

O-550-17

TRADE MARKS ACT 1994

IN THE MATTER OF THE REQUEST FOR PROTECTION IN THE UK  
OF INTERNATIONAL REGISTRATION NO. 1291862  
BY ABC DETERJAN SANAYI VE TICARET ANONIM SIRKETI  
FOR THE TRADE MARK



IN CLASSES 3 AND 5  
AND  
THE OPPOSITION THERETO UNDER NUMBER 407649  
BY THE PROCTER & GAMBLE COMPANY

## Background

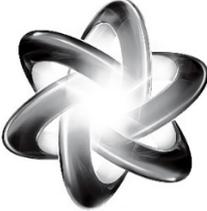
1. ABC DETERJAN SANAYI VE TICARET ANONIM SIRKETI (“the holder”) is the holder of International Registration (“IR”) number for the mark shown on the cover page of this decision. Protection in the UK is sought from 11 December 2015, claiming a priority date of 27 October 2015 (Turkey). The request for protection was published for opposition purposes in the *Trade Mark Journal* on 12 August 2016. Protection is sought in respect of the following goods:

**Class 3:** *Bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers; dishwasher detergents; perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps.*

**Class 5:** *Pharmaceutical and veterinary preparations for medical purposes; chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles.*

2. The IR in issue is subject to a colour claim which reads “the mark contains the colors red, blue, yellow and white”.

3. On 12 October 2016, The Procter & Gamble Company (“the opponent”) filed a notice of opposition to the protection of the entire IR. The opponent claims that the IR offends under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). Both the marks listed below are relied upon under Sections 5(2)(b) and 5(3):

Marks	Goods relied upon
<p data-bbox="204 250 762 338"><b>European Union Trade Mark (EUTM)</b> <b>Number 9939984</b></p>  <p data-bbox="204 683 767 770"><b>Filing date:</b> 4 May 2011 <b>Registration date:</b> 14 September 2011</p>	<p data-bbox="809 250 1372 504"><b>Class 3:</b> Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; essential oils; cosmetics; hair care; dentifrices.</p>
<p data-bbox="204 799 762 887"><b>European Union Trade Mark (EUTM)</b> <b>Number 7437874</b></p>  <p data-bbox="204 1176 719 1263"><b>Colours Claimed:</b> Red, green, blue and white.</p> <p data-bbox="204 1285 667 1373"><b>Filing date:</b> 03 December 2008 <b>Registration date:</b> 21 July 2009</p>	<p data-bbox="809 799 1321 994"><b>Class 3:</b> Washing and bleaching preparation for household purposes including laundry-related use; detergents.</p>

4. The opponent refers to its first mark as the “Atomium” mark. For convenience, I will use the same terminology as that employed by the opponent. I will call the second mark the ARIEL ACTILIFT mark.

5. The opponent claims under Section 5(2)(b) that there exists a likelihood of confusion owing to the similarities between the marks and the goods. Under Section 5(3), the opponent claims that the earlier marks have a significant reputation in the goods relied upon, such that use of the IR would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks. It is said that the holder would ‘free-ride’ on the reputation of the earlier marks and that any sales the holder may enjoy in relation to the contested goods, would be as a result of

the opponent's reputation in the earlier marks. Also that the opponent offers top quality fabric and laundry care goods and that the offering of less adequate goods under a confusingly similar mark, would dilute the distinctive character and reputation of the earlier marks.

6. Both marks set out above are earlier marks in accordance with section 6 of the Act. Only the ARIEL ACTILIFT mark had been registered for more than five years on the date on which the opposed IR was published and it is therefore subject to proof of genuine use under Section 6A of the Act. The relevant period for proof of use is the five years ending on the date on which the IR was published in the UK for opposition purposes, i.e. 13 August 2011 to 12 August 2016. The holder, in its counterstatement, requests that the opponent provides proof of use in relation to its earlier ARIEL ACTILIFT mark and denies all the grounds of opposition.

7. Both parties are professionally represented, the holder by HGF Limited and the opponent by D Young & Co LLP. Only the opponent filed evidence. This will be summarised to the extent that it is considered appropriate. The holder filed nothing beyond the counterstatement. Neither party requested a hearing; only the opponent filed written submissions in lieu. I now make this decision on the basis of the papers before me.

### **The opponent's evidence**

8. This consists of a witness statement dated 23 March 2017 from Tara M. Rosnell, assistant secretary at the opponent's company, accompanied by 18 exhibits (PG1-10). Ms Rosnell confirms that she has been employed by the opponent since November 2010 and that she is duly authorised to make her statement on the opponent's behalf, the facts contained within, being derived either from the records of the company or based on facts within her own knowledge and experience.

9. Before proceeding further, I should mention, however, that although Ms Rosnell refers, in her witness statement, to numbered points of the attached exhibits, e.g. point 1 of exhibit PG12, the exhibits do not appear to have been referenced accordingly. Further, the exhibits have been numbered with the initials of the

opponent rather than with those of the witness<sup>1</sup>. Nonetheless, the evidence to which Ms Rosnell refers is readily identifiable within the exhibits and the exhibits' header sheets clearly identify the case reference number. Consequently, neither of these inadequacies has a material effect on the admissibility and/or readability of the evidence filed. Thus, I will say no more about them.

10. Ms Rosnell says that the opponent manufactures and produces laundry care products under the mark ARIEL. She explains that the ARIEL brand was first launched in Germany in 1967. According to Ms Rosnell, due to "the popularity of ARIEL as a quality laundry product", by 2003 it was available in more than 80 countries worldwide, including the UK where it was first launched in 1969.

