

O-347-20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3298713

BY DOMINIQUE TILLEN

FOR THE FOLLOWING SERIES OF THREE TRADE MARKS:



Go-Kidz



Go-Kidz



Go-Kidz

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 413253

BY DESIGN GO LIMITED & DG CAPITAL LIMITED

Background and pleadings

1. On 22 March 2018, Dominique Tillen applied to register the following as a series of three trade marks, under number 3298713:



The application was published for opposition purposes on 27 April 2018 in respect of the following goods:

Class 3: Dentifrices; Tooth care preparations; Baby wipes; Pre-moistened cosmetic wipes; Moist wipes impregnated with a cosmetic lotion.

Class 5: Impregnated medicated wipes; Moist wipes impregnated with a pharmaceutical lotion; Wipes for medical use.

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].

Class 21: Electric toothbrushes; Manual toothbrushes; Toothbrushes; Toothbrushes, electric.

2. The application is opposed by Design Go Limited (“DGL”) and DG Capital Limited (“DG Capital”), collectively “the opponents”. The opposition was filed on 24 July 2018 and is based upon ss. 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under both grounds, the opposition is directed against all of the goods in the application. For the claim based upon s. 5(2)(b), the opponents rely upon the following trade marks:

(i) UK trade mark number 2163188 **GO**

Filing date: 4 April 1998; date of entry in register: 12 November 1999.

Goods relied upon:

Class 5: Bandages; dressings; plasters.

Class 21: Toothbrushes; toothbrush covers and containers.

(ii) UK trade mark number 3016419



Filing date: 2 August 2013; date of entry in register: 8 August 2014.

Goods relied upon:

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.

Class 21: Toothbrushes; toothbrush heads and toothbrush cases.

3. The opponents claim that the marks are similar and the goods are identical or similar. They claim that the distinctiveness of the marks has been enhanced through use. Therefore, they say, there exists a likelihood of confusion, including the likelihood of association.

4. Under s. 5(4)(a), it is claimed that DGL has used the sign shown below throughout the UK since 2012:



It is said that the sign has been used in relation to the following goods:

Corner protectors for tables, 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.

5. The opponents claim that DGL is the owner of goodwill in the business represented by the sign and that the adoption by the applicant of the trade mark applied for in the context of infants' healthcare/comfort products would constitute a misrepresentation leading to damage to DGL's business.

6. Ms Tillen filed a counterstatement denying the grounds of opposition and putting the opponents to proof of their claims.

7. Given their dates of filing, the opponents' trade marks qualify as earlier marks in accordance with s. 6 of the Act. As UK3016419 had not been registered for five years at the date of publication of the contested application, it is not subject to the use provisions at s. 6A of the Act. The opponents may, therefore, rely upon all of the goods identified without showing that they have used the mark. UK2163188, however, had been registered for five years at the date of publication of the contested application and is

subject to the use provisions. Ms Tillen requested that the opponents provide evidence of use for all of the goods relied upon under this mark. The relevant period for demonstrating use of this mark is 28 April 2013 to 27 April 2018.

8. Both parties filed evidence and written submissions during the evidence rounds. A hearing took place before me, by videoconference, on 7 May 2020, at which the opponents were represented by Gareth Jenkins for Marks & Clerk LLP and Ms Tillen by Nick Zweck of counsel, instructed by Murgitroyd & Company. As a consequence of the preliminary issue discussed below, submissions were also filed by both parties after the hearing, which I bear in mind.

Preliminary issue

9. On 27 April 2020, the opponents' representatives wrote to the tribunal, by email, withdrawing the ground based upon s. 5(4)(a). On 6 May 2020, a further email was sent to the tribunal in which the opponents sought to reinstate the ground based upon s. 5(4)(a). I allowed the reintroduction of the ground at the hearing, for the reasons I now give.

10. At the hearing, Mr Jenkins explained that the opposition had been filed by a different partner in his firm and that the opposition had been run by an attorney who was now on maternity leave. At the time of withdrawing the s. 5(4)(a) ground, Mr Jenkins had thought that the opponents' best case lay with s. 5(2)(b) and was not aware of previous decisions in a related case. He submitted that, as the request to remove s. 5(4)(a) was only recent and its reintroduction would allow the proceedings to be concluded in one go, without the need for further proceedings, it would be proportionate to reinstate the ground.

