

O-525-21

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3480865
BY THAMEEN LIMITED
TO REGISTER:**

Imperial Crown

AS A TRADE MARK IN CLASSES 3, 4 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421138 BY
PZ CUSSONS (INTERNATIONAL) LIMITED**

BACKGROUND & PLEADINGS

1. On 12 April 2020, Thameen Limited (“the applicant”) applied to register **Imperial Crown** as a trade mark for the goods and services in classes 3, 4 and 35 shown in Annex A to this decision.

2. On 7 August 2020, the application was opposed, in part, by PZ Cussons (International) Limited (“the opponent”). The goods and services being opposed are shown in Annex A in bold. The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the trade marks and goods shown in Annex B to this decision. In relation to the first earlier trade mark relied upon, which consists of the words “IMPERIAL LEATHER” *solus*, in relation to its objection under section 5(2)(b) of the Act, the opponent states:

“We consider that the earlier trade mark for IMPERIAL LEATHER and IMPERIAL CROWN application are confusingly similar, as both marks contain at the beginning the word "IMPERIAL", which is the element that primarily catches the consumer's attention and will be remembered more clearly than the rest of the sign. Overall, the conflicting trade marks are visually and phonetically similar.

The IMPERIAL CROWN trademark covers goods in Class 3 that are identical to the goods covered by the IMPERIAL LEATHER trade mark in the same class. Further, the retail services in Class 35 relating to the products covered by Class 3 of the IMPERIAL CROWN application are similar to the Class 3 products protected by the IMPERIAL LEATHER trade mark.

The average consumer for the goods will be a member of the general public, and in view of the above, there is a risk that the public might believe that the goods in question originate from the same undertaking, or as the case may be, from economically linked undertakings. Hence, there is a likelihood of confusion, including likelihood of association, between the earlier trade mark registration and the opposed trade mark application.”

3. Insofar as its objection based upon section 5(3) of the Act is concerned, the opponent states that its trade marks enjoy a reputation for all the goods upon which it relies, adding that it considers that some of the goods for which registration is sought (shown in Annex A in bold) would take unfair advantage of, or be detrimental to, the distinctive character or reputation of its trade marks. Having answered “Yes” to question 3 in the Notice of opposition which states:

“Is it claimed that the similarity between the [trade marks being relied upon] and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?”,

in relation to the first earlier trade mark, the opponent states:

“The reputed earlier trade mark and the later trade mark are highly similar as both trade marks start with the word IMPERIAL, and in general the beginning of a sign has a significant influence on the general impression made by the mark. Overall the conflicting trade marks are similar and the relevant public might believe that the later trade mark is a sub-brand of PZ Cussons (International) Limited, and, therefore, there is a serious risk of customer confusion, or that customers will associate the identical and/or similar goods and services designated by the later trade mark with PZ Cussons (International) Limited, and its earlier trade mark for IMPERIAL LEATHER.”

4. In relation to questions 4, 5 and 6 in the Notice of opposition which begin “Is there any other basis for your claim other than your answer to Q3”, again in relation to its first earlier trade mark, the opponent states:

Unfair advantage

“The earlier trade mark has been registered since 1965, and has been present on the UK market since then, and, therefore, it has acquired reputation in the UK in relation to products designated under class 3

specification. The opponent has invested considerable amount in marketing, and the applicant's use of the IMPERIAL CROWN mark is likely to exploit the marketing effort expended by the opponent, this will take unfair advantage of the reputation of the IMPERIAL LEATHER trade mark. Hence, there is a serious risk that the use of the later trade mark by Thameen Limited would benefit from the power of attraction of the earlier trade mark for IMPERIAL LEATHER, and as such will take unfair advantage of the IMPERIAL LEATHER's reputation.”

Detriment to reputation

“In the event that the goods sold, or to be sold by the applicant under the IMPERIAL CROWN mark are less adequate than the ones offered by the opponent, this could impact negatively on the opponent and cause detriment to the reputation of its IMPERIAL LEATHER mark.”

Detriment to distinctive character

“It is clear that the later trade mark and the earlier right are highly similar, and there is a serious risk that the use and registration of the later trade mark could result in customers confusion, or the associations of the IMPERIAL CROWN mark with IMPERIAL LEATHER mark, and the distinctive character of the earlier mark could be weakened as a result of the use of the later mark.”

5. The opponent also states:

“The IMPERIAL LEATHER trade marks have been on the market for over 100 years. The relevant public when confronted with the later trade mark is likely to make a link with the earlier reputed trade mark for IMPERIAL LEATHER. As the IMPERIAL CROWN application covers goods in class 3 that are identical to the ones covered by the IMPERIAL LEATHER mark in class 3 and similar retail services relating to the sale of class 3 products in Class 35, the

differences in the marks are insignificant, and, therefore, the public when confronted with the IMPERIAL CROWN mark will make a connection or establish a link with the reputed IMPERIAL LEATHER marks.”

6. In relation to the other trade marks upon which it relies, the opponent’s comments under both section 5(2)(b) and 5(3) are much the same, save to the extent that it argues that:

“The verbal element of the earlier trade mark for IMPERIAL LEATHER has a stronger impact on the consumer than the figurative component...”

