8431744.

5. Both parties have been professionally represented throughout; the applicant by Carpmaels & Ransford LLP and the opponent by Boulton Wade Tennant LLP.

6. Both parties filed evidence and the opponent filed written submissions in lieu of a hearing. I make this decision from the material before me.

### **Opponent's evidence in chief**

7. The opponent filed two witness statements and annexed exhibits in support of their opposition. The first witness statement is in the name of Catherine Wolfe, a

partner in the opponent's representatives Boulton Wade Tennent. Ms Wolfe attaches one exhibit. The second witness statement is in the name of Gavin Hyde-Blake, an investigator and director of Eccora Limited. Mr Hyde-Blake attaches six exhibits.

8. Taking Ms Wolfe's evidence first, the exhibit CW1 consists of a selection of publicly available material already filed for corresponding opposition proceedings at EUIPO. The material is taken from the opponent's company's prospectus for share dealing on the Swedish Stock Exchange and the opponent company's annual reports for 2014, 2015, 2016 and 2017. The company prospectus appears undated but contain references to activities occurring in 2016.

9. The prospectus contains reference to the word mark TEMPO on pages 9 of 29, 10 of 29 and 11 of 29 in relation to the 'consumer tissue business area' which is described as covering 'toilet paper, household towels, handkerchiefs, facial tissues, wet wipes and napkins'. There a reference to the figurative mark  on page 10 of 29 as part of a list of brands covered by the opponent.

10. In the 2014 annual report, the figurative mark appears on page 13 of 29, both in a list of brands and as applied to a product which appears to be a box of handkerchiefs. On page 14 of 29 the word mark appears in text and the figurative mark appears on packaging for what appears to be paper handkerchiefs but the image is unclear. The word mark appears again on page 15 of 29 where it is stated that TEMPO is a 'leading brand in large areas of Europe' in the consumer tissue sector.

11. In the 2015 annual report, both the word and figurative markets are shown under the heading 'Tissue' on page 17 of 29 which is described as covering 'toilet paper, kitchen rolls, facial tissues, handkerchiefs and napkins'. The figurative mark appears on packaging for handkerchiefs. Both marks appear again on page 19 of 29. On the following page there are illustrations of product innovation and launches for 2015 and both marks appear in relation to handkerchief products.

12. In the 2016 annual report both the word and figurative mark appear in relation to the Tissue sector on pages 22 of 29, the word mark appears again on pages 23 and 24 of 29. On page 25 of 29 under the heading 'strategy', the text states that a wet wipes product was launched under the TEMPO brand in 2016.

13. In the annual and sustainability report 2017, the words and figurative mark feature on pages 27, 28 and 29 of 29. On page 28 of 29 the figurative mark appears on packaging for a moist toilet paper product and on the following page the figurative mark appears on a box of handkerchiefs.

14. Turning to the evidence of Gavin Hyde-Blake, he states that his company provides IP investigation, research and acquisition services and was instructed by Boulton Wade Tennant to investigate the opponent's use of the word and figurative marks for the five years up to 2018. The exhibits provided are the results of his investigations.

15. Exhibit GHB1 consists of Mr Hyde-Blake's findings. In this report he outlines his sources, namely specialist media databases, print and online trade publications, market intelligence reports, audio visual advertisements (mainstream media and online) and social media throughout the EU. The report's conclusions are that the opponent's marks are used extensively throughout the EU and have been for the relevant period for paper handkerchiefs, moist toilet paper and moist hand wipes.

16. Exhibit GHB2 consists of 140 thumbnail stills of advertisements featuring the word and figurative marks between 2013-18. I have identified 9 which are dated after the end of the relevant period, i.e. after 12 October 2019 so cannot be considered. The relevant advertisements comprise digital, internet TV, press, billboard hoarding and radio offerings for the following goods, namely paper handkerchiefs, moist toilet paper and moist hand wipes.

17. Exhibit GHB3 comprises a selection of press releases from the opponent dated between June 2017 and July 2018 relating the company listing on the Nasdaq Stockholm stock exchange, its ranking as one of the world's top 100 sustainable

companies, its pension investments, growth of wet wipe products and share price in Austria and Germany. The opponent is named alongside the word mark.

18. Exhibits GHB4, 5 and 6 were provided on a CD-ROM and consists of video advertisement and jpgs of billboard and print advertisements dated between 2013 and 2018. The dates are all within the relevant period. I have viewed the videos and images and confirm the figurative mark is used on paper handkerchiefs, moist toilet paper and moist hand wipes.