11. Mr Zweck submitted that Mr Jenkins' personal predicament is not the point. The decision not to proceed was a conscious one and there is no mention of the ground either in the opponents' skeleton argument or in the observations in reply filed during the evidence rounds. Mr Zweck submitted that there would be a serious prejudice to the

applicant if the ground were reinstated as he had had no time to prepare submissions on that ground, being personally committed all day on 6 May (i.e. the day before the hearing). Although written submissions could be prepared, the applicant would not have the benefit of an oral hearing on the issue. He also submitted that there was a policy point involved and that permitting the reintroduction of the ground would be tantamount to allowing the worst type of tactical gamesmanship.

12. It is not desirable that parties should easily be able to withdraw and reintroduce grounds which they themselves have raised and then judged superfluous, not least because of the risk of, to use Mr Zweck's words, "tactical gamesmanship". In this case, Mr Jenkins has explained his mistake and I have no reason to doubt that it was any more than an error on his part. The opposition had largely run its course by the time the ground was withdrawn, some ten days before the substantive hearing. Mr Zweck is right that the applicant will not have the benefit of oral submissions on the ground, though he did not argue that an adjournment was necessary. It was also unsatisfactory that the opponents' submissions on the s. 5(4)(a) ground had not been prepared for the hearing and that time was sought to make those submissions in writing, further prolonging events. However, there was a very short period of time between the withdrawal of the ground and the opponents' reversal of their position, no additional evidence would be required and only submissions remained to be made. In addition, the applicant would not be deprived of the chance to make submissions altogether but could file written submissions in lieu, whilst allowing the ground to be reinstated would obviate the need for further proceedings. Bearing all of these factors in mind, I considered that in the exceptional circumstances of this case it was appropriate to allow the reinstatement of the s. 5(4)(a) ground.

Evidence

13. I have read all of the evidence but will summarise it only to the extent I consider necessary.

Opponents' evidence

14. This consists of the witness statement of Glenn Rogers. Mr Rogers is the Vice Chairman of DGL. He previously held the position of Managing Director and has been involved with the company for over twenty years. He is also a Director of DG Capital, which is, he explains, a non-trading holding company.

15. Mr Rogers explains that the business began trading in 1978 and was incorporated under the name Jack Rogers & Co. Limited before being renamed in 2004 as Design Go Limited. In 2011, the business was rebranded as "Go Travel".

16. Mr Rogers provides a list of trade marks which are said to have been used by DGL or its predecessor in title from 1979.¹ All feature the word "GO", in varying degrees of stylisation. They include a mark corresponding to UK3016419 and, from 2011, the following sign:



Mr Rogers says that these marks have been used on product packaging, display stands, trade show stands, business stationery including letterheads and business cards, and other business papers.

17. Prints taken from DGL's website, go-travelproducts.com are exhibited.² These are said to show the "current" range of products (Mr Rogers' statement is dated 30 August 2019). A wide range of goods is shown, from travel adaptors to eye masks. UK3016419, or a version where the mark is in a light colour on a dark background, is visible on some goods. The goods include mini floodlights, ziplock bags, a toothbrush cover and a "sonic

¹ Exhibit GR1.

² GR2.

traveller” toothbrush, a travel blanket, “Acustraps”, children’s travel pillows, nightlights and a mosquito net for cots.³

18. Mr Rogers explains that DGL launched a range of children’s products under “the Go Travel brand” to complement its existing children’s products. Catalogues said to be dated 2012 to 2017 are exhibited.⁴ The unregistered sign is shown in exhibits GR5 to GR7; only one of these catalogues, from 2012 (see GR5, p. 20), is dated. The evidence is not easy to make out but the sign also appears to be applied to packaging shown in this exhibit, though a different mark (without the word “TRAVEL”) is applied to the goods themselves. The goods shown are the same as those listed at paragraph 4, above, though not all of them are present in every catalogue: the catalogues appear to show a growing range of products, consistent with the sales data at GR4. Catalogues dated 2016 and 2017 show the sign reproduced at paragraph 16, above, and some of the goods also in the earlier catalogues.⁵ It is not possible to tell if the packaging shows the unregistered sign as relied upon.

