

O-322-10

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2493618

BY

ALAN CRABTREE

TO REGISTER THE TRADE MARK:



IN CLASS 1

AND

THE OPPOSITION THERETO

UNDER NO 98519

BY

NATUREX

Trade Marks Act 1994

**In the matter of application no 2493618
by Alan Crabtree
to register the trade mark:**



**in class 1
and the opposition thereto
under no 98519
by Naturex**

1) The application to register the trade mark was made by Mr Alan Crabtree on 24 July 2008. It was published, for opposition purposes, in the Trade Marks Journal on 26 September 2008. On 24 December 2008 Naturex filed a notice of opposition to the registration of the trade mark. The specification of the application has been amended since publication. It is now:

ingredients for cosmetics, all excluding natural products intended for preserving cosmetic and perfumery products, natural products intended for colouring, cosmetic and perfumery products, pigments, paints, aromatics (essential oils) and odoriferous substances.

The above goods are in class 1 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) Naturex opposes the registration of the trade mark under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act). According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 5(4)(a) of the Act states:

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

3) Naturex relies on two international registrations in relation to its opposition under section 5(2)(b) of the Act:

- No 657349 of the trade mark:

NATUREX

The registration was designated in the United Kingdom on 18 May 2006. It has been granted protection in respect of goods in classes 1, 2, 3 and 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. In relation to this opposition Naturex relies only on some of the goods in class 3:

natural product intended for preserving cosmetic and perfumery products;
natural product intended for colouring cosmetic and perfumery products.

- No 933348 of the trade mark:



The registration was designated in the United Kingdom on 19 June 2007. It has been granted protection in respect of goods in classes 1, 2, 3 and 5 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. In relation to this opposition it relies only on some of the goods in class 2 and all of the goods in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended:

pigments, paints;

aromatics (essential oils), odoriferous substances.

In relation to section 5(4)(a) of the Act, Naturex relies upon the sign which is protected by international registration no 657349. It states that it first used this sign in 1992. Naturex states that it has used the sign in the United Kingdom "in relation to the promotion and sale of natural vegetable extracts for use in preserving and colouring cosmetic and perfumery products. The earlier right has also been used for the promotion and sale of natural products (such as essential oils and other natural products) for flavouring, colouring and preserving foodstuffs." Naturex goes on to state:

"The opponent's NATUREX marks have a well established reputation in the UK in relation to the provision of naturally sourced plant extracts which are used in flavouring, colouring and preserving cosmetics, food and dietary supplements. Use of the subject mark would give rise to a likelihood of confusion among relevant consumers, who may be misled into believing that the applicant's goods and services emanated from, or were authorised by, or connected with the opponent. Such misrepresentation could damage the goodwill built up in the opponent's marks."

4) Mr Crabtree filed a counterstatement. In the counterstatement he amended the specification (to read as per paragraph 1). Mr Crabtree states:

"We deny that the mark is similar to an earlier mark because:

1) The mark is visually different being white on a coloured background as opposed to coloured on a white background.

2) The mark uses lower case font as opposed to upper case font.

We deny that the goods and services are identical as the description of the goods and services for the mark specifically excludes goods and services based on naturally sourced plant extracts, which is the essence of the existing mark.

We deny that the goods and services are similar as having excluded naturally sourced plant extracts our goods and services will be from synthetic sources.”

5) Both parties filed evidence. A hearing was held on 7 September 2010. Mr Crabtree was represented by Mr Mark Spence. Naturex was represented by Mr Ben Mooneapillay of Fry Heath & Spence LLP.

Evidence

Main evidence for Naturex

6) This consists of a witness statement by Mr Antoine Dauby. Mr Dauby is the Group Marketing Director of Naturex SA. Mr Dauby states that the objective of Naturex is to develop natural plant extracts for specific product ranges within each of the food and beverage, nutrition and health and beauty and cosmetics markets. He states that these extracts are classified according to their properties: natural colouring, flavouring, preservative and healthy ingredients for food and beverage applications, plant extracts and antioxidant ingredients for nutraceutical and pharmaceutical applications; and botanical extracts and function raw materials for cosmetic applications. Mr Dauby states that the NATUREX trade mark has been used continuously in the United Kingdom since 2005 in connection with *natural product intended for preserving cosmetic and perfumery products; natural product intended for colouring cosmetic and perfumery products; pigments, paints; aromatics (essential oils), odoriferous substances*. He states that the registered goods are promoted and sold to the manufacturers of cosmetics and perfumery.

