

O-218-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2552659
BY BOO BOO PRODUCTS LTD
TO REGISTER A TRADE MARK IN CLASSES 3 & 4**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 101006 BY WASABI FROG LIMITED**

BACKGROUND

1. On 12 July 2010, Boo Boo Products Ltd (“BB”) applied to register



as a trade mark. Following examination, the application was accepted and published for opposition purposes on 24 September 2010 for the following goods:

Class 3: Toiletries, perfumes, cosmetics, shower and bath cleansers and soaks, soap, anti-stretch mark preparations, skin care and hair care preparations and treatments and bath preparations based on natural ingredients.

Class 4: Aromatherapy candles, natural candles.

2. On 28 September 2010, Wasabi Frog Limited (“Wasabi”) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (“the Act”). Wasabi indicates that its opposition is directed against all of the goods contained in the application for registration. Wasabi relies upon one trade mark registration:

Trade Mark	No.	Application date	Registration date	Goods
BOOHOO	E6399372	26.10.2007	07.10.2008	3 - Soaps; cosmetics; perfumery; essential oils; eau de parfum; eau de toilette; cologne; fragrances and fragrance products for personal use; massage oils; hair lotions; dentifrices; cosmetic preparations for skin care; skin care cosmetics; skin care preparations; astringents for cosmetic purposes; preparations for the bath and shower; shower gel; bath gels; scented body lotions and creams; scented moisturizing skin cream; moisturisers; body lotions and creams; moisturising creams; scented skin soap; body oil; face, lip and cheek make-up; face powder; face glitter; lipstick; lip gloss; non-medicated lip balm; lip

				<p>pencils; perfumed shimmer sticks; eye shadow; eye pencils; mascara; eye make-up; eyeliners; eye creams; eye gels; eye balms; highlighter; masks; cleansers; toners; clarifiers; exfoliators; foundation make-up; blusher; compacts; make-up remover; fragrance sachets; room fragrances; beauty care preparations; beauty care products; beauty creams; beauty tonics for application to the body; beauty tonics for application to the face; non-medicated beauty preparations; non-medicated skin care beauty products; skin care products for personal use, namely, face, eye and lip moisturisers; face and skin creams; lotions and serums; anti-aging treatments; foundation for the face; hair care products; shampoo; hair conditioners; hair gel and hair spray; nail care preparations; nail polish; nail strengtheners and nail polish remover; shaving cream; shaving gel; after-shave preparations; after-shave lotion; depilatory preparations; personal deodorant; antiperspirants; potpourri; sun tanning preparations; cosmetic preparations for skin tanning; artificial tanning preparations.</p>
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3. In its Notice of Opposition Wasabi says:

“The prefix BOO is identical for both marks, with the only difference between the marks being a one letter difference between the suffixes HOO and BOO.

Thus, both marks are visually very similar and there is a strong degree of phonetic similarity between the marks.

Conceptually, neither mark has a clear and identifiable meaning when used in connection with the goods in issue.

Furthermore, the applicant’s mark covers good in class 3 which are either identical or very similar to those protected by the opponent’s earlier trade mark in class 3.

The applicant's mark also covers goods in class 4 which are similar to those protected by the opponent's earlier trade mark in class 3 (e.g. aromatherapy candles/natural candles might be sold in a store next to, or on the same shelf as massage oils, room fragrances, potpourri and/or bath preparations and/or might well be seen as being complementary to any of the aforesaid products – for example, consumers often light candles, rather than putting on bright, electrical lights, when they relax in the bath/have a massage)."

4. On 26 October 2010, BB filed a counterstatement in which the ground of opposition is denied. In its counterstatement BB says:

"Boo Boo and BOOHOO are very different in their marks with BOOHOO being spelt as one word and Boo Boo as two separate words. The suffix is also an entirely different word.

The words also have very different meanings Boo Boo is a child-like turn of phrase which is well suited to our business which focuses on mother and baby toiletries. It is a phrase many grown-ups use when referring to their children or loved ones conjuring up sentimental feelings. BOOHOO is almost the polar opposite, meaning to cry.

The marks also have an entirely different design, Boo Boo being a swirly, vintage-style, thicker, bolder font to represent the vintage-inspired toiletries it sells and BOOHOO is a thin, modern, minimal, futuristic-style font to suit its website which sells young women's fashions (they don't sell candles or toiletries on their website)."

