

O-249-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2508228  
IN THE NAME OF ECC NOMINEES LIMITED

AND

OPPOSITION THERETO UNDER NO 99157  
BY NÖLKEN HYGIENE PRODUCTS GMBH

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### IN THE MATTER OF APPLICATION

No 2508228 in the name of  
ECC NOMINEES LIMITED and  
opposition thereto under No. 99157  
by NÖLKEN HYGIENE PRODUCTS GMBH

### Background

1. Application No 2508228 was applied for on 9 February 2009, stands in the name of ECC Nominees Limited (“ECC”) and seeks registration of the following trade mark:



2. Following examination of the application it was published in the *Trade Marks Journal* on 3 April 2009 in respect of the following goods:

Class 3:

Cosmetics; soaps; toilet preparations; perfumery, essential oils, shampoos, hair lotions, shower gels, bath foam, facial scrubs, body lotions, creams, hand creams, eye pencil, talcum powder, facial powder, facial powder, hand creams, deodorants, cleansers, beauty care products, moisturisers, petroleum jelly (for cosmetic purposes), castor oil.

3. Notice of Opposition was filed against the application by Nölken Hygiene Products GmbH (“NHP”). NHP rely on a single ground of opposition, that being an objection under section 5(2)(b) based on its earlier International trade mark M833819.

4. ECC filed a counterstatement in which it accepted that there is similarity as regards the respective goods of each mark but otherwise denied the grounds of opposition.

5. Neither party filed evidence though both filed written submissions. Neither party sought to be heard but elected instead to have the matter decided from the papers filed. I go on to give my decision.

### Decision

6. 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 registered trade mark, international trade mark (UK), 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.”

7. NHP’s International registration is an earlier trade mark within the meaning of the Act. The earlier trade mark did not gain protection in the UK until 23 October 2005 which is less than 5 years before the publication date of the application in suit and therefore NHP is not required to prove use of its earlier mark.

8. The opposition is brought under the provisions of section 5(2)(b) of the Act. This reads:

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

(a) ...

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

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

9. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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 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*, 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.

10. In essence the test under Section 5(2)(b) is whether there are similarities in the marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

### **Comparison of the respective goods**

11. Although the earlier mark is protected for goods in a number of classes, NHP relies only on the goods for which the mark is protected in class 3. These are:

“Cosmetics, in particular, skin creams and skin cleansing products, oils, lotions and body powders; personal hygiene products, in particular, oil impregnated wipes, lotion impregnated wipes, moist flannels for cosmetic use, moist skin care wipes and cleansing wipes impregnated with cosmetic lotions; bath additives, not for medical purposes; soaps; sun care products; hair care products, shampoos; cotton wool sticks”

12. In its counterstatement ECC accept that there is similarity in the respective goods however, as each of the above goods are cosmetics, toilet preparations and beauty care products, terms which are included within the specification of the mark for which registration is applied in my view the goods are identical (see *Gérard Meric v OHIM*, Case T-133/05). This being the case the identity will extend to the channels of trade, from manufacturer to retailer.



**Average consumer and the purchasing process**

13. NHP submits “The goods at issue are general cosmetic products, but it is clear that both marks are intended to be used in connection with goods marketed for use on babies or young children.” For its part, ECC submits that although its goods “are for use on babies and young children they are also marketed for, and used by adults.”

14. It seems to me that some of the goods as applied for would be highly unsuited for use on babies and young children e.g. eye pencils, deodorants, facial scrubs. Whatever the parties’ intentions, I note that neither of the respective specifications has been limited in any way and I have to consider the specifications are advertised and registered. The goods are everyday articles. Whilst some, e.g. eye pencils, are traditionally most likely to be used by older girls and women, others e.g. deodorants, may be used by older children and adults of both genders and still others e.g. soaps and shampoos, by those of both genders and all ages. Depending on such matters as the purpose and ingredients making up the individual items, their cost are likely to vary with those intended for everyday use being relatively inexpensive e.g. cotton wool sticks, with the others intended for more discerning use e.g. perfumery being more costly. All of the goods are such as will most often be bought by self-selection in a chemists or other shop or from a supermarket (whether actual or virtual) where the visual consideration of the respective marks is likely to be the most important. I also bear in mind that some goods, such as perfumery, may be kept in locked display cabinets with the purchaser having to ask an assistant for them in which case the aural consideration may also be important. I, of course, have to take a global approach in reaching my decision and consider all relevant factors.

**Comparison of the respective marks**

15. For ease of reference I set out below the respective marks to be compared:

ECC’s mark	NHP’s earlier mark
	

16. ECC's mark consists of the word BABYLINA presented in block capitals with each letter presented in one of first five colours of the rainbow (with the colour of each successive letter differing from the one preceding it). Underneath this, and extending the full width of this word are the words PETROLEUM JELLY, with the initial letter of each word capitalised, and the letters BP and EP each presented in a single colour. The whole is enclosed within an oval border which has a slight shadowing to the lower right quarter.