11. Ms Rosnell further explains that the Atomium device has been consistently used on all product packaging and marketing material of ARIEL branded products since 1967. A copy of an article from 2012 which appeared in an internal publication about the importance of the Atomium device for the ARIEL's brand is in evidence (PG2). The article talks about the inspiration behind the Atomium device and records that the idea came from the Brussels' Atomium. It is said that the opponent wanted to "visually communicate that ARIEL was a scientifically advanced detergent" and that "this led [the opponent] to select the atom, a symbol for science". It is further said that "the "out of focus" overlapping bubbles at the heart of the atom [...] suggested the enzymes at work during the washing process" and that "this became a symbol for enzymes in the industry for years". Samples of packaging designs used between 1967 and 2000 (including in the UK) (PG1) along with samples of packaging guidelines for ARIEL branded products from 2012 and 2013 (PG3) are also exhibited. The material shows prominent use of the ARIEL name in conjunction with the Atomium device. It is noted that the latter is featured in an earlier version, as well as in the form relied upon by the opponent. When reproduced in one of the forms relied upon by the opponent (i.e. without the word ARIEL superimposed over it), the Atomium device always appears in green as shown below:

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<sup>1</sup> Normal practice in proceedings before the Registry is to use the initials of the person making the witness statement.



12. According to Ms Rosnell, the Atomium device is “a core part of the Ariel brand” and the opponent has applied to register numerous trade marks in the EU and worldwide to protect it. A list of hundreds of marks consisting of combinations of the Atomium device and the name ARIEL is exhibited at PG4.

13. Ms Rosnell says that although the device has evolved since 1967 “the general design has remained in a consistent format whereby it consists of interlocking circular rings in shades of blue, yellow and/or green”. Further, the name ARIEL is said to have been consistently placed across the centre of the Atomium device over the last 15 years and displayed in the colour red since its launch in 1967.

14. Ms Rosnell provides the following information:

- The ARIEL ACTILIFT logo and Atomium device have been used continuously and extensively on ARIEL branded products throughout the EU since 1967;
- The opponent owns the website [www.ariel-info.com](http://www.ariel-info.com) which is directed to consumers from within the EU. Print-outs dated 14 March 2017 from that website are in evidence (PG5). The copy from the UK page [www.ariel.co.uk](http://www.ariel.co.uk) shows that ARIEL Excel Gel was voted as “Best Buy” by WHICH? in the category “Laundry Detergent” in June 2016. It also shows the Atomium mark (as a self-standing sign) in green, used prominently on packaging in conjunction with the name ARIEL;
- The opponent’s advertising efforts since its launch over 50 years ago have led to extensive consumer awareness of the ARIEL brand. The ARIEL ACTILIFT logo and Atomium device are well-known and have become household names throughout the EU;
- According to Ms Rosnell, data from the period February 2012-February 2013 shows that the ARIEL brand held a 15% share of the Fabric Care market in

Western Europe and accounted for 50% of the opponent's total sales. The following table is provided:

Value sales, past 12 months ending Feb 2013 - US\$

	BENELUX	DACH	FRANCE	IBERIA	TOTAL GREECE	NORDICS	UK / IRELAND	WE total (except Italy)
FABRIC CARE	924,946	2,918,314	2,204,311	1,404,119	278,160	249,496	2,392,063	10,371,407
PROCTER & GAMBLE (FC)	328,323	715,028	630,968	324,794	90,334	53,297	1,095,309	3,238,052
ARIEL	118,017	355,710	415,875	286,815	54,370	53,296	317,251	1,601,335

- The opponent is a worldwide partner of the Olympics and was an official sponsor of the 2012 London Olympics. The official sponsor logo used in



marketing and promotional activities was . PG6 contains a screenshot taken from an advert produced by the opponent as part of the London Olympic marketing campaign. As the text is in French, it seems likely that the advert was addressed to the French public. The copy features the Atomium mark in blue and green with the words ARIEL ACTILIFT superimposed on it, as shown below:



- In 2012 a selection of UK consumers were asked to draw a representation of the ARIEL brand and its packaging. Whilst Ms Rosnell asserts that some of the drawings reproduce the Atomium device, there is no indication of how the survey was conducted and/or how many people were interviewed;
- Exhibited at PG8 is an undated extract taken from the website of a company called Design Board with which, it is said, the opponent has worked on design strategies relating to the ARIEL brand within the EU. The extract features the Atomium mark in blue and green (as shown above but without the word ACTILIFT) and refers to it as "iconic";
- Ms Rosnell asserts that ARIEL branded products bearing the Atomium device are "commonly found across the Internet within the EU". At PG9 she exhibits

the results of a UK google image search for ARIEL LAUNDRY, carried out on 14 March 2017. The number of results produced by the search is significant. It is noted that the Atomium mark is shown in green, as a self-standing sign, albeit one used in conjunction with the mark ARIEL, or in blue and green, as part of the ARIEL logo. The copy also includes samples of packaging featuring the ARIEL ACTLIFT mark and other variant marks, all of which incorporate the Atomium device in green, blue or blue and green.

15. The evidence filed also shows extensive use of both earlier marks in a number of EU countries. The main facts and evidence to emerge are as follows:

#### United Kingdom

16. According to Ms Rosnell, in the late 90's the opponent launched Ariel "Professional", a range of products aimed for use by businesses, e.g. hotel, in France and in the UK. These products have been available for purchase on the Amazon UK and eBay websites since, at least, 2011. Exhibited PG10 is provided in support. The pages, dated 9 March 2017, show a range of laundry products offered under the mark ARIEL. The Atomium mark is displayed on all product labels, either as a self-standing sign, in green (and in conjunction with the mark ARIEL), or as part of the ARIEL logo, in blue and green. The copies also show the ARIEL ACTLIFT mark.

17. Ms Rosnell further says that the opponent has two dedicated YouTube Channels, namely "ArielOnline UK" which was launched in 2011 and "Ariel UK and Ireland" which was launched in 2012. Printouts dated 10 March 2017 from both channels are provided within PG10. These appear to show tutorial videos regarding laundry and stain removal. I note that some of the videos appear to be dated "six years ago" and "1 year ago", which means that they must have been uploaded within the relevant period, i.e. 13 August 2011 to 12 August 2016. The Ariel UK and Ireland channel has over 1,400 subscribers and over 1 million views. The Atomium mark is displayed as a self-standing sign, in green and in conjunction with the mark ARIEL. The copies also show the ARIEL ACTILIF mark.