5. While only BB filed evidence, Wasabi filed written submissions at both the evidence-in-chief and evidence-in-reply stages of the proceedings. BB filed written submissions in lieu of attendance at a hearing. I will refer to both parties' written submissions as necessary later in this decision.

BB's evidence

6. This consists of a witness statement from Jennifer Cawthron who is a Director of BB. Ms Cawthron explains that BB began using the trade mark the subject of its application on the goods the subject of the application in April 2008. Exhibit JC1 consists of a range of articles relating to and advertisements for its products which appeared in publications and on websites such as Marie Claire, The Daily Mail and Cosmopolitan and whose publication dates range from June 2008 to January 2011. Exhibit JC2 consists of a selection of articles relating to and advertisements for BOOHOO products which appeared in magazines and on websites such as The Independent, Heat Magazine and Cosmopolitan and which appeared between January 2009 and July 2010. Exhibit JC3 consists of a number of pages taken from the July 2010 edition of Cosmopolitan in which both parties' trade marks are mentioned (albeit in respect of Wasabi's trade mark

only in relation to sunglasses). Ms Cawthron concludes her statement in the following terms:

“6. In my time working for Boo Boo Products Ltd I do not know of any instances where there has been confusion on the part of the relevant purchasing public between [BB’s] BOO BOO mark and [Wasabi’s] BOOHOO mark. [BB] is a small company and the employees consist of myself and one other director and, therefore, I would have been made aware of any instances of confusion.”

7. In its submissions dated 23 February 2011 Wasabi commented on Ms Cawthron’s evidence. The main points I take from this are that:

the evidence shows that BB have used their BOO BOO trade mark in relation to goods in class 3;

the evidence shows that (save for one reference to sunglasses) Wasabi have used their BOOHOO trade mark in relation to goods in class 25;

BB’s evidence is intended to show that there has been no confusion between the competing trade marks in the market place;

such evidence is flawed as it only compares the applicant’s products in class 3 with (save for one exception) Wasabi’s goods in class 25;

as Wasabi has only made very limited use of its trade mark in relation to goods in class 3 it is not surprising that Ms Cawthron is not aware of any instances of confusion;

I must assess the competing trade marks on the basis on notional and fair use;

as per the comments of the Court of Appeal in *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283, the absence of actual confusion is not conclusive;

any evidence of co-existence provided must be sufficient to carry the inference that the co-existence has been peaceful;

BB have not put forward strong evidence that the two marks have co-existed in the marketplace in respect of class 3 (and/or class 4) goods.

DECISION

8. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(a)....

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

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

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

10. In these proceedings Wasabi is relying upon the registration shown in paragraph 2 above. This constitutes an earlier trade mark under the above provisions, and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

11. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (case C-120/04) and *Shaker di L. Laudato & Co. Sas v Office for Harmonization in the Internal Market (Trade Marks & Designs)* (case-334/05).

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

- (b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (j) further, 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; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing process

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In its submissions Wasabi says:

“40. It is submitted that the goods in question are everyday, general consumer goods and thus, consequently, the relevant public in relation to which a likelihood of confusion must be assessed is composed of average consumers, with no specialised knowledge or specialised experience in the area of the goods covered by the applicant's TM application...”

13. I agree that the goods at issue (broadly speaking toiletries and candles) are goods that will be bought by members of the general public; they then are the average consumer for such goods. As to the manner in which the goods will be selected by the average consumer, Wasabi say:

40. [Such] a consumer is unlikely to evince a high degree of attentiveness...”

And:

“48. In this case, the goods in issue may be sold in stores (where consumers can themselves choose the goods they wish to buy, or be assisted by the sales staff), via websites, or via mail order catalogues (whereby orders are made by telephone or in writing). Therefore, the visual, aural and conceptual perceptions of the marks in question will, it is submitted, play an equal role in the global assessment of the likelihood of confusion.”

14. In its submissions BB says:

“21. The goods provided by the applicant under the BOO BOO mark are luxury items made from natural ingredients and sold through high-end retailers. These are goods that the average consumer will spend time deliberating over the purchase. The benefit of natural products has made customers more discerning when making their purchases and they are more trade mark aware and focussed in those purchases. This will not therefore be an impulse purchase but a considered one with the trade mark being an essential consideration within that purchase. Because of this the average consumer will be able to notice the distinctions between the marks and recognise that the goods are from unrelated undertakings.”