7) Mr Dauby states that the NATUREX trade mark has been advertised in press releases, product brochures, sales brochures, trade advertisements, publicity mail shots and websites. Exhibited at AD1 and AD2 are copies of booklets from 2009, so emanating from after the date of application, the material date. Exhibited at AD3 is a copy of Naturex’s current brochure, this is dated August 2009 and so emanates from after the material date. Exhibited at AD4 are a page from the website naturex.com, downloaded on 15 October 2009 (so after the material date) and a copy of a brochure dated September 2009 (after the

material date). Mr Dauby makes specific reference to the following products shown in the brochure:

- Effineo – a caffeine-free green coffee extract, used Mr Dauby states in cellulite reduction creams;
- Hydravance – an extract of the flower of bitter orange, used in moisturising creams;
- Macaderm – an extract from the maca plant, used in skin creams for firming and rejuvenating;
- Natrox range of antioxidants and Efficlear range of antimicrobials, which are used in protective and antibacterial skin creams.

8) Most of the material exhibited at AD5 does not relate to the United Kingdom. However, the material does include a press release which refers, inter alia, to the opening of a Naturex subsidiary in the United Kingdom. A press article, dated 3 April 2007, refers to the opening of a new commercial office in the United Kingdom. In a printout from cosmeticsdesign-europe.com dated 6 May 2009 the following appears:

“Naturex steps up its focus on cosmetics with the release of the first three ingredients in its NatBeauty range.

Traditionally known for its food, flavour and beverage portfolio, Naturex announced in April last year that it would be taking steps to grow its cosmetics division, with the aim of achieving 10 per cent of its total turnover from this category by the end of 2010.

Macaderm, hydravance and effineo make up the France-based company’s new portfolio of cosmetics activities.”

9) Exhibited at AD6 are copies of archived web pages from naturex.com. The first page gives an address in the United States of America, the second page contact details for the United States of America and France. There is nothing in the pages that shows a relationship with the United Kingdom. Included in the exhibit is a page that gives notice of trade shows that Naturex will be attending in Tokyo between 21 and 23 May 2008 and in New Orleans between 29 June and 1 July 2008. There is no indication as to the nature of the trade shows and as to which market(s) they are aimed. Mr Dauby states that these trade shows are attended by some of the world’s largest natural ingredient suppliers and manufacturers, including cosmetics and perfumery manufacturers from the United Kingdom. Exhibited at AD7 are pages from the Naturex website downloaded on 15 October 2009 (after the material date). Included at AD8 are two photographs of the Naturex stand taken during the Food Ingredients Europe show in London in 2007. Also include in the exhibit are two photographs which Mr Dauby states show Naturex’s cosmetic products. The 933348 trade mark can be seen in the photographs, the descriptions of the products cannot be seen. Mr

Dauby states that the Natural Ingredients Exhibition is run alongside Food Ingredients Europe and showcases a wide range of natural products including cosmetic and personal care products.

10) Exhibited at AD9 are copies of 9 invoices from Naturex to undertakings in the United Kingdom. The first is dated 4 March 2004, the last is dated 26 June 2006. The products the subject of the invoices are: Capiscum oleoresin ws, Pap'Brite 40000 ls wd, extra-virgin apricot kernel oil, 2411 StabilEnhance WSR, StabilEnhance OSR 5%, Bay oleoresin, Oxy'Less Clear, Carrot'Brite 100 000, Carrot'Brite, Oxy'Less UD and Veragel 200 standardiz.

11) Page 8 of exhibit AD1 indicates that oleoresins are used in the food industry, page 9 of the same exhibit indicates that StabilEnhance and Oxy'Less products are also used in the food industry. Oxy'Less UD and Carrot'Brite products appear on the same invoice, page 8 of exhibit AD9, indicating that the latter products are for use in the food industry. Page 9 of exhibit AD9 shows that Veragel products are used in cosmetic applications. Page 5 of AD2 indicates that Parp'Brite is used in the food industry. Consequently, it appears that 7 of the invoices are for products for use in the food industry, it is not possible to ascertain the purpose of the extra-virgin apricot kernel oil, one invoice is for products for use in the cosmetics industry; the invoice dated 26 June 2006 to Crabtree & Evelyn. The amount of this invoice is \$US2,800; the other invoices are in pounds sterling or euros. This invoice differs from the others in that the VAT number of the purchaser is not given and that there is only one address, the other invoices have a delivery and invoice address.

12) Mr Dauby states that synthetic polymers can be used as thickeners and gelling agents in a broad range of cosmetic and personal care products such as shampoos, conditioners, hair and body gels, skin creams, liquid and cream foundations, sunscreen lotions and sprays. He states that Naturex's botanical extracts are also used in making these products. Mr Dauby states that Hydravance is a moisturising cream produced from extracts of the bitter orange flower whose active ingredient increases the secretion of hyaluronic acid in the skin to protect it against drying out. He states that Macaderm is an anti-aging cream that increases the collagen content in the skin and makes it firmer. Mr Dauby states that both products are used in the manufacture of skin creams. Mr Dauby states that the preserving and colouring products in classes 2 and 3 of the international registrations are produced in the laboratory and are derived from plant extracts. These botanical extracts are also made up of chemical compounds. Mr Dauby states that the goods of Naturex and those of Mr Crabtree's application are likely to be sold through the same distribution channels, ie directly to manufacturers of cosmetic ingredients, perfumery manufacturers, or indirectly through wholesalers of and dealers in cosmetic ingredients.

Evidence of Alan Crabtree

13) Mr Crabtree is the Product Development Chemist of ACW Associates Limited, which trades as Rheolab. Mr Crabtree states that Rheolab is a specialist supplier of polymers as ingredients in the cosmetics industry in the United Kingdom, Belgium, the United States of America, Germany, Spain, Eastern Europe, Malaysia, Thailand, Hong Kong and Vietnam. Rheolab has a sister company, Rheolab Inc, based in Chicago. He states that Rheolab markets Rheosol synthetic polymers, Naturex Part Natural polymers and Coloursoft polymers for colour cosmetic applications. Mr Crabtree states that 95% of Rheosol's sales are generated outside of the United Kingdom. He states that sales revenues for 2009 for Rheolab and Rheolab Inc were £1.1 million.

14) Mr Crabtree states that his trade mark has been used continuously in the United Kingdom since 2008 in connection with the goods in the specification; this use is presumably by Rheolab. Exhibited at N1 is printed list of Rheolab personal care products. The list is clearly marked as relating to the goods of Rheolab. On the list, the products Naturex A100 and Naturex C100 appear. These are described as thickeners/emulsion stabilisers. Naturex also appears in the form of the application, but the oval is in two shades of blue, rather than two shades of green. The list is dated September 2008, after the date of application for registration (the material date). Mr Crabtree states that the goods the subject of the application are promoted and sold to cosmetic manufacturers by Rheolab's distributors. Mr Crabtree states that his trade mark has been advertised in Rheolab's brochures, sales brochures, publicity material and on its website. Exhibited at N2 is what appears to be part of a brochure. This brochure was published in September 2008, after the material date. Mr Crabtree states that Rheolab first issued and distributed product brochures in 2008. Two of the four pages exhibited at N2 clearly identify the products as emanating from Rheolab by use of a trade mark and the contact details of Rheolab and Rheolab Inc. The pages exhibited relate to Naturex C100 and Naturex A100. C100 can be used in cream bases, cleansing products, sun care lotions and hair conditioners. It has the following functions: thickening, softening, moisturising, stabilising, enhanced spreading, gelling and opacifying. In relation to Naturex C100 and A100 and the environment the following appears:

“Our carefully selected natural components are derived from renewable resources and by maximising their efficiency we have substantially reduced the proportion of synthetic component placing less demand on non renewable oil resources.”

Naturex A100 is described as “a unique thickening technology based upon a combination of well established synthetic inverse emulsion polymer technology and a carefully selected and modified cellulose derivative all dispersed in a personal care grade carrier oil”. Exhibited at N3 is a printout of a page from rheosolutions.com, downloaded on 17 February 2010, after the material date.

The page describes Naturex as the Rheolab range of “part natural” cosmetic polymers. Exhibited at N4 are pages from rheosolutions.com, downloaded on 17 February 2010, after the material date. The top of the page is clearly marked with the Rheolab trade mark. The pages list the products in which Rheolab Naturex products can be used. There are a large number of products, including anti-aging cream, body moisturising cream, basic aftershave splash and cleansing shampoo.

15) Mr Crabtree states that Rheolab’s website has been running since 2008. Exhibited at NB5 are copies of Rheolab data sheets, they were issued on 25 November 2008, 26 January 2010 and 10 February 2010. A technical data sheet for Naturex A100, which includes Mr Crabtree’s trade mark in black and white, advises:

“**NATUREX A100** is a combination of an anionic acrylic homopolymer and a cellulose derivative dispersed in a personal care grade carrier oil. Its prime function is an additive to control the viscosity and rheology of finished formulations. Applications are within the toiletries and cosmetics industry.

NATUREX A100 is designed to be applied within hair and skin care formulations. It improves performance whilst promoting excellent spreading of the finished product.”

A technical data sheet for Naturex C100, which includes Mr Crabtree’s trade mark in black and white, advises:

“**NATUREX C100** is a combination of a cationic acrylic homopolymer and a cellulose derivative dispersed in a personal grade carrier oil. Its prime function is an additive to control the viscosity and rheology of finished formulations. Applications are within the toiletries and cosmetics industry.

NATUREX C100 is designed to be applied within hair and skin care formulations. It improves performance whilst promoting excellent spreading of the finished product.”

Further information about the Naturex A100 and C100 downloaded from the Rheolab website on 25 March 2010 is exhibited at N6. Exhibited at N7 is a flyer for Naturex A100 and C100. This flyer shows the Rheolab trade mark and domain name address. Mr Crabtree states that this flyer was used at the In-Cosmetics exhibition in Paris in April 2010.

16) Exhibited at N8 and N9 are invoices from Rheolab. The first dated 1 February 2010 is made out to Ore-An Personal Care Ltd of Brighouse. It is for

£94 worth of Naturex C100. The second is from Rheolab of Illinois and is to a company in Miami. It is dated 12 January 2010.

17) Mr Crabtree states that the Naturex trade mark is associated in the United Kingdom with at least 4 companies in a diverse range of product areas. Exhibited at N10 is a list of trade marks . The full details of the trade marks are not given. However, annotations have been given by Mr Crabtree which identifies the goods as being used for the care of wood, products for animals and vets and herbal teas.

18) The rest of the statement consists of submission rather than evidence of fact. These submissions are borne in mind in reaching this decision.

Further evidence of Naturex

19) This consists of a witness statement by Ms Christine Mather. Ms Mather is a trade mark associate at Fry Heath Spence LLP, the trade mark attorneys of Naturex.

20) Ms Mather exhibits at CAM1 pages downloaded from the website of in-cosmetics.com on 12 May 2010. Ms Mather states that pages 1 and 2 of the exhibit list details of Naturex and Rheolab as exhibitors of cosmetic ingredients at the International In-cosmetics show which took place on 14 and 15 April 2010 in Paris. Ms Mather states that these shows are attended by manufacturers and suppliers of cosmetic ingredients. Ms Mather particularly identifies a paragraph on page 3 of the exhibit:

“Bringing together the world’s leading cosmetics suppliers, R&D, production and marketing specialists. In-cosmetics showcases a spectacular range of new and innovative cosmetic ingredients and services and offers a crucial insight into future scientific advances, emerging trends and regulations.”

21) Exhibited at CAM2 are copies of the Companies House records for Rheolab Ltd. The records show that the company was previously known as ACW Associates Limited. The company was incorporated on 23 December 2003. The nature of the business of the company is identified as “[w]hole sale of chemical products”.

Likelihood of confusion - section 5(2)(b) of the Act

Average consumer, nature of purchasing decision and standard for likelihood of confusion

22) The average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant”ⁱ. The goods of the application will be bought by manufacturers of cosmetic products. The nature of the purchase and the goods means that purchasing process will be careful and educated. Consequently, imperfect recollection will have a limited effect. The goods upon which Naturex relies in relation to international registration no 657349 will be the subject of a similar purchasing process. *Paints, aromatics (essential oils) and odoriferous substances* will be purchased both by industry and the public at large. *Pigments* are ingredients used in finished products, they are purchased by manufacturers. Consequently, the purchasing process will be careful and educated. Therefore, in relation to the last goods, imperfect recollection will have a limited effect.

Comparison of goods

23) Naturex’s best case lies with the goods of international registration no 657349 upon which it relies:

*natural product intended for preserving cosmetic and perfumery products;
natural product intended for colouring cosmetic and perfumery products.*

The specification of the application is:

ingredients for cosmetics, all excluding natural products intended for preserving cosmetic and perfumery products, natural products intended for colouring, cosmetic and perfumery products, pigments, paints, aromatics (essential oils) and odoriferous substances.

24) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”ⁱⁱ. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaningⁱⁱⁱ. Consideration should be given as to how the average consumer would view the goods or services^{iv}. The class of the goods and services in which they are placed may be relevant in determining the nature of the goods^v. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary^{vi}.

25) Mr Spence submitted that the goods of the application are thickeners with rheological properties and so their purpose in the production of cosmetics is very

different to those of the earlier registration. He made an analogy to the ingredients used in making a cake, flour and eggs being very different. The specification of the application is not limited to thickeners with rheological properties. As Mr Mooneapillay submitted, the specification of the application will cover the goods of the international registration with the sole difference that they are not 'natural products'. In this case the respective goods have the same general intended purpose, being used to manufacture cosmetics. They also have the same specific purpose in so much that they are 'non-natural' versions of the goods of the international registration. The goods could all be in the form of powders, emulsions, liquids etc. The respective goods are fungible, as the goods of the application would cover 'non-natural' versions of the goods of the international registration. Consequently, the respective goods are in competition. The respective goods will have the same channels of trade in reaching the same customers (manufacturers of cosmetics), who will be the same end users of the products.

26) The respective goods are similar to a high degree.

Comparison of trade marks

27) Owing to the finding in relation to similarity of the goods and the very limited stylisation of international registration no 657349, it is only necessary to consider the trade mark the subject of this registration. If Naturex cannot succeed in relation to this registration, it will not succeed in relation to its other registration.

28) The trade marks to be compared are:

Naturex's trade mark:

NATUREX

Mr Crabtree's trade mark:



29) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details^{vii}. 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^{viii}. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{ix}. The assessment of

the similarity of the trade marks must be made by reference to the perception of the relevant public^x.

30) Naturex's trade mark is not readily divisible into distinctive and dominant components, its distinctiveness lies in the trade mark as a whole. The trade mark of Mr Crabtree consists of the italicised word naturex on a two tone green oval which is divided by a white line. The point of identification of the trade mark will primarily be the word element, this is the distinctive and dominant component.

31) Phonetically the trade marks are identical. Visually, there are the differences of the fonts of the trade marks and that one is in upper case and the other in lower case. There is also the two tone green oval which is divided by a white line. The point of recollection and identification for the consumer will be the word element of Mr Crabtree's trade mark, it is the word that the letters form which is of key importance rather than a particular font or background. It is to be remembered that consumers will seldom be in a position to directly compare trade marks. Owing to the presence of the same letters forming the same word, the respective trade marks are similar; despite the elements of Mr Crabtree's trade mark which are alien to the trade mark of Naturex. Naturex is the word nature followed by the letter x, there is an evocative effect in relation to the word nature^{xi}. Consequently, there is a conceptual similarity between the trade marks.

32) The respective trade marks are similar to a high degree.

Conclusion

33) There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

In this case the evidence of use of the goods of the application in the United Kingdom is extremely limited, limiting the opportunity of confusion. The use has always been by reference to Rheolab, the products being identified at all times as Rheolab products. The goods of Naturex are clearly identified with the French company Naturex. Consequently, the trade marks have been used with clear indicators of origin that can differentiate between them. There has been no use

of Mr Crabtree's trade mark outweighs the identification with Rheolab. The claimed absence of confusion in the market place is most certainly not significant in this case. Of course, if a purchaser was completely deceived as to the provenance of the product, he or she would not know that he or she had been confused.