17. The first element of NHP's mark is the word BABY presented in light blue, lower case letters. Underneath this, and in a smaller, cursive, font is a word presented in black script. NHP states that the word is LINE although given the style of presentation it is, in my view, somewhat difficult to read and may be seen by some as the word LIME. This is especially so given the positioning of the colour yellow within the mark. The whole is presented in a rectangular border with curved corners. The cursive script extends to, and joins to form the lower portion of, the border (the resultant space being filled in with the colour yellow).

18. As both marks begin with the letters B-A-B-Y-L-I there is clearly a degree of similarity between them from a visual perspective. For those who see NHP's mark as BABY LINE rather than BABY LIME, there will be further similarity in respect of the letter N. There are, however, some differences between the marks given that ECC's mark presents these letters as part of a single word whereas NHP presents them as two separate words with one word above the other and where, as indicated above, the second word is less easily discernible due to its being in cursive script. And whilst both marks have further similarities in that each is presented in a number of colours, there are also differences in that ECC's mark uses a different colour for each of the letters of the word BABYLINA whereas NHP's mark presents each word within its mark in a different but single colour. The difference in the shape of the border of each mark is emphasised to some degree by the use and positioning of the block of yellow colour within NHP's mark.

19. The words PETROLEUM JELLY are entirely descriptive of goods being or made using that substance. The letters BP and EP are recognised abbreviations for the British and European Pharmacopoeia respectively and therefore are descriptive of products meeting the respective quality standards for medicinal etc. substances. The word BABYLINA is not, as far as I am aware, a dictionary word and this, coupled with the size and style of presentation make this word the dominant element within the mark for which registration is applied. It is also the distinctive element within the mark and is the word the average consumer will use when referring to the mark. Being an invented word, some, on seeing it, may break it down in such a way as to create two component parts i.e. BABY and LINA. For those who do this, I do not think there can be any doubt as to how the first component part will be pronounced given that this forms a well known word and particularly so where the goods concerned may be for use on babies. The same is not true, however with the second component part which may be articulated either as in liner or as in leaner. Others may break the word down differently, particularly so where the goods are to be used by adults and may articulate it as BAB-EE-LIE-NER, BAB-EE-LEE-NER or BAB-ILL-EE-NER. The earlier mark is likely to be articulated as two distinct elements BABY LINE (or BABY LIME, though given the similarity between the sound of the letters N and M at this position, any aural difference between these is likely to be lost).

However the respective marks are pronounced, ECC's mark will be articulated as having four syllables and the earlier mark as three which increases the differences between them.

20. Those who identify the word BABY within ECC's mark are likely to bring to mind something to do with babies. Those who articulate the word as BABY-LINER may, for example, bring to mind something for providing a lining, in the sense of a e.g. a protective barrier, to a baby's skin. Those who do not identify the word BABY with the mark and articulate it as BAB-EE-LIE(or LEE)-NER, are likely to see it as an invented word with no particular meaning. This is particularly so, in my view, where the goods are not intended for use on babies.

21. As I indicated above, the earlier mark may be seen as BABY LINE or BABY LIME. Although the letters B and A of the word BABY both touch the letter L of the word LINE (or LIME), BABY holds a somewhat separate position within the mark and, being in a larger and clearer font, is the dominant element within the mark. Whilst it is the dominant element, for goods intended for babies it will not be distinctive. The word LINE is a word in common use to describe a connected range of goods. The words BABY LINE are entirely apt for use on a line of goods for babies and, in these circumstances, the distinctiveness in the mark will rest in the mark as a whole though the level of distinctiveness will be low. Where used on a line of goods for adults, the word BABY will be somewhat more distinctive though given that it is apt to describe a range of goods which have baby-like qualities e.g. where the goods are gentle in nature and unlikely to aggravate the skin, the level of distinctiveness is still fairly low. For those who see the mark as BABY LIME, the word BABY is still likely to be the dominant element given its size and position however the mark will have a slightly greater degree of distinctiveness when considered as a whole.

22. No evidence of any use of the earlier mark has been filed and therefore I am unable to say that it has accrued any enhanced distinctive character as a result of use.

### **Likelihood of confusion**

23. In reaching a decision on whether there is a likelihood of confusion, I must make a global assessment based on all relevant factors including the fact that consumers rarely have the opportunity to compare marks but must instead rely on the imperfect picture they have kept of them in their mind. Having done so, it seems to me that whilst there are some similarities between the respective trade marks, there are also significant differences them particularly so when taking account of the visual comparison which, for reasons given above, are likely to be the most important consideration. In my view, those differences outweigh the similarities, even where identical goods are involved. That being the case I consider there is no likelihood of confusion and the opposition brought under the provisions of section 5(2)(b) fails in its entirety.

### **Costs**

24. The opposition has failed and ECC is entitled to an award of costs in its favour. I take note that no evidence was filed by either party but both filed written submissions

in lieu of attendance at a hearing. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4/2007. Using that TPN as a guide, I award costs on the following basis:

Preparing a statement and considering other side's statement:	£200
Preparing and reviewing written submissions:	£400
Total:	£600

25. I order Nölken Hygiene Products GmbH to pay ECC Nominees Limited the sum of £600. 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 16 day of July**

**Ann Corbett  
For the Registrar  
The Comptroller-General**