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

“7. The Earlier Marks are IMPERIAL LEATHER (word mark) and figurative marks comprising of the words IMPERIAL LEATHER and Cussons IMPERIAL LEATHER MASTER PERFUMERS.

8. The Earlier Marks that are figurative marks consist of the word IMPERIAL over the word LEATHER. The Earlier Mark of UK trade mark registration no. 3014453 also includes the words Cussons MASTER PERFUMERS. Both Earlier Marks that are figurative marks include significant figurative elements. The Earlier Mark of UK trade mark registration no. 3014453 also includes colour elements.

9. The Mark is the word mark Imperial Crown, with no figurative and/or colour elements whatsoever.

10. The Mark does not contain the words LEATHER, CUSSONS, MASTER or PERFUMERS, nor anything similar thereto. The Earlier Marks do not contain the word Crown, nor anything similar thereto.

11. There are clear visual, phonetic and conceptual differences between each of the Earlier Marks and the Mark. The Opponent is put to strict proof of the

points noted in their Notice of Opposition and which are directed to an allegation of similarity based on the Mark and the Earlier Marks.

12. Overall, the Mark is dissimilar to each of the Earlier Marks.”

8. Although in its counterstatement, the applicant comments on what it refers to as the opponent’s “earlier marks”, I note that when identifying the “earlier marks”, the applicant does not refer to the fourth earlier trade mark being relied upon. However, the fourth earlier trade mark differs from the third earlier trade mark only to the extent that it is presented in black and white. In those circumstances and as the applicant’s position is palpably clear, rather than delay the proceedings by requesting a formal amendment to the counterstatement, I shall proceed on the basis most favourable to the applicant i.e. (i) the applicant’s comments in relation to the third earlier trade mark apply equally to the fourth earlier trade mark, and (ii) the applicant denies that the goods relied upon in the specification of the fourth earlier trade mark (which is not subject to proof of use and which are identical to those in the third earlier trade mark) are identical/similar to the goods and services being opposed.

9. In these proceedings, the opponent is represented by Addleshaw Goddard LLP (“AG”) and the applicant by Appleyard Lees IP LLP. Only the opponent filed evidence (accompanied by written submissions). At the conclusion of the evidence rounds the parties were asked if they wished to be heard, failing which, a decision from the papers would be issued. Neither party requested a hearing nor did they elect to file written submissions in lieu.

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

DECISION

11. The opposition is based upon sections 5(2)(b) and 5(3) of the Act which read as follows:

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

(a)...

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

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

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

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

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

12. In these proceedings the opponent is relying upon the four trade marks shown in Annex B, all of which qualify as earlier trade marks under the provisions of section 6

of the Act. Given the interplay between the date on which the opponent's trade marks were entered in the register and the application date of the trade mark being opposed, the first three earlier trade marks being relied upon are subject to the proof of use provisions contained in section 6A of the Act. As the fourth earlier trade mark is not subject to proof of use, the opponent can rely upon it without having to demonstrate that it has been used.

13. In its Notice of opposition, the opponent states that it has used its first three earlier trade marks in relation to all the goods upon which it is relying and, in its counterstatement, the applicant asked the opponent to make good on that claim.

Proof of use

Section 6A:

14. This reads as follows:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

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

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

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

15. In reaching a conclusion, I must apply the same principles as I would if I were considering an application for revocation based upon non-use. The relevant five-year period is 13 April 2015 to 12 April 2020. I begin by reminding myself that section 100 of the Act reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) (28 June 2018), Arnold J. summarised the case-law on genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 *P Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or

services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to

provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

17. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated:

“22. The burden lies on the registered proprietor to prove use...However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

18. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all

depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

The opponent’s evidence

19. This consists of a witness statement, dated 19 January 2021, from Ioana Ghiurco. Miss Ghiurco is a Trade Marks Advisor in the Commercial Team at AG. She states:

“2. I am responsible for the day to day conduct of this matter on behalf of the Opponent. I make this statement on behalf of the Opponent in relation to the Opposition thereto brought by the Opponent.

3. The statements made in this witness statement are derived from my own personal knowledge and on information provided by my colleagues and the Opponent, all with direct involvement in the matter concerned. Any matters referred of which I have no direct personal knowledge are true to the best of my knowledge, information and belief.”

20. Miss Ghiurco explains that the opponent is “a well-known provider and manufacturer of personal care and beauty products, among other products.” She states that:

“6. The Opponent's IMPERIAL LEATHER trade marks have been used in the UK, on their own, or by adding insignificant variations, since at least 1930...”

21. Exhibit IG1 consists of, inter alia, pages obtained from imperialleather.co.uk, the first page of which contains the following: “OVER 100 YEARS OF HAND-CRAFTED FRAGRANCE – THE STORY OF IMPERIAL LEATHER.” The document recounts that in the 1930s “Cussons launch their first Imperial Leather soap...” and in the 1950s, “Imperial Leather was one of the first brands to invest in TV advertising, in between episodes of popular drama. It was this investment that led to the coining of the phrase ‘Soaps’ in relation to such shows in the UK.”

