

O-756-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3241954
BY DOMINIQUE TILLEN TO REGISTER:**

Go-Kidz

AS A TRADE MARK IN CLASSES: 3, 5, 10, & 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 410594 BY DESIGN GO LIMITED & DG CAPITAL LIMITED**

BACKGROUND & PLEADINGS

1. On 6 July 2017, Dominique Tillen applied to register the trade mark **Go-Kidz** for the goods shown in paragraph 30 below. The application was published for opposition purposes on 21 July 2017.

2. The application has been opposed in full by Design Go Limited (“DGL”) & DG Capital Limited (“DGC”) (“the opponents”). The opposition is based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In relation to the objection based upon section 5(2)(b) of the Act, the opponents rely upon the following United Kingdom trade mark registrations:

No. 2163188 for the trade mark **GO** which was applied for on 4 April 1998 and which was entered in the register on 12 November 1999. The opponent indicates that it relies upon the goods shown in paragraph 30 below.

No. 3016419 for the trade mark shown below which was applied for on 2 August 2013 and which was entered in the register on 8 August 2014. The opponent indicates that it relies upon the goods shown in paragraph 30 below:



3. The opponents state that the trade mark the subject of the application is “visually, phonetically and conceptually similar [to their trade marks] to the extent that the marks in issue coincide in the word element GO” and contains goods which the opponents regard as “identical and/or similar” to the goods upon which they rely in these

proceedings. They add that DGL has “extensively” used the above trade marks in relation to the goods relied upon in the United Kingdom, resulting in the above trade marks acquiring an enhanced degree of distinctive character.

4. In relation to their claim based upon section 5(4)(a) of the Act, the opponents rely upon the unregistered trade mark shown below:



5. The opponents state that DGL is the proprietor of this unregistered trade mark and explain that it has been used throughout the United Kingdom since 2012 in relation to what they describe as “a range of children’s and baby products, some of which have been incorporated into its Go Travel range of travel items and accessories”. A list of the specific goods upon which the opponents rely can be found at paragraph 17 of this decision.

6. As a consequence of this use, they state that DGL is the owner of goodwill in the business conducted under the above unregistered trade mark and that adoption by the applicant of the trade mark the subject of the application in “the context of infants’ healthcare/comfort products” would constitute a misrepresentation likely to damage the opponents’ business.

7. The applicant filed a counterstatement in which the basis of the opposition is denied.

8. In these proceedings, the opponents are represented by Marks & Clerk LLP and the applicant by chapman+co. Although only the opponents filed evidence, the applicant filed written submissions during the evidence rounds. Whilst neither party asked to be heard, the opponents elected to file written submissions in lieu of attendance at a hearing. I shall refer to these submissions, as necessary, later in this decision.

The opponents' evidence

9. This consists of a witness statement from Glenn Rogers. Mr Rogers explains that he is Vice Chairman of DGL (having previously been its Managing Director) and has been involved in the company for over 20 years. He is also a Director of DGC, which he explains is a non-trading company “which owns some of the intellectual property exercised by the Design Go group of companies, including [his] company.”

10. Mr Rogers states that the business commenced trading in 1978. It was incorporated in 1980 under the name Jack Rogers & Co. Limited and in 2004 the name was changed to Design Go Limited. He states that the company “has grown to become a leading player in the field of travel products and accessories” and explains that in 2011 the business was rebranded as “Go Travel” to, he states, “capitalise on the goodwill in the “GO” name which has been associated with [his] company since inception (some 35 years ago)...”

11. Mr Rogers explains:

“2. My company and its predecessor in business have used the GO mark in a number of different and overlapping forms since 1978 and continue to do so to the present day. These forms include the GO mark either used on its own or in a way in which the GO word is predominant.”

12. Exhibit GR1, consists of what Mr Rogers describes as a table “setting out the evolution of the GO trade mark...from 1979 to date.” I note there are fifteen variants identified with the trade marks relied upon under section 5(2)(b) having, it appears, been used from 2004 (GO plain word) and GO (stylised) from 2011, respectively. All of the variants identified contain the word GO (often in varying degrees of stylisation) used either alone or accompanied by one or more of the following words “DESIGN”, “TRAVEL EMPORIUM” and “TRAVEL”.

