

O-511-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2581565  
BY THORNTON & ROSS LIMITED TO REGISTER THE FOLLOWING TRADE  
MARK IN CLASSES 3 & 5:**



**AND**

**OPPOSITION THERETO (NO 102474) BY STRELLSON AG**

## The background and the pleadings

1) Application 2581565 was filed by Thornton & Ross Limited (“Thornton”) on 17 May 2011 and it was published in the Trade Marks Journal on 8 July 2011. The mark and the goods for which registration is sought are:

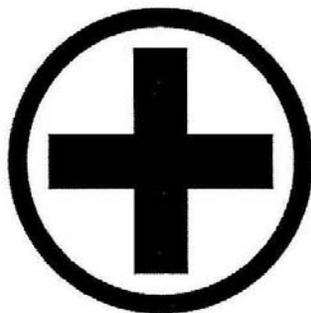


**Class 03:** Preparations for care of the skin; cosmetics; toilet preparations; after-sun preparations; preparations for sun protection; hair lotions; shampoos; hair care preparations; foot care preparations; dentifrices; mouthwashes; essential oils; soaps; cleaning preparations; bleaching preparations and other substances for laundry use; polishing, scouring and abrasive preparations

**Class 05:** Pharmaceutical preparations and substances; veterinary preparations; sanitary preparations for medical purposes; medicated skin care preparations; medicated preparations for application to the skin after exposure to the sun and for use in the treatment of sunburn; sun protection preparations for medical purposes; medicated hair care preparations; medicated foot care preparations; medicated mouthwashes; materials for dressings; preparations for aiding removal of head lice in hair; insecticidal preparations for hygiene purposes; disinfectants; fungicides

2) Strellson AG (“Strellson”) opposes the registration of Thornton’s mark. Its opposition was filed on 4 October 2011 and is based on a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). A single earlier mark is relied on as set out below:

International registration 837400 which designated the EU for protection on 5 October 2004 with protection being conferred on 31 January 2008 for the mark:



which is protected in respect of:

**Class 3:** Perfumes, cosmetics

**Class 9:** Spectacles, sunglasses

**Class 14:** Jewellery, timepieces

**Class 25:** Clothing, footwear, headgear

3) Strellson relies only on its class 3 goods, but opposes all of the goods Thornton seeks to register. Given the respective filing dates, Strellson's mark constitutes an earlier mark as defined by section 6 of the Act. Furthermore, given the date on which the earlier mark had its protection conferred, it is not subject to the proof of use provisions set out in section 6A of the Act; there is no dispute about this.

4) Thornton filed a counterstatement denying the grounds of opposition. It makes various points in its defence including highlighting:

- The differences between the marks;
- That Strellson's mark is a "Swiss" cross associated with its nationality whereas the cross in its mark reflects medical/pharmaceutical goods;
- That Thornton has used its mark since 2006;
- That Thornton's core activity does not conflict with cosmetics nor are they "beauty" products.

5) Both sides filed evidence. Strellson also filed written submissions (which will be borne in mind but not summarised in my review of the evidence). The matter then came to be heard before me on 15 November 2012 at which Thornton was represented by Ms Jane Lambert, of counsel, instructed by LJ Bray & Co; Strellson was represented by Mr Mark Foreman of Rouse & Co.

### **Thornton's evidence**

#### *Witness statement of Mr Neville Edwards*

6) Mr Edwards is the International Sales Director of Thornton. He explains that Thornton is a family owned business founded in 1922 that makes and sells healthcare, disinfectant and household products. It employs some 453 people at its site near Huddersfield. Mr Edwards states that it is the largest independent pharmaceutical manufacturer in the UK and specialises in over the counter medicines ("OTCs") and related goods. At Exhibit NGE1 is a graph showing Thornton as the 5<sup>th</sup> largest OTC company in the UK in 2010 with sales of over £40 million; for context, the top 3 companies have sales of over £160 million.

Thornton has over 200 medicine licences in the UK and Ireland mainly for OTC medicines.