22. In the UK, the opponent operates at the domain name imperialleather.co.uk, which was registered on 27 December 1999. The opponent also operates and promotes its IMPERIAL LEATHER trade marks at pzcussons.com. Exhibit IG2 consists of, inter alia, pages obtained from the imperial leather website mentioned above which are dated 18/01/21. The pages provided contain references to the following categories of goods “Bar Soap”, “Bath”, “Foamburst”, “Foamburst Moisture”, “Hand Wash” and “Shower”. The words “IMPERIAL LEATHER” solus can be seen on the pages provided and when they appear on the goods, they are shown in various colours in the formats shown in the third and fourth earlier trade marks. Some examples are shown below:





23. Miss Ghiurco states:

“10. There is no doubt that the Opponent has spent considerable amount of money in advertising and marketing of its IMPERIAL LEATHER marks...”

24. In support of that statement, as exhibit IG3, she provides an article from www.thedrum.com dated 4 January 2013 entitled: “Imperial Leather to launch “magical” £1 million TV advertising campaign.” That article contains, inter alia, the following:

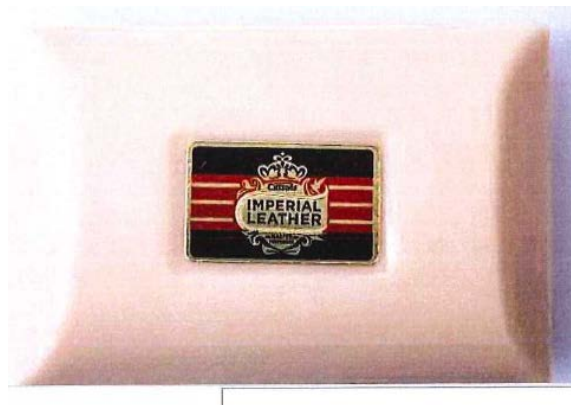
“Imperial Leather is set to release an advertising campaign promoting the new formulation of its core shower range. The £1m initiative heralds a new direction for the brand and aims to drive re-appraisal of its products. Breaking on Monday 7 January during Sky Living’s America’s Next Top Model, the ad will run for two months across TV and video-on-demand services. The ad will also air during ITV1’s Dancing on Ice on Sunday 13 January reaching a prime-time audience...the advertisement showcases Imperial Leather’s

reformulated shower gel...aims to reflect 200 years of sensory mastery and craftsmanship at Imperial Leather...”.

25. Also provided in exhibit IG3 is an article dated 1 August 2002 from www.campaignlive.co.uk which contains references to “Yet from its earliest days, Imperial Leather has always been a big advertiser” and “By 1946, Cussons was spending £100,000 a year on ATL ads – a massive sum in those days...” Exhibit IG4 consists of what Miss Ghiurco describes as:

“11. Further evidence of the publicity that the Opponent and its IMPERIAL LEATHER trade marks have received over the years, in the form of articles... also included...a list of examples of Imperial Leather ads, published on magazines or released on TV between 1940 and 2008.”

26. Although I do not intend to summarise these articles here, I have read them all and shall, of course, keep them in mind in reaching a conclusion. I do, however, note that while many of the articles provided are from outside the relevant period, the exhibit does contain, inter alia, an article from thesun.co.uk (dated 23 January 2019) entitled “Here, we test out bars of soap and rate them out of five in our Soap Awards” and which contains the following: “Best lather and value: Imperial Leather Original...” which I note was rated “5/5”. The article contains the following image:



The exhibit also contains an article from dailymail.co.uk dated 20 December 2018 which includes the following:

“So that’s what it’s for! Imperial Leather fans are left baffled by the REAL reason why every bar has a sticker that never wears away (and it’s all about making the soap last longer).”

And:

“Debate has raged for years over what the actual reason for the label was for.” (my emphasis)

The article contains the following image:



27. Exhibit IG5 consists of screenshots of “Imperial Leather TV adverts...” from what appears to be 2002, 2007, 2011, 2014 and 2015 obtained from YouTube, some of which, states Ms Ghiurco, have “over 20,000 views on YouTube.” Examples are shown below:



28. Miss Ghiurco adds:

“13. In addition to the above, the IMPERIAL LEATHER brand has supported over the years sport events, such as the Commonwealth Games in Manchester in 2002, the Norwich Union Olympic Trials & AAA Championship in 2004, the outdoors Norwich Union Trials events in 2005 and 2006...and TV shows such as Ant & Dec's Saturday Night Takeaway.”

29. Exhibit IG6 consists of pages from imperialleather.co.uk obtained using the waybackmachine Internet archive dated as follows: **2016** - 10 March (in relation to bar soap and shower cream), 18 July (which lists Asda, Boots, Morrisons, Ocado, Sainsburys, Superdrug, Tesco and Waitrose as stockists), 5 August (in relation to hand wash) and 18 October; **2017** - 8 June (in relation to body wash, hand wash and shower cream), 22 June, 13 September (in relation to bar soap), 13 November and 4 December 2017 (in relation to body wash); **2018** - 1 March (in relation to body wash) and 15 March and in **2019**, 3 September 2019 (in relation to body wash). Many of the examples of the trade marks in use are the same as those shown above.