13. Mr Rogers states that the GO trade marks referred to above have been used on, inter alia, products, packaging, display stands for products, trade show stands, business stationery and business cards. He refers to what he describes as “the overlapping use of the various GO marks”, which he explains results from the various versions being introduced “gradually over time.”

14. Exhibit GR2, consists of what he refers to as “the current range of products offered by my company”. The pages provided were obtained from www.go-travelproducts.com.uk and printed on 20 March 2018. Inter alia, the trade mark the subject of registration no. 3016419 can be seen on a number of the goods listed. The goods are categorised under the following headings: “Electricals”, which includes “Adaptors”, “Appliances”, “Audio”, “Chargers”, “Fans”, “Torches” and “Weighing Scales”. Under the heading “Test Holders” there appears items such as a “Money belt” and “Travel Wallet”. Further categories listed are as follows: “Security”, which includes “Passport Holders” and “RFID Range”, “Bags & Holders”, which includes “Clothing Protectors”, “Protective Pouches”, “Travel Bags” and “Waterproof Pouches”, “Accessories”, which includes “Combi Locks”, “Key Locks”, “Miscellaneous” (which includes items such as a “Travel Clothes Line”, a “Drinks Bottle” and “Travel Playing Cards”), “Tags”, “TSA Range”, “Trolleys”, and “Straps”. The category “Health & Comfort” includes “Ear Plugs”, “Eye Masks”, “Insect Repellents”, “Pillows”, “Rainwear”, “Toiletries” and “Wellbeing”. The final category listed is “For Kids” which includes a range of pillows, night lights, a mosquito net for a cot and a poncho and pouch.

15. Mr Rogers states that his company's products are "seen by millions of UK consumers each and every day", explaining that the products are distributed through a wide variety of bricks and mortar retail stores. At the time of his statement, i.e. March 2018, he explains the opponents have around 190 retail stands/selling points across five terminals in Heathrow airport as well as servicing 10 other airports in the United Kingdom including Gatwick, Stanstead, Manchester and Scotland. He adds that retailing at airports accounts for only 30% of the opponents' revenue in the United Kingdom, with the remainder achieved through department stores, supermarkets, pharmacies, post offices and in retailers such as Sainsbury's, Boots, WH Smith, Harrods, Selfridges, House of Fraser, John Lewis, Sports Direct, JD Sports, Ryman's, Robert Dyas, Waitrose, Dixons, Halfords and Fenwicks.

16. Exhibit GR3, consists of details of the opponents' annual sales figures in the United Kingdom since 1990. Given what the opponents regarded as the confidential and sensitive nature of these figures, under the provisions of rule 59 of the Trade Marks Rules 2008, they sought a direction that they only be made available to the registrar, the applicant and their legal advisors and not disclosed to any other party. The applicant did not object to that request, and on 12 July 2018, the registrar issued an Order for Confidentiality on the basis indicated.

17. Mr Rogers states that in 2012 the opponents launched a range of children's products "under the Go Travel brand to complement the existing range of products..." and "since that time the Go Kids range of products has expanded to include at least the following: Corner protectors for babies, shelves and furniture, padded door stops, wrist links and walking reins/harnesses for children, chair harnesses, torches/lights for children, sterilising bags for babies bottles, zip lock bags for children's travel essentials such as nappies, cups, medicines, drinks and snacks, wipe clean baby bibs, nappy bag dispensers, changing mats, baby towels, travel blankets, comfort blankets, cuddly toy travel pillows for children, cuddly toy neck pillows, cuddly nightlights in the form of toys, mosquito nets for cots, cribs prams and pushchairs, children's headphones."

18. Exhibits GR4 to GR9 consist of copies of the opponents' catalogues between 2012 and 2017 in which, inter alia, the unregistered trade mark relied upon by the opponents i.e:



can be seen and the goods offered are, broadly speaking, those referred to by Mr Rogers and shown in paragraph 17 above.