19. Mr Rogers says that DGL sells its goods through UK department stores, supermarkets and pharmacies, such as Selfridges, John Lewis, Sainsbury’s and Boots, as well as post Office branches and UK airports including Heathrow and Manchester. Airport retailing is said to account for 30% of UK revenue. Total UK sales are given as over £8.6 million each year from 2012.⁶ An overall breakdown is provided but it is extremely difficult to read. Sales figures for the goods specified at paragraph 4, above, and said to be sold under the “Go Travel Kids logo” are also given from 2012 to 2017.⁷ The figures are variable and not all of the goods have been sold throughout the period. For example, the monkey neck pillow has been sold since 2014 with 3,410 units sold in 2017 at a value of £8,592; in contrast, no door stops or zip lock bags were sold in 2017 and sales were less

³ Pp. 12, 27,28 and 29.

⁴ GR5 to GR9.

⁵ GR8, GR9.

⁶ GR3.

⁷ GR4. Similar information is provided at confidential exhibit GR12.

than £70 in each of 2015 and 2016. Sales figures for the “Go Kids range” are said to be £143,000 since 2012.⁸

20. Sales figures from 2012 to 2017 are provided for brush shields, “sonic traveller”, first aid kits, “Mosqui-Go” wipes and sonic heads.⁹ Sales of the “Sonic Traveller” are between £7,875 and £18,134 over the period, whilst brush shield sales fell from a high of £37,000 in 2012 to around £18,000 in 2017. Toothbrush head sales were less than £1,000 each year, and the “Mosqui-Go” wipes have been loss-making or had no sales since 2013: the sales in 2013 were £1,109 and £6,511 the year before. Sales of first aid kits range from none (2017) to £7,806 (2013).

21. Invoices are provided which show sales to companies in the UK of corner protectors, door stops, wrist links, child reins, chair harnesses, sterilising bags, wipe-clean bibs nappy bag dispensers, changing mats, baby towels, travel and comfort blankets, cuddly toy travel and neck pillows, cuddly toy nightlights and mosquito nets for cots.¹⁰ The product references correspond to the goods shown in the catalogues at GR5 to GR9. They are dated between September 2012 and February 2017. One invoice includes “Sonic Traveller” toothbrushes and heads, though no quantities are shown.¹¹

22. Photographs of stands at trade shows, dated between 2012 and 2017 are in evidence.¹² There are also images from 2018 but the precise date is not given. The unregistered sign relied upon is visible in the images from 2012 and 2013; the “Go TRAVEL” sign, shown at paragraph 16, above, is visible throughout. The size of some of these shows is given: the numbers range from 80 to 2,500 exhibitors and 350 to 58,000 visitors.¹³

⁸ Rogers, §15.

⁹ GR4.

¹⁰ GR11.

¹¹ GR11, p. 38.

¹² GR10.

¹³ Rogers, §13.

23. Press articles dated November and December 2016 from the *Telegraph* are provided, in which DGL's giraffe and lion neck pillows are mentioned.¹⁴ No trade marks are visible but DGL's web address is given. There is also an article from *Frontier* magazine concerning the 2015 launch of new products by DGL, which specifically refers to cuddly toy nightlights and children's headphones.¹⁵ The same exhibit also contains an undated print from *IN* magazine which shows a children's folding travel pillow (priced in £), whilst a print from *babyworld* (2015) shows what appears to be DGL's neck pillow, though I cannot make out the context. A print from *My Baba* is illegible. Additional prints from *Mother and Baby Online* (2015) and *skyscanner* (2014) review DGL's children's neck pillows.

Applicant's evidence

24. This consists of the witness statement of Dominique Tillen. Ms Tillen explains her relationship with Brushbaby Limited and describes the company's background and sales outlets. Despite the application being in her name rather than the company name, Ms Tillen suggests that the "Go-Kidz" brand is part of Brushbaby's portfolio and that goods are available through Brushbaby stockists. It is said that the "Go-Kidz" brand was launched in August 2018. Sales figures are given for Brushbaby Limited but are not broken down by trade mark.

