

O-266-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3143312

BY MILTON LLOYD (TRADE MARKS) LIMITED

TO REGISTER THE TRADE MARK

FAME & GLORY

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER No. 406418 BY

SOAP & GLORY LIMITED

BACKGROUND

1) On 7 January 2016, Milton Lloyd (Trade Marks) Limited (hereinafter the applicant) applied to register the trade mark "FAME & GLORY" in respect of the following goods:

Class 3: Perfumes, perfumery, fragrances (perfumery), essential oils.

2) The application was examined and accepted, and subsequently published for opposition purposes on 22 January 2016 in Trade Marks Journal No.2016/004.

3) On 13 April 2016 Soap & Glory Limited (hereinafter the opponent) filed a notice of opposition. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
SOAP & GLORY	2394916	22.06.05 27.01.06	3	Cosmetics; moisturizers; toners; serums; masks; cleansers; toiletries, soaps, perfumery; fragrances; shampoos; conditioners; lotions; creams; preparations for the care and treatment of the body, face, skin or hair; serums; masks; shower gels; moisture lotions; moisture creams; body scrubs; bath gels; bath oils; bath creams; facial moisturising lotions; face masks, eau de toilette; parfums; scented body sprays; body gels; body lotions; body creams; body masks; facial creams, lotions and toners; hand care creams, masks, serums and scrubs; skin moisturisers.

a) The opponent contends that its mark and the mark applied for are very similar and that the goods applied for are identical and/or similar to the goods for which the earlier mark is registered. As such the mark in suit offends against Section 5(2)(b) of the Act.

4) On 13 April 2016 the applicant filed a counterstatement basically denying that the marks are similar and stating that the two parties are not in the same marketplace. The applicant put the opponent to strict proof of use.

5) Both parties filed evidence. Both parties seek an award of costs in their favour.

Neither side wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 19 September 2016, by Katie Smith a trade mark attorney employed by the opponent company since October 2015. She provides the following exhibits:

- KS1: An extract from the UKIPO database showing details of the opponent's registration.
- KS2: An extract from the online Oxford Dictionary which provides the following definition: "Glory: High renown or honour won by notable achievements".
- KS3: A witness statement by Alexandra Mayo, dated 23 August 2016, the Global Category Director of the opponent company, a position she has held since September 2015. She states that the brand "Soap & Glory" was launched in the UK in 2006. She confirms that the opponent's mark has been used upon the goods relied upon (see paragraph 3 above) in the UK in the last five years. She states that the goods are sold in approximately 1,700 Boots UK Ltd stores throughout the UK and online at www.boots.com, and also through the opponent's own website. She states that the mark is applied to the products, their packaging as well as point-of-sale material and product literature. The following turnover and advertising figures are provided in exhibits AM2 & 4. She also provides the exhibits listed below.

Year	Approximate Turnover £million	Promotion & advertising £000
2011	40	730
2012	50	750
2013	60	730
2014	61	530
2015	64	620