19. Mr Rogers explains that the opponents regularly attend trade shows in the United Kingdom and overseas where goods sold under the above unregistered trade mark are exhibited. Exhibit GR10, consists of photographs taken at trade shows held in the United Kingdom between 2012 and 2018, i.e. the AIS Trade Show (2013, 2014, 2015 and 2017), the OTS Trade Show (2012, 2013 and 2014) and the Spring Trade Fair Show (2015 and 2018) in which the opponents participated and in the majority of which, inter alia, the unregistered trade mark can be seen. No information is provided as to the duration of these trade shows nor how many people attended them.

20. Exhibit GR11, consists of a range of partially redacted invoices issued by the opponents between 12 September 2012 and 22 February 2017 all of which are addressed to undertakings based in the United Kingdom and all of which contain entries which relate to one or more of the goods shown in paragraph 17 above. Mr Rogers states “the invoices all relate to the sale of Go Kids product...”

21. Like exhibit GR3, exhibit GR12 is subject to an Order for Confidentiality. It contains details of sales achieved between 2012 and 2017 by the opponents under the unregistered trade mark mentioned above.

22. Exhibits GR13 and GR14 consist of what Mr Rogers describes as “samples of advertisements bearing the mark placed in online newspapers in the United Kingdom” and “samples of magazines articles bearing the mark”, respectively. I note that exhibit GR13 contains articles which appeared in (i) the *Independent* (date uncertain) featuring the opponents’ children’s headphones, and (ii) in the *Telegraph* from November and December 2016, in relation to the opponents’ giraffe and lion neck pillows. I note that the entries at (ii) mention go-travelproducts.com.

23. Exhibit GR14 contains (i) an extract from *Frontier Magazine* dated 30 October 2015, headed “Go Travel reveals 50 new launches in 2015”; it refers, inter alia, to the opponents’ nightlights and child safe headphones, (ii) an undated article from *IN Magazine* which refers to one of the opponents’ travel pillows and also contains a reference to the opponents’ website mentioned above, (iii) an extract from *baby world* dated July 2015, which refers to one of the opponents’ neck pillows and mentions it is from “Go Travel”, (iv) an extract dated July 2015 from *MYBABA*, which appears to refer to the opponents’ headphones for children, (v) an extract dated 17 February 2015 from *Mother and Baby Online*, which mentions both the opponents’ monkey travel pillow and its website, and finally, (vi) an extract dated 19 August 2014 from *Skyscanner* which mentions “Go kids Luxury Travel Pillow”.

24. That concludes my summary of the evidence filed by the opponents to the extent I consider it necessary.

DECISION

25. The opposition is based upon sections 5(2)(b) and 5(4)(a) of the Act which read 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 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.”

And:

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

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

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

26. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

27. Under section 5(2)(b) of the Act, the opponents are relying upon the UK trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. Given the interplay between the dates on which the opponents' trade marks were entered in the register and the publication date of the application for registration, only trade mark no. 2163188 is subject to the proof of use provisions contained in section 6A of the Act. In its Notice of opposition, the opponents indicated that the trade mark had been used in relation to the goods shown in paragraph 30 and in its counterstatement, the applicant asked the opponents to make good that claim. As trade mark no. 3016419 is not subject to proof of use, the opponents are entitled to rely upon it in relation to all the goods shown in paragraph 30 without having to demonstrate genuine use.

My approach to the opposition under section 5(2)(b)

28. Trade mark no. 2163188 stands registered for the word “GO” presented in block capital letters. However, that registration is: (i) subject to proof of use, and (ii) the goods relied upon are narrower than those included in trade mark no. 3016419 (which is not subject to proof of use and contains all of the goods in 2163188). Although that latter trade mark consists of the well-known word “Go” presented in a slightly stylised bold font in a device of a square, as I do not regard either the slight stylisation of the word

“Go” or the inclusion of the device to be matters which are likely to materially impact on the opponents’ prospect of success, it is upon the basis of this trade mark that I shall conduct the comparison, only returning to consider the other trade mark upon which the opponents rely if I consider it necessary to do so.