25. That concludes my summary of the evidence.

My approach

26. Although UK 2163188 is a word-only mark and, at first blush, might appear to offer the strongest case, it is subject to proof of use. UK 3016419, by contrast, is not subject to the use requirements. For the assessment under s. 5(2)(b), I will, therefore, begin by

¹⁴ GR13.

¹⁵ GR14.

considering the position in respect of UK 3016419 and will return to the other earlier mark if it becomes necessary.

Section 5(2)(b)

27. Section 5(2)(b) of the Act reads 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”.

28. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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

29. The goods to be compared are:

Earlier specification	Contested specification
<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>

	Class 21: Electric toothbrushes; Manual toothbrushes; Toothbrushes; Toothbrushes, electric.
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30. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“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”.

31. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

32. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, EU:T:2006:247, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

33. In *Kurt Hesse v OHIM*, Case C-50/15 P, EU:C:2016:34, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2009:428, the 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”.

Class 3

Dentifrices; Tooth care preparations

34. The applicant accepts that these goods are similar to the earlier goods in class 21 to a medium degree.¹⁶ I will proceed on that basis.

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

35. The opponents submit that these goods are highly similar to “cleansing wipes and antiseptic wipes” in the earlier specification because the goods have the same intended purpose, trade channels and end users. The applicant submits that there is only a low degree of similarity, pointing out that the earlier specification is for “first aid kits comprising [...] cleansing wipes and antiseptic wipes”, not wipes alone. Whilst “comprising” may be read either as “including” or “consisting of”, it seems to me that the average consumer is more likely to consider that a first aid kit contains a number of different items rather than just one type of product. That said, the wipes themselves are highly similar, both being impregnated wipes with the only difference being in the liquid. Their method of use and users will be the same. Although one is medicated and the other is not, both are for cleansing, albeit to different degrees. Whilst there may be a competitive relationship between the wipes themselves, I am doubtful that a first aid kit would be purchased as an alternative to the contested baby/cosmetic wipes. Nor does it seem to me that the contested wipes are important or essential for first aid kits: there is no evidence on the point but first aid kits, being intended to treat wounds, typically include only sterile wipes and dressings, not general-purpose cleansing wipes. I agree with the applicant that there is a low degree of similarity overall.

36. Whilst the opponents’ submissions referred only to “cleansing wipes and antiseptic wipes” rather than first aid kits including those items, I am mindful that that position was

¹⁶ Applicant’s skeleton argument, §20.

probably influenced by the previous decision based upon the same earlier specification. The opponents' original pleaded position was that "wipes" in class 5 of the earlier specification are similar to the wipes in class 3 of the contested specification and its reliance on the whole of class 5 was never formally dropped. The earlier "mosquito repellent wipes; insect repellent wipes" are similar to the contested wipes in class 3 to a high degree. There are differences in nature and purpose arising from the different impregnated liquid but there are also strong similarities. Users and method of use are the same, whilst channels of trade will overlap to some extent. They are not in competition or complementary. I will return to this point when considering the likelihood of confusion.

Class 5

Impregnated medicated wipes; moist wipes impregnated with a pharmaceutical lotion; wipes for medical use

37. The opponents' position is that these goods are identical or highly similar to "mosquito repellent wipes; insect repellent wipes" in the earlier specification. The nature of the goods is highly similar, the only difference being in the impregnated liquid. As wipes may have the dual function of cleansing and applying a treatment to the skin, their purpose overlaps, though there is a difference because one is intended to treat a skin condition or complaint and the other for insect-repellence. Given their specific uses they are unlikely to be in direct competition. Methods of use and users are identical. Whilst insect repellents are most likely to be found with travel goods and ordinary medicated wipes will be on different shelves, they will be found in the same retail premises such as chemists' shops and in the same general area of a supermarket. There is no evidence going to complementarity. My view is that these goods are not typically intended to be used together and that, for that reason, they are not complementary as defined in the case law. The goods are similar to a high degree.

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].

38. No case is set out by the opponents in relation to these goods. It is not obvious to me that there is any similarity between these goods and any of the goods of the earlier specification. The nature, purpose and method of use are all different. There may be an overlap in channels of trade and users but this is likely to be at a superficial level and there is no competition or complementarity. I do not consider that there is any meaningful degree of similarity between these goods.