### **Applicant's evidence**

19. The applicant filed a witness statement in the name of Jonathan Day, a partner at Carpmaels & Ransfords LLP, the applicant's representative. Mr Day annexes five exhibits. Mr Day states that the some of the evidence presented here has also been presented in parallel proceedings at EUIPO between the parties. This concerns exhibit JD-1 which contains redacted information of a commercially sensitive nature. Overall Mr Day's witness statement contains a number of submissions which I will return to later in the decision if it becomes necessary to do so.

20. Exhibit JD-1 consists of a copy of 'observations in reply' filed at EUIPO. These observations are given in reply to the evidence filed by the opponent in those proceedings and are largely critical of the evidence provided. In particular the applicant is critical of the quality of the opponent's exhibits and states that the use shown is only on a limited range of goods.

21. Exhibits JD-2,3,4 & 5 all relate to the differences between the applicant's and opponent's goods with reference to different prices, different point of display locations and difference between retailers of high-end perfumes and retailers of tissue products.

### **Opponent's evidence in reply**

22. The opponent filed evidence in reply, namely a second witness statement from Catherine Wolfe and eight annexed exhibits. The witness statement rebuts submissions made in Mr Day's statement especially in relation to the differences identified between the goods at issue. Ms Wolfe's exhibits contain a number of

images of scented tissues, scented drawer liners and perfume products sold alongside matching scented moist tissues.

### **Proof of Use**

23. The first issue is to establish whether, or to what extent, the opponent has shown genuine use of the earlier marks within the 'relevant period'. The relevant period is defined as being a period of five years ending with the publication date of the contested application. In this case the relevant period would be 13 October 2013 to 12 October 2018.

24. The relevant statutory provisions for proof of use are as follows:

6A. - (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), (b) 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(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.”

25. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it”.

26. The following case law is also applicable. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J 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 Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, 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 established 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].”

27. As the opponent’s trade mark is an EUTM, the comments of the CJEU in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. It noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use”.

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been

registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark”.

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

28. The Court held that,

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods

or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity”.

29. In *London Taxi*, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC),

[2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33][40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use".

30. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

31. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTMs, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown

- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown.

### **Sufficiency of use**

32. It is clear to me from the opponent's evidence provided that there has been promotion of the figurative mark in the EU, namely Austria, Belgium, Germany, Italy and the Netherlands during the relevant period on tissue type goods via advertisements and commercial media coverage. This has resulted in considerable coverage across a wide territory. The opponent is stated to be the market leader in Europe in the tissue sector and Tempo is one of the leading brands in "large areas of Europe" <sup>1</sup>. Evidence of use of the word mark has been in the form of text passages in reports, articles and the like and refer to the "Tempo brand". It is not made clear by the opponents as to how widespread the circulation of the documents is but I have made the presumption that they are available to external bodies as the nature of the prospectus and annual report documents for example would be to present a picture of the opponent's company's financial situation to stakeholders. I note that no turnover figures or advertising expenditure for the TEMPO brand specifically have been given, only figures relating to the overall business turnover of the opponent's predecessors in title. This was a criticism made by the applicant in its exhibit JD-1. However notwithstanding this factor, I am content that there has been genuine use of the mark.

### **Framing a fair specification**

33. The next stage is to decide whether the opponent's use entitles it to rely on the the goods it has claimed. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. 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

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<sup>1</sup> Exhibit CW1, page 10 of 29

the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

34. 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.*”

35. As per the *Euro Gida* extract given above with regard to particular categories of goods, I find that the evidence demonstrates that the opponent has used its marks on paper handkerchiefs, moist toilet paper and moist hand wipes. In my view the opponent can rely on these goods.

### **Section 5(2)(a) and (b)**

36. Section 5(2)(a) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the 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”.

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

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is

protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

38. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

### **The principles**

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

39. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

40. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

41. As per my previous finding regarding the proof of use evidence, the opponent is entitled to rely on paper handkerchiefs, moist toilet paper and moist hand wipes for its earlier word mark. I propose to focus on the earlier word mark as the figurative mark does not improve the opponent’s case based on the word TEMPO. I will be assessing the TEMPO PROTECT mark for the goods specified in the notice of opposition as this mark was not subject to proof of use and the opponent can rely on these goods in full.

