

O/295/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3248781
BY HONESTLY HOPE LIMITED
TO REGISTER AS A TRADE MARK:

Honestly Hope

FOR GOODS IN CLASSES 3 AND 5

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 410211
BY THE HONEST COMPANY, INC.

BACKGROUND AND PLEADINGS

1. On 7 August 2017, Honestly Hope Limited ("the Applicant") applied to register as a UK trade mark the words "Honestly Hope", in respect of goods in Classes 3 and 5 as follows.

Class

Applicant's goods

3 (Non-medicated-); After-sun oils [cosmetics]; Age retardant lotion; Anti-ageing creams; Anti-aging moisturizers; Anti-wrinkle creams; Aromatic oils for the bath; Aromatics [essential oils]; Bath and shower gels, not for medical purposes; Bath oils; Beauty lotions; Beauty serums; Blended essential oils; Body cleaning and beauty care preparations; Body oils; Body wash; Bubble bath; Cosmetic creams for skin care; Cosmetic oils; Cosmetic products for the shower; Cosmetics in the form of oils; Distilled oils for beauty care; Essential oils; Face and body lotions; Face oils; Facial oils; Hair care lotions; Hair care serums; Hair oils; Hair serums; Hand oils (Non-medicated-); Lotions for beards; Massage oils; Mineral oils [cosmetic]; Moisturisers; Natural oils for cosmetic purposes; Non-medicated bath oils; Non-medicated cleansing creams; Non-medicated hair shampoos; Non-medicated oils; Oil baths for hair care; Oils for cosmetic purposes; Oils for hair conditioning; Oils for perfumes and scents; Perfume oils; Perfumed oils for skin care; Serums for cosmetic purposes; Shower and bath gel; Skin care creams, other than for medical use; Skin care lotions [cosmetic]; Skin care oils [cosmetic]; Skin care oils [non-medicated].

5 Edible fish oils for medical purposes; Medicinal oils; Oils (Medicinal -); Ointments for pharmaceutical purposes; Plant and herb extracts for medicinal use; Serums; Skin care creams for medical use; Skin care lotions [medicated]; Skin care (Pharmaceutical preparations for -); Skin care preparations for medical use.

2. The application was published for opposition purposes on 18 August 2017 and is opposed by The Honest Company Inc. ("the Opponent"). The opposition is directed against the entirety of the application and is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opponent claims that the mark applied for is highly similar to the Opponent's

earlier registrations detailed below and that the parties' goods and services are identical or similar such that there is a likelihood of confusion on the part of the relevant public.

Marks relied on by the Opponent

EU Trade Mark (EUTM) No. 13779211

HONEST

(Word mark)

Filed: 27 February 2015

Registered: 19 November 2015

Relying on **goods** registered in **classes 3, 4 and 21**.

Class 3: Body care preparations; soap, body butters, body sprays, body and bath oils, body creams, eye creams and gels, facial lotion, facial creams, facial cleaners, facial scrubs, body scrubs, body gels, lip balms; cosmetics; exfoliants for skin; eyebrow cosmetics; non-medicated serums for use on skin; non-medicated skin care preparations, including creams, lotions, gels, toners, cleaners, scrubs, oils and peels; tinted skin moisturizer; tinted foundation; tinted powders; tinted concealers; make up for face and body; sunscreen sprays; sunscreen creams; scalp and hair care preparations; hair conditioners; hair shampoos; shaving preparations; shaving lotions; shaving oil; shaving cream; perfumes; colognes; fragrances; personal deodorants and antiperspirants; pre-moistened cosmetic wipes.

Class 4: Candles; fragranced candles.

Class 21: Shaving brush holders; shaving brushes.

EU Designation of International Registration No:

HONEST

WE1245396 (based on a trade mark registered in USA)

(Word mark)

Date of Designation of the EU: 17 October 2014

Date protection granted in EU: 11 March 2016

Relying only on **goods** registered in **classes 3 and 5**, and **services in class 35**

Class 3: All-purpose cleaners; anti-static dryer sheets; baby bubble bath; baby hair conditioner; baby hand soap; baby lotion; baby oil; baby shampoo; baby wipes; body lotion; body oil; body wash; cleaning agents for cleaning surfaces; detergent soap; dish detergents; dishwasher detergents; dishwashing detergents; fabric softeners for laundry

use; face and body lotions; facial lotion; facial moisturizer with SPF; fruit and vegetable wash; hair sprays; hand soaps; laundry detergent; laundry soap; lip balm; liquid soap; liquid soaps for hands and face; liquid soaps for hands, face and body; non-medicated diaper rash cream; rinse agents for dishwashing machines; soaps and detergents; soaps for babies; soaps for body care; soaps for household use; soaps for personal use; stain removers; sunscreen cream; bar soap; cleaner for use on floors and windows; deodorants and antiperspirants; make-up remover; mouthwashes; non-medicated skin care preparations, namely, nipple cream; room fragrances; tooth paste.