Class 21

Electric toothbrushes; manual toothbrushes; toothbrushes; toothbrushes, electric.

39. “Toothbrushes” is found in both specifications and these goods are self-evidently identical. The remaining goods are included within the earlier specification’s “toothbrushes” and are identical on the principle outlined in *Meric*.

40. Where there is no similarity between the goods, there can be no confusion and the opposition against the contested goods in class 10, insofar as it is based upon s. 5(2)(b), is dismissed accordingly.¹⁷

The average consumer and the nature of the purchasing act

41. It must be determined who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the

¹⁷See, for example, *Waterford Wedgwood*.

average consumer in the course of trade. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik*.

42. Neither party addressed the identity of the average consumer. Mr Jenkins submitted that the consumer will pay no more than an average degree of attention; Mr Zweck's position was that the average consumer will pay a higher than normal degree of attention.¹⁸

43. The average consumer for most of the goods at issue will be a member of the general public. Although the consumer of the contested wipes in class 5, given their medical application, may include healthcare professionals, the potential for these items to be used in general first aid means that the general public is also a relevant group of consumer. None of the goods at issue strikes me as particularly costly or being an infrequent purchase. I do not think that the fact that some of the goods may be intended for children (such as children's toothbrushes) will result in a significantly higher level of attention: they are purchased often and are inexpensive. Whilst I accept that in certain circumstances medicated goods or goods for medical use might require a higher than average degree of attention (for example, if they are purchased by healthcare professionals), I do not think that the same applies to the contested wipes in class 5 when purchased by the public: some attention will be paid to, for example, whether they are sterile or antiseptic but it will not result in a higher than medium level of attention. Overall, all of the goods at issue will, when purchased by the general public, be selected with a medium level of attention.

44. The purchasing process will be mainly visual. The goods are likely to be selected from the shelves of retail premises or from websites. Consumers may also be exposed to the

¹⁸ Opponent's skeleton §§48-49; applicant's skeleton §18.

marks though advertising in print or online. I do not rule out, however, that there may be an aural aspect to the process.

Distinctive character of the earlier trade mark

45. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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.

46. The earlier mark is a stylised representation of the word “Go”, surrounded by a border. That is an ordinary English word which, given its allusiveness to travel or easily portable goods, is possessed of a fairly low degree of inherent distinctive character.

47. The opponents have claimed that the earlier mark’s distinctiveness has been enhanced through the use which has been made of it. Whilst the sales figures are not insignificant, the goods are common consumer goods. There is no evidence of the size of the market but it is likely to be very large. I am not persuaded that the level of sales in respect of the goods relied upon under this ground (£289,386 in total since 2012) has been at such a level that it would have materially increased the mark’s distinctive character.

Comparison of trade marks

48. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that

the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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”.

49. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Contested mark (series of three)
	

50. The earlier mark consists of the word “Go”, presented in a slightly stylised typeface surrounded by a border. The border has three curved corners and one pointed one. The

overall impression of the mark is dominated by the word “Go”. The stylisation and border are likely to be perceived as decorative and will play a weak role.

51. All of the contested marks feature the words “Go” and “Kidz”, separated by a hyphen. In each of them, the tail of the “G” is in a stylised arrow form and the dot of the “i” is a star device. The first mark is presented in a particular shade of blue. Nevertheless, the overall impression is dominated by the words “Go” and “Kidz”. The colour, the hyphen and the stylised “G” and “i” will have only a weak impact. The third mark in the series is in grey. My assessment of the overall impression is the same as for the first mark: the words “Go” and “Kidz” will dominate and the other figurative or colour elements will play a much subordinate role. The second mark in the series features the word “Go” and the dot of the “i” in the same shade of pink, whilst the remaining elements are in green. Although the way in which the colours are combined is rather unusual, the mark remains dominated by the word “Go” and “Kidz”, with the other elements playing weaker roles.

52. Mr Zweck submitted that the hyphenation of the contested marks means that the words “Go-Kidz” will be perceived as a composite unit having a different meaning from that of the separate components. It is submitted that the concept “is quite clearly the idea of particularly active or busy kids who are “on the go””. Mr Zweck submitted that the average consumer would not, therefore, see the marks as conceptually similar. It is also submitted that the word “Go” is generic and “has no particular status over and above the word “Kidz””.