42. The goods to be compared are:

Opponent's goods	Applicant's goods
<p><b>TEMPO</b></p> <p>3: moist toilet paper and moist hand wipes.</p> <p>16: paper handkerchiefs</p>	<p>3: Perfumery, eau de parfum, colognes and toilet waters; room perfume sprays, room scenting sprays, room perfume diffusers</p>
<p><b>TEMPO PROTECT</b></p> <p>3: Soaps, cleaning preparations, towels impregnated with cosmetic lotions, make-up removing preparations, lotions for cosmetic use, tissues impregnated with cosmetic preparations for make-up and care purposes, paper products for household and hygienic purposes (as far as they are contained in class 3), namely moist toilet paper; cosmetic wipes soaked with liquid; handkerchiefs soaked with liquid.</p> <p>5: disinfectants.</p> <p>16: Paper, cardboard and goods made from these materials, not included in other classes, being scented; perfumed drawer liners of paper; hand towels of paper, face towels of paper, handkerchiefs of paper, toilet paper, make-up removing napkins of paper.</p>	

43. Taking first the comparison of the goods for which proof of use has been accepted, i.e. for the TEMPO word mark, I do not find any similarity between *moist toilet paper* and *moist hand wipes* in class 3 or *paper handkerchiefs* in class 16 and the applicant's goods. Taking into account the *Treat* criteria referenced above, I find that the goods do not share the same use. Moist wipes and paper handkerchiefs are intended to cleanse, freshen and wipe as an aid to personal hygiene. Even if they are perfumed, this is not their primary use nor why they are purchased. Perfume products *per se* for household or personal use are intended to fragrance and to give a specific odour. Further, the physical nature of the goods is different. The opponent's goods are paper based products whereas the applicant's goods are oil or water based liquids. Whilst the respective users of the goods are all members of the general public, this in and of itself it not sufficient for a finding of similarity. In terms of trade channels, both the respective goods could be found in the same retail outlet such as a chemist's shop but they are very unlikely to be found on the same shelves. The opponent's products would be in the tissue products section and the perfumes for personal use in their own area, whilst perfumes for household use may well be in a separate homewares section altogether. Finally, I do not consider the products to be complementary in the sense outlined in *Boston Scientific*<sup>2</sup>. Moist tissue products and paper handkerchiefs are not important or indispensable for the use of perfume products.

44. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

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<sup>2</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06,

45. The opponent's EUTM 637751 is in respect of an identical mark. However, as previously stated I have found no similarity between the respective goods, of the earlier TEMPO word mark and the applied for mark. It follows then that there is no likelihood of confusion and the grounds of opposition under section 5(2)(a) fail.

46. Turning to the remaining earlier mark TEMPO PROTECT, I intend to group the opponent's goods together where appropriate for ease of comparison, starting with class 3.

47. I find that *Soaps and lotions for cosmetic use* in the opponent's class 3 specification are similar to a low degree to *Perfumery, eau de parfum, colognes and toilet waters* in that they all fall with the broader category of cosmetics for the purpose of beautification of the person. However I do not find that the opponent's goods are similar to *room perfume sprays, room scenting sprays, room perfume diffusers* in the applicant's specification as there are household goods not personal beautification products.

48. I do not find that *cleaning preparations* and *make-up removing preparations* in the opponent's class 3 specification are similar to the applicant's goods. In my view these goods are used as cleansing products. They are different in nature from the applicant's goods in nature and are not for beautification or fragrance enhancing.

49. For the reasons outlined above with regard to the points made about the dissimilarity of the applicant's goods and the opponent's paper and moist wipe products, I find that *towels impregnated with cosmetic lotions; tissues impregnated with cosmetic preparations for make-up and care purposes, paper products for household and hygienic purposes (as far as they are contained in class 3), namely moist toilet paper; cosmetic wipes soaked with liquid; handkerchiefs soaked with liquid* will fall into the same category and are not considered similar goods for the same reason.

50. In relation to the opponent's class 5 good *disinfectants*, I find this to be dissimilar to the applicant's class 3 goods. The use and physical nature of disinfectants are to

sanitise surfaces and destroy bacteria, not to fragrance the person or a room. Such goods may be sold in the same physical retail premises as the applicant's goods, but they would be situated in their own section among other anti-bacterial cleansers.

51. In relation to the opponent's class 16, I find there is a low degree of similarity with the opponent's goods *Paper, cardboard and goods made from these materials, not included in other classes, being scented; perfumed drawer liners of paper with room perfume sprays, room scenting sprays, room perfume diffusers* in the applicant's specification. The purpose of both sets of goods is to add fragrance to an environment. There will be an overlap in users who seek to purchase household fragrancing products and there may be an element of competition between the goods. The respective goods themselves are most likely to found in the same homewares section of a retail premises.

52. I do not find that *hand towels of paper, face towels of paper, handkerchiefs of paper, toilet paper, make-up removing napkins of paper* in the opponent's class 16 specification can be considered as similar goods to the applicant's class 3 specification for the reasons previously stated about tissue products.