- AM1: Extracts from the opponent's website which show goods offered for sale under the opponent's mark, but which are dated August 2016, after the relevant date. Whilst the mark is used on the webpage it cannot be seen on the actual goods offered.
- AM2: Turnover figures for the UK during the years 2011 to 2016 (see above).
- AM3: A selection of invoices dated between 2008 and 2015 relating to the sale of goods under the opponent's mark in the UK. The majority are dated between March 2008 and December 2010. These show the mark Soap & Glory and a device at the top of the page. It does not appear in the description of the articles being supplied. The balance of the invoices are dated between 23 March 2011 and 8 October 2015. There are twenty invoices, all of which show the mark SOAP & GLORY inside a circle device at the top of the page. The item descriptions do not include the mark. Three invoices are for overseas customers. Eleven relate to sales to Harvey Nichols in London, totalling approximately £5,000 including VAT; two invoices totalling ££3,409 were to Boots International Ltd in Nottingham; two invoices totalling £749 were to ASOS in London, the last two were to addresses in London for Flipflop Ltd and Staff sales and were both for £25. Whilst in the case of some names of goods used in the invoices, such as "butter yourself" and "sit tight", the actual product cannot be identified, there are other instances where a proper description is used. These instances show sales of mascara, body wash, hand cream, cleanser, face soap, shampoo, conditioner, body scrub, face wipes, pore cleanser & bath soak. However, by cross referencing these names to exhibit 5 it is clear that they all relate to cosmetics, soaps, perfumes, creams and shampoos.
- AM4: Figures relating to the advertising and promotional expenditure for the UK during the years 2011 to 2016 (see above).
- AM5: A selection of marketing material such as brochures, point of sale material and product literature and also a selection of press advertising and coverage in a variety of magazines such as *OK!*, *Glamour*, *Heat*, & *Elle*. These show a range of cosmetics such as conditioners, shampoo, perfumes, lotions, soaps, body sprays, moisturisers, cleansers eye cream, lip gloss, face powder, scrubs, toners, serums, eye liner and foot cream. In addition in 2013 (at page211) a range of products for men is advertised for Father's Day. These include shaving gel, body spray, shower gel, facial balm, sculpting putty and eau de toilette. On all the illustrations of the

goods the mark Soap and Glory in a circle device can be seen. These pages all appear to be dated between 2011 and 2015.

APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 20 February 2017, by Alan Venner the applicant's Trade Mark Attorney. He provides the following exhibits:

- AV1: Details from the IPO and EUIPO websites of other marks registered for goods in Class 3.
- AV2: A depiction of the mark used by the opponent as shown below:



- AV3: A photograph taken at a Boots retail outlet which shows a stand of the opponent's products. The stand has at the top the words SOAP & GLORY in the same font as shown in exhibit AV2 above, except that the words are in a single line rather than one being underneath the other. Below this in much smaller print is the strapline "GIFTS WITH "THRILL HER" INSTINCT".



- AV4: A copy of a page from the opponent's website where the statement "Soap & Glory has been supporting the Clean of England since 2006, when we started formulating fun, fearlessly world-class products to give every girl THE BEST BANG FOR HER BEAUTY BUDGET."
- AV5: This consists of a witness statement, dated 21 February 2017, by Peter Jackson the Chairman of the applicant company, a position he has held for 16 years. He states that his company have produced and sold a perfume under the trade mark FAME since the early 1990s. This product was primarily aimed at women. The applicant wished to extend the range to target male customers and so re-branded the perfume / cologne range FAME & GLORY. He states that the applicant's products are sold throughout the UK but not in Boots stores. He states that he was unaware of the opponent's mark prior to these proceedings. He provides the following exhibits:
 - PJ1: A copy of an undated page from the applicant's website showing FAME perfume.
 - PJ2: A copy of an undated page from the applicant's website showing FAME & GLORY eau de toilette.

OPPONENT'S EVIDENCE IN REPLY

8) The opponent filed a second witness statement, dated 31 March 2017 by Katie Smith who has provided evidence earlier in these proceedings. She states that the opponent has recently invalidated an EU mark belonging to a third party not connected with this case. She states that the opponent used to sell a range of men's products under the SOAP & GLORY mark. She also makes reference to another EU case regarding the opponent's mark, but this does not assist me with my decision.

- KS4: A copy of a page dated 11 June 2013 from the opponent's website which shows products aimed at men offered under the SOAP & GLORY mark.

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) The only ground of opposition is under section 5(2)(b) which 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.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

12) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The applicant requested that the opponent provide proof of use and, given the interplay between the date that the opponent’s mark was registered (27 January 2006) and the date that the applicant’s mark was published (22 January 2016), the proof of use requirement bites. Section 6A of the Act states:

“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.”