53. It is possible that a certain proportion of average consumers will see the contested marks as meaning kids who are on the go, in the way suggested by Mr Zweck. However, I do not think that such a meaning is so clearly apparent from the combination “Go-Kidz” that this would be the perception across the board. The word “KIDZ” is an obvious misspelling of the word “KIDS” and is likely to be perceived as descriptive or, at best, weakly distinctive by a significant proportion of average consumers, if not the majority. I do not think that the hyphen will result in the two separate words being seen as one, or that its presence clearly indicates a “unitary concept”, given that the words do not hang

together in a grammatical way which indicates an obvious and different concept from the individual components. In addition, whilst the word “Go” is not highly distinctive, it has greater distinctive character than the word “Kidz”, which directly indicates the intended users. The average consumer who does not see “Go-Kidz” as having a distinct meaning is likely to attribute greater trade mark significance to the word “Go” and to perceive the word “Kidz” as indicative of the group for whom the goods are intended.

Go-Kidz^{*} and Go-Kidz^{*}

54. As nothing turns on the presentation in colour of the first and third marks in the series, I will take these together. The earlier and contested marks share the word “Go”. It is the primary element of the earlier mark and the first element of the contested marks. There are visual differences because of the hyphen and the additional word “Kidz” in the contested marks, as well as the stylisation in both marks. Taking all of the competing factors into account, there is a medium degree of visual similarity overall.

55. Aurally, the identical word “Go” is present in both marks. The word “Kidz” introduces an obvious difference. The presentational elements will not be articulated. The words are aurally similar to a medium degree.

56. The word “Kidz” introduces a concept not present in the earlier mark. However, the shared presence of the word “Go”, which retains in both marks its connotations of movement and/or travel, will result in a medium degree of conceptual similarity.

Go-Kidz^{*}

57. This trade mark also shares with the earlier mark the word “Go” but, in addition to the differences described above between the single-colour marks and the earlier mark, this mark has a two-tone effect. As the fair and notional use of the earlier mark would not include this rather usual combination, the colour constitutes a further difference. That

said, the overall impression of the mark is overwhelmingly dominated by the words “Go” and “Kidz”. Whilst I take into account the colour, my view is that, overall, there remains a medium degree of visual similarity between this mark and the earlier mark. My assessments of the aural and conceptual similarity, above, apply equally to this mark, as the colour has no effect on how the mark will be pronounced or its conceptual meaning.

Likelihood of confusion

58. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]). Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion involves the consumer recognising that the marks are different but nevertheless concluding that the later mark is another brand of the earlier mark owner. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C. explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of

the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

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

60. I also bear in mind the comments of Mr Purvis, again sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O/075/13. He 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 marks that are identical or similar, saying:

“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”.

61. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

62. 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*. The judge said:

“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”.

63. The level of similarity between the competing goods varies, from goods which are similar to only a low degree to goods which are identical. There is a medium degree of visual, aural and conceptual similarity and the earlier mark has a fairly low degree of distinctive character. The consumer common to all of the goods is the general public, who will pay a medium degree of attention and who will purchase the goods primarily through visual means. Whilst I have accepted that some consumers may consider that the mark “Go-Kidz” forms a unit indicating active or on-the-go children, I do not consider this to be the most probable perception. At least a significant proportion of consumers are likely to perceive the “Kidz” element of the contested mark as having a limited degree of distinctiveness, if any, and as signalling the intended users of the goods. In those circumstances, the combination “Go-Kidz” does not form a unitary whole with a distinct meaning greater than the sum of its parts and the word “Go” carries greater trade mark significance.

64. It is clear from the case law quoted above that the distinctiveness of the common element is an important factor both in applying the ordinary principles of indirect confusion and in the rather specific circumstances of *Medion*-type confusion. The lower the distinctive character of the common element, the less likely it is that there will be confusion. The other elements in the respective marks necessarily inform the outcome. In this case, the greatest difference between the marks is the word “Kidz”. It is, for the reasons I have explained, an element which has less trade mark significance than the word “Go”. Bearing in mind the fairly modest stylisation in the respective marks, I do not think that confusion will be avoided. The similarity between the marks, in particular the prominent and shared distinctive element “Go”, even though not particularly distinctive of itself, is not sufficiently offset by the differences between the marks and any differences

between the goods. I have carefully considered whether this applies even where the goods are similar only to a low degree. I have concluded that it does. Although the goods have only a low degree of similarity, the limited distinctiveness of the word “Kidz” and the other differences between the marks are not sufficient to avert confusion. The average consumer is likely to think that the contested marks are variants of the earlier mark, used by the same or a connected undertaking. There is a likelihood of indirect confusion.