18. Exhibit PG10 also includes various extracts from the Mintel's Global New Products Database (GNPD) confirming that a number of ARIEL ACTILIFT products were available at major UK supermarkets such as Tesco, Morrison, Aldi and ASDA within the relevant period. The goods displayed in the extracts include laundry products and stain removers in the form of tablets, gels and powders. These include claims in the product description and labels that the goods provide brilliant cleaning at low temperatures. In most cases, the packaging features the ARIEL ACTILIFT mark presented on a circular background. A number of copies also show the Atomium mark in blue and green with the words ARIEL ACTILIFT superimposed on it (as shown at paragraph 14 above) and surrounded by a sort of aureole against a purple or green background. In most cases the mark includes additional words, e.g. 'Excel Tabs', 'Excel Gel', although their graphical impact is very marginal due to their size. Two examples are reproduced below:



19. Ms Rosnell says that ARIEL products bearing the Atomium device have been advertised extensively throughout the UK both online and in the press, although no advertising spend details are provided. Samples of adverts which, are said, were disseminated in the UK during the 1960's and between 2005 and 2011 are in evidence. A number of adverts dated 27 January 2009 include the text "The best ever detergent tested, says Which?" and "No liquid removes annoying stains better" and the note "The lovely people at Which? tested 85 detergents over the last 2 years and found that Ariel Excel Gel was better than any other Laundry detergent even in cool clean". According to Ms Rosnell, ARIEL products have also been advertised extensively throughout the UK in television adverts on terrestrial and digital TV channels. Copies are provided on a pen drive exhibit. These are said to show representative samples of adverts broadcast in the UK between 2010 and 2011. The adverts each lasted between 10 and 30 seconds and are entitled "ARIEL ACTILIFT EXCEL GEL TV SPOT 2010 UK", "ARIEL ACTILIFT EXCEL GEL TV SPOT

CELEBRATION JULY 2011 UK” and “ARIEL ACTILIFT TV SPOT 4UK\_RACE OCT 2011 UK”. The adverts feature the ARIEL ACTILIFT mark prominently. An advert also features the Atomium mark in blue and green with the words ARIEL ACTILIFT superimposed on it, as shown at paragraph 14 above.

## France

20. Ms Rosnell says that ARIEL ACTILIFT was voted product of the year in France in 2012. A print-out confirming the award is in evidence; this shows use of the ARIEL ACTILIFT mark prominently on packaging. According to Ms Rosnell, ARIEL products bearing the Atomium device have been advertised extensively throughout France in television adverts on terrestrial and digital TV channels. Two samples of adverts broadcast in France in 2011 are provided on a pen drive exhibit at PG12; one of these show the ARIEL ACTILIFT mark placed prominently on packaging. In October 2012 LSA Magazine, which is said to be a French well-known consumer magazine, published an article regarding a new ARIEL ACTILIFT product launched in France in 2010. A copy of the article as published online at [www.lsa-conso.fr](http://www.lsa-conso.fr) is provided in support. This shows use of the ARIEL ACTILIFT mark on packaging. The page is in French (with no translation) but I can see that the article refers to the opponent as one of the leaders of hygiene products. It also refers to the launch of the laundry detergent ARIEL in the 1960's; this is said to be one of the opponent's most sold products. PG12 includes extracts from the Mintel's GNPD and copies of pages from French websites and comparison websites, including the French Amazon website. These show a number of ARIEL laundry products available for sale in French supermarkets and on French websites within the relevant period. Most of the pages show the Atomium mark used prominently on packaging; this appears either as a self-standing sign, in green (in conjunction with the mark ARIEL) or with the marks ARIEL ACTILIFT superimposed on it, in blue and green (as shown in paragraphs 14 above). According to Ms Rosnell, the opponent's laundry detergent brands, which include ARIEL branded products accounts for 32% of the opponent's total sale in France.

## Spain

21. Rosnell says that sales of ARIEL products in Spain have been extensive and that in 2008 ARIEL was voted product of the year in Spain. She gives the following sales figures for the period 2011 -2015/16:

Time Name	Period Type	Country	Brand	Value Sales (M EUR)	Volume Sales (MSU)	Category Volume Share	Category Value Share
CY2011	CALENDAR YEAR	SPAIN	ARIEL	156,071	5,934	14.5	25.6
CY2012	CALENDAR YEAR	SPAIN	ARIEL	199,425	7,704	13.7	24.0
CY2013	CALENDAR YEAR	SPAIN	ARIEL	187,678	7,598	14.0	23.5
CY2014	CALENDAR YEAR	SPAIN	ARIEL	186,964	7,993	14.5	24.2
CY2015	CALENDAR YEAR	SPAIN	ARIEL	192,092	8,335	14.6	24.8
CYTD	CALENDAR YEAR	SPAIN	ARIEL	48,189	2,082	14.4	24.8

*'1MSU' = 15,000kg of detergent*

22. Ms Rosnell further says that ARIEL products bearing the Atomium device have been advertised extensively throughout Spain in television adverts on terrestrial and digital TV channels. Exhibited at PG15 are copies of videos, which are said to provide representative samples of adverts broadcast in Spain in the period 2006-2013; all the adverts dated 2013 show the ARIEL ACTILIFT mark placed prominently on packaging. The exhibit also includes a copy of a promotional leaflet which, it is said, was produced for the launch of the ARIEL Extra Gel range of products. According to Ms Rosnell this was disseminated in Spain in March 2009. The copy is in Spanish with no translation but I can see that it provides the following information:

- The market share held by ARIEL was of 24,3% in Spain and of 15-16% in Europe;
- The ARIEL logo was created as an artistic representation of an atom. The three rings represent the electrons because, it was thought, this image would communicate to consumers that the product was scientifically innovative;
- ARIEL has been on the market for 40 years. It is described as an emblematic brand which offers the best of laundry innovation.