7) Exhibit NGE2 contains an A-Z list of Thornton's goods (excluding those in what are described as the "care" category). A large number are detailed; Mr Edwards states that most are OTC products. Details of promotional expenditure in relation to all the goods it has sold is provided which ranges between £3million and £5 million over the last 7 years. In terms of this promotion, Mr Edwards states that this is in the form of TV advertising, advertising in trade publications (they appear to be pharmacy trade publications), advertisements and sponsored articles in magazines (these appear to be more general interest magazines), advertisements in national newspapers, online advertising on websites (such as netdoctor, mumsnet, babyworld, patientUK and madeformums) and point of sale materials.

8) Mr Edwards states that the mark in its present form was first used on its care range of goods in 2006, such a range being of OTC goods for health and body care, most being medicines and medical devices which are regulated by The Medicines and Healthcare products Regulatory Agency ("MHRA"). The remainder of the goods are "cosmetic" or "unlicensed".

9) Mr Edwards discusses at some length the various changes that have been made to Thornton's logos (including its corporate logo and the logo used on the care range of goods) between 1991 and 2006. For reasons that will become apparent, I do not consider it necessary to summarise this evidence in detail. It is suffice to say that the various logos have in one form or another featured a white cross on a blue background or vice versa. Mr Edwards believes that through such changes, the cross device has become more intrinsic to Thornton's branding. I should add that in some of the representations provided by Mr Edwards, the uses he sets forth feature other brand names very prominently, with the cross logo (whichever version is being used) having less significance.

*Witness statement of Leanne Doughty*

10) Ms Doughty is the Care Senior Brand Manager of Thornton. As her title suggests, Ms Doughty provides evidence about Thornton's "care" range of goods. She says that the mark was first used on its care range of goods in early 2006. Exhibit LD1 contains an A-Z of such goods. She states that the goods comprise OTC medicines and related goods for health and body care, most of which are medicines and medical devices regulated by the MHRA. The remainder are unlicensed or cosmetics.

11) The mark is used on Thornton's websites, a large list of which is provided in Exhibit LD3. Some feature, it is stated, the care logo (akin to the mark the subject of this dispute, albeit with the word CARE to the left of the cross), others feature Thornton's corporate logo.

12) Exhibit LD4 contains sales figures for the care range. The sales range between £5 and £7 million in the UK for the last 7 years. The goods are sold throughout the UK with unit sales of around 12 million. The goods are also exported. Sales in the UK are through pharmacies including Boots, Lloyds and Superdrug, and, also, independent and major supermarkets. There are also some online sellers.

13) Promotional expenditure has ranged between £262,000 and £350,000 per annum during the last 7 years. Similar publications to those mentioned by Mr Edwards are referred to in terms of this promotion. Exhibit LD5 contains various promotional materials featuring the mark. There are no examples of the mark without the word CARE included.

### **Strellson's evidence**

#### *Witness statement of Mark Foreman*

14) Mr Foreman works for Rouse & Co, Strellson's representatives in this matter. His evidence is in reply to that of Mr Edwards and Ms Doughty. It is, essentially, by way of critique. The main purpose of Mr Foreman's evidence is to highlight that the mark at issue in these proceedings is not the mark which forms part of the materials submitted by Thornton's witnesses. As I have stated above, I found no use of the mark on its own, therefore, it is not necessary to detail Mr Foreman's evidence further. Whether Thornton's evidence is irrelevant (as Mr Foreman states) will be considered later in this decision.

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

15) Section 5(2)(b) of the Act reads:

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

(a) .....

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

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

16) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas*

*Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (BL O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **The notional assessment**

17) At the hearing, Ms Lambert argued that a contextualized approach should be adopted, which she said had to bear in mind the width of Strellson's specification. She argued that the position was indicative of a fashion house selling perfumes etc (slipped into her skeleton argument was a copy of Strellson's website to demonstrate its primary fashion orientated business) which she contrasted with Thornton selling health care orientated products and related ranges.

18) The above approach is not the correct one. Strellson have a protected trade mark in respect of various goods. Its mark is not subject to proof of use nor should current marketing strategies be counted against it; such marketing strategies may, in any event, change with time. The matter must be assessed on a notional basis comparing the marks in question with the respective goods for which they are protected/applied. The fact that Strellson's mark has been registered for other goods is not relevant in the notional assessment I must undertake. The arguments made by Ms Lambert in this respect are, therefore, rejected.