30. Exhibit IG7 consists of pages from the following websites: amazon.co.uk, waitrose.com, onlinepoundstore.co.uk, superdrug.com, sainsburys.co.uk, ocado.com, glossybox.co.uk, groceries.asda.com, boots.com, iceland.co.uk and bmstores.co.uk. Although all the pages bear printing dates of 18 January 2021, a significant number of the pages provided contain customer reviews dated within the relevant period. Many of the examples of the trade marks in use are the same as those shown above. The goods shown are much the same as those shown above but also include talcum powder and anti-perspirants.

31. Finally, it appears that at the date of Miss Ghiurco's statement, the opponent's Imperial Leather Facebook, LinkedIn and Instagram accounts, enjoyed over 95k, 70k and 17,000 followers respectively (exhibit IG8 refers). Miss Ghiurco states that this “evidence shows that the opponent has made considerable investment on social marketing.”

Overview of the opponent's evidence – conclusions on proof of use

32. I begin by reminding myself that it is only the first three earlier trade marks that are subject to the requirement to provide proof of use. Although the opponent's evidence has not been challenged by the applicant, it is far from perfect. For example, no turnover figures have been provided (at all, let alone within the relevant period). In addition, although the evidence demonstrates that the opponent has spent not inconsiderable sums promoting its "IMPERIAL LEATHER" trade marks prior to the relevant period, not even an indication has been provided of promotional spend within the relevant period. There are, however, articles from within the relevant period referring to the opponent's goods (exhibit IG4) and extracts from the opponent's website imperialeather.co.uk obtained using the waybackmachine (exhibit IG6) as well as numerous examples of customer's reviews of the opponent's goods, also from within the relevant period (exhibit IG7).

33. Consequently, notwithstanding the various shortcomings, when the evidence is viewed as a totality, it is clear that the opponent has been using the words "IMPERIAL LEATHER" in the UK for many years prior to the date of the application for registration and that those words continued to be used alone and in a range of trade marks within and after the relevant period. The evidence shows use in formats deemed acceptable by the CJEU in the guidance it provided in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12. However, it is, I think, fair to say that when applied to the goods, more recently they appear primarily in the device format shown in the third and fourth earlier trade marks being relied upon (shown below) which are, of course, acceptable on the basis of *Colloseum*:



34. In its submissions, the opponent states:

“22 By way of an example, the Opponent has provided evidence that the IMPERIAL LEATHER was used during the relevant period, to promote and sell product such as soaps, hand wash, shower gels and creams, bath gels and creams, oil body wash, bath soak and bath creams, deodorant and talc powder...”

35. That, in my view, is a fair assessment of the goods upon which the opponent’s trade marks have been used. Having concluded that the opponent has used its three earlier trade marks in relation to the goods mentioned above, I must now decide what constitutes a fair specification.

Fair specification

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

37. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas*

Pink Ltd v Victoria's Secret UK Ltd [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

38. Applying the above guidance, I am satisfied that a fair specification for each of the earlier trade marks being relied upon which are subject to proof of use, is as follows:

UK no. 879288 – Preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; soap; liquid soap; personal cleaning wipes; bath creams; bath foams; bath salts; bath oils; bath herbs; bath wash; bubble bath; shower gels; shower creams; talc; deodorants and anti-perspirants, toilet soaps. in so far as they relate to goods for export.....Preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; soap; liquid soap; personal cleaning wipes; bath creams; bath foams; bath salts; bath oils; bath herbs; bath wash; bubble bath; shower gels; shower creams; talc; deodorants and anti-perspirants, toilet soaps. except in so far as they relate to goods for export.

UK no. 2258230 - Preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; shower gels and shower creams; bath creams and bath foams; soap; deodorants and anti-perspirants; talc.

UK no. 3014453 - preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; soap; liquid soap; personal cleaning wipes; bath creams; bath foams; bath salts; bath oils; bath herbs; bath wash; bubble bath; shower gels; shower creams; talc; deodorants and anti-perspirants.

39. It is those specifications together with the full specification of the fourth earlier trade mark being relied upon (which is not subject to proof of use) that I shall use for the purposes of the comparison which follows.

The objection based upon section 5(2)(b) of the Act

Case law

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

My approach to the comparison

41. As I mentioned earlier, the opponent's fourth earlier trade mark is not subject to proof of use. In addition, not only does it have the same specification of goods, it is for all practical purposes identical to the third earlier trade mark which features heavily in the evidence provided. As a consequence, it is upon that trade mark that I shall conduct the comparison, returning to the other earlier trade marks later in this decision.

Comparison of goods and services

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

Opponent's goods	Applicant's goods and services being opposed
<p>UK no. 3360286 – Class 3 - Non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; body creams, milks, lotions; massage oils; aromatic and fragrance preparations; hand creams; emollient creams and washes; soap; liquid soap; personal cleaning wipes; bath creams; bath foams; bath salts; bath oils; bath herbs; bath wash; bubble bath; shower gels; shower creams; shaving preparations; shave gels; shaving creams; shaving foams; after-shave preparations; talc; deodorants and anti-perspirants; hair preparations; hair care preparations; shampoos; conditioners; combined shampoo and conditioners; hair lotions; hair colouring preparations; hair straightening preparations; hair sprays; hair mousses; hair lacquers; foot sprays; perfumes, eau de toilettes; essential oils; stretch mark creams.</p>	<p>Class 3 - Perfumery; perfumes; fragrances; cosmetics; toiletries; make-up; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances; pomades; pomades for cosmetic purposes; hair pomades; lip pomades; essential oils; parts and fittings for any or all of the aforesaid goods in this Class.</p> <p>Class 35</p> <p>Retail services connected with the sale of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions including from an Internet website; shop retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions; the bringing together, for the benefit of others, of a variety of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, enabling customers to conveniently view and purchase those goods, including from an Internet website specialising in the same; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase perfumery,</p>

	<p>perfumes, fragrances, cosmetics, toiletries, body lotions; electronic shopping retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions; mail order retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.</p>
--	---

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

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

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

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that

customers may think that the responsibility for those goods lies with the same undertaking”.