Section 5(2)(b) – case law

29. 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.

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 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

30. The competing goods are as follows:

Opponents' goods being relied upon	Applicant's goods
<p>No. 2163188</p> <p>Class 5 – Bandages; dressings; plasters.</p> <p>Class 21 - Toothbrushes; toothbrush covers and containers.</p> <p>No. 3016419</p> <p>Class 5 - First aid kits comprising adherent and non-adherent dressings, gauze bandages, plasters, dressing tape, cleansing wipes and antiseptic wipes; mosquito repellent wipes; insect repellent wipes.</p> <p>Class 21 - Toothbrushes, toothbrush heads and toothbrush cases.</p>	<p>Class 3 - Dentifrices; Tooth care preparations; Baby wipes; Pre-moistened cosmetic wipes; Moist wipes impregnated with a cosmetic lotion.</p> <p>Class 5 - Impregnated medicated wipes; Moist wipes impregnated with a pharmaceutical lotion; Wipes for medical use.</p> <p>Class 10 - Baby teething rings; Teething rings for relieving teething pain; Teething soothers; Teething rings; Rings (Teething -); Baby dummies; Dummies for babies; Pacifiers [babies dummies].</p> <p>Class 21 - Electric toothbrushes; Manual toothbrushes; Toothbrushes; Toothbrushes, electric.</p>

31. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

“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”.

32. 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.

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

“... 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."

34. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

35. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria 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".

36. Finally, in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* 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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

37. In reaching a conclusion, I have taken into account, but do not intend to record here, all of the parties’ competing submissions on this aspect of the case.

Class 3

38. In their written submissions filed in lieu of a hearing, the opponents stated:

“11...dentifrices, toothcare preparations [in the application] are similar to the [goods in class 21 of registration no. 3016419] in the sense that the respective products are used together or closely associated.

12...baby wipes etc. [in the application] are similar to the opponent’s wipes and bandages; dressings; plasters [in class 5].”

Dentifrices; tooth care preparations

39. Collinsdictionary.com defines “dentifrice” as “any substance, esp. paste or powder, for use in cleaning the teeth.” Although the physical nature of a toothbrush and a dentifrice/tooth care preparation will obviously differ, inter alia, their intended purpose is

the same and they will be found on the same shelves in, for example, a supermarket; each is, self-evidently, important for the use of the other. The users of the competing goods will be the same and I am satisfied such average consumers will be well used to both sets of goods emanating from the same commercial undertakings. Considered overall, the goods at issue are complementary, leading, in my view, to an above medium degree of similarity between them.

Baby wipes; Pre-moistened cosmetic wipes; Moist wipes impregnated with a cosmetic lotion.

40. The opponents' specification in class 5 includes "first aid kits comprising...cleansing wipes and antiseptic wipes...". Although these wipes are medicated and the applicant's wipes in this class are not, the physical nature and method of use of the various wipes are, if not identical, likely to be highly similar. As the users may be the same and as such users may choose to use a medicated wipe as opposed to a non-medicated one or to use both as part of their daily cleansing regime, there is also likely to be a degree of competition/complementarity between the various wipes. Considered overall, I regard the opponents' wipes in class 5 to be similar to the applicant's wipes in this class to an above medium degree.

Class 5

41. As I mentioned above, the opponents' specification includes "first aid kits comprising...cleansing wipes and antiseptic wipes..." As "cleansing wipes and antiseptic wipes..." are simply an alternative way of describing the various wipes in the applicant's specification, the goods are identical.

Class 10

42. In their Notice of opposition, the opponents stated:

“9. The applicant’s class 10 goods are similar to the opponents’ “plastic bibs for babies” in class 25 of no. 3016419 in the sense that the respective goods are closely associated.”

43. In its written submissions filed during the evidence rounds, the applicant stated:

“4.7.3...However, as class 25 is not included in the opposition, this paragraph is wholly irrelevant and it is requested that this paragraph is struck out”.