### **The relevance of Thornton's evidence**

19) The main thrust of Ms Lambert's arguments in relation to Thornton's evidence appeared to be a confusion free parallel trade argument. The prior use Thornton had made was also referred to as providing some basis for rejecting the opposition. Setting aside, for the time being, Mr Foreman's critique of the evidence, Ms Lambert's arguments appear to be flawed. For the trade of the parties to be instructive on whether there exists a likelihood of confusion or not, there must be clear parallel trade that provides an opportunity for confusion to have arisen. However, there is no evidence before the tribunal as to Strellson's trade so there is nothing whatsoever that can be read into an absence of confusion. That is even before coming to the normal caution that needs to be exercised when dealing with this type of argument because the absence of confusion is rarely significant due to extraneous factors relating to the actual trade of the parties<sup>1</sup>.

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<sup>1</sup> As expressed by Millet J in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283

20) In terms of the simple fact that Thornton may have prior user is likewise not relevant. Strellson has an earlier trade mark. The question is simply whether there exists a likelihood of confusion. If the prior user was relevant then Thornton could have opposed the earlier mark or taken cancellation proceedings against it (similar points were highlighted by Ms Anna Carboni (sitting as the Appointed Person), in *Muddies* (BL O-211-09)). In any event, I also agree with Mr Foreman's assessment of the evidence in that the lack of use of the mark put forward for registration (as opposed to variants of it) would also have been a telling factor. All things considered, I can see nothing in Thornton's evidence that has a material impact on the matters before the tribunal.

### **The average consumer**

21) The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

22) In terms of the class 3 goods, they are, in the main, cosmetic products or other products for personal use; there are some exceptions to this that I will come to later. The average consumer will be a member of the general public and, although the cost of the goods can vary, they are not, generally speaking, expensive items and will be selected with no more than an average level of care and consideration. The goods in class 5, on the other hand, contain goods which are medicated. The impact of this is that the level of care and attention used in their selection is likely to be higher and, furthermore, the average consumer may be a member of the general public or a health care professional.

### **Comparison of goods**

23) When making the comparison, all relevant factors relating to the goods in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU 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."

24) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

25) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* it was stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

26) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>2</sup> and that I must also bear in mind that

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<sup>2</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>.

27) As a starting point, it is worth considering what goods are covered by the earlier mark. In terms of perfume, such a term is self-explanatory. In terms of cosmetics, the question arises as to the breadth of such an expression. “Cosmetics” is defined in the Collins English Dictionary as:

“Any preparation applied to the body, esp. the face, with the intention of beautifying it.”

28) A cosmetic is, therefore, a preparation, the purpose of which is to beautify the face or body. Whilst cosmetics such as lipstick, mascara and eye shadow may be the first and most obvious type of goods that come to mind if one were asked to consider the type of goods that fall within this category, I do not consider that this is all the term covers. For example, preparations (such as creams and lotions) whose intended effects are to reduce wrinkles would be classified as a cosmetic given that it aims to have a cosmetic impact on the appearance of the user. A further example can be seen when Mr Justice Neuberger in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* held, on the facts of the case before him, that a dry skin lotion was a cosmetic.

29) I will begin by assessing the goods applied for in class 3, comparing them to the cosmetics and/or perfumes as protected under the earlier mark:

#### Preparations for care of the skin

30) Given what I believe the term cosmetics to cover, I consider that these goods fall within the ambit of the cosmetics protected by the earlier mark. **The goods are identical, or if I am wrong on that then they must be highly similar.**

#### Cosmetics

31) Strellson’s specification covers cosmetics at large. The goods are identical. Even if Thronton limited its cosmetics in some way, this would not assist because whatever they limit to would fall within the generality of Strellson’s unlimited term. **The goods are identical.**

#### Toilet preparations

32) Toilet preparations would include toilet waters which are a form of perfume, as in eau de toilette, so the goods are identical. Toilet preparations would also