15. In my view, the goods at issue in these proceedings (toiletries and candles) are likely (for the most part) to be the subject of self selection from, for example, a supermarket shelf, or from the pages of a catalogue or website. While in retail premises some of the goods (designer perfumes for example) may be housed in locked glass

cabinets, in my experience even in those circumstances the average consumer will have inspected the goods visually before approaching a sales assistant. Considered overall, I think the selection of all of the goods will be predominantly a visual one; while aural considerations may play their part, in my view, it will be to a much lesser extent. As to the level of attention the average consumer will pay when selecting the goods, Wasabi say it will not be high, whereas BB argue (based upon the nature of the goods on which they actually use their trade mark i.e. luxury goods made from natural ingredients), that the average consumer will be particularly discerning. Of course, as not all of BB's goods are limited in this way, it is goods across the whole spectrum that I must keep in mind. My own experience tells me that the cost of the goods may vary considerably. For example, I am aware that the cost of designer perfumes is not insignificant (no doubt part of the reason why retailers house them in locked cabinets). However, for the most part the cost of the goods at issue will be relatively low. That said, as the majority of the goods at issue are for use in or on the person, the average consumer will need to ensure, for example, they are buying the correct shampoo for their particular type and style of hair, or, insofar as candles are concerned, the candle that emits the scent they desire. Overall, I think the average consumer will pay an average level of attention to their selection, although I accept that this level of attention is likely to increase as the cost of the goods increases.

Comparison of goods

16. For the sake of convenience, the goods to be compared are as follows:

Wasabi's goods	BB's goods
<p>Class 3 - Soaps; cosmetics; perfumery; essential oils; eau de parfum; eau de toilette; cologne; fragrances and fragrance products for personal use; massage oils; hair lotions; dentifrices; cosmetic preparations for skin care; skin care cosmetics; skin care preparations; astringents for cosmetic purposes; preparations for the bath and shower; shower gel; bath gels; scented body lotions and creams; scented moisturizing skin cream; moisturisers; body lotions and creams; moisturising creams; scented skin soap; body oil; face, lip and cheek make-up; face powder; face glitter; lipstick; lip gloss; non-medicated lip balm; lip pencils; perfumed shimmer sticks; eye shadow; eye pencils; mascara; eye make-up; eyeliners; eye creams; eye gels; eye balms; highlighter; masks; cleansers; toners; clarifiers; exfoliators; foundation make-up; blusher; compacts; make-up remover; fragrance sachets; room fragrances; beauty care preparations; beauty care products; beauty creams; beauty tonics for application to the body; beauty tonics for application to the face; non-medicated beauty preparations;</p>	<p>Class 3: Toiletries, perfumes, cosmetics, shower and bath cleansers and soaks, soap, anti-stretch mark preparations, skin care and hair care preparations and treatments and bath preparations based on natural ingredients.</p> <p>Class 4: Aromatherapy candles, natural candles.</p>

non-medicated skin care beauty products; skin care products for personal use, namely, face, eye and lip moisturisers; face and skin creams; lotions and serums; anti-aging treatments; foundation for the face; hair care products; shampoo; hair conditioners; hair gel and hair spray; nail care preparations; nail polish; nail strengtheners and nail polish remover; shaving cream; shaving gel; after-shave preparations; after-shave lotion; depilatory preparations; personal deodorant; antiperspirants; potpourri; sun tanning preparations; cosmetic preparations for skin tanning; artificial tanning preparations.	
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17. In their submissions BB admit that the goods contained in class 3 of their application are “identical or similar” to the goods in Wasabi’s registration. It is, I think, self evident that the competing goods are identical.

18. Turning now to the goods in class 4 of BB’s application, in its submissions Wasabi explain why, in their view, the competing goods are “quite similar”; for the sake of convenience these comments are repeated here:

“The applicant’s mark also covers goods in class 4 which are similar to those protected by the opponent’s earlier trade mark in class 3 (e.g. aromatherapy candles/natural candles might be sold in a store next to, or on the same shelf as massage oils, room fragrances, potpourri and/or bath preparations and/or might well be seen as being complimentary to any of the aforesaid products – for example, consumers often light candles, rather than putting on bright, electrical light, when they relax in the bath/have a massage).”