23. Rosnell concludes her witness statement by saying that the opponent has extensively used its ARIEL ACTILIFT and Atomium device in the UK to such extent

that it enjoys a strong reputation in this territory. She further says that use of the letter A at the beginning of the IR is “critical”. In this connection, she exhibits at PG18 a report by an investigation agency, BISHOP IP Investigations, into “Availability of laundry products beginning with “A” in the UK. The report clarifies that “it is intended to identify uses of A prefixed marks by third parties but does not explore the exact nature, extent or duration of any particular third party’s use”. It states that, at 30 September 2016, in addition to the opponent’s ARIEL brand, four brands of laundry care products beginnings with the letter A had been identified as available in the UK. Ms Rosnell adds that the report makes clear that use of the letter A at the beginning of a laundry care brand name is not commonplace in the UK and that this, in turn, would increase the likelihood of association or confusion with the opponent’s brand ARIEL. The remainder of the witness statement contains opinion evidence from Ms Rosnell that the trade marks in questions are similar and that there is a risk of harm to the opponent’s reputation. I will return to this where appropriate later in my decision.

## **DECISION**

### **Section 5(2)(a)**

24. Section 5(2)(a) of the Act is as follows:

“5(2) 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 similar to those for which the 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”.

25. Section 6A:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),
- (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

### **Proof of use**

26. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

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

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the

import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

27. As the opponent’s earlier mark is a EUTM, the comments of the Court of Justice of the European Union (CJEU) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant, where it noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

28. The ARIEL ACTILIFT mark is a EUTM mark upon which protection has been conferred in the EU. Therefore, in term of use, the relevant test is to establish use in a substantial part of the EU.

29. Ms Rosnell estimated the value of the opponent's sales of ARIEL laundry products in Western Europe in 2012-2013. Even if the evidence refers to only one year, I am content that the extent of use can be assumed to be maintained within the relevant period, bearing in mind the intensity, length and continuity of use. The figures given show a total of 1.6m USD. The amount is broken down by country, but not by type of product. Whilst there are not specific figures which tell what percentage of the 1.6m USD relates to the sale of goods under the ARIEL ACTILIFT mark, Ms Rosnell clearly stated that the mark was voted product of the year in France in 2012. Since the total sale of ARIEL branded products in France in the period February 2012- February 2013 was of over 415 thousands USD, a not-insignificant part of that turnover, must, therefore relate to goods sold under the ARIEL ACTILIFT mark. Further, the evidence shows that ARIEL ACTILIFT laundry products were available for sale at major UK supermarkets within the relevant period, and that there has been extensive marketing and advertising of the ARIEL ACTILIFT mark in UK and France within the same period.

30. Accordingly, I find that the opponent has made genuine use of the ARIEL ACTILIFT mark in the EU during the relevant period. The goods in relation to which the mark has been used, on the basis on the evidence filed, are all laundry related products. I consequently find that use has been established in relation to *washing and bleaching preparation for laundry related use and laundry detergents*.

### **Section 5(2)(b) case law**

31. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## The principles

- (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**

32. In the judgment of the 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”.

33. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) 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;
- e) 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.

34. In *G rard Meric v OHIM*, Case T- 133/05, the General Court (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 fur 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”.

35. The competing goods are as follows:

Earlier goods	IR
<p><b>Atomium device (EUTM 9939984)</b></p> <p><b>Class 3:</b> Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; essential oils; cosmetics; hair care; dentifrices.</p>	<p><b>Class 3:</b> Bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers; dishwasher detergents; perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps.</p>
<p><b>ARIEL ACTILIFT mark (EUTM 7437874) following proof of use</b></p>	<p><b>Class 5:</b> Pharmaceutical and veterinary preparations for medical purposes; chemical preparations for medical and</p>

<p><b>Class 3:</b> washing and bleaching preparation for laundry-related use and laundry detergents.</p>	<p>veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles.</p>
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### Class 3

36. The holder admits that “*bleaching and cleaning preparations [for household purposes], laundry bleach, fabric softeners for laundry use, stain removers, dishwasher detergents*” in the IR “are identical or similar to the earlier goods” but, denies that the remaining goods are similar.

37. I find that the contested *bleaching and cleaning preparations, laundry bleach, fabric softeners for laundry use, stain removers; dishwasher detergents* are identical or highly similar to the opponent’s *bleaching preparations and other substances for laundry use* (as protected by the Atomium mark) and to *washing and bleaching preparation for laundry-related use and laundry detergents* (as protected by the ARIEL ACTILIFT mark). I also find that the contested *detergents other than for use in manufacturing operations and for medical purposes*, is broad enough to encompass *detergents for laundry purposes* and is also identical to the opponent’s *bleaching preparations and other substances for laundry use* (as protected by Atomium mark) and *washing and bleaching preparation for laundry-related use and laundry detergents* (as protected by ARIEL ACTILIFT mark).

38. The contested *cosmetics* and *soaps* are identically contained in the specification covered by the Atomium mark and are identical.

39. The opponent submits that the contested *perfumery, fragrances* and *deodorants for personal use and animals* are similar to the term *cosmetics* in the earlier mark. I agree that *perfumery* and *fragrances* in the IR are similar to *cosmetics* in the Atomium mark. Although the goods are different in nature and methods of use, they

have the same purpose (to improve personal appearance and personal hygiene) and target the same consumers. Further, *perfumery* and *fragrances* are sold in close proximity to *cosmetics* in the same retail outlets; might be produced by the same undertakings and are competitive to a certain degree as cosmetic creams and lotions may have the same scents as perfumes and fragrances and may be applied to the body just because of their pleasant scent. There is a medium degree of similarity.

40. The contested *deodorants for personal use* are similar to the opponent's *soap* to the extent that they both serve hygienic purposes and are used for personal hygiene. Although the nature and methods of use is different, the goods target the same users, share the same trade channels, are sold in in close proximity to one other and could be produced by the same undertakings. There is a low degree of similarity.

41. The contested *deodorants for animals* are goods used on pets. The opponent's goods are either household goods or goods for human consumption. The users, nature, purpose, methods of use and trade channels are different. There is no competition or complementarity. There is no similarity.