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<sup>3</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

include a variety of cosmetic preparations which must be identical to the cosmetics of the earlier mark. **The goods are identical.**

After-sun preparations; preparations for sun protection

33) An after-sun preparation will be in the form of a lotion or a cream. It will moisturise the skin so as to prevent it from drying out – although not a cosmetic per se, it is very similar in nature and methods of use and has a similarity of purpose. The channels of trade will not be exactly the same but they are likely to be sold in fairly close proximity. **I consider after-sun preparations to be reasonably high in similarity to cosmetics.** In terms of preparations for sun protection, it is possible for lotions and even moisturisers (both of which would be covered by cosmetics) to incorporate UV protective ingredients. Again, there may be similarity in purpose, methods of use and have a similar (although not identical) channel of trade. Cosmetics would also cover fake tanning lotions and, as such, there is also similarity here. **I consider preparations for sun protection to have a reasonably high degree of similarity to cosmetics.**

Hair lotions; shampoos; hair care preparations

34) Mr Foreman appeared to accept that such goods were not cosmetics per se but he argued they were nevertheless highly similar. I agree they are not cosmetics and, thus are not identical. In terms of similarity, the nature may be similar (to, for example, skin care lotions which are a form of cosmetic), but their intended purposes have only a loose degree of similarity in terms of being part of a person's personal care regime. The methods of use are different. The channels of trade have only a low level similarity, the goods are unlikely to be found in particularly close proximity. The goods are not competitive nor are they complementary in the sense described by the case-law. **I consider the goods to be similar but only to a moderate degree.**

Foot care preparations

35) Such goods could be in the nature of creams and lotions for application to the feet. They would thus be extremely similar to cosmetics such as skin care creams in terms of purpose and nature. The channels of trade are likely to be similar and may be found in reasonably close proximity. It may be that cosmetics such as skin care creams and lotions could also be used on the foot without a foot specialism being required, thus, there may well be a competitive relationship. **I consider there to be a reasonably high degree of similarity with cosmetics.**

Dentifrices; mouthwashes

36) Such goods are for a quite different purpose although, like certain cosmetics, they may form part of a person's morning personal care routine. The nature

though is different as is the method of use. Any similarity in trade channels is likely to be on a fairly loose footing. The goods are not competitive nor are they complementary in the sense described by the case-law. Mr Foreman identified that that such goods often perform a quasi cosmetic purpose as teeth whitening is nowadays an important aspect that users require. Whilst noted, when the inherent differences I have identified are factored in, I consider that **the goods are not similar, or if I am wrong on that then any similarity is only low.**

### Essential oils

37) According to the Collins English Dictionary, essential oils are products used for perfuming (as well as for flavouring); Strellson's closest goods will, therefore, be perfumes. Essential oils consist of a concentrated extract of a particular plant. There is, however, nothing in the evidence to inform me as to how and for what purpose they are sold to the general public as opposed to being sold to perfumery manufacturers. It may be possible that they can be purchased and then added to substances in the home to take advantage of their perfuming characteristics. For example, as aromatherapy products used to create massage oils, to add to bath water or to perfume the air. It seems unlikely, however, that an essential oil will be applied to the skin directly in the same way that a perfume may. There may be a similarity in nature in terms that they are perfumed liquids, however, the methods of use, primary purpose (although both may perfume) are not particularly similar. I doubt that the channels of trade are particularly similar, there is no evidence to offset my doubt. It does not strike me that the respective goods will be competitive in the sense that one would choose an essential oil as an alternative to perfume (or vice versa). Nor do I see that they are complementary in the sense described by the case-law. Overall, any aspects of similarity are not highly significant, however, as both perform, to some extent, a perfuming function, I would not go so far as to say that there is no similarity. **I consider the goods to be similar but only to a moderate degree.**