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

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

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

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

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

the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

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

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

Class 3

51. “Essential oils” and “perfumes” appear in both parties’ specifications and are identical. The applicant’s “perfumery”, “fragrances”, “fragrances for the person”,

¹ Case C-411/13P

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

³ Case C-398/07P

“fragrances for personal use” and “toiletries” are self-evidently identical to, inter alia, the opponent’s “perfumes” and “non-medicated toilet preparations” respectively. As the applicant’s “hair pomades” would be encompassed by the opponent’s “hair preparations” and as its “fragrances for the home”, “room fragrances”, “fragrance preparations” and “aromatics for fragrances” are encompassed by the opponent’s “aromatic and fragrance preparations”, the competing goods are to be regarded as identical on the inclusion principle outlined in *Meric*. The same is true of “lip pomades” which would be encompassed by the term “facial and body moisturising preparations” in the opponent’s specification. Insofar as “cosmetics”, “make-up”, “pomades” and “pomades for cosmetic purposes” in the applicant’s specification are concerned, if not encompassed by one or more of the broad terms contained in the opponent’s specification, given what is likely to be an overlap in, at least, the respective nature, intended purpose, method of use, users and trade channels, the competing goods are, in my view, similar to a high degree. Finally, as the “parts and fittings” in the applicant’s specification relate to goods which I have found to be either identical or similar to a high degree to the opponent’s goods, they too are to be regarded as similar to, at least, a high degree.

Class 35

52. The applicant’s specification relates to: (i) “retail services connected with the sale of...”, (ii) “shop retail services connected with...”, (iii) “the bringing together for the benefit of others, of a variety of...”, (iv) “electronic shopping retail services connected with...”, (v) “mail order retail services connected with...”, and (vi) “consultancy, advisory and information services...” in relation to such services.

53. Categories (i) to (iv) above all relate to “perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions.” Category (v) also relates to such goods as well as to “candles, fragranced candles”. As the applicant’s services in categories (i) to (iv) all relate to goods in class 3 which I have found to be either identical or similar to a high degree to goods in the opponent’s specification, such services are complementary to the opponent’s goods and, as a consequence, similar to a medium degree. The same is also true of the applicant’s “mail order retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions”

in category (v) above, as it is in relation to the applicant's "consultancy, advisory and information service" in relation to such services.

54. That leaves "mail order retail services connected with candles, fragranced candles" and "consultancy, advisory and information service..." in relation to such services to be considered. In this regard, I note that the opponent is not opposing the applicant's goods in class 4 (which includes candles and fragranced candles), nor is it opposing the same goods as they appear in categories (i) to (iv).

55. Given its approach to the goods in class 4 and the other categories of services mentioned above, in my view, the inclusion of "candles and fragranced candles" in relation to "mail order retail services", smacks of a drafting error introduced in the Notice of opposition and perpetuated in the written submissions. In any event, in the absence of any specific explanation as to why a mail order retail trade in relation to candles and fragranced candles (and not the other categories of retail services applied for) should be regarded as similar to a trade in the opponent's goods in class 3, I find there is no meaningful degree of similarity between the opponent's goods and the applicant's named services and the "consultancy, advisory and information service" which relate to them. Given the comments of Lady Justice Arden in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, the opposition to such services fails accordingly.

The average consumer and the nature of the purchasing act

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

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably

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

57. The average consumer of the goods and services at issue is a member of the general public. As the evidence shows that the goods at issue are most likely to be self-selected from the shelf of a bricks-and-mortar outlet or from the equivalent pages of a website, visual considerations are likely to dominate the selection process, although not to the extent that aural considerations in the form of, for example, oral requests to sales assistants or word-of-mouth recommendations can be ignored; the same is true of the applicant’s retail services. As to the degree of care the average consumer will display when selecting the goods and services at issue, the goods at issue are, in the main, fast-moving, inexpensive consumer goods that will be purchased on a fairly regular basis. However, as the average consumer will be alive to factors such as fragrance, ingredients etc., I would expect him/her to pay a normal (medium) degree of attention to their selection.


58. As for the retail services, in relation to physical stores the average consumer will have in mind factors such as price, breadth of goods stocked, location, opening times etc. and in relation to their digital/mail-order equivalents, ease of use of the website or catalogue, delivery prices etc. I would, therefore, expect them to also pay a medium (normal) degree of attention when selecting the retail services at issue.