Class 5: Anti-insect spray; antibacterial alcohol skin sanitizer gel; baby diapers; disposable baby diapers; insect exterminating agents; insect repellents (based on intent to use) air deodorizer; breast pads; breast-nursing pads; disinfectant bathroom cleaners; feminine hygiene pads; infant formula; inserts specially adapted for cloth infant diapers made of paper; menstruation pads; menstruation tampons; nursing pads; rubbing compound for medical and/or therapeutic use; tampons; vitamins.

Class 35: Retail store services featuring a wide variety of consumer goods, namely, eco-friendly baby products, baby bath products, baby diaper products, baby body care products and household cleaning products; providing consumer product information via the internet or other communications networks; computerized on-line ordering services featuring a wide variety of consumer goods, namely, eco-friendly baby products, baby bath products, baby diaper products, baby body care products and household cleaning products.

UK Designation of International Registration (IR) No:

WO1245396 (based on a trade mark registered in USA)

HONEST

Date of Designation of the UK: 17 October 2014

Date protection granted in UK: 12 November 2015

Relying on goods and services registered in classes 3, 5 and 35, as in the IR EU above WE1245396.

3. The Applicant filed a notice of defence and counterstatement on Form TM8 denying the grounds of opposition, particularly that “Honestly Hope” is similar enough for the public to be confused. Its counterstatement also included points that are not relevant to the decision

to be made in this case, including points relating to differences between the parties' branding, which I shall address later in this decision.

Papers filed and representation

4. Neither party filed evidence, but both filed written submissions in lieu of an oral hearing, although the Applicant's submissions mainly repeated the points from its counterstatement. I shall refer to points submitted so far as I consider appropriate in this decision.
5. The Applicant is self-represented in these proceedings and Bird & Bird LLP acts as the Opponent's representative. Neither party requested an oral hearing and I take this decision based on a careful reading of the papers filed.

DECISION

6. Section 5(2)(b) of the Act states:

"... A trade mark shall not be registered if because-

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

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

7. The definition of an "earlier trade mark" includes, under section 6(1)(a) of the Act, "a registered trade mark, international trade mark (UK), a European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question ...". As detailed above, all three of the registrations relied on by the Opponent were filed on dates earlier than the Applicant's mark and are clearly earlier trade marks under the Act.
8. None of the marks relied on had been registered for five years or more when the Applicant's mark was published for opposition. They are therefore not subject to the proof of use

provisions under section 6A of the Act, and consequently, for the purposes of its section 5(2)(b) claim, there is no obligation on the Opponent to show that it has used those marks.

9. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

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.

10. The principles are that:

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

Comparison of goods and services

11. The Opponent submits that the Applicant's goods "are all identical and/or highly similar to the goods and services covered by the Opponent's earlier rights". The Opponent submits that in particular "body care preparations" and "scalp and hair care preparations" encompass most, if not all, of the Applicant's Class 3 goods. The Opponent also submits that its "earlier rights cover various types of bath and cosmetic products, as well as services relating to the retail of such products, all of which are highly similar" to the Applicant's Class 3 goods.

12. In relation to the Applicant's Class 5 goods, the Opponent submits that they cover "a number of skin care products and preparations which are highly similar to the Class 3 and Class 35 services covered by the Opponent's earlier rights." It also submits that the Applicant's Class 5 goods are "also highly similar to the Class 5 goods covered by the Opponent's earlier rights, all of which are types of everyday hygiene and well-being products that would be sold through the same retail channels, namely pharmacies and supermarkets."
13. I note from my own comparison that the parties' specifications include some identical terms. Moreover, it is clear from case law such as *Meric*¹ that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application or vice versa. It is clear therefore that the parties have at least some identical goods in Classes 3 and 5, as may be seen from my selection of goods that I have extracted and arranged for ease of comparison in the table below:

Opponent's goods under EUTM No. 13779211	Applicant's goods
<p>Class 3:</p> <p>Body care preparations</p> <p>body and bath oils</p> <p>body creams, facial lotion, facial creams</p> <p>eye creams and gels, cosmetics; non-medicated serums for use on skin; non-medicated skin care preparations, including creams, lotions</p>	<p>Class 3:</p> <p>Body cleaning and beauty care preparations</p> <p>Bath oils; Body oils</p> <p>Face and body lotions</p> <p>Anti-wrinkle creams; Beauty lotions; Beauty serums; Cosmetic creams for skin care; Skin care creams, other than for medical use; Skin care lotions [cosmetic]</p>