### Soaps; cleaning preparations

38) Soaps and cleaning preparations can be considered together. They both have a primary purpose of cleaning/washing the face/body. This is more of a rudimentary human routine than a true cosmetic purpose to beautify oneself. The nature of soap and other cleaning preparations will often be in bar form or it could be in liquid form (such as liquid soap). Some cosmetics (such as lotions) are also liquid in nature so there is some similarity. The methods of use are similar in that they are applied to the body/face, but the exact methods of use differ due, for example, to the use of soap with water. The goods would not ordinarily compete and I do not regard the goods to be complementary in the sense described by the case-law. **I consider the goods to be similar but only to a moderate degree.**

### Bleaching preparations and other substances for laundry use

39) The reference to “other substances for laundry use” is indicative that the bleaching preparation is also for laundry use rather than personal use. One would hardly use a bleaching preparation for laundry use on one’s person (such as the hair). Whilst there may be a similarity in nature (possibly in liquid form with bleaching properties) there are key differences in terms of purpose, methods of use, channels of trade. The goods do not compete nor are they complementary. **I conclude that the goods are not similar to cosmetics (or perfumes).**

### Polishing, scouring and abrasive preparations

40) These goods are not positively defined as to whether they are for personal use or domestic use. However, the very construction of the term is indicative of something used in the home as opposed to the body. Whilst there is such as product as nail polish, I doubt whether this is something that would ordinarily be described as a polishing preparation. Nail polish is simply something that is painted on to ones nails. Similarly, whilst it is possible for certain cosmetics to have an exfoliating function, I doubt whether these would be described as scouring and abrasive preparations; there is no evidence to offset this doubt. **I conclude that these terms do not include goods for personal use and, thus, are not similar to cosmetics (or perfume).**

41) I now turn to consider the goods applied for in class 5, but begin with certain goods which Mr Foreman accepted were not similar, namely:

Pharmaceutical preparations and substances; veterinary preparations;  
sanitary preparations for medical purposes; materials for dressings;  
insecticidal preparations for hygiene purposes; disinfectants

**42) On the basis of this concession, the above goods are not similar to cosmetics and/or perfume.**

### Medicated skin care preparations

43) I found non-medicated skin care preparations to be identical to cosmetics (or if not identical highly similar). Although the purpose is different between medicated and non-medicated, it is possible for the medicated versions to also provide a cosmetic function. I consider the medicated factor to reduce the degree of similarity, **but there is still similarity on a reasonable level.**

Medicated preparations for application to the skin after exposure to the sun and for use in the treatment of sunburn; sun protection preparations for medical purposes

44) I found a reasonable degree of similarity between the non-medicated versions of the above goods and cosmetics. However, given that these goods are for medicinal purpose to be used by people with a medical condition or other ailment (such as sun burn requiring medical treatment) then in comparison to cosmetics, the purpose is a step removed as are the likely trade channels. **I consider that this reduces any level of similarity to a low-moderate degree.**

Medicated hair care preparations

45) I have already found that non-medicated hair care preparations are similar to only a moderate degree. There are starker differences here. Being medicated, the goods have an even more distinct purpose to treat some medical problem. This also introduces and even greater distance in terms of channels of trade. **I conclude that these goods are not similar to cosmetics and/or perfumes, or if I am wrong on that then the degree of similarity is only low.**

Medicated foot care preparations

46) No evidence has been provided as to what a medicated foot preparation is. Although I found a reasonably high degree of similarity with the non-medicated versions of these goods with cosmetics, I think the medicated versions must be regarded as quite different, being clearly intended to cure or treat some foot related problem. This creates a much starker difference in purpose and channels of trade and removes any possible competitive relationship. **I consider the degree of similarity to be low-moderate.**

Medicated mouthwashes

47) I have already found that non-medicated mouthwashes are not similar to cosmetics, or that if this is wrong then the goods have only a low degree of similarity. The difference here is even starker. Being medicated, the goods have an even more distinct purpose to treat some medical problem. This also introduces and even greater distance in terms of channels of trade. **I conclude that these goods are not similar to cosmetics and/or perfumes.**

Preparations for aiding removal of head lice in hair

48) Such goods perform a specific medical function quite different from a product such as a cosmetic. Whilst I have found a moderate degree of similarity between normal shampoos and cosmetics, these goods are a further step away. The channels of trade are likewise distant. **I conclude that these goods are not similar to cosmetics and/or perfumes.**

## Fungicides

49) Fungicides would cover fungicidal creams and ointments etc for human use. Despite Mr Foreman suggesting that there was some similarity with cosmetics, it is difficult to see where this lies on any practical front. The purposes are different. The methods of use will differ, the trade channels will differ. The goods are not competitive nor are they complementary in the sense described by the case-law. **I conclude that these goods are not similar to cosmetics and/or perfumes.**

### **The distinctiveness of the earlier mark**

50) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). No use of the earlier mark has been filed so I have only its inherent characteristics to consider. In her submissions, Ms Lambert referred to a cross as being a simple geometric symbol which has been used by many organizations for hundreds of years; she referred also to the use of crosses (particularly green crosses) in the world of medicine and, also, that Strellson are a Swiss company and that a cross (particularly using the colours red and white) is relevant to such a nationality. Mr Foreman reminded me that the earlier mark is registered and had a presumption of validity. Notwithstanding Ms Lambert's comments, he argued that the mark had an average level of distinctiveness.

51) Mr Foreman is quite right in his view that the earlier mark must be regarded as valid. This was confirmed by the CJEU in Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*. Nevertheless, the degree of distinctive character a mark possesses may be low, moderate, average or high, or various shades between. I come to a view somewhere between the two side's arguments. The earlier mark is a simple geometric shape of unremarkable characteristics. I consider that such a mark has at best a moderate degree of distinctiveness.

### **Comparison of the marks**

52) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:



v



53) The dominant and distinctive element of Strellson's mark is the cross in a circle; the cross itself is the element of most importance. In terms of Thornton's mark, I consider the circle in a cross to be that mark's dominant and distinctive element also. Whilst the lozenge/cartouche is not negligible as it contributes to the overall presentation of the mark, it is still, at the end of the day, little more than a boarder.

54) From a visual perspective, the sharing of what I regard as a very similar dominant and distinctive element creates an inevitable degree of visual similarity. Although Ms Lambert identified some differences in the crosses, her assessment was too detailed a one. Many of the differences she identified were unlikely to be noted by an average consumer other than by way of a forensic side by side analysis. Obviously, the lozenge/cartouche needs to be borne in mind and, furthermore, I bear in mind the raised profile of Thornton's mark as opposed to the flat look of Strellson's mark (although I do not consider that this latter point should be overplayed). In my view, this still equates to the marks being similar to a reasonable degree. It should be noted that I have made no reference to colour in this assessment. This is because the earlier mark is not protected with regard to colour and, thus, colour should not count as a distinguishing feature<sup>4</sup>.

55) From an aural perspective, I agree with Mr Foreman that **if** the marks were to be articulated, it is the cross aspect that would form the primary part of such an articulation, although, it is difficult to be certain of the exact articulation that will be made in each case. However, in my view the marks themselves are unlikely to be articulated often by the average consumer given its highly visual as opposed to verbal nature – in view of this, I do not consider that aural similarity has any significant role to play in whether there exists a likelihood of confusion.

56) In terms of concept, the primary concept of both marks, and the one likely to form a conceptual hook, is that of a cross. Overall, this all equates to marks that are reasonably similar to each other.

### **Likelihood of confusion**

57) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

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<sup>4</sup> See to that effect *Mary Quant Cosmetics Japan Ltd v. Able C&C Co Ltd*, O-246-08 and, also, the judgment of Mr Justice Mann in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch).

58) As a starting point, the following goods were either conceded as not being similar or I have found them not to be similar:

Class 3: Bleaching preparations and other substances for laundry use; polishing, scouring and abrasive preparations.

Class 5: Pharmaceutical preparations and substances; veterinary preparations; sanitary preparations for medical purposes; materials for dressings; insecticidal preparations for hygiene purposes; disinfectants; medicated mouthwashes; preparations for aiding removal of head lice in hair; fungicides.

**If the goods are not similar then there can be no finding of a likelihood of confusion<sup>5</sup>. The opposition in relation to the above goods must therefore fail.**

59) In terms of the other goods, I must bear in mind the interdependency of the various factors. For this reason, I will begin by considering the applied for goods which I found to be identical (or if not identical then highly similar); if Strellson cannot succeed here then it is unlikely to be in any better position with regards to the goods which are less similar.