53. As I have found some similarity of goods between the earlier mark TEMPO PROTECT and the applied for mark, then I shall proceed on this basis when I come to the comparison of marks.

### **Average consumer and the purchasing process**

54. I next consider who the average consumers are for the goods and how they are purchased.

55. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

56. The average consumers in this case are the general public. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: see *Lloyd Schuhfabrik Meyer, Case C-342/97*. For moist wipe products, handkerchiefs, soap and the like, the average consumer will likely pay a low to medium degree of attention as these are more mundane, everyday type of purchases. Perfumery products for personal use are more expensive one offs or at least not regular purchases so I would pitch the level of attention as higher than medium, although perfumery products for household use would be not be as expensive so more likely to slide back down the scale to a medium degree of attention. The act of purchasing is likely to be mainly visual as consumers select goods from a physical retail or specialist outlet or by browsing online. However, I do not discount aural considerations such as word of mouth recommendations.

### **Comparison of marks**

57. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

58. 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.

59. The marks to be compared are

Opponent's mark	Applicant's mark
<b>TEMPO PROTECT</b>	<b>TEMPO</b>

60. The opponent's earlier mark consists of the words TEMPO PROTECT in a regular type face with no other aspect such as stylisation to it. In my view the word PROTECT plays a lesser role in the overall impression of the mark as it is lower in distinctiveness for goods which have a protective function, e.g. goods which protect the skin against bacteria. I find that TEMPO plays an independently distinctive role within the mark as a whole.

61. The applicant's mark consists of the word TEMPO in a regular type face with no other aspect to it. The overall impression resides solely in this word.

62. In a visual comparison, the marks both share the word TEMPO. The opponent's mark has an additional word, which is absent in the application, making it a longer mark. Taking this in account I find there to be a medium degree of visual similarity.

63. In an aural comparison, the word common to both marks is TEMPO. It will be pronounced identically in each case. The opponent has the additional word PROTECT which will be verbalised with its usual pronunciation. Taking this factor into account, I find there is a medium degree of aural confusion.

64. In a conceptual comparison, the shared word TEMPO will bring to mind its usual dictionary definition of being the speed at which something happens. The opponent's additional word PROTECT will also bring to mind its usual definition.

There is nothing to suggest that the opponent's two-word mark in combination will bring to mind anything new or unusual in its concept other than the meanings already established here. Taking this onboard and given the point I set out above regarding the lower distinctiveness for PROTECT, I find the marks are conceptually similar to a medium degree.

### **Distinctiveness of the earlier marks**

65. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 promoting 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).”

66. No evidence has been presented demonstrating enhanced distinctiveness for the mark TEMPO PROTECT, so I have only the inherent position to consider. The

earlier mark comprises one distinctive word combined with a less distinctive one. Overall the mark does not directly describe the goods for which it is registered, as such I consider the mark to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

67. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent's mark, the average consumer and the nature of the purchasing process for the contested goods. In doing so, I must be aware 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.

68. 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 and services down to the responsible undertakings being the same or related.

69. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting 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.

70. So far in this decision, I found that whilst some of the parties’ goods are similar to a low degree, some are considered dissimilar. I also found that goods are purchased visually by the general public by a mainly visual means, although I did not rule out aural considerations during the purchasing process. The level of attention paid was found to be low to medium for the less expensive everyday hygiene products rising to a higher level of attention for more expensive perfumery goods. Finally, I found there to be medium degree of inherent distinctiveness in the earlier mark and that the marks were visually, aurally and conceptually distinctive to a medium degree.

71. Taking the above factors into account, I do not think that the average consumer will directly mistake one mark for the other. In terms of indirect confusion, the average consumer would not overlook the PROTECT element in the earlier mark and would, in my view, assume that the shared distinctive word TEMPO indicates that the goods originated from the same or related undertaking. The PROTECT word difference will be put down to one being a sub brand of the other and consumers will assume that the same undertaking is responsible for the respective goods. As such I find that there is a likelihood of indirect confusion.

## **Conclusion**

72. The opposition succeeds under section 5(2)(b). Subject to any successful appeal against this decision, the application is refused.

## **Costs**

73. As the opponent has been partially successful, it is entitled to a contribution of the costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs to the opponent as follows:

£100 TM7 official fee  
£300 Preparing Notice of Opposition  
£500 Preparing evidence  
£300 Preparing written submissions  
**£1200 Total**

74. I order Diptyque S.A.S. to pay Essity Hygiene and Health Aktiebolag the sum of £1200. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4<sup>th</sup> day of March 2020**

**June Ralph  
For the Registrar  
The Comptroller-General**