44. While the opponents’ registration does include “plastic bibs” in class 25, as the applicant correctly points out, those goods were not identified in the Notice of opposition. However, despite being aware of the applicant’s comment above, no request has made by the opponents to amend their pleadings in this regard. Rather, in their submissions filed in lieu of a hearing, the opponents simply maintained the position they adopted in their Notice of opposition. As the opponents have not identified any other basis upon which they consider any of their other goods might be regarded as similar to the applicant’s goods in this class, it is an irresistible inference that they were unable to identify any similarity beyond that mentioned above. In the circumstances described, I intend to proceed on the basis that the applicant’s goods in this class are not similar to any of the opponents’ goods.

45. However, even if I am wrong in that regard, beyond the fact that some of the opponents’ goods in class 5 and, more likely, class 21, may be used upon or in relation to babies, having applied the case law mentioned above, I can find no meaningful degree of similarity between the applicant’s teething rings, soothers, dummies and pacifiers and any of the opponents’ goods in these classes.

46. Finally, in an abundance of caution (should my decision be appealed and any appellate Tribunal consider it appropriate to allow the opponents an opportunity to amend their pleadings to include the goods in class 25 mentioned above i.e. “plastic

bibs”), I shall express my own views. As such goods in class 25 are likely to be of a different nature, serve a different purpose, have different methods of use and are neither complementary to, nor in competition with the applicant’s goods in this class, I would have found no similarity in any event.

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

“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. Having concluded that there is no similarity between the applicant’s goods in this class and any of the opponents’ goods on any of the bases indicated above, the opposition to the goods in this class fails and is dismissed accordingly.

Class 21

49. The opponents’ specification in this class includes the term “toothbrushes”, which is identical to the same term in the applicant’s specification and broad enough to include all of the applicant’s toothbrushes whether electric or manual; the competing goods are either literally identical or to be regarded as identical on the *Meric* principle.

The average consumer and the nature of the purchasing act

50. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods I have found to be identical or similar. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

51. The average consumer of the goods at issue is a member of the general public. As such goods are most likely to be selected from the shelves of a brick and mortar retail outlet on the high street or from the pages of a catalogue or website, visual considerations are, in my view, likely to dominate the selection process, but not to the extent that aural consideration (perhaps in the form of word-of-mouth recommendations or requests to sales assistants) should be ignored. As the goods at issue are, for the most part, likely to be relatively inexpensive, I would expect the average consumer to pay a normal degree of attention to their selection.

Comparison of trade marks

52. 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.”

53. 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:

Opponents' trade mark	Applicant's trade mark
	Go-Kidz

54. As I mentioned earlier, the opponents' trade mark consists of the well-known word “Go” presented in a bold, slightly stylised font, in a device of a square. Although the

device component is not negligible and will contribute to the overall impression conveyed, it has very little, if any, distinctive character. Rather, it is the word “Go” that dominates the overall impression the opponents’ trade mark conveys and it is in this component that the vast majority of any distinctiveness the trade mark enjoys lies.

55. The applicant’s trade mark consists of the words “Go” and “Kidz” presented in title case joined by a hyphen. Whether the hyphen goes unnoticed or not, it is the words that will dominate the overall impression the trade mark conveys. The word “Go” appears as the first word in the applicant’s trade mark. As to the word “Kidz”, I do not agree with the applicant’s submission to the effect that the inclusion of the letter “z” at the end of the word “Kid” makes the totality unusual. Rather, I am satisfied that the average consumer will be well used to seeing what would normally be a letter “s” being replaced by a letter “z”.

56. As the word “Kidz” will, in my view, be construed by the average consumer as a simple misspelling of the word “Kids” (i.e. the group for whom the applicant’s goods are intended), any distinctiveness it may possess is at best very low. It is possible that the combination of the words “Go” and “Kidz” may create a unit in the average consumer’s mind, for example, when one requests a group of children to move (in which case the word “Go” would not play an independent distinctive role and the overall impression the trade mark conveys and its distinctiveness would reside in the unit created). However, as the word “Kidz” is freighted with descriptive connotations, it is, in my view, equally likely that, irrespective of the hyphen, it is the word “Go” that will have a higher relative weight in the overall impression the trade mark conveys and it is in that word the overwhelming majority of the trade mark’s distinctiveness would lie.