Comparison of trade marks

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

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

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

Opponent’s trade mark	Applicant’s trade mark
	<p>Imperial Crown</p>

Overall impression

61. The applicant’s trade mark consists of two words presented in title case. Both words and their meanings will be well-known to the average consumer. The words form a unit in which the word “Imperial” qualifies the word “Crown.” It is in that unit the overall impression and distinctiveness lies.

62. The opponent’s trade mark consists of a number of components. The first is the word “Cussons” presented in title case in a cursive script in the colour white. The opponent’s evidence shows that this is a surname. That, in my view, is how the average consumer is most likely to construe the word. Despite its size in the context of the trade mark as a whole, given its positioning at the top of the trade mark, this

word is likely to make a modest contribution to both the overall impression the trade mark conveys and its distinctiveness.

63. Below the word “Cussons” and in much larger text, again in the colour white, there appears the second component i.e. the words “IMPERIAL LEATHER” presented one above the other in block capital letters. Like the word “Crown” in the applicant’s trade mark, the word “LEATHER” and its meaning will be well-known to the average consumer. Also like the applicant’s trade mark, the word “IMPERIAL” qualifies the word “LEATHER”, once again forming a unit. Given its size and positioning at the centre of the trade mark, this unit will make what I regard as the most important contribution to both the overall impression the trade mark conveys and its distinctiveness.

64. The third component, also in the colour white, appears below and is much smaller than the words “IMPERIAL LEATHER”. It consists of the words “MASTER PERFUMERS” presented one above the other in block capital letters which, once again, form a unit. Given the nature of the goods upon which the opponent is relying, these words are likely to be regarded by the average consumer as laudatory in nature, extolling as they do the virtues of the undertaking concerned. As a consequence, and given their size and positioning, they are unlikely to make any meaningful contribution to either the overall impression conveyed or the trade mark’s distinctive character.

65. The final component consists of a device presented in the colour black, upon which the other components are placed. It will, in my view, be treated by the average consumer as akin to an armorial bearing, at the top of which there appears a stylised device of a crown. Despite its subordinate role to, in particular, the words “Cussons” and “IMPERIAL LEATHER” which appear upon it, it will, nonetheless, play a role in the overall impression conveyed and will make a modest contribution to the trade mark’s distinctiveness. I will bear all of the above conclusions in mind when conducting the visual, aural and conceptual comparison which follows.

Visual similarity

66. The competing trade marks share the word “IMPERIAL”/ “Imperial.” It is the first word in the applicant’s trade mark and the first word in the second component in the opponent’s trade mark, a component I have already concluded will make the most important contribution to the overall impression conveyed. Weighing the similarities and differences, results in what I regard as a between low and medium degree of visual similarity between the competing trade marks.

Aural similarity

67. As the words in the applicant’s trade mark will be well-known to the average consumer, how it will be pronounced is predictable. As for the opponent’s trade mark, it is well-established that when a trade mark consists of a combination of words and figurative components it is by the word components it is most likely to be referred to. Given their size, positioning and laudatory nature, I think it is highly unlikely that the average consumer will verbalise the words “MASTER PERFUMERS.” Despite its positioning at the top of the trade mark, given its size, the same may also be true of the word “Cussons” in the opponent’s trade mark. In that scenario, the competing trade marks will be verbalised as two word trade marks in which the first word is identical, resulting in a medium degree of aural similarity between them. However, although much less likely in my view, if the word “Cussons” is verbalised, the degree of aural similarity reduces to a between low and medium degree.

Conceptual similarity

68. The overall concept conveyed by the applicant’s trade mark will be of an imperial crown, whereas the words “IMPERIAL LEATHER” in the opponent’s trade mark is likely to evoke, for example, the concept of leather suitable for an emperor or empress. To the extent that both trade marks contain the word “Imperial”/“Imperial”, they are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

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

Inherent distinctive character

70. Other than the words “MASTER PERFUMERS” (which I have already concluded are laudatory in nature), there is nothing to suggest that the words “Cussons”, “IMPERIAL LEATHER” or the device component in the opponent’s trade mark are descriptive of, or non-distinctive for, the goods upon which it relies. The opponent’s trade mark as a whole and in particular the words “IMPERIAL LEATHER” are, absent use, possessed of at least a medium degree of inherent distinctive character.

Enhanced distinctiveness

71. The opponent’s evidence shows that the trade mark upon which I am conducting the comparison has been used by it (in varying colour combinations) in relation to what it describes as “soaps, hand wash, shower gels and creams, bath gels and creams, oil body wash, bath soak and bath creams, deodorant and talc powder...” I am satisfied that in relation to such goods, the use the opponent has made of its trade mark mentioned earlier in this decision will have built upon its inherent distinctiveness, resulting in a trade mark possessed of a high degree of distinctive character.

Likelihood of confusion

72. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

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

74. Earlier in this decision I concluded that:

- the opponent has made genuine use of its first, second and third earlier trade marks in relation to the goods shown in paragraph 34 and that a fair specification for each is as shown in paragraph 38;
- my comparison would be based upon the fourth earlier trade mark which is not subject to proof of use;
- where not identical, the applicant's goods in class 3 are similar to the opponent's goods to a high degree;
- the applicant's remaining services in class 35 are similar to the opponent's goods to a medium degree;

- the average consumer is a member of the general public who, whilst not ignoring aural considerations, will select the goods and services by predominantly visual means whilst paying, in the main, a normal (medium) degree of attention during that process;
- the competing trade marks are visually similar to a between low and medium degree, aurally similar to at least a between low and medium degree (and much more likely aurally similar to a medium degree) and conceptually similar to a medium degree;
- the opponent's earlier trade mark is inherently distinctive to at least a medium degree and, in relation to soaps, hand wash, shower gels and creams, bath gels and creams, oil body wash, bath soak and bath creams, deodorant and talcum powder, distinctive to a high degree.