## **Class 5**

42. The opponent contends that the contested class 5 goods are similar to the goods protected under the Atomium mark. In particular, it claims that *sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles* in the IR are similar to the opponent's *cleaning preparations* and *cosmetics* because the goods will be sold in the same outlets by the same manufacturers to the same consumers.

43. Insofar as *sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles* are concerned, I cannot find any similarity with the opponent's goods. Even though the opponent's *cosmetics* are used on the body, they have a different nature and purpose; in relation to the opponent's claim that these goods are similar to *cleaning preparations*, the term *cleaning, polishing, scouring and abrasive preparations* will be understood by the average consumer, as referring to household

and industrial preparations<sup>2</sup>. The goods are not complementary or in competition with each other, they target another section of the public and even though they have the same distribution channels, such as drugstores, they are normally not placed close to each other. Further, these goods are normally produced by different undertakings. There is no similarity.

44. I find that *pharmaceutical preparations for medical purposes* in the IR would include pharmaceuticals such as skincare preparations with medical properties whose purpose coincides in part, with the purpose of cosmetic creams not for medical use that are covered by the term *cosmetics* in the opponent's specification. There is therefore a degree of competition since the opponent's cosmetics may be used as alternative (soft) remedies for numerous pharmaceutical preparations. Further, anti-ageing creams contain small amounts of collagen and other products that, in greater quantities, are considered to be pharmaceuticals. The nature and methods of use of the respective goods may be similar, the goods may target the same users and may be available in the same outlets, i.e. pharmacies. There is a medium degree of similarity.

45. The contested *chemical preparations for medical and veterinary purposes* and *chemical reagents for pharmaceutical and veterinary purposes* are chemical products for use in the pharmaceutical and veterinary industry to obtain a pharmaceutical or veterinary product. Their distribution channels are different, in particular, whilst the opponent's *cleaning preparations* and *cosmetics* are widely available in shops, the contested *chemical preparations for medical and veterinary purposes* and *chemical reagents for pharmaceutical and veterinary purposes* might be available only through chemical companies. Consequently, the nature, purpose, methods of use, trade channels and users are different. Further, the goods are not complementary, since goods intended for different publics cannot be complementary<sup>3</sup>. There is no similarity.

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<sup>2</sup> *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589 (Ch)

<sup>3</sup> See for example decision of the General Court T-76/09 paragraph 30

46. This leaves *veterinary preparations for medical purposes*. As these are goods used on pets, for similar reasons to those outlined at paragraph 48, there is no similarity.

47. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

48. Accordingly, for a claim under Section 5(2)(b) to succeed, there must be at least a degree of similarity of goods and services. Having concluded that there is no meaningful similarity between the opponent’s goods and:

**Class 3:** *deodorants for animals*

**Class 5:** *veterinary preparations for medical purposes; chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles.*

In the IR, there can be no likelihood of confusion and the opposition to these goods under Section 5(2)(b) fails accordingly.

### **The average consumer and the nature of the purchasing act**

49. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in

which these goods will be selected 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.”

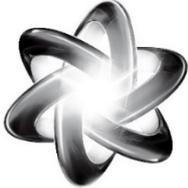
50. The average consumer of the competing goods is the general public. The goods will be selected visually from the shelves of a shop or a website, although I do not discount aural considerations. In my view all of the parties' goods in class 3 will be purchased with an average degree of attention, including *bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers; dishwasher detergents*; although these goods may be purchased relatively frequently, they are not purchased without some considerations, not at least as they have specific functions in the house. Given the nature of the goods, I consider that the level of attention in relation to the purchase of *pharmaceutical preparations for medical purposes* in class 5 is likely to be slightly above average.

### **Comparison of marks**

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

IR	Opponent’s marks
	<p data-bbox="810 965 1337 1055"><b>EUTM Number 9939984 (Atomium mark)</b></p> 
	<p data-bbox="810 1361 1286 1451"><b>EUTM Number 7437874 (ARIEL ACTLIFT mark)</b></p> 

**Overall impression**

53. The IR consists of a composite sign resulting from the combination of two intersecting orbits in yellow and red and a lighter blue diagonal oval which gives the impression of a third orbit. The combination of these elements form a star-like shape.

The IR also contains a blue horizontal oval on whose surface appear the letters ABC. The letters are represented in white and in bold uppercase and stand out because of their size, prominent position and colour and because they are superimposed on the graphical elements. However, due to its size, colour and particular graphics, the device is also quite eye catching. In my view, both the letters and the device are equally dominant and contribute equally to the mark's overall distinctive character.

54. The opponent's Atomium mark consist of three intersecting orbits, which form a star-like shape, registered in shades of grey with a bright white area in the centre. As the shape is the only element of the earlier mark, this is the overall impression it will convey.

55. The opponent's ARIEL ACTILIFT mark consists of a device made up of two overlapping orbits in green and blue and a central green oval, diagonally placed, which gives the impression of a third orbit. The combination of these figurative elements forms a star-like shape. The mark also includes the words ARIEL ACTILIFT in red, placed in the middle of the device. The centric position, the size and colour of the word ARIEL make it stand out. The word ACTILIFT is placed beneath the word ARIEL and it is likely to be understood by the public as a trade mark for goods of a certain detergent formula. Due to its nature, secondary position and size, this element does not have the same distinctive weight from a visual point of view, although it is not negligible in terms of impact. In my view, due to their greater visual impact, both the word ARIEL and the device are the most dominant elements of the mark.