¹ See paragraph 29 of the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05

scalp and hair care preparations; hair shampoos; hair conditioners	Hair care lotions; Hair care serums; Non-medicated hair shampoos; Oils for hair conditioning
<p align="center">Opponent's goods under its international registrations designating EU and UK (WE/O1245396)</p> <p>Class 5: rubbing compound for medical and/or therapeutic use</p>	<p>Class 5: Medicinal oils; Oils (Medicinal -); Ointments for pharmaceutical purposes; Plant and herb extracts for medicinal use; Serums; Skin care creams for medical use; Skin care lotions [medicated]; Skin care (Pharmaceutical preparations for -); Skin care preparations for medical use.</p>

14. Since the parties have at least some identical goods, I find it unnecessary for the purposes of this decision to compare the respective goods further. I will proceed on the basis that all of the goods are identical because, if the opposition fails in respect of goods that are identical, it will also fail in respect of goods/services which are only similar (or not similar).

The average consumer and the purchasing process

15. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select the goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question². In *Hearst Holdings Inc*,³ 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 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 word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”

² *Lloyd Schuhfabrik Meyer*, Case C-342/97

³ *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),

16. The Opponent submits that the average consumer for the goods at issue in Class 3 are members of the general public⁴. I agree. The Opponent submits that the relevant consumer will demonstrate “*at least a medium degree of attention when purchasing such goods*”. I accept that too. The level of attention when selecting the goods will likely be sufficient perhaps to check ingredients and factor in considerations of personal suitability (scent, allergies etc). Visual considerations will feature particularly significantly in the purchasing act because such goods are likely to be selected visually after perusal of racks/shelves in retail outlets, or from images on websites or in catalogues. However, aural considerations may also play a part, such as on the basis of word of mouth recommendations or advice from sales assistants. For the medicinal and hygiene goods at issue in Class 5 the Opponent submits that there are two possible sets of relevant average consumers, namely the general public and medical practitioners, both of whom will demonstrate a medium-high level of attention when purchasing such goods. Again, I accept that.

Comparison of the marks

17. It is clear from *Sabel*⁵ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (CJEU) stated in *Bimbo* 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.*”
18. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

⁴ The Opponent submission to that effect extends to the goods in Classes 3, 4, 21 and services in Class 35.

⁵ *Sabel BV v Puma AG*, Case C-251/95

Opponent's earlier registered trade mark:	HONEST
Applicant's contested trade mark:	Honestly Hope

19. The Opponent's mark consists only of the word "HONEST"⁶ so the overall impression of the Opponent's mark comes solely from that ordinary English-language word. The Applicant's mark is the same word in adverbial form, coupled with and preceding the word "Hope", again ordinary English-language words. The overall impression of the Applicant's mark comes from each of its two words in roughly equal measure.

Visual similarity

20. Although the Applicant's word mark is presented in title case, and the Opponent's in upper case, this has no bearing on my assessments since normal and fair use of a trade mark registered as a word mark would certainly allow for such variation between upper and lower case.

21. The Opponent submits that the respective marks are visually similar as the word HONEST is distinctive for its registered goods (and services) and the word is fully subsumed within the Applicant's mark. The first six letters of the Applicant's mark are the same six letters of the Opponent's mark and, in that regard, the Opponent submits that the rule of thumb is that consumers tend to pay more attention to the beginning of a mark. I accept those points from the Opponent. There is some visual similarity between the marks, but I estimate the degree of **visual similarity** to be **between low and medium**. The additional two letters present at the end of the first word of the Applicant's mark both lengthen and alter the word that is the earlier mark. What is more, the additional four letter word "Hope" in the Applicant's mark is an important point of distinction in the overall impression of the Applicant's mark.

⁶ Although the International Registration designating the UK (WO1245396) appears to involve a particular font (though not an elaborate one) the WIPO record shows it in standard characters, i.e. not figurative and I anyway consider it a word mark for the purposes of this decision.

Aural similarity

22. The words will be given their usual pronunciation and the first two syllables of the Applicant's mark will be pronounced in the same way as the two syllables of the Opponent's mark. Although the marks coincide in the first part, there is a clear aural difference, not only in the additional syllable ending the first word of the Applicant's mark, but more strikingly because of the extra word 'Hope' in that mark.
23. I estimate the degree of **aural similarity** to be **medium at most**.