75. In reaching a conclusion, I shall begin by considering the position based upon the inherent distinctiveness of the fourth earlier trade mark and, in doing so, I remind myself that I have concluded that the visual aspect of the comparison is the most important. In those circumstances and notwithstanding the identity/high degree of similarity in the competing goods and the medium degree of similarity in the services, the various visual and aural differences between the competing trade marks are, in my view, sufficient for an average consumer paying even a low degree of attention during the purchasing process not to mistake one trade mark for the other. That conclusion is even stronger when one considers that earlier in this decision I concluded that the average consumer will pay a medium degree of attention (thus making him/her less susceptible to the effects of imperfect recollection). In short, there is no likelihood of direct confusion.

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

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

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

78. In its written submissions, the opponent states:

“41 Considering the global appreciation of the marks in conflict, it is clear that the overall impression produced by the respective parties' marks is confusingly similar, the public is likely to believe that the Application is one of the Opponent's brands or sub-brands.”

79. Considered in isolation, the words “LEATHER” and “Crown” will evoke different and unrelated concepts in the mind of the average consumer. However, the degree of visual and aural similarity between the competing trade marks stemming from the fact that both contain the word “IMPERIAL”/“Imperial”, combined with the fact that the presence of that word in both trade marks will evoke what I regard as the somewhat unusual concept of an empire in the mind of the average consumer is, I agree with the opponent, likely to result in such a consumer concluding that the applicant's trade mark is a sub-brand related to the opponent's trade mark. As such

a mistake on the average consumer's part will result in indirect confusion, the opposition to the remaining goods and services succeeds accordingly. The fact that the fourth earlier trade mark's inherent credentials will have been enhanced in relation to the goods mentioned, is a further point leading to the same conclusion.

The three earlier trade marks subject to proof of use

80. Finally, having reached that conclusion in relation to the fourth earlier trade mark and as the opponent's other earlier trade marks which are subject to proof of use place it in no better position, I need say no more about them.

Conclusion under section 5(2)(b)

81. The opposition has succeeded in relation to all the goods in class 3 and all of the opposed services in class 35 with the exception of:

Mail order retail services connected with candles, fragranced candles; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.

The objection based upon section 5(3) of the Act

82. Having found for the opponent under section 5(2)(b) of the Act in relation to the vast majority of the goods and services which have been opposed, it is only strictly necessary for me to consider the alternative ground based upon section 5(3) of the Act in relation to those services in class 35 I have found not to be similar to the opponent's goods i.e. those specifically identified in paragraph 81. However, in the event my decision based upon section 5(2)(b) of the Act is the subject of an appeal, insofar as it is necessary, I will consider the ground in its entirety.

83. The relevant case law can be found in the following judgments of the CJEU: *Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L'Oreal v Bellure* and *Case C-323/09, Marks and Spencer v Interflora*. The law appears to be as follows:

- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.
- (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.
- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

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

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

84. In *General Motors*, Case C-375/97, the CJEU held:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

85. In Case C-408/01, *Adidas-Salomon*, the CJEU held:

"28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

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

86. In determining whether the public will make the required mental 'link' between the competing trade marks, the following factors in *Intel* are to be considered: (i) the degree of similarity between the conflicting trade marks, (ii) the nature of the goods or services for which the conflicting trade marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public, (iii) the strength of the earlier trade mark's reputation, (iv) the degree of the earlier trade mark's distinctive character, whether inherent or acquired through use, and (v) whether there is a likelihood of confusion.

87. Based upon the evidence filed, by the relevant date i.e. April 2020, at the very least the opponent's third earlier trade mark had, in relation to the goods shown in

paragraph 34, the necessary reputation in the UK to get this objection off the ground. Having considered the majority of the relevant factors identified in paragraph 86 under section 5(2)(b) of the Act in relation to the fourth earlier trade mark (which I will bear in mind in relation to the third earlier trade mark), I am further satisfied that the similarities between the competing trade marks are sufficient for a link to be formed in the mind of the average consumer. The opponent's evidence shows that goods sold under its trade mark are, for the most part, well-regarded by the general public and evoke within many of them, inter alia, a sense of nostalgia. Having already concluded there is a likelihood of indirect confusion in relation to all the goods in class 3 and the vast majority of the services in class 35 in relation to the fourth earlier trade mark, the transfer of the image of quality and nostalgia associated with goods for which the opponent's trade mark has a reputation to the applicant's goods and services in relation to which I have already found a likelihood of indirect confusion, will lead the applicant to gain, at least, an unfair advantage of the type envisaged by the opponent at paragraph 4 of this decision. As it is only necessary for the opponent to succeed under one of the heads of damage under section 5(3) of the Act, the opposition based upon section 5(3) also succeeds in relation to those goods and services where I have found there to be a likelihood of indirect confusion.