### **Visual similarity**

56. Although the earlier Atomium mark is registered in monochrome such that normal and fair use could be in any colour, the question arises of how far one can go in attributing a distinctive colour scheme to the earlier mark. The CJEU's judgment in *Specsavers*<sup>4</sup> ruled that where an earlier mark is registered in black and white but it is

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<sup>4</sup> *Specsavers International Healthcare Ltd & Others v Asda Stores Ltd* [2012] EWCA Civ 24

used extensively by the owner in a particular colour(s), which becomes part of the mark's distinctive character through use, those colours can be taken into account. However, the IR at issue involves a complex contrasting colour scheme and I do not think that it is correct to compare the marks as though the earlier Atomium mark were in the same colours as the IR, so that to produce a colour replica of the IR. This is because, firstly, the UK courts have always approached these comparisons on the basis that it is necessary to consider 'normal and fair' notional use of the marks. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in Canon at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

57. Applying a complex contrasting colour scheme which (a) is not part of the registration and (b) is not part of the mark shown to have been used, is, in my view, going beyond considering normal and fair uses of the earlier mark in one colour or another. Therefore, I will consider the Atomium mark as being capable of being used in any single colour, including blue, yellow, red or green, but not in colour combinations as per the IR.

58. The distinctive character of the IR relies on both the figurative element and the letters ABC whilst the Atomium mark is, in effect, a device mark with no semantic content. Due to the similarity of the figurative elements, both forming a star-like shape, but taking into account the contrasting colour scheme and the presence of the word element ABC in the IR, I find that the marks are visually similar to a very low degree.

59. Moving on to the ARIEL ACTILIFT mark, even though the word elements of both marks are prominently displayed in a central position, in a similar type of script on similar devices, they are very different, i.e. ABC and ARIEL. However, the similarity between the shape of the device elements and the common use of blue and red colours on white background creates a certain degree of similarity between the marks. In my view, there is a moderate degree of visual similarity between the IR and the ARIEL ACTILIFT mark.

### **Aural similarity**

60. The Atomium device will not be articulated. The IR will be articulated as EI- BI- SI. There is no aural similarity between these marks.

61. The ARIEL ACTILIFT mark is likely to be articulated as E-RIEL or E-RIEL ACTI-LII-FT and the IR as EI- BI- SI. The respective marks are aurally different.

### **Conceptual similarity**

62. Both the earlier marks and the IR incorporate an image giving the impression of three overlapping orbits forming a star-like shape. Whilst the opponent states that the devices in the earlier marks are meant to represent an atom (a fact which is corroborated by the evidence) and that this, in turn, creates a conceptual similarity with the IR, I do not think that this concept jumps out at the public and there is no evidence that the UK average consumer has been educated to perceive the device elements of the opponent's marks in such a way. I do not consider that the images conveyed by the competing marks convey any concept that is likely to be grasped immediately by the average consumer. Therefore, I find that, insofar as the devices are concerned, the marks are conceptually neutral. As regards to the word elements, namely ABC and ARIEL ACTLIFT, I find that neither of them convey any concept.

### **Distinctive character of the earlier marks**

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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).”

64. The opponent’s earlier marks are, absent use, inherently distinctive and in my view, inherently distinctive to an above average degree. The visual impact of the Atomium device is quite striking. Insofar as the word ARIEL is concerned, according to Collins English Dictionary, it denotes either “an Arabian gazelle” or “the smallest of the four large satellites of Uranus” and is not a term commonly used in the UK. Though the holder refers to ARIEL being a female name, it is not a name commonly used in the UK.

65. The opponent claims that the earlier marks have acquired an enhanced level of distinctiveness as a result of the use made of them. In this connection, it points out that the Atomium mark is used in conjunction with the distinctive brand name ARIEL and it is associated with that name and there is evidence of the Atomium mark being used as a separate sign to the words. I find that the use shown in the UK has built

upon the degree of inherent distinctiveness of the ARIEL ACTILIFT mark, increasing it to a very high degree, in relation to *washing and bleaching preparation for laundry related use and laundry detergents*. I also find that, although the Atomium mark is always used in conjunction with the mark ARIEL, it has acquired a fairly high distinctive character through use, when used in the colour scheme in which it appears to be most often used as a self-standing sign, i.e. green<sup>5</sup>. However, the degree to which the distinctive character of the Atomium device has been enhanced is comparatively less significant than the one relating to the ARIEL ACTILIFT mark. Further, to the extent that the distinctive character of the Atomium mark has been enhanced in the colour green, this does not assist the opponent because the holder's mark is in different colours.

### **Likelihood of confusion**

66. 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 marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

67. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and/or services come from the same or a related trade source). This distinction was summed up by 75. Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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<sup>5</sup> See by analogy *Société des Produits Nestlé SA v Mars UK Ltd*, CJEU, Case C-353/03, where the CJEU found that the distinctive character of a mark for the purpose of assessing absolute grounds of refusal, may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.

“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.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

68. The opponent stated in its submissions:

“The Applicant has encountered objections to registration of the Application in other jurisdictions. Indeed, it is noted that the Applicant has been refused

registration in Spain, Portugal and Switzerland as a result of oppositions by the Opponent. Copies of the decisions in these matters are enclosed at **Annex 1**. The application has also been provisionally refused registration on the basis of the Opponent's rights in Armenia, Cyprus, Czech Republic, Denmark, Egypt, Croatia, Hungary, Iceland, Italy, Kenya, Lithuania, Latvia, Morocco, Republic of Moldova, Montenegro, Slovenia, and Slovakia. Confirmations are attached at **Annex 2**"

69. The material filed consists of print-outs from the European Union Intellectual Property Office (EUIPO) website detailing a number of marks registered in the opponent's name and copies of documents relating to ex-officio provisional refusals of the IR from various national offices. This material is of no assistance to the opponent. This is because an ex-officio provisional refusal is a refusal based on the filing of a valid opposition; whether the opposition is likely to succeed is a different matter. Further, no translation has been provided and I am unable to identify any substantive decisions within the annexes filed. In any event, even if the opponent had provided copies of decisions confirming that it had been successful in other jurisdictions against the same IR on the basis of the same earlier marks relied upon in these proceedings, the Registrar is not bound by the decisions of other national offices. Thus, I will say no more about these submissions.

70. As to Ms Rosnell's evidence in relation to confusion, her expressions of opinion, as opposed to her evidence on actual facts, has no weight in this case<sup>6</sup> so I shall say no more about it.

71. Earlier in my decision, I found that the IR and the Atomium mark are visually similar to a very low degree and that the IR and the ARIEL ACTILIFT mark are visually similar to a moderate degree. I also found that the conceptual position is neutral. There is no aural similarity between the IR and the Atomium mark and the IR and the ARIEL ACTILIFT mark are aurally different. The opponent's ARIEL ACTILIFT mark benefits from enhanced distinctiveness in relation to *washing and*

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<sup>6</sup> See *In esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842, L. J.

*bleaching preparation for laundry-related use and laundry detergents.* These goods are identical (or highly similar) to some of the goods contained in the IR, namely *bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers and dishwasher detergents.* The remaining goods in the IR, namely *perfumery; cosmetics; fragrances; deodorants for personal use and soaps* in class 3 and *pharmaceutical preparations for medical purposes* in class 5, are similar to a low to medium degree to goods covered by the Atomium mark, i.e. *cosmetics and soaps*, and for which the opponent has not used the mark.

#### *Direct confusion?*

72. Though the opponent's seems to rely on indirect confusion, for the sake of completeness, I will also determine whether there is a likelihood of direct confusion. I will consider the position first in relation to the ARIEL ACTILIF mark. Accordingly, I find that the device elements of the competing marks are similar to a good degree. However, even taking into account the degree of similarity between the colour schemes used in marks, the similar positioning of the word elements, and the fact that the first letter of each mark is the letter A, the different letters ABC in the IR certainly appear in such a prominent position that even where an average degree of attention is deployed, identical goods are involved and the earlier mark benefits from enhanced distinctiveness, the average consumer is unlikely to be confused between the ABC mark and the ARIEL ACTILIFT mark as wholes. **There is no likelihood of direct confusion between the IR and the ARIEL ACTILIFT mark.**

73. In relation to the Atomium mark, the differences between the marks are starker and I find that even where identical goods are involved, **there is no real likelihood of direct confusion between the IR and the Atomium mark.** Indeed, confusion is even less likely in relation to the remaining goods, which are not closely similar to the goods of the earlier mark.

#### *Indirect confusion?*

74. The opponent claims that:

“ [...] when considered in relation to the goods in question, the [IR] immediately call the Atomium Marks to mind. This is especially so considering that the trade marks coincide in the use of atom devices, the Opponent is known for use of atom devices under its famous Ariel brand [...] and the Opposed Goods are identical or closely similar to goods protected by the Atomium Marks” (my emphasis)

And

“[...] Therefore, use of an atom type device, beginning with the letter ‘A’ in a format similar to how the ARIEL brand is used, in relation to laundry products, is likely to be wrongly perceived as a brand extension of, or a product connected with the Opponent’s famous brand.”

75. Likelihood of confusion and likelihood of association are not, strictly speaking, the same thing. There might, in fact, be situations in which the average consumer may consider two marks to be similar and may make an association in the sense that the later sign will call to mind the memory of the earlier mark, but nonetheless, there will be no likelihood of confusion (either direct or indirect)<sup>7</sup>. All depends on the circumstances of the case. Again, I will consider the position first in relation to the ARIEL ACTILIF mark. In this connection, I found that whilst the similarities between the competing marks derive from the devices, which are distinctive elements of the marks, the devices are not identical. Further, although they use some of the same colours, they do not use the same colour scheme. Further still, the prominent display in the IR of the letters ABC (which is a dominant and distinctive element of the mark), is likely to be perceived as denoting who makes the goods, i.e. a trader called ABC. In those circumstances, whilst the IR may call to mind the opponent’s mark, it is unlikely that the public will believe that the ABC mark is a brand extension of the ARIEL ACTILIF mark. A brand extension would not normally replace a household name with a different brand name.

76. Moving on to the Atomium mark, the right approach is to consider the matter from a notional perspective, disregarding how the opponent actually uses the mark

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<sup>7</sup> See Case C-251/95 *Sabel v Puma*

(in conjunction with the household name ARIEL). The devices in the competing marks are drawn differently, are clearly not identical and do not give rise to a conceptual similarity. Additionally, the Atomium mark does not include colour and, therefore, the complex colour scheme visible in the IR. Whilst the Atomium mark has acquired a fairly high degree of distinctive character, to the extent that the distinctive character of the mark has been enhanced in the colour green, it does not assist the opponent because the IR is in different colours. Finally, the IR includes the letters ABC in addition to the device. In my view, in those circumstances, the gap between the two marks is such that it is unlikely that the public will believe that the IR is a brand extension of the Atomium mark.

77. For the sake of completeness, I should say that I am not able to consider the argument that the opponent is known for use of the Atomium mark under its famous brand ARIEL. The assessment of the likelihood of confusion must be made on the basis of the earlier mark, as it registered (notional use) and the way the opponent actually uses the mark is irrelevant. In any event, even if I were to consider that the average consumer were to associate the Atomium mark to the household name ARIEL, the consequence of this would be that the device element in the IR would bring to mind the brand ARIEL. Proceeding on that basis, it is unlikely that the public will be misled as to the origin of the goods as no customer would draw the conclusion that ABC is a brand extension of ARIEL; once again, a brand extension would not normally replace a household name with a different brand name. **There is no likelihood of indirect confusion.**

78. Having found that the differences between the marks are sufficient to avoid the likelihood of confusion (both direct and indirect), I will move on to consider the opponent's case under Section 5(3).

### **Section 5(3)**

79. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

80. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in

the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is

clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## Reputation

81. As the earlier marks are EUTMs, in terms of reputation, the relevant test is to establish reputation in a substantial part of the EU. However, the necessary link must be made by the relevant section of public in the UK.

82. The evidence demonstrates that the name ARIEL has been used by the opponent throughout the EU on a very substantial scale in relation to laundry products and is a household name for those products. According to Ms Rosnell, in 2013 ARIEL held a 15% market share of the fabric care market in Western Europe and the sale of ARIEL branded products accounted for 50% of the opponent's total sales. Though the figures reproduced at paragraph 14 above do not appear to be in line with the figures shown in paragraph 22<sup>8</sup>, these are nevertheless impressive figures and have not been challenged by the holder. I accordingly find that the name ARIEL has a reputation in the EU for laundry products. I also find that the reputation conveys the image of exceptional quality: ARIEL branded products are marketed as high quality laundry products which guarantee excellent results even at low temperatures.