19. In its submissions BB comment on the clash between the goods in classes 3 and 4 in the following terms:

“19. The opponent’s submissions suggesting that the goods in class 4 of the application are similar to those in class 3 of its CTM are rather contrived and devised merely for the purpose of artificially suggesting similarity. The goods in class 4 of the application are candles with the primary function of providing light. This is considerably different to the function and use of any of the goods in the opponent’s CTM registration. In light of this, there is no connection between the opponent’s goods and the candles in the application which would make them complementary or sold in the same area, let alone shelves, in retail establishments and therefore no similarity between the goods.

20. The opponent has attempted to draw a similarity between aromatherapy candles and massage oils, room fragrances, potpourri and bath preparations as it claims they may be sold on the same shelves in retail stores and they may be seen to be complementary. Aromatherapy is a form of alternative medicine where the candles have specific properties depending on the essential oils within

them and these relate to the therapy that is intended. These are not merely scented candles which fragrance a room but instead have a specific therapeutic purpose. The retail stores that sell these types of candles are likely to segregate them due to their purpose and therefore it is unlikely they will be sold with the above mentioned goods in the opponent's registration."

20. The leading authorities on how to determine similarity between goods and services are, as Wasabi points out in its submissions, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

21. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the General Court (GC) explained when goods were complementary:

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48)."

22. In both its Notice of Opposition and submissions Wasabi argue that the following goods in their registration, massage oils, room fragrances, potpourri and bath preparations are “quite similar” to BB’s goods in class 4 and they explain why; not surprisingly, BB disagree. In my view, Wasabi’s best case lies with its room fragrances and potpourri; if it fails in relation to these goods it will be in no better position in relation to the other goods mentioned.

23. While candles may at one time have been used purely as a source of light, their use has moved on. Clearly while still a source of light, if one compares the aromatherapy candles and natural candles in BB’s application (all of which could be scented) with the room fragrances and potpourri in Wasabi’s registration, it is clear that while the physical nature of the goods and their method of use may be different, the users of the goods would be the same as would their primary intended purpose i.e. to freshen or create an ambience within a room. In addition, the competing goods are likely to be found in the air freshener aisle of, for example, a supermarket and, as they offer the user different methods of achieving the same result, they are likely, in my view, to be in competition with one another. Overall, I consider there to be quite a high degree of similarity between the competing goods.

Comparison of trade marks

24. The trade marks to be compared are:

Wasabi’s trade mark	BB’s trade mark
BOOHOO	

25. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

26. Wasabi’s trade mark consists of the letters BOOHOO presented in upper case; as no part of the trade mark is accentuated or emphasised in any way there are, in my view, no distinctive and dominant components, the distinctiveness of Wasabi’s trade mark lies in its totality. Turning to BB’s trade mark, this consists of the words Boo Boo presented as separate words in a cursive script with enlarged letter Bs. Considered in isolation the word Boo is, as far as I am aware, a distinctive component of BB’s trade

mark. However, the presentation of BB's trade mark (where the word Boo is repeated and presented in exactly the same manner), results, in my view, in there being no dominant element. The distinctiveness of BB's trade mark (like that of Wasabi) lies in the totality that it creates which is, absent evidence to the contrary, distinctive of the goods at issue. I will approach the comparison of the competing trade marks with these conclusions in mind.

Visual/aural similarity

27. In its submissions Wasabi says:

"12. At a visual level, it is submitted that the marks in issue are very similar, with only one letter difference between them.

14. Further, the mark the subject of the applicant's TM application starts with the letters/prefix BOO, as does the opponent's trade mark.

15. Given that a relevant member of the public must read the beginning of a mark before the end of a mark and that a relevant member of the public will encounter the initial letters before the others, it is submitted that, in this case, the initiating three letters/prefix must be considered more important than the endings...In this case, it is further submitted that the very slight difference between the endings of the two marks i.e. BOO and HOO does not draw the average consumer away from the identical beginnings of both marks.

16. The mark the subject of the applicant's TM application and the opponent's trade mark are also of identical length. BOO BOO is 6 letters in length, as is BOOHOO."