The visual, aural and conceptual comparison

57. Although the device component in the opponents’ trade mark and the word “Kidz” in the applicant’s trade mark are not negligible and will contribute to the overall

impressions conveyed, the fact that they have very little, if any, distinctive character will inevitably impact upon their significance in the visual comparison. Considered on that basis, as both trade marks contain the word “Go”, it results in what I regard as a medium degree of visual similarity between them.

58. It is well established that when a trade mark consists of a combination of words and figurative components, it is by the word components that the trade mark is most likely to be referred. As the device component in the opponents’ trade mark is unlikely to be articulated, it will be referred to by the one syllable word “Go”. The first word in the applicant’s trade mark will be pronounced in an identical fashion and, in my view, the word “Kidz” will be pronounced identically to the one syllable word “Kids”, resulting in a medium degree of aural similarity between the competing trade marks.

59. Finally, the conceptual comparison. In its submissions, the applicant states:

“4.6.5...the word “GO” is a verb which can be used in a plethora of manners. The term “GO” in the opponent’s registration is used in the abstract in so far as it is not qualified or given further meaning by the addition of another word. The applicant’s “GO” mark is succeeded by the noun “KIDZ”, providing it with a meaning that is not abstract...”

60. I agree with the applicant that the word “Go” has a number of meanings. However a number of these meanings relate to, for example, moving or travelling or leaving the place where you are (collinsdictionary.com refers). Although the word “Kidz” in the applicant’s trade mark introduces a concept alien to the opponents’ trade mark, the fact that both trade marks are likely to evoke in the average consumer’s mind the concept of, broadly speaking, moving, results in the competing trade marks being conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

61. 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.

62. In their Notice of opposition, the opponents claims that they have:

“11...extensively used the earlier trade marks in the United Kingdom in respect of the goods relied upon...and, as a result, the earlier trade marks have acquired a higher degree of distinctiveness (enhanced distinctiveness) at the time of filing the applicant’s trade mark...”

63. The applicant denies that is the case stating, inter alia:

“4.9...it can only be assumed that any registration whatsoever was achieved through evidence of acquired distinctiveness. To state that it has anything beyond the minimal distinctiveness required for registration is preposterous, let alone having acquired a high enough level of distinctiveness...and hence a broader protection of the mark...”

64. Evidence of the opponents’ annual sales figures is provided as confidential exhibit GR3. The annual sales figures, provided in a separate table in the exhibit, are significant. However, although it appears that on 4 April 2018 this exhibit, inter alia, was,

at the Tribunal's request, provided on a USB stick, in an official letter dated 27 April 2018, the Tribunal stated:

"It is noted that exhibit GR3 is not able to be admitted into the proceedings as it not legible, please provide a clear copy."

65. In an email dated 11 May 2018, the opponents' agents referred again to the exhibit being provided on a USB stick. In an official letter dated 5 June 2018, the Tribunal admitted the exhibit into the proceedings, presumably on the basis that the information provided on it was as good a quality/format as the opponents' agents could achieve. However, whether viewed on screen or in hard-copy, I am unable to establish the sales figures for the individual categories of goods being relied upon. In those circumstances (and irrespective of the trade marks that may have been used), I am simply not in a position to judge whether the quantum of sales of the goods being relied upon are sufficient for the opponents' trade mark to have acquired an enhanced distinctive character by virtue of the use that has been made of it.

66. Proceeding on that basis, when considered as a totality in relation to the goods being relied upon, the opponents' trade mark is, in my view, possessed of a fairly low degree of inherent distinctive character. It is, of course, the distinctive character of the word in common i.e. "Go" that is crucial, a point I shall return to shortly.

Likelihood of confusion

67. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' 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, 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.

68. 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 down to the responsible undertakings being the same or related.

69. Earlier in this decision I concluded:

- earlier trade mark no. 3016419 offered the opponents the best prospect of success and it was on the basis of this trade mark I would initially conduct the comparison;
- the applicant's goods in class 3 are similar to goods in the opponents' specifications in classes 5 and 21 to an above medium degree;
- the applicant's goods in classes 5 and 21 are either literally identical or identical on the *Meric* principle to goods in the opponents' specification in the corresponding class;
- the average consumer of the goods at issue is a member of the general public;
- while such a consumer will select the goods at issue by predominantly visual means, aural considerations must not be ignored;

- the average consumer will pay a normal degree of attention to the selection of the goods;
- the word “Go” will dominate the overall impression the opponents’ trade mark conveys and in that word lies the vast majority of any distinctiveness the trade mark possesses;
- the words “Go” and “Kidz” will dominate the overall impression the applicant’s trade mark conveys. While that combination may create a unit, the distinctiveness lying in the totality created, it is equally likely the word “Kidz” will be construed as indicating the group for whom the applicant’s goods are intended, resulting in the distinctiveness being weighted heavily in favour of the word “Go”;
- the competing trade marks are visually, aurally and conceptually similar to a medium degree;
- given the format in which the opponents’ evidence has been filed, I am not in a position to judge whether, in relation to the goods being relied upon in classes 5 and 21, its trade mark enjoys an enhanced reputation;
- considered as a totality, the opponents’ trade mark is possessed of a fairly low degree of inherent distinctive character.

70. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of “distinctive character” is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the trade marks that are identical or similar. He stated:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use,

the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

71. In other words, simply considering the level of distinctive character possessed by the earlier trade mark is not enough. It is important to ask “in what does the distinctive character of the earlier trade mark lie?” Only after that has been done can a proper assessment of the likelihood of confusion be carried out. I have already concluded that (i) the device component present in the opponents’ trade mark has very little if any distinctive character, and (ii) considered as a whole, the trade mark has a fairly low degree of inherent distinctive character. However, whatever distinctiveness the earlier trade mark possesses, stems, in my view, primarily from the presence in it of the stylised word “Go”.

72. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson* and stated:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

73. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU held:

“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.”

74. Although the opponents’ trade mark (when considered both as a whole and in relation to the word “Go” within it) enjoys only a very weak inherent distinctive character, as the above case makes clear, that does not preclude a likelihood of confusion. That is particularly the case where, as here, the only other component in the applicant’s trade mark, i.e. the word “Kidz” is, in my view, even less distinctive than the component in common, i.e. the word “Go.”

75. While I accepted above that it is possible the words in the applicant’s trade mark will create a unit in which the word “Go” does not play an independent distinctive role, I also concluded that is equally likely that the average consumer will not consider the applicant’s trade mark to create a unit and will simply interpret the word “Kidz” as indicating the group for whom the applicant’s goods are intended.

76. Considered on that basis and assuming the opponents’ trade mark does not benefit from an enhanced distinctive character in relation to the goods being relied upon, I think that even in relation to the goods in class 3 which I have assessed as being similar to only an above medium degree, an average consumer paying a normal degree of attention during the selection process (but who will still be prone to the effects of imperfect recollection) is, given the descriptive message that is likely to be conveyed by

the word “Kidz”, likely to mistake one trade mark for the other, i.e. there will be direct confusion. The opponents’ position might, of course, have been stronger had I been able to assess its claim to enhanced distinctive character in relation to the goods upon which it relies.

77. If I am considered to be wrong in relation to a likelihood of direct confusion, I will now go on and consider the likelihood of indirect confusion. 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:

“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.”

78. 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 mark. This is mere association not indirect confusion.

79. If the average consumer notices the differences between the competing trade marks resulting in no direct confusion, I still think there is likely to be indirect confusion. In this regard, the average consumer is, in my view, more likely than not to simply assume that the applicant's trade mark is a variant of the opponents' "Go" trade mark, but in which the opponents have elected to indicate those for whom its goods are intended, i.e. children.