83. Insofar as the position in the UK is concerned, the evidence establishes that the name ARIEL has been used prominently on the packaging and in marketing activities in conjunction with the Atomium device in the UK since 1969, so use is longstanding and intensive. ARIEL branded products were available in the UK prior to the relevant date with a strong presence in major supermarkets and on the Internet. ARIEL was voted best buy by "Which" in 2016 and the turnover figures show that the brand enjoys a consolidated position amongst UK market leaders with a share of about 13% (in 2012-2013). Although the marketing spend is not given,

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<sup>8</sup> The figures at paragraph 22 seem to indicate annual sales in Spain for 2013 of over 100m euros whilst the opponent claims that the total sale of ARIEL branded products in Western Europe for the same period was of 1.6m USD.

there is evidence to show that ARIEL was an official sponsor of the 2012 London Olympic games and the ARIEL ACTILIFT mark was part of the official sponsorship logo. There is enough evidence to support the view that the opponent had made significant advertisement investment in the earlier marks. These are all circumstances that establish that the earlier marks had a reputation in the UK at the date of filing of the contested mark in relation to laundry products.

84. For the avoidance of doubt, I should mention that whilst I acknowledge that the ARIEL ACTILIFT mark and the Atomium mark are only two of the marks used by the opponent over the last 50 years, this does not matter greatly. This is because there is ample use shown of both the ARIEL ACTILIFT mark and the Atomium mark in the exhibits and I have no doubt that they have been used to a significant extent in the UK in relation to laundry products. I therefore accept that both the ARIEL ACTILIFT mark and the Atomium mark have a reputation for 5(3) purposes for laundry products, although the Atomium mark has a less strong reputation than the composite ARIEL ACTILIFT mark.

### **The link**

85. In addition to having a reputation a link must be made between the contested mark and the earlier mark. In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

“ 29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

86. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of

that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

87. Once again, I will consider the position in relation to the ARIEL ACTILIFT mark first.

88. In making a direct comparison between the IR and the ARIEL ACTILIFT mark, I found that the marks are visually similar to a moderate degree. Some of the contested goods, are identical or highly similar to the goods for which the ARIEL ACTILIFT mark has a strong reputation, i.e. laundry products. The remaining goods in the IR are not similar to the goods covered by the ARIEL ACTILIFT mark, though they are similar to a low to medium degree to goods covered by the Atomium mark (but in relation to which the mark has not been used). In assessing the opponent’s claim under Section 5(2)(b) I found that there is no likelihood of confusion.

89. Carefully weighing all of the aforementioned factors against each other, I come to the conclusion that the similarities that exist between the respective marks together with the strong reputation of the earlier mark will result in the IR bringing to mind the ARIEL ACTILIFT mark when encountered on identical or highly similar goods, namely *bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers and dishwasher detergents*. In other words a link will be made.

90. The remaining goods in the IR are not similar to any of the goods for which the ARIEL ACTILIFT mark has a reputation. Accordingly, I find that the contested remaining goods are so different apart from the goods in respect to which the opponent has reputation, as to make the association of the marks at issue sufficiently unlikely. Though I accept that the ARIEL ACTILIFT has a significant reputation, it is difficult to see how this can extend beyond the field of laundry products and the marks are not so similar that they bridge the gap created by the distance between the respective goods. I therefore consider that in respect of *perfumery, cosmetics, fragrances, deodorants for personal use and animals and soaps in class 3 and pharmaceutical and veterinary preparations for medical purposes, chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes, sanitary preparations for medical use, hygienic pads, hygienic tampons, plasters, materials for dressings, diapers, including those made of paper and textiles in class 5*, no link will be established in the mind of the relevant consumer. Without a link, there can be no damage. The ground of opposition under Section 5(3) therefore fails in respect of these goods.

91. Insofar as the Atomium mark is concerned, as the degree of similarity to the Atomium mark in green (or no) colour is no higher, then the opponent has no better Section 5(3) case based on this mark.

### **Unfair advantage**

92. There is no evidence to suggest that the holder chose the subject IR with the intention of exploiting the opponent's reputation. However, I note that in *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a

particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

93. I find that there is a non-hypothetical risk that in respect to the following:

**Class 3:** *bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers; dishwasher detergents.*

that the link consumers will make between the respective marks will result in the positive characteristics associated with the ARIEL ACTILIFT mark, namely the marks' reputation for high quality laundry products that work at low temperatures, being transferred to the IR. This association with the opponent's reputed mark would give the holder customers it would not otherwise have enjoyed and make its job of marketing its goods easier. As this would come without paying any compensation to the opponent, and without the holder expending the money necessary to create a market for its own goods in the UK, this is unfair advantage. The holder has not pleaded any 'due cause' defence. The ground under section 5(3) succeeds.

94. Having reached this conclusion, I do not consider it necessary to consider the other heads of damage under this ground.

## **CONCLUSIONS:**

95. The opposition therefore succeeds in relation to:

**Class 3:** *bleaching and cleaning preparations, detergents other than for use in manufacturing operations and for medical purposes, laundry bleach, fabric softeners for laundry use, stain removers; dishwasher detergents*

96. And fails in relation to:

**Class 3:** *perfumery; cosmetics; fragrances; deodorants for personal use and animals; soaps.*

**Class 5:** *Pharmaceutical and veterinary preparations for medical purposes; chemical preparations for medical and veterinary purposes, chemical reagents for pharmaceutical and veterinary purposes; sanitary preparations for medical use; hygienic pads; hygienic tampons; plasters; materials for dressings; diapers, including those made of paper and textiles.*

## **COSTS**

97. As both parties have achieved a measure of success it is appropriate that the parties bear their own costs.

**Dated this 31<sup>st</sup> day of October 2017**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**