65. I have not found it necessary to base my decision in respect of the contested wipes in class 3 on “mosquito repellent wipes; insect repellent wipes” in the earlier specification. In case I am held to be wrong that there is a likelihood of confusion where there is only a low degree of similarity between the respective goods, I would have found that there was a likelihood of confusion with the class 3 wipes on the basis of “mosquito repellent wipes; insect repellent wipes”. There is a higher degree of similarity between these goods and the other factors considered above apply equally. The average consumer would be confused for the same reasons as given at paragraph 64, above.

66. For completeness, I note that the applicant has pointed to an absence of actual confusion. However, apart from an indication in submissions that the parties share the same stockists, there is no evidence to substantiate the claim.¹⁹ The sales figures for the applicant do not relate to the trade marks at issue but the company at large and there is no evidence which would show that despite exposure to both marks the average consumer is not confused. There is certainly not sufficient evidence to show that the absence of actual confusion is because, despite opportunities for confusion to occur, the average consumer does not or would not confuse the marks.²⁰

67. As the opposition has succeeded against all of the goods in classes 3, 5 and 21, and given the specification for which UK2163188 it is registered, that mark would put the opponents in no stronger a position and I need say no more about it.

¹⁹ Submissions at §9.9.4.

²⁰ See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220 at [60] and *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283.

Section 5(4)(a)

68. Given my findings, above, it is only necessary for me to consider this ground insofar as it relates to the contested goods in class 10.

69. Section 5(4)(a) states:

“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”.

70. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, HHJ Clarke, sitting as a deputy Judge of the High Court stated that:

“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)".

71. 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 relevant date for the purposes of s. 5(4)(a) of the Act and concluded:

"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'".

72. There is no claim that the contested marks were in use prior to the date of application. That being the case, the relevant date is 22 March 2018.

73. The House of Lords considered goodwill in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, saying:

"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".

74. The applicant says that the opponents' heavy reliance on previous decisions in a related case and the fact that it has not indicated how the evidence filed in these proceedings substantiates its goodwill mean that it has failed to discharge its evidential burden. The opponents' submissions are rather unusual in that regard but the applicant's point is a little optimistic. The opponents have at no point withdrawn the evidence filed in this case, or their reliance upon it. The thrust of the opponent's argument regarding the earlier proceedings is that, as the same evidence was held to have established goodwill, the result should be the same here. That is not, of course, the position: I must determine the question of goodwill based upon the evidence before me. I do not think, however, that the opponents' failure to take me to the relevant evidence in submissions means that I am not entitled to assess its claim to goodwill based on the evidence filed in these proceedings.

75. The evidence shows that DGL began using the sign relied upon in 2012 in connection with a range of different goods and that the range has expanded over time. There is some evidence of use of the sign in 2012 and 2013 at trade fairs. Whilst the documentary evidence could be clearer, and it would have assisted if the dates of each of the catalogues were provided, Mr Rogers has given sales figures for goods which, he specifies, were sold under the sign up to 2017. Invoices are provided to substantiate the sales figures. Although not all of the goods were sold throughout the period 2012 to 2017, and the sales figures for individual products are variable, the overall figures are not trivial: *Hart v Relentless Records* [2002] EWHC 1984 (Ch) at [62]. Taken as a whole, I am satisfied that DGL had, at the relevant date, a protectable goodwill in a business, of which the sign relied upon was distinctive, selling the goods listed at paragraph 4, above.