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 22 January

2016, therefore the relevant period for the proof of use is 23 January 2011 – 22 January 2016. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

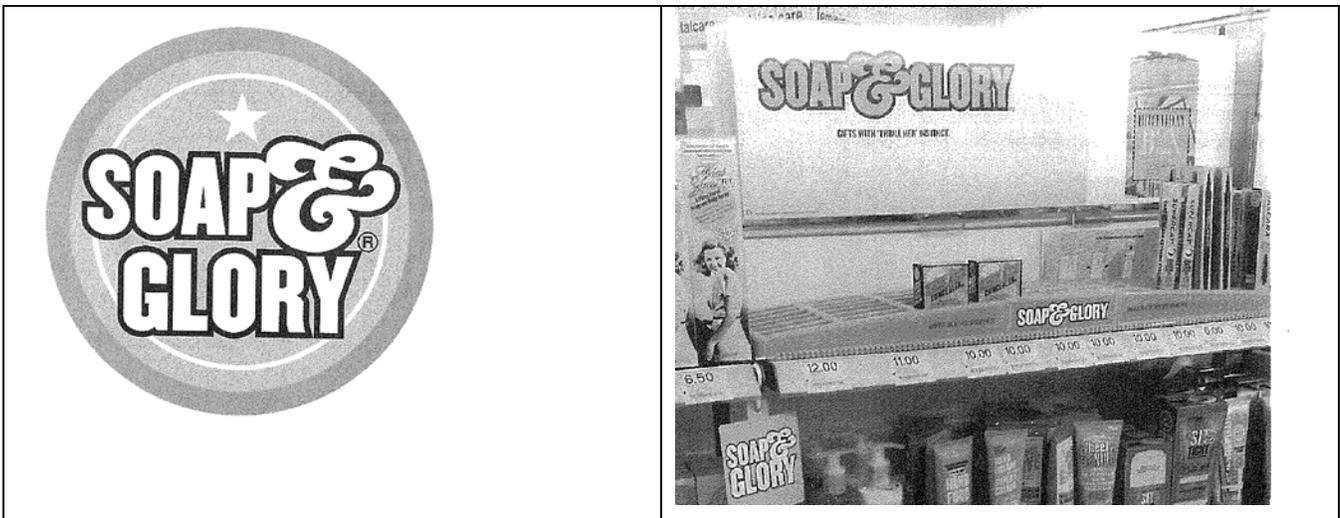
(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

14) All of the evidence shows use of the mark in the formats shown below (see exhibits in paragraph 7 above).



15) The mark was registered in simple capital letters "SOAP & GLORY". I must therefore decide whether use of the marks above can be deemed to be use of the registered mark. In deciding this question I look to the comments of Mr Richard Arnold Q.C. (as he then was) as the Appointed Person, in *Nirvana Trade Mark*, BL O/262/06, where he summarised the test under s.46(2) of the Act as follows:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

16) Although this cases was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark. I note that in its submissions the applicant does not take issue that the use shown under the marks at paragraph 14 above is use of the registered mark. To my mind, whilst a slightly stylised font is used, this does not alter the distinctive character of the mark which resides in the words "SOAP & GLORY". Similarly the use of a circle and star devices in the first version does not alter the distinctive character of the registered mark as these will be seen as mere marketing devices to draw attention to the mark and the goods on offer. The use of a separate strapline "Gifts with "thrill her" instincts" in the second version of the mark shown above does not alter the distinctive character of the mark "SOAP & GLORY" as the strapline is clearly separate, in a smaller standard font and distanced some way below the actual mark. I do not believe that the average consumer will view the strapline as part of the trade mark. **Therefore, I regard use of the marks shown in paragraph 14 above to be use of the registered mark.**

17) The applicant contended in its submissions that the use shown did not include the following items which are found within the applicant's specification: "perfumes, perfumery, fragrances (perfumery), essential oils". What I am required to do under the proof of use test is to determine what, if any, use has been shown of the various goods for which the opponent's mark is registered and following this then compare the goods of the two parties. In the instant case, considering the various exhibits provided I reach the conclusion that the opponent has shown use of the following goods for which its mark is registered: "Cosmetics; moisturizers; toners; serums; cleansers; toiletries, soaps, perfumery; fragrances; shampoos; conditioners; lotions; creams; preparations for the care and treatment of the body, face, skin or hair; serums; shower gels; moisture lotions; moisture creams; body scrubs; facial moisturising lotions; eau de toilette; parfums; scented body sprays; body gels; body lotions; body creams; facial creams, lotions and toners; hand care creams, serums and scrubs; skin moisturisers".