19. From an aural perspective, strong similarities are also present between the mark[s]...

20. The beginning of a mark plays an essential part in establishing phonetic similarity.

21. Phonetically, [both parties' trade marks] begin with the identical and dominant sound BOO.

22. Further, there are only two syllables in both marks, with the endings of the marks being only very slightly different phonetically..."

28. In its submissions BB says:

"8. The opponent claims that both marks are six letters in length but it is essential to consider the number of characters in the marks when discussing visual similarity. The application consists of seven characters with a space in the middle

separating two words. The space in the application adds a considerable difference dividing the mark into two separate three letter words rather than a single six letter word. The visual appearance of the two three letter words is extremely distinctive and, coupled with the additional character in the marks, acts to make it visually distinct from the opponent's mark.

9. Both marks are relatively short in length and, as such, the difference between a single letter can create a substantial difference. The judgment in *Ruiz-Picasso and Others v OHIM* stated that,

“...in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity.”

10. [In] its submission on visual similarity the opponent appears to divide its marks artificially into separate three letter words and apportion relevant importance to each word in order to create some similarity between the marks. This is artificial as the opponent's mark BOOHOO consists of a single word and will therefore be viewed and remembered by the average consumer as a single word...

11. The visual impact of the initial BOO must also be considered with the rest of the mark rather than attempting to view it as a separate element. The applicant's mark BOO BOO has a repetition of the word BOO which is very distinctive and visually striking. The separation of the mark before the second B gives it an additional visual appearance in the eyes of the consumer. This makes the mark completely distinct from BOOHOO where the H is within the mark and which does not provide the visual separation which would cause the consumer to view the elements separately.

12. In considering the aural similarities of the marks the opponent considers the beginning of the mark to be essential in establishing the aural similarity. This reasoning is flawed. The applicant's mark comprises two identical words, the repetition of which lends as much importance in creating the marks aural distinctiveness to the second word as the first. This repetition is unusual within the English language and, as such, enables the average consumer to distinguish between the marks.

13. The aural distinctiveness of the second element of the mark BOO BOO is further enhanced by the strong B sound. This is in stark contrast to the opponent's much softer H sound contained within the middle of the mark which rather than emphasising the separation of two separate syllables acts to conjoin the mark as a single word.”

29. I have described the competing trade marks above. In simple terms both trade marks consist of six letters and differ by only one letter (the difference being in the

fourth letter of the competing trade marks). However, as BB points out, its trade mark is presented as two separate words (with, I would add, very noticeably enlarged letter Bs), whereas Wasabi's trade mark is presented as one word in which none of the elements are emphasised in any way. In *Inter-Ikea Systems BV v OHIM* the GC stated:

“54 As regards the visual comparison between the verbal element of the contested mark and the earlier word marks, the applicant claims that the only difference between them is the presence of the letter ‘d’ in the contested mark and the letter ‘k’ in the earlier word marks. However, the Court has already held in Case T-185/02 *Ruiz-Picasso and Others v OHIM – DaimlerChrysler(PICARO)* [2004] ECR II-1739, paragraph 54) that, in the case of word marks which are relatively short, even if two marks differ by no more than a single consonant, it cannot be found that there is a high degree of visual similarity between them.

55 Accordingly, the degree of visual similarity of the earlier word marks and the verbal element of the contested mark must be described as low.”

30. Both trade marks begin with the same three letters i.e. BOO, and I accept that as a rule of thumb the beginnings of trade marks are generally more important than their endings. However, the manner in which the competing trade marks are presented i.e. one word as opposed to two, together with the difference in the visual impact created by the cursive script and enlarged letter Bs, results, in my view, and keeping in mind the comments of the court in the case mentioned above, in only a low to moderate degree of visual similarity between them. Insofar as aural similarity is concerned, both trade mark marks consist of six letters containing two syllables that would be pronounced as BOO-HOO and BOO-BOO. While I accept that the letter B has a quite different (“strong”) sound compared to the letter H appearing in Wasabi's trade mark, the identical first syllable and similar rhythm with which the competing trade marks would be pronounced leads, in my view, to a fairly high degree of aural similarity between them.

Conceptual similarity

31. In its submissions Wasabi says:

“24. Conceptually, neither mark has a clear and identifiable meaning when used in connection with the goods at issue. There is certainly no clear conceptual difference that would operate as a hook for the memory of the average consumer of the goods in issue, which would help him or her to distinguish between them.”