76. The sign consists of the words "GO Travel" on a black background with a black border, above the word "kids". The words "Go" and "kids" are presented in different, slightly stylised fonts. My view is that both "Travel" and "kids" will be perceived as descriptive, whilst the background and border are likely to be seen as decorative elements with little or no distinctive character. The greater part of the mark's distinctiveness is, therefore, contained in the word "Go". My comments, above, in relation to the overall impressions

of the contested marks and the relative distinctiveness of their components are equally applicable here. I do not think that the differences in colour between the contested marks have a material impact on the overall level of similarity with the sign. I take into account the vertical arrangement of the words in the sign and differences in the size of the letters. However, the marks and sign have not only the word “GO” in common, which is given some prominence in both by virtue of its position, but also the words “KIDZ”/“kids”. In spite of differences, the sign and the marks are similar to a reasonably high degree.

77. The goods in relation to which the sign has been used are not identical to those in the contested specification. Indeed, they appear to be in separate fields. Whilst the fact of different fields of activity is a factor which must be taken into account, it is not fatal to an opposition based on this ground that the parties do not operate or intend to operate in a common field: *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA). In this case, it is clear that DGL has been selling, for some time, travel goods for children. It seems to me that the use of the contested marks in relation to, broadly speaking, dummies and goods for teething, is likely to be construed by the relevant public as an extension of DGL’s business selling children’s travel goods under the “Go Travel Kids” brand. There will be misrepresentation.

78. The applicant accepts that, if there is a misrepresentation, damage will follow.²¹ The passing-off ground succeeds accordingly.

Conclusion

79. The opposition has succeeded in full. The application will be refused.

Costs

80. The opponents have been successful and, in the ordinary course of events, would be entitled to an award of costs. At the hearing, both parties indicated that costs were sought

²¹ Written submissions dated 27 May 2020, §25.

on the scale, contained in Tribunal Practice Notice (“TPN”) 2/2016, up to that point in proceedings. However, the parties have made additional submissions in relation to the costs of the preparation of written submissions subsequent to the hearing.

81. The opponents’ position is that the applicant’s costs in preparing the skeleton argument and oral submissions were reduced because it did not include preparation of submissions on s. 5(4)(a). The opponents maintain that any costs incurred after the hearing would have been incurred in preparation for the hearing had the ground been included at that stage. It is also submitted that dealing with the ground now has avoided further costs through additional proceedings.

82. The applicant seeks an award off the scale in relation to the submissions for the s. 5(4)(a) ground, irrespective of the outcome. It submits that the applicant, its attorney and counsel have been put to substantial inconvenience and cost by the conduct of the opponents. It submits that the opponents’ conduct in dropping the s. 5(4)(a) ground then seeking to have it reinstated was unreasonable. It submits that counsel focused the budgeted preparation on the extant grounds and that additional costs have inevitably been incurred in preparing written submissions, including because of duplication caused by the time which elapsed between the original preparation of the case and written submissions. Counsel’s fees in the sum of £1,100 are sought.

83. It has long been recognised that the registrar may award costs off the scale to deal proportionately with breaches of rules or other unreasonable behaviour, provided that it does so in accordance with judicial principles.²² I accept that the opponents’ conduct in withdrawing and seeking the reinstatement of the s. 5(4)(a) ground was not a deliberate tactic to frustrate or place the applicant in a disadvantageous position but that it was the result of a failure to appreciate the ramifications of reliance upon s. 5(2)(b) only. That said, I do not consider that it was reasonable behaviour. The opponents are professionally represented and ought to have been aware of the consequences of dropping a ground they had raised. However, it appears that the error was not noticed until after exchange

²² *Rizla Ltd's Application* [1993] RPC 365. TPN 4/2007 also refers.

of skeleton arguments. In preparing for the hearing, the applicant relied upon the opponents' withdrawal on the record; it could not have done otherwise. The applicant has been put to additional expense in responding to the ground in written submissions, which is directly attributable to the opponents' conduct. I do not accept that the sum would have been incurred in any event. At the very least, there will have been at least some duplication of effort. The applicant is entitled to actual costs in respect of counsel's fees for the written submissions on s. 5(4)(a). Offsetting these costs against the award which I would have made to the opponents as the successful party, I will in the circumstances award the opponents £200, which is the official fee for filing the opposition.

84. I order Dominique Tillen to pay Design Go Limited and DG Capital Limited the sum of **£200**. This sum is to be paid within two months of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of July 2020

**Heather Harrison
For the Registrar
The Comptroller-General**