18) In my opinion the opponent has not shown use of the following goods: "masks; bath gels; bath oils; bath creams; face masks; body masks". These goods will not form part of the comparison test.

19) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *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.

(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.

The average consumer and the nature of the purchasing decision

20) 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 *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.”

21) The applicant’s specification, consist of perfumes and essential oils whilst the opponent’s specification consists of, broadly speaking, cosmetics, perfumes, creams and cleansers of various descriptions. Such goods will be sold in, inter alia, traditional retail outlets on the high street, through catalogues and on the Internet. The specifications of both parties are unlimited, and so I must keep all of these trade channels in mind. The average consumer of the goods at issue is a member of the general public (including businesses such as hotels) who is likely, in my opinion, to select the goods mainly by visual means. The costs of such items can vary widely with perfumes costing from a few pounds to many thousands. I accept that more expensive items may be researched or discussed with a member of staff. Clearly, the average consumer’s level of attention will vary considerably depending on the cost and nature of the item at issue. However, to my mind even when selecting routine inexpensive items of perfume such as a body spray, the average consumer will pay attention to considerations such as smell, whether the item is hypo-allergenic and how it is tested (animal free etc). **Overall the average consumer is likely to pay a low to medium degree of attention to the selection of items of perfumery and cosmetics.**

Comparison of goods

22) In the judgment of the Court of Justice of the European Union (CJEU) 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”.

23) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

24) In its submissions the applicant contends that whilst there is a degree of similarity between the goods of the two parties, the opponent’s goods are sold through Boots outlets and aimed at the female consumer (use of the word HER in exhibits AV3 & 4). Whereas the applicant’s goods are targeted at the male consumer and sold through what it describes as “an entirely different wholesale distribution network which means that the products are unlikely to ever be sold in the same retail outlet.” I note that neither parties’ specification is limited by gender or indeed by sales outlet, nor could they be so limited. These contentions are therefore irrelevant and are dismissed.

25) The applicant seeks registration in respect of the following goods in class 3 “Perfumes, perfumery, fragrances (perfumery), essential oils”. The opponent’s specification includes “perfumery; fragrances; eau de toilette; parfums; scented body sprays”. Clearly these terms in the opponent’s specification encompass the terms “Perfumes, perfumery, fragrances (perfumery)” in the applicant’s specification. I note that essential oils are oils which contain the essence of the plant from which it was extracted and that these are used in perfumes, cosmetics, soap and also food. **I therefore find that the applicant’s goods “Perfumes, perfumery, fragrances (perfumery)” are identical to the opponent’s goods and the term “essential oils” in the applicant’s specification is highly similar to the opponent’s specification of “perfumery; fragrances; eau de toilette; parfums; scented body sprays; cosmetics; soaps”.**

Comparison of trade marks

26) 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 them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

27) It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponent's trade mark	Applicant's trade mark
SOAP & GLORY	FAME & GLORY

28) The applicant correctly points out that the first word of the two marks are completely different, but both are common English words with well- known meanings which are entirely different. The applicant disputes that the opponent has any exclusivity to the “& GLORY” part of its mark as it contends that there are a number of marks on the Register which also have this element and are registered for Class 3 goods. However, no evidence that any of these marks have been used in the UK has been adduced, and so this must be regarded as “state of the Register” evidence. In the *Torre-mar* case [BL O/207/02] Mr G Hobbs Q.C. acting as the Appointed Person stated that whether a consumer deems a mark to be origin specific or origin neutral:

“may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally. In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks; entries in the register do not in themselves affect the way in which marks are perceived and remembered.”