*Conclusion in relation to: cosmetics, toilet preparations, skin care preparations (class 3)*

60) Here the goods are identical or at the very least highly similar. I have found the marks to be reasonably similar and the earlier mark to have a moderate degree of distinctiveness. Both sets of goods are non-medicated so the point regarding crosses being used in medical fields is not overly significant. The average consumer will pay a reasonable degree of care and consideration, but no higher than the norm. Bearing all the relevant factors in mind, including the concept of imperfect recollection, **I consider that there is a likelihood of confusion. The opposition succeeds in relation to these goods.**

*Conclusion in relation to: After-sun preparations; preparations for sun protection; foot care preparations (class 3)*

61) I have found that these goods are similar to a reasonably high degree. This level of goods similarity is sufficient, when all the other factors are considered, for there to be a likelihood of confusion. **The opposition succeeds in relation to these goods.**

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<sup>5</sup> See, for example, the CJEU's judgment in *Waterford Wedgwood plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-398/07*.

Conclusion in relation to: Medicated skin care preparations (class 5)

62) Notwithstanding that the goods sought are medicated, and, therefore, that the medical message in Thornton's cross device may be perceived, I still consider that the degree of similarity, when all the other factors are considered (including imperfect recollection), for there to be a likelihood of confusion. **The opposition succeeds in relation to these goods.**

Conclusion in relation to: Class 3 - Hair lotions; shampoos; hair care preparations; essential oils; soaps; cleaning preparations (class 3).

63) I found these goods to possess only a moderate degree of similarity to cosmetics. Making the necessary multi-factorial assessment, **I come to the view that there is no likelihood of confusion. The opposition fails in relation to these goods.**

Conclusion in relation to: Medicated foot care preparations; medicated preparations for application to the skin after exposure to the sun and for use in the treatment of sunburn; sun protection preparations for medical purposes (class 5)

64) In relation to the above goods, the degree of similarity with the goods of the earlier mark is low-moderate. Also, although this was not enough to avoid a likelihood of confusion in relation to medicated skin care preparations, the medical message of Thornton's earlier mark is a factor working against a finding of likelihood of confusion. These factors, combined with all the others, means that **there is not a likelihood of confusion in relation to these goods. The opposition fails in relation to these goods.**

Conclusion in relation to: Dentifrices; mouthwashes (class 3) Medicated hair care preparations (class 5)

65) My primary finding was that these goods are not similar and, therefore, in line with my comments in paragraph 58 there is no likelihood of confusion. Even if the goods were considered to be similar to a low degree, then, for similar reasons to that already expressed, **there is no likelihood of confusion. The opposition fails in relation to these goods.**

## **Summary of conclusions**

66) The opposition succeeds in relation to:

**Class 03:** Preparations for care of the skin; cosmetics; toilet preparations; after-sun preparations; preparations for sun protection; foot care preparations.

**Class 05:** Medicated skin care preparations

67) The opposition fails (and the mark should be registered) in respect of:

**Class 03:** Hair lotions; shampoos; hair care preparations; dentifrices; mouthwashes; essential oils; soaps; cleaning preparations; bleaching preparations and other substances for laundry use; polishing, scouring and abrasive preparations.

**Class 05:** Pharmaceutical preparations and substances; veterinary preparations; sanitary preparations for medical purposes; medicated preparations for application to the skin after exposure to the sun and for use in the treatment of sunburn; sun protection preparations for medical purposes; medicated hair care preparations; medicated foot care preparations; medicated mouthwashes; materials for dressings; preparations for aiding removal of head lice in hair; insecticidal preparations for hygiene purposes; disinfectants; fungicides

## **Costs**

68) Both sides have achieved a measure of success. Although it could be said that Thornton has won more than it has lost, this does not necessarily mean that it should receive an award of costs in its favour. In my view the parties should bear equal responsibility for costs and neither side should be favoured with an award costs.

**Dated this 27th day of December 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**