32. In its submissions BB says:

“14. The opponent has claimed that neither mark has a meaning in relation to the goods and therefore there exists no conceptual meaning that would distinguish the marks. The opponent has ignored the fact that in the English language both marks have a distinct meaning that would enable the relevant consumer to distinguish the marks. The meanings according to the Concise Oxford English

Dictionary are: BOO BOO – a mistake or minor injury and BOOHOO – representing the sound of someone crying nosily.

15. The words in the marks are in regular use in everyday English and the different meanings will allow the average consumer to distinguish between the two marks and identify the goods from each undertaking without confusion occurring.

16. The mark BOO BOO is also well known within the UK through the characters in the Mabel Lucie Atwell children's books and as the side kick of Yogi Bear in the popular and long running Hanna-Barbera cartoon and films. The association that the mark BOO BOO will make with these characters for the average consumer will provide sufficient conceptual difference from the BOOHOO mark that they are unlikely to confuse the marks."

33. When considering the issue of conceptual similarity, the following explanation from *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] helpfully sets out the position:

"Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above.

The fact that one of the marks at issue has such a meaning is sufficient –where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks." (my emphasis)

34. In my view BB's submissions are to be preferred. I think that (at the very least) the word Boohoo would be well known to the average consumer as a reference to (as BB explain) the sound of someone crying nosily. In view of the guidance in *Pash*, that is likely to be sufficient "to counteract to a large extent" any visual and aural similarities between the competing trade marks. However, in this case I think BB's position is even stronger as, in my view, the word Booboo is also be likely to be well known to the

average consumer as a word meaning, inter alia, to make a mistake. As a consequence, the competing trade marks are, in my view, conceptually dissonant.

Distinctive character of Wasabi's earlier trade mark

35. I must now assess the distinctive character of Wasabi's earlier trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In its submissions Wasabi says:

“44. It is submitted that the opponent's trade mark is inherently distinctive for the class 3 goods for which it is registered. The mark does not contain any elements descriptive of the class 3 goods in issue, or their essential characteristics. Therefore, the mark has a greater capacity to identify such goods as originating from a particular undertaking and thus to distinguish those goods from those of other undertakings. As a consequence, it is submitted that the opponent's trade mark enjoys broader protection than a mark with a less distinctive character.”

36. BOOHOO is, as I mentioned above, a well known word in the English language. Whilst not in the category of an invented word, it is, absent use, and for the reasons Wasabi suggest, possessed of a fairly high level of inherent distinctive character.

Likelihood of confusion

37. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to consider the distinctive character of Wasabi's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has retained in his/her mind. Earlier in this decision I concluded, inter alia, that the average consumer is the public at large, that the visual aspects of the competing trade marks are likely to dominate the selection process, that the competing goods in class 3 are identical and that there is quite a high degree of similarity between Wasabi's goods in class 3 and BB's goods in class 4, and that Wasabi's BOOHOO trade mark is possessed of a fairly high level of inherent distinctive character. Having identified what I considered to be the distinctive and dominant components, I also concluded that the

competing trade marks share a low to moderate degree of visual similarity, a fairly high degree of aural similarity and that the competing trade marks are likely to create conceptually dissonant images in the mind of the average consumer.

38. I must now apply those conclusions to the issue before me. Having done so, and notwithstanding, inter alia, the identity/high degree of similarity in the competing goods, but keeping in mind the importance of the visual aspects of the competing trade marks to the selection process, I have come to the conclusion that the low to moderate degree of visual similarity between the competing trade marks combined with the very different conceptual images the competing trade marks are likely to convey to the average consumer (which as the case law explains are likely to counteract to a large extent any visual and aural similarities), are sufficient to avoid the average consumer either confusing one parties' trade mark for the other (i.e. there will be no direct confusion) or assuming that the goods come from undertakings which are economically linked (i.e. there will be no indirect confusion). Wasabi's opposition based upon section 5(2)(b) of the Act fails.

Costs

39. As BB has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide (and making no award to BB in respect of its evidence which has played no part in my decision), I award costs to BB on the following basis:

Preparing a statement and considering Wasabi's statement:	£200
Written submissions:	£300
Total:	£500

40. I order Wasabi Frog Limited to pay to Boo Boo Products Ltd the sum of **£500**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of June 2011

**C J BOWEN
For the Registrar
The Comptroller-General**