88. However, having considered the above factors in relation to the applicant's "Mail order retail services connected with candles, fragranced candles; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class", and given, in particular, what I regard as the lack of proximity between the goods in relation to which the opponent enjoys a reputation and the applicant's services, I am not satisfied that the opponent's trade mark would be brought to mind i.e. no link will be created in the relevant public's mind. Without a link there can be none of the adverse consequences for the opponent contemplated by this section of the Act and, as a consequence, the opposition to these services fails and is dismissed accordingly.

Overall conclusion

89. The opposition has succeeded in relation to the following goods and services:

Class 3

Perfumery; perfumes; fragrances; cosmetics; toiletries; make-up; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances; pomades; pomades for cosmetic purposes; hair pomades; lip pomades; essential oils; parts and fittings for any or all of the aforesaid goods in this Class.

Class 35

Retail services connected with the sale of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, including from an Internet website; shop retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions; the bringing together, for the benefit of others, of a variety of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, enabling customers to conveniently view and purchase those goods, including from an Internet website specialising in the same; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions; electronic shopping retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions; mail order retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.

And failed in relation to:

Class 35 - Mail order retail services connected with candles, fragranced candles; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.

90. The following goods and services were not opposed and may proceed to registration regardless:

Class 4 - Candles, fragranced candles; aromatherapy fragrance candles; parts and fittings for any or all of the aforesaid goods in this Class.

Class 35 - Retail services connected with the sale of candles, fragranced candles and aromatherapy candles, including from an Internet website; shop retail services connected with candles, fragranced candles and aromatherapy candles; the bringing together, for the benefit of others, of a variety of candles, fragranced candles and aromatherapy candles, enabling customers to conveniently view and purchase those goods, including from an Internet website specialising in the same; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase candles, fragranced candles and aromatherapy candles; electronic shopping retail services connected with candles, fragranced candles and aromatherapy candles; mail order retail services connected with aromatherapy candles; consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.

Costs

91. As the opponent has been overwhelmingly successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice 2 of 2016. Applying the above guidance but making a small reduction (on a “rough and ready” basis) to reflect the very limited nature of the applicant’s success, I award costs to the opponent on the following basis:

Filing the Notice of opposition and reviewing the counterstatement:	£400
Official fee:	£200
Filing of evidence:	£500
Written submissions:	£300

Total:

£1400

92. I order Thameen Limited to pay to PZ Cussons (International) Limited the sum of **£1400**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of July 2021

C J BOWEN

For the Registrar

The goods and services applied for:

Class 3

Perfumery; perfumes; fragrances; cosmetics; toiletries; make-up; fragrances for the person; fragrances for the home; fragrances for personal use; room fragrances; fragrance preparations; aromatics for fragrances; pomades; pomades for cosmetic purposes; hair pomades; lip pomades; essential oils; parts and fittings for any or all of the aforesaid goods in this Class.

Class 4

Candles, fragranced candles; aromatherapy fragrance candles; parts and fittings for any or all of the aforesaid goods in this Class.

Class 35

Retail services connected with the sale of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles, including from an Internet website; shop retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; the bringing together, for the benefit of others, of a variety of perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles, enabling customers to conveniently view and purchase those goods, including from an Internet website specialising in the same; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; electronic shopping retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced candles and aromatherapy candles; mail order retail services connected with perfumery, perfumes, fragrances, cosmetics, toiletries, body lotions, candles, fragranced

candles and aromatherapy candles; **consultancy, advisory and information service, for or in relation to any of the aforesaid services in this Class.**

The opponent's earlier trade marks/goods relied upon

UK no. 879288 for the words **IMPERIAL LEATHER** (the “first earlier trade mark”) which was applied for on 11 May 1965.

Goods relied upon - Perfumes, toilet preparations (not medicated), cosmetic preparations, dentifrices, depilatory preparations, toilet articles (not included in other classes) sachets for use in waving the hair, toilet soaps and essential oils. in so far as they relate to goods for export. Perfumes, toilet preparations (not medicated), cosmetic preparations, dentifrices, depilatory preparations, toilet articles (not included in other classes) sachets for use in waving the hair, toilet soaps and essential oils. except in so far as they relate to goods for export.

UK no. 2258230 for the trade mark shown below (the “second earlier trade mark”) which was applied for on 17 January 2001 and registered on 21 December 2001:



Goods relied upon - Non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; shower gels and shower creams; bath creams and bath foams; soap; deodorants and anti-perspirants; talc; shaving preparations; after-shave preparations; perfumes, eau de toilettes and after-shaves; hair preparations; shampoos.

UK no. 3014453 for the trade mark shown below (the “third earlier trade mark”) which was applied for on 18 July 2013 and registered on 18 October 2013:



Goods relied upon - Non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; body creams, milks, lotions; massage oils; aromatic and fragrance preparations; hand creams; emollient creams and washes; soap; liquid soap; personal cleaning wipes; bath creams; bath foams; bath salts; bath oils; bath herbs; bath wash; bubble bath; shower gels; shower creams; shaving preparations; shave gels; shaving creams; shaving foams; after-shave preparations; talc; deodorants and anti-perspirants; hair preparations; hair care preparations; shampoos