Conclusion under section 5(2)(b)

80. The opposition based upon section 5(2)(b) of the Act succeeds in relation to all of the goods in classes 3, 5 and 21. As the other trade mark upon which the opponents rely puts them in no better position, I need say no more about it.

Section 5(4)(a) – passing off

81. I need only consider this ground to the extent that the opponents have not already succeeded i.e. in relation to the goods in class 10 i.e. "Baby teething rings; Teething rings for relieving teething pain; Teething soothers; Teething rings; Rings (Teething -); Baby dummies; Dummies for babies; Pacifiers [babies dummies]."

82. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "*a substantial number*" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

83. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He stated:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'"

84. There is no evidence that the applicant's trade mark was in use prior to the date of application. That being the case, the relevant date is 6 July 2017. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing

which distinguishes an old-established business from a new business at its first start”.

85. The evidence shows that the opponents have conducted a business under the unregistered trade mark shown in paragraph 4 since 2012, and that such use has been in relation to a range of goods introduced gradually during this period, shown in paragraph 17. In addition, between 2012 and the date of the application, the opponents attended a number of trade shows in the United Kingdom to promote the business conducted under the unregistered trade mark and the unregistered trade mark has, I note, appeared in a range of online publications and magazines. Annual sales of goods in the United Kingdom between 2012 and 2017 achieved by the opponents’ business under the unregistered trade mark are provided in confidential exhibit GR12; the sales in this period are not trivial (*Hart v Relentless Records* [2002] EWHC 1984 (Ch) and *Stacey v 2020 Communications* [1991] FSR 49 refer).

86. Considered as a totality, I am satisfied that the opponents’ evidence demonstrates that by the date of the application for registration in July 2017, the opponents had a protectable goodwill in a business conducted under the unregistered trade mark relied upon in relation to the goods shown in paragraph 17. While none of the goods upon which the unregistered trade mark have been used are identical to the applicant’s goods in class 10, the absence of a common field of activity is not fatal; neither, of course, it is irrelevant (*Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA) refers).

87. Insofar as the applicant’s trade mark and the unregistered trade mark is concerned, both contain, inter alia, the word “Go” and the word “kids”/“Kidz”. The unregistered trade mark also contains an unremarkable device in the nature of a border, a device of a square presented in the colours black and white and the word “TRAVEL”. However, as the border and device of a square are, in my view, likely

to be construed by the relevant public as largely decorative/non-distinctive and the words “TRAVEL” and “kids” as descriptive, it is the word “Go” that the relevant public is, in my view, most likely to identify as the primary indicator of origin in both parties’ trade marks. Considered on that basis, the competing trade marks are, in my view, very likely to be recalled by a substantial number of the relevant public as children’s products from “Go”, they are, as a consequence, similar overall to a fairly high degree.

88. As I mentioned above, the applicant’s goods are not identical to those upon which the business conducted under the unregistered trade mark has been used. However, the unregistered trade mark has been used upon a fairly wide range of travel related goods for children. In my view, a substantial number of the relevant public familiar with the opponents’ unregistered trade mark and the goods sold under it, are likely to think that the applicant’s teething rings, soothers, dummies and pacifiers are an extension of the opponents’ existing suite of travel related goods for children. That assumption on the part of the relevant public is, in my view, likely to result in damage to the opponents’ business by, for example, preventing it from extending its existing trade or by the injurious association referred to in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA).

Conclusion under section 5(4)(a)

89. The opposition based upon section 5(4)(a) of the Act succeeds in relation to all of the goods in class 10.

Overall conclusion

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

Costs

91. As the opponents have been successful, they are entitled to a contribution towards their costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the guidance in that TPN, I award costs to the opponents on the following basis:

Preparing the Notice of Opposition and reviewing the counterstatement:	£300
Preparing evidence:	£500
Written submissions:	£200
Official fee:	£200
Total:	£1200

92. I order Dominique Tillen to pay Design Go Limited & DG Capital Limited (jointly) the sum of **£1200**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of November 2018

C J BOWEN
For the Registrar