Conceptual similarity

24. The Opponent submits that the average consumer will likely perceive the term "honest" as *"relating to something that is truthful, sincere and pure, all qualities that are positive and forward-looking in nature. The term Honestly Hope is also likely to be perceived by consumers as a positive statement relating to both honesty and positivity."* I largely agree with those submissions, except for the reference to "forward-looking", which notion I find apt in relation to "hope", but not to "honest".
25. The marks share the concept of honesty, but there is a perceptible difference in focus in the messages of the marks. The mark "Honest" will be understood to mean "free of deceit; truthful and sincere" and as an adjective to allude to a quality or something of the nature of the goods. The word "honestly" is an adverb qualifying the verb "hope"; so the mark "Honestly Hope" may therefore be understood more as a directive or suggestion addressed to the consumer of the goods, less directly a reference to the goods themselves. If this analysis risks straying towards the territory of artificial dissection of the trade mark, then I anyway find that the additional presence of the word "hope" creates a distinct conceptual difference between the marks. The average consumer will understand the word hope as relating to aspiration or wanting something to happen or to be true. I find that the respective marks are **conceptually similar to a low degree**.

Distinctive character of earlier trade mark

26. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*⁷ 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

*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).”*

27. The Opponent’s registration under EUTM No. 13779211 “HONEST” is not an invented word (and therefore particularly distinctive), but nor is it descriptive of the goods for which it is registered (as such). I find it has a normal or average level of inherent distinctiveness. (The word may involve an allusion to some sort of quality of the goods, but any such allusion is too vague to diminish the degree of inherent distinctive character.)
28. The level of inherent distinctiveness of a trade mark may be enhanced through use in the UK, but since the Opponent has in this case filed no evidence of use, there is no possibility of considering an enhanced level of distinctiveness in the perception of the UK consumer.

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

Conclusion as to likelihood of confusion

29. I now turn to reach a conclusion as to the likelihood of confusion between the marks HONEST and Honestly Hope if they were used in relation to their respective registered goods. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of weighing up the combined effect of all relevant factors in accordance with the authorities I have set out in this decision.
30. My findings have included:
- the Opponent has goods that are identical to those of the Applicant goods;
 - the average consumer in this case is a member of the general public, who would pay at least a medium level of attention when buying the goods at issue, in which process visual considerations of the mark predominate, but aural considerations also feature (and for goods in Class 5, the relevant consumer will pay a medium–high level of attention);
 - the Opponent’s HONEST mark is inherently distinctive to a normal or average degree, but no more than that;
 - the parties’ marks are visually similar to a degree between low and medium, are aurally similar to a medium degree at most and are conceptually similar to a low degree.
31. The average consumer is deemed reasonably well informed and reasonably circumspect and observant, but s/he rarely has the chance to make direct comparisons between marks and must instead rely on the imperfect picture of them s/he has kept in their mind. I also bear in mind guidance from case law⁸ to the effect that consumers tend to pay more attention to the beginning of a mark, and that in this case the beginning of the Applicant’s mark is identical to the earlier mark. However, that guidance is just a rule of thumb. I note the principle that a lesser degree of similarity between the marks may be offset by a great degree of similarity between the goods or services, but in this case I conclude that even where the goods are identical, the differences between the marks means that there is no likelihood that

⁸ See for example, the CJEU judgment in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, at para 81 and *Enercon GmbH v OHIM*, T-472/07 (the latter for the application of the principle to a two word mark). But see also *CureVac GmbH v OHIM*, T-80/08 (similar beginnings not necessarily important or decisive).

the average consumer, paying at least a medium level of attention, seeing or hearing the marks at issue would be confused. **Consequently, the opposition fails.**

32. For completeness, as I mentioned earlier, the Applicant made various points in its counterstatement and submissions, none of which is influential in this decision. The task before me involves a notional assessment of whether normal and fair use of the marks as registered in relation to the goods at issue would be likely to confuse the average consumer. Branding considerations, such as packaging and styling, are not relevant⁹, as they are open to change and are not what is protected by a trade mark registration. The Applicant also submitted that the Registry “*obviously considered that there did not appear to be a conflict of interest when they accepted [the] application.*” This is ill-founded, since if the proprietor of a trade mark considers that an applicant’s mark will conflict with its registration, it is for the proprietor to bring a claim – the Registry does not refuse registration on these “relative grounds” (i.e. because of pre-existing right).

Costs

33. The opposition has failed and the Applicant is entitled to a contribution towards its costs. The Applicant is self-represented and was offered the opportunity to file a request for award of costs, but the Applicant stated that it did not seek costs. I therefore make no order for costs.

Dated this 16th day of May 2018

Matthew Williams
For the Registrar,
the Comptroller-General

⁹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. Similarly in *Oakley v OHIM* (Case T-116/06) it is made clear that consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties.