

O-391-21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3434315
BY PURITY WELLNESS GROUP LTD
TO REGISTER:**



AS A TRADE MARK IN CLASSES 3, 5 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 419115 BY
THE STOCKROOM (KENT) LTD**

BACKGROUND & PLEADINGS

1. On 7 October 2019, Purity Wellness Group Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision for a range of goods and services in classes 3, 5, 30 and 35.

2. On 17 January 2020, the application was opposed, in part, by The Stockroom (Kent) Ltd (“the opponent”), following which, the application was divided; the goods and services in classes 30 and 35 which were not the subject of the opposition have now proceeded to registration under no. 3466833. The opposition, which is directed against all the remaining goods and services in the application (shown in paragraph 10 below), is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the United Kingdom Trade Mark registration shown below and the goods shown in paragraph 10 below:

UK no. 3077295 for the trade mark **Purity Gel** which was filed on 16 October 2014 and registered on 30 January 2015.

3. In its Notice of opposition, the opponent states:

“Purity is the main distinctive component of the earlier mark. It also the main distinctive component of the application mark. Those components are identical, notwithstanding that each mark contains other (less important) elements.

The respective class 3 goods are highly similar and will be marketed and sold through identical channels and to the same or similar buying public. The class 5 goods in the application are similar and closely related to the class 3 goods in the earlier mark and will be marketed and sold through similar/identical channels and to the same or similar buying public as the class 3 goods in the earlier mark.

The class 35 services which the opponent objects involve the retailing or online sale of goods which are either identical with or highly similar to the class 3 goods in the earlier mark...”

4. The applicant filed a counterstatement in which it denies the basis on which the opposition has been brought. It states:

“41. The Opposition has obviously been brought in error by the Opponent in an attempt to disrupt the Applicant’s legitimate business. The Applicant therefore requests that the Opposition be dismissed in its entirety and off the scale costs awarded in the Applicant’s favour.”

5. In these proceedings, the opponent is represented by JP Mitchell Solicitors and the applicant by Briffa. Both parties filed evidence and written submissions during the evidence rounds. At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Neither party requested a hearing. Only the opponent filed written submissions in lieu. I shall keep all of these submissions in mind, referring to them to the extent I consider it appropriate to do so.

6. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

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

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

(a)...

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

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

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

8. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2, which qualifies as an earlier trade mark under the provisions of section 6 of the Act. Given the interplay between the date on which the opponent’s trade mark was entered in the register and the application date of the trade mark being opposed, the earlier trade mark is not subject to the proof of use provisions contained in section 6A of the Act.

Case law

9. The following principles are gleaned from the decisions of the courts of the European Union 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 greater 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.

Comparison of goods and services

10. The goods and services to be compared are as follows:

Opponent's goods	Applicant's goods and services
<p>Class 3 – Professional Nail Products; UV Gel; LED Gel; Gel Polish; Non-medicated beauty preparations.</p>	<p>Class 3 – Ethereal oils; Natural essential oils; Essential vegetable oils; Essential oils for soothing the nerves; Essential oils for the care of the skin; Essential oils for aromatherapy use; Essential oils for personal use; Skin cream; Body cream.</p> <p>Class 5 – Dietetic food and substances adapted for medical use; Nutritional supplements; Dietary supplements based on hemp proteins, hemp seed, hemp oil or CBD oil.</p> <p>Class 35 – Retail and online retail services in relation to essential oils, etheric oils, scented oils, aromatic oils, ethereal oils, essential vegetable oils, emulsified essential oils, blended essential oils, natural essential oils, aromatic essential oils, terpenes [essential oils], essential oils of citron,</p>

	essential oils of cedar wood, essential oils of lemon, ethereal essences and oils, skin care creams, skin care mousse, essences for skin care, skin care lotions, skin care oils.
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11. 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:

“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”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

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

“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”.

16. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

17. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

18. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

19. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

20. As I mentioned earlier, both parties filed evidence. The opponent's evidence consists of a witness statement, dated 8 May 2020, from its Managing Director, Anthony Palmer, accompanied by two exhibits. The applicant's evidence consists of a witness statement, dated 21 September 2020, from one of its Directors, Michael Walker, accompanied by one exhibit. In his statement, Mr Palmer explains:

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

“6. I have been asked to comment on the similarity of the class 3 goods comprised in the [opponent’s trade mark] to those contained in the applicant’s class 3 and class 5 specifications. I have been particularly asked to comment on whether I consider the respective products would, or are likely to be, sold through similar sales channels or outlets.”

21. He states:

“10. Based on many years’ experience of the UK beauty care industry, I consider that applicant’s class 3 and class 5 products are very similar to the products comprised in the [opponent’s trade mark].

11. I also believe the Applicant’s said products are likely to be provided or offered for sale through the same or very similar channels as the products comprised in our Earlier Mark. Those channels include supermarkets, chemists/pharmacies, department stores and specialist beauty care and/or nail care stores, beauty salons and other such outlets.”

22. In support of the above conclusions, Mr Palmer provides pages from boots.com (exhibit A) and hollandandbarrett.com (exhibit B), all of which bear printing dates of 16 April 2020.

23. Pages 6-8 of exhibit A contain a search for the letters “cbd” in what appears to be the “Beauty & Skincare” section of the website. All of the items are priced in £ sterling. Sixteen items retrieved by the search are shown and include: “Eco Style CBD Hair oil” and “Simple Hemp Ultra Calming Sheet Mask.” Page 9 relates to a search for the word “hemp”. Four items are shown and include “Tresemme Botanique Hemp Hydration Shampoo.” Pages 10, 11 and 12 contain what appears to be the results of searches for “nails”, “essential oil” and “cosmetics”. Items such as “Gel Nail Polish”, “Massage Oil” and “Eye Make-up Remover Pads” are shown on the pages provided. Of these pages, Mr Palmer states:

“12...[The pages from boots.com] feature the sale of hemp/CBD products, vitamin supplements, essential oils, cosmetic products containing essential

oils and nail care products through the same channel and alongside each other. It is also apparent that essential oils and hemp/CBD oils are an important ingredient in many types of product, including cosmetic and beauty products as well as supplements and dietetic/food substances. It is also worth noting that products containing hemp or CBD are listed under the general heading of "Beauty & Skincare" on the Boots website which serves to confirm that, for UK retailers, hemp/CBD products fall under the same classification as beauty products, including skin care and nail care products."

24. Exhibit B contains pages from what appears to be the "natural-beauty/skincare/cbd-beauty", "CBD Oil and Capsules", "skin creams", "nails" and "vitamins for nails" sections of the above website. All of the items are priced in £ sterling. I note the pages provided include references such as "H&B CBD Muscle Balm Ultra", "Holland and Barrett CBD Skincare Bundle" and "Vitabiotics Perfectil Max/Plus...Capsules/Tablets." I note the packaging for the Vitabiotics products contains references to skin, hair and nails. Of these pages, Mr Palmer states:

"13. The same picture is found at the Holland & Barrett website...Again, one finds CBD/hemp products sold alongside nail products, vitamins, supplements for the hair and nails and cosmetic products...Holland & Barrett even have a page listing entitled 'CBD Beauty', which confirms the integral role that CBD products play in relation to beauty care and beauty products in the eyes of major UK retailers like Holland & Barrett."

25. Broadly speaking, in his witness statement Mr Walker responds to Mr Palmer's conclusions on the similarity of the competing goods. In relation to exhibit A of Mr Palmer's statement, Mr Walker states:

"14... I do note that he has undertaken a search on the Boots.com website for "CBD" and filtered the search results to "Beauty & Skincare". Mr Palmer explains that this page features the sale of Hemp/CBD products, vitamin supplements essential oils, cosmetic products containing essential oils and nail care products through the same channel and alongside each other. I take two issues with this:

a. at Exhibit A of Mr Palmer's statement there are no nail products (save for page 10 which appears to simply be a search for nail products); and

b. if a person searches for "CBD" and limits the result to beauty and skincare then of course those products will feature alongside each other."

26. Pages 16-34 of exhibit MW1 consist of the results of a search for "cbd" on boots.com which bear printing dates of 21 September 2020, in relation to which Mr Walker states:

"15...This search has been undertaken for "CBD" with no filter on the results, I see that no nail care products feature."

27. Pages 35-39 of exhibit MW1 consists of the results of a search for "nail care" on boots.com which bear printing dates of 21 September 2020, in relation to which Mr Walker states:

"16...This search has been undertaken for "nail care" with no filter on the results, I see that no CBD products feature."

28. Mr Walker states:

"17. I believe that contrary to what Mr Palmer says, CBD products are not listed under the "Beauty & Skincare" heading of Boots.com and nail care products and CBD products are not likely to be sold in the same area..."

29. Mr Walker states that pages 40 and 41 of exhibit WM1 consist of:

"17...an extract from the Boots.com website which shows "CBD" under the "Health & Pharmacy" heading, I cannot see CBD products under the "Beauty & Skincare" heading.

18...an extract from the Boots.com website which shows nail products as being part of the "Beauty & Skincare" headings."

30. As far as I can tell, neither of the pages are dated. Mr Walker concludes his statement in the following terms:

“19. I now bring my attention to Exhibit B of Mr Palmer’s statement. I see that the hollandandbarrett.com website does have a “CBD Beauty” section but do not see any nail care products or beauty products in the traditional sense. The products listed in this section seem to be muscle and skin creams.

20. I believe that it is highly unlikely that any proper CBD product retailer would list CBD products alongside beauty products or certainly nail care products. For example, the Applicant’s website lists only CBD products as it is a specialist area.”

31. The parties also commented on the similarity of the competing goods and services and the competing evidence filed in their various written submissions. Although I do not intend to summarise these submissions here, I shall, of course, keep them all in mind. Although the evidence filed is from after the material date in these proceedings, neither party has taken any issue in this regard. As the position is unlikely to have changed to any significant extent between the material date in October 2019 and the date the pages were printed i.e. 16 April and 21 September 2020 respectively, I have borne this evidence in mind. While a good deal of the evidence/submissions focuses on CBD, I note that with the exception of “dietary supplements based on hemp proteins, hemp seed, hemp oil or CBD oil” in class 5 of the applicant’s trade mark, the remaining goods and services are not so limited. I shall bear that in mind in the comparison which follows.

Class 3

32. Irrespective of the opponent’s various nail related products, its specification also includes the term “non-medicated beauty preparations”. Collinsdictionary.com defines “beauty preparations” as “the cosmetics, creams etc used to improve someone's beauty.” That accords with my own understanding of the term and, more importantly will, I am satisfied, accord with the average consumer’s understanding of

the term. Despite the applicant's submissions to the contrary, as the applicant's "ethereal oils", "essential oils" "skin cream" and "body cream" would, in my view, all be encompassed by the broad term mentioned in the opponent's specification, they are to be regarded as identical on the inclusion principle outlined in *Meric*.

Class 5

33. In its written submissions, the applicant states:

"12...the Opponent avers that the above listed class 5 and 3 goods are closely related, this is an erroneous belief. The class 5 goods of the Application, when given their natural and ordinary meaning, are not aimed at improving the condition of the skin, hair or nails, instead it is obvious these goods are concerned with supplementing the diet. These goods, therefore, are not concerned with improving the outward facing appearance, or beauty, of the average consumer.

13. The class 5 goods of the Application are goods with pharmaceutical application, the average consumer will clearly be able to differentiate pharmaceutical products to real and faux nail products as described in the Registrations class 3 goods. The Applicant submits these goods are wholly dissimilar..."

34. The evidence shows, unsurprisingly in my view, that large UK undertakings such as Boots and Holland & Barrett conduct a trade in a wide range of goods which fall within classes 3 and 5. There is, therefore, likely to be an overlap in the trade channels of the applicant's and opponent's goods as there will in the users. The nature of the competing goods and their methods of use are, however, likely to differ. I also note that the opponent's evidence contains a references to, inter alia, "Vitabiotics Perfectil Plus...Tablets", the packaging of which contain references to "Skin, Hair and Nails." Thus it appears that the average consumer may, for example, chose to correct what it considers to be deficiencies in those areas of his/her body and improve their outward facing appearance by using either the opponent's goods externally or by ingesting the applicant's goods, resulting in an overlap in the

intended purpose of the competing goods as well as creating a likely competitive relationship between them. However, in the sense outlined in the case law, there is, at least as far as I can tell, no meaningful degree of complementarity between the goods. Weighing the relative importance of the various similarities and differences I have identified, results in what I consider to be a medium degree of similarity between the applicant's goods in class 5 and the opponent's goods.

Class 35

35. Having applied the case law mentioned above, I am satisfied that the applicant's "retail and on line retail services..." all of which relate to goods in class 3 are complementary to, at least, the opponent's "non-medicated beauty preparations" in class 3 and, as a consequence, similar to a medium degree.

The average consumer and the nature of the purchasing act

36. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue. I must then determine the manner in which these goods and services 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."

37. Although in their submissions the parties have debated the significance of the word “professional” in the opponent’s specification, as the opponent points out, this term only relates to “nail products.” Regardless, the average consumer of the remaining goods and services at issue is either a member of the general public or a professional user such as a beautician or dietician. As the evidence shows that the goods at issue are most likely to be self-selected from the shelf of a bricks-and-mortar outlet or from the equivalent pages of a website, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations in the form of, for example, oral requests to sales assistants or word-of-mouth recommendations can be ignored; the same is true of the applicant’s retail services. As to the degree of care the average consumer will display when selecting the goods and services at issue, the opponent suggests the average consumer will pay “nothing more than a normal level of attention.” As the goods at issue are either for use upon the person or are or to be ingested, when making a selection, the average consumer is likely to have a range of factors in mind, for example, ingredients, compatibility with existing medical conditions, method of use, fragrance, cost etc. As a consequence, I would expect the average consumer to pay a higher than normal degree of attention when selecting many of the goods at issue.

38. As for the retail services, the average consumer will have in mind factors such as price, breadth of goods stocked and, where appropriate, location, opening times etc. (for physical stores) and ease of use of the website. I would, therefore, expect them to pay a medium (normal) degree of attention when selecting the retail services at issue.

Comparison of trade marks

39. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade 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.”

40. 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 they create. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
Purity Gel	

Overall impression

The opponent’s trade mark

41. The opponent’s trade mark consists of the words “Purity” and “Gel” presented in title case in standard characters; both words and their meanings will be very well-known to the average consumer. When considered in relation to the goods for which the opponent’s trade mark is registered, the word “Gel” is likely to be regarded as descriptive in nature (indeed it actually appears in the opponent’s specification). That being the case, and as “Purity” appears as the first word in the opponent’s trade mark, means that it is that word which will dominate the overall impression the trade

mark conveys and it is in that word the overwhelming majority of the distinctiveness lies.

The applicant's trade mark

42. This consists of a number of components. The first, is a device presented in the colours yellow, blue and orange which the opponent describes as a "stylised hemp leaf"; that, I think, is a fair characterisation. The second component consists of the word "PURITY" presented in capital letters in the colour yellow in a conventional typeface. The third component is smaller than the word "PURITY" which appears above it and consists of the words "HEMP COMPANY" presented in capital letters in the colour blue in a conventional typeface. The fourth and final component is much smaller again and consists of the words "IMPROVING LIFE AS NATURE INTENDED" presented in capital letters in a conventional typeface in the colour yellow.

43. Given its size, positioning, colouring and stylisation, the first component will make an important contribution to both the overall impression conveyed and the trade mark's distinctiveness. I reach the same conclusion in relation to the second component. While the words "HEMP COMPANY" will contribute to the overall impression conveyed, given their size, positioning and as they are likely to be regarded by the average consumer as descriptive in nature (describing as they do the nature of some of the goods in which the undertaking concerned conducts a trade), any distinctiveness they may possess is likely to be, at best, low. Finally, even if the words "IMPROVING LIFE AS NATURE INTENDED" have any inherent distinctive character (which, in my view, is arguable), given their size and positioning in the context of the trade mark as a whole, any contribution they may make to the overall impression and distinctiveness will, once again, be, at best, low.

44. I will bear the above conclusions in mind when comparing the competing trade marks.

Visual similarity

45. The word “Purity”/“PURITY” appears in both parties trade marks. It is the only distinctive component of the opponent’s trade mark and an important component in the applicant’s trade mark. Bearing that in mind, whilst reminding myself of the various visual differences, results in what I regard as a between low and medium degree of visual similarity between the competing trade marks.

Aural similarity

46. As all of the words in the competing trade marks will be well-known to the average consumer the manner in which they will be articulated is entirely predictable. It is, of course, also well-established that when a trade mark consists of a combination of words and figurative components, it is by the word components that it is most likely to be referred to. As the word “Gel” in the opponent’s trade mark is descriptive, it is highly likely that the average consumer will not articulate it. Given its size and positioning and as it is in the nature of a strap-line, the same is, in my view, likely to be true of the words “IMPROVING LIFE AS NATURE INTENDED” in the applicant’s trade mark. As the words “HEMP COMPANY” qualify the word which appears above them, it is possible they will not be articulated by the average consumer. However, even if they are, the aural comparison is, from the applicant’s perspective, at best between “Purity Gel” and “PURITY HEMP COMPANY”. As the word “Purity”/“PURITY” would be the first word articulated in both scenarios, there is at least a medium degree of aural similarity between the competing trade marks. However, it is equally likely given the descriptive nature of the words which follow them that the competing trade marks will be pronounced simply as “Purity”/“PURITY”, i.e. they will be aurally identical.

Conceptual similarity

47. The word “Gel” in the opponent’s trade mark and the words “HEMP COMPANY” and “IMPROVING LIFE AS NATURE INTENDED” in the applicant’s trade mark are alien to the other party’s trade mark. However, even in those circumstances, as the

concept of purity remains in both, it results in, at least, a medium degree of conceptual similarity between them.

Distinctive character of the earlier trade mark

48. 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 – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

49. In his statement, Mr Palmer explains:

“4. The company manufactures and sells beauty care and nail care products, including nail polish and nail gel, under a number of product-specific trade mark, including Purity. I established the company in January 2020 and have been involved in all aspects of its development since then. The company is a well-established business in the UK and employs 11 full time staff and 5 part time staff. We also have 16 “ambassadors” working throughout UK and Ireland, responsible for promoting the company’s interests and brands.”

50. While it appears the opponent has used the trade mark upon which it relies from prior to the material date in these proceedings, i.e. October 2019, as it has filed no evidence relating to the use that it has made of its trade mark, for example, how the trade mark has been used, to whom goods under the trade mark have been sold, where the trade mark has been used, revenue generated under the trade mark or amounts spent on promoting it, it cannot benefit from an enhanced distinctive character. As a consequence, I have only the inherent characteristics of the trade mark to consider.

51. As I mentioned earlier the word “Purity” and its meaning will be well-known to the average consumer. However, for the avoidance of doubt, I note that collinsdictionary.com defines “purity” as “the state of being pure”. It further defines “pure” as “a pure substance is not mixed with anything else” and “something that is pure is clean and does not contain any harmful substances.” The word “Gel” in the opponent’s trade mark will be regarded as descriptive in nature. Considered in that context, as a totality, the opponent’s trade mark is likely to be understood as meaning, for example, goods in the form of gel which do not contain any harmful substances. Given the obvious desirability in many areas of trade to indicate to a potential consumer that goods are free from harmful substances, but particularly in relation to those to be applied to the body, absent use, the opponent’s trade mark has, in my view, a low degree of inherent distinctive character.

Likelihood of confusion

52. 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 services 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 it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, 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.

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

54. Earlier in this decision, I concluded that:

- the applicant's goods in class 3 are identical to the opponent's "non-medicated beauty preparations" also in class 3;
- the applicant's goods in class 5 are similar to the opponent's goods to a medium degree;
- the applicant's services in class 35 are similar to the opponent's goods to a medium degree;
- the average consumer of the goods and services at issue is either a member of the general public or a professional user such as a beautician or dietician;
- whilst not ignoring aural considerations, the average consumer will select the goods and services at issue by predominantly visual means whilst paying, in the main, a higher than normal degree of attention to the selection of the goods and a medium (normal) degree of attention when selecting the services;
- the competing trade marks are visually similar to between a low and medium degree, aurally similar to at worst a medium degree (and potentially aurally identical) and conceptually similar to at least a medium degree;
- absent use, the opponent's earlier trade mark has only a low degree of inherent distinctive character.

55. In *L'Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

"45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in

question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

56. The word “Purity” in the earlier trade mark will dominate both the overall impression it conveys and its distinctive character. Proceeding on that basis, I remind myself that the competing goods in class 3 are identical and the applicant’s goods in class 5 and services in class 35 are similar to the opponent’s goods to a medium degree. Although I have found the competing trade marks to be aurally similar to at least a medium degree, I also found the visual aspect of the comparison to be the most important and concluded that in this regard the competing trade marks are only similar to a between low and medium degree. Notwithstanding the fact that both parties’ trade marks share the word “Purity”/“PURITY”, the presence of, in particular, the stylised device component in the applicant’s trade mark and, to a lesser extent, the words “HEMP COMPANY” are, in my view, sufficient to rule out a likelihood of direct confusion even in relation to the identical goods in class 3. It follows that conclusion applies with even greater force to the goods and services in classes 3 and 35 which are only similar to a medium degree.

57. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that

the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

58. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

59. The word "Purity"/"PURITY" is a distinctive component in both parties' trade marks and the competing goods and services are either identical (class 3) or similar to a medium degree (classes 5 and 35). Notwithstanding the low degree of inherent distinctive character the opponent's trade mark enjoys, even a consumer paying a higher than normal degree of attention during the purchasing process (who is, as a consequence less prone to the effects of imperfect recollection) is likely, in my view, to conclude that the applicant's trade mark is, for example, a variant brand being used by the opponent to indicate, for example, that its goods contain hemp. As that mistake on the consumer's part will result in indirect confusion, the opposition to all of the applicant's goods and services succeeds.

Overall conclusion

60. The opposition has succeeded against all of the goods and services in the application and, subject to any successful appeal, the application will be refused.

Costs

61. As the opponent has been successful it is entitled to an award of costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying the guidance in the above TPN, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£300
Official fee:	£100
Filing of evidence and reviewing the applicant's evidence:	£500
Written submissions:	£400
Total:	£1300

62. I order Purity Wellness Group Ltd to pay to The Stockroom (Kent) Ltd the sum of **£1300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of May 2021

C J BOWEN
For the Registrar