34) Mr Crabtree has included state of the register evidence in his evidence. The state of the register does not indicate whether there will be confusion in the market place in relation to the respective trade marks. Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court (GC) in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06* and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* have both rejected arguments based upon state of the register evidence. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* GC stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

It is what is happening in the market place that is relevant, not what trade marks are sitting upon trade mark registers. In this case Mr Crabtree indicates that the trade marks have been registered in relation to goods different from those under consideration of this case; further undermining any relevance or effect of the evidence.

35) Mr Spence referred to the current use and marketing of goods under Mr Crabtree's trade mark. The current marketing undertaken by the parties is not relevant to the issues to be determined, as the GC stated in *NHL Enterprises BV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-414/05*:

“71 The Court considers, first, that that assessment by the Board of Appeal is not called in question by the particular conditions in which the applicant's goods are marketed, since only the objective marketing conditions of the goods in question are to be taken into account when determining the respective importance to be given to visual, phonetic or conceptual aspects of the marks at issue. Since the particular circumstances in which the goods covered by the marks at issue are marketed may vary in time and depending on the wishes of the proprietors of those marks, the prospective analysis of the likelihood of confusion

between two marks, which pursues an aim in the general interest, namely that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions of the trade mark proprietors – whether carried out or not – which are naturally subjective (see, to that effect, *NLSPORT*, *NLJEANS*, *NLACTIVE* and *NLCollection*, cited at paragraph 61 above, paragraph 49, and Case T-147/03 *Devinlec v OHIM – TIME ART (QUANTUM)* [2006] ECR II-11, paragraphs 103 to 105, upheld on appeal by the Court by judgment of 15 March 2007 in Case C-171/06 P *TIME ART v OHIM*, not published in the ECR, paragraph 59).”

36) In comparing the respective trade marks the use of NATUREX without stylisation by Rheolab has not been considered or taken into account. The comparison has to be made on the basis of the trade mark the subject of the application. A similar matter was dealt with by the European Court of Justice (ECJ) in *Calvin Klein Trademark Trust v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-254/09 P:

“46 It should be noted in that connection that the similarity of the marks at issue must be assessed from the point of view of the average consumer by referring to the intrinsic qualities of the marks and not to circumstances relating to the conduct of the person applying for a Community trade mark.

47 It must therefore be held that, contrary to the appellant’s submissions in the first part of its first ground of appeal, the General Court’s analysis is not vitiated by an error of law due to the fact that it failed to take account of alleged wrongful conduct on the part of the trade mark applicant. While such conduct is a particularly significant factor in proceedings brought under Article 51(1)(b) of Regulation No 40/94 – which is not at issue in the present appeal – it is not, on the other hand, a factor that must be taken into account in opposition proceedings brought under Article 8 of that regulation.”

37) The ECJ also stated in the above case:

“56 It must be observed in that connection that, contrary to what appears to be stated at paragraph 39 of the judgment under appeal, the existence of a similarity between two marks does not presuppose that their common component forms the dominant element within the overall impression created by the mark applied for. According to established case-law, in order to assess the similarity of two marks, it is necessary to consider each of the marks as a whole, although that does not rule out the possibility that the overall impression created in the mind of the relevant public by a complex trade mark may, in certain circumstances, be dominated by one or more of its components. However, 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 (see *OHIM v Shaker*, paragraphs 41 and 42; the judgment of 20 September 2007 in Case C-193/06 P *Nestlé v OHIM*, paragraphs 42 and 43; and *Aceites del Sur-Coosur v Koipe*, paragraph 62). In that connection, it is sufficient for the common component not to be negligible.”

So, in considering the similarity of the respective trade marks the device element and stylisation of Mr Crabtree’s trade mark has been considered and borne in mind.

38) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa^{xii}. In this case the respective trade marks are similar to a high degree and the respective goods highly similar. So both sides of the equation are in favour of Naturex.

39) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion^{xiii}. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public^{xiv}. In determining the distinctive character of a 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 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^{xv}. The trade mark the subject of international registration no 657349 is made up of the word nature with an x upon the end. It is, therefore, an invented word. However, there is a clear evocation of the word nature, which is allusive to natural products. Taking these factors into account it is considered that this trade mark has an inherent distinctiveness at the lower end of the spectrum. The evidence of use in the United Kingdom is limited and there is a lack of evidence of turnover in the United Kingdom. On the evidence, the use of the trade mark in the United Kingdom has not added to its distinctiveness.

40) In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the GC stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent

qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

The goods under consideration will primarily be bought as a result of visual consideration. Owing to the presence of the same word in the trade marks, albeit in different fonts, there is a good deal of visual similarity. The NATUREX element of Mr Crabtree’s trade mark is likely to be the hook upon which the memory relies.

41) The purchasing process for the respective goods will be careful and educated. However, owing to the common presence of the word NATUREX (whether in stylised or non-stylised form), however careful and educated the purchasing decision the average consumer, albeit that this is a manufacturer, is highly likely to confuse the trade marks. The careful and educated purchasing decision is of relevance where there are differences in the trade mark such that the average relevant consumer will not be confused.

42) Taking all of these factors into account there is a likelihood of confusion and the application for registration is refused under section 5(2)(b) of the Act.

Passing-off – section 5(4)(a) of the Act

43) Naturex’s case will not be any stronger under this section of the Act than under section 5(2)(b) of the Act, consequently, it is not necessary to deal with the opposition under this head. It is noted, however, that the evidence is given on behalf of Naturex SA, rather than Naturex. It is common for French undertakings not to use indications of their company status, as demonstrated by the invoices. There is little doubt that Naturex and Naturex SA are one and the same. However, it would have been helpful if Mr Dauby had made this clear in his witness statement. As the case has been decided upon the basis of the international registrations, which are in the name of Naturex, nothing turns upon this point.

Costs

44) Naturex having been successful is entitled to a contribution towards its costs. Costs are awarded upon the following basis

Opposition fee:	£200
Preparing a statement and considering the counterstatement of Mr Crabtree:	£300
Preparing evidence and considering evidence of Mr Crabtree:	£500
Preparation and attending hearing:	£500
Total:	£1,500

I order Mr Alan Crabtree to pay Naturex the sum of £1,500. 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 20 day of September 2010

**David Landau
For the Registrar
the Comptroller-General**

ⁱ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

ⁱⁱ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

ⁱⁱⁱ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{iv} *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the

attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use”

^v *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

^{vi} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{vii} *Sabel BV v Puma AG* [1998] RPC 199.

^{viii} *Sabel BV v Puma AG* [1998] RPC 199.

^{ix} *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

^x *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

^{xi} See the judgment of the GC in *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 353/04:

“90 Second, it should be noted that the earlier mark, although it does not correspond as such to any word in the relevant European languages, has a certain ‘evocative force’ in that it is very close to the words ‘euro’ and ‘Europe’, words particularly well known and easily recognisable in all of the languages examined, generally used to refer to Europe or the European Union, or as regards ‘euro’, also to the single currency (see, as regards the evocative force, *MUNDICOR*, cited in paragraph 38 above, paragraphs 89 and 90, and, as regards the word ‘euro’, Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 26, and Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 48). Consumers will be aware of the evocative effect of the earlier mark without undertaking a conceptual analysis of it, but simply by focussing their attention instinctively on the recognisable element of the word mark EURON, that is to say, the term ‘euro’ (see, to that effect, Case T-186/02 *BMI Bertollo v OHIM – Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 57).

91 This evocative effect is independent of whether or not the word mark EURON designates a characteristic of the goods for which registration of the earlier mark was made, since that fact does not influence the ability of the relevant public to make an association between that word mark and the words ‘euro’ and ‘Europe’ (see, by way of analogy, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the same way, the evocative force of the earlier mark cannot be altered by the fact that it is supposedly ‘made up’. Even a made-up word may carry conceptual weight.”

^{xii} *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

^{xiii} *Sabel BV v Puma AG* [1998] RPC 199.

^{xiv} *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

^{xv} *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.