29) The applicant also refers to the opponent's use of "eye-catching and distinctive pink, white and black colour theme, retro packaging and idiosyncratic product names". However, I must consider the mark as registered which does not contain limitations regarding colour etc. nor the other features commented upon. Considering the marks, as registered, there is an obvious visual and aural difference in the first element of both marks. Equally the second and third elements of both marks "& GLORY" are identical. Conceptually, the applicant contends that there is no similarity as the applicant's mark "is surely a pun on the British patriotic phrase "Hope and Glory" whereas the applicant's mark has been coined as a development of their long established and used mark FAME". I note that the applicant, although mentioning use of the mark FAME on perfume since the early 1990s has not provided any sales figures, market share etc. which would give an indication as to its reputation in the mark FAME. I would also question whether the mark in suit would be seen as an extension of the FAME brand. It was stated by the applicant that its FAME perfume was aimed at women and it wanted to extend the brand to appeal to men. Quite why the words "& GLORY" would signify to consumers that this was the masculine product of the FAME perfume has not been explained. I agree with the applicant that the words "Hope & Glory" would resonate with the average UK consumer as the words from the Elgar classic "Land of Hope & Glory". However, the opponent's mark is "SOAP & GLORY" which, given many of the goods for which it is registered (soap, cleansers, shampoo, gels etc.) would be seen as a clear allusion to the product. I accept that for many of the products for which the opponent's mark is registered the word "Soap" has no meaning/connection. Whilst "FAME" and "GLORY" would be seen as two sides of the same coin. To my mind, the average consumer is likely to view both parties' marks as suggesting they are well known, of high renown or having resplendence. There are clear visual, aural and conceptual similarities as well as differences. **Overall I believe that the marks are similar to a low to medium degree.**

Distinctive character of the earlier trade mark

30) 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).”

31) The applicant contends:

“It cannot be accepted that the Earlier Mark has anything other than a low degree of inherent distinctive character. It has already been submitted that the conceptual construction of the mark strongly draws to mind the patriotic phrase “Hope & Glory” with the first word “SOAP” of the earlier mark a perfect rhyme of the word Hope. Further the use of the word “soap” for products that at their core are goods to be used as toiletries and can loosely be described a *soaps* cannot possibly instil a strong distinctive character.

Without admission of all of the evidence submitted by the opponent as fact it can be accepted that their mark has been put to use on some scale in the United Kingdom over the past ten years. It is however not accepted that such use has derived them the benefit of any additional distinctive character other than in the specific pink, white and black colour theme logo as already referred to in this submission.”

32) It would appear from the above comments that the applicant is asserting that the distinctive character of the opponent’s mark cannot lie in the word “Soap” as this is descriptive of the products for which it is registered. The distinctive character of the opponent’s mark must therefore lie in the last two elements” & GLORY” which have no truly descriptive meaning, only the allusive reference described in paragraph 29 above, when used on what can loosely be described as toiletries. The opponent’s mark as a whole is therefore **inherently distinctive to a medium degree. The opponent**

has shown use of its mark but given the specification for which it is registered, the absence of information regarding market share and the enormity of the market in the UK for toiletries, the level of sales shown is not sufficient to warrant a finding of enhanced distinctiveness.

Likelihood of confusion

33) In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive the 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 has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer for the goods is a member of the general public including businesses who will select the goods by predominantly visual means, although I do not discount aural considerations and that they are likely to pay a low to medium degree of attention to the selection of perfumery and cosmetics.
- the marks of the two parties are similar to low to a medium degree.
- The opponent's mark has a medium level of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- The applicant's goods "Perfumes, perfumery, fragrances (perfumery)" are identical to the opponent's goods whilst the applicant's "essential oils" are highly similar to the opponent's goods.

34) In view of all of the above, and allowing for the concept of imperfect recollection there is a likelihood of consumers being confused into believing that the goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by an undertaking linked to it.

The opposition under Section 5(2) (b) therefore succeeds.

CONCLUSION

35) The opposition in relation to all the goods applied for has been successful.

COSTS

36) As the opponent has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£300
Expenses	£200
Submissions	£200
TOTAL	£1,000

37) I order Milto Lloyd (Trade Marks) Limited to pay Soap & Glory Limited the sum of £1,000. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2ND day of June 2017

George W Salthouse
For the Registrar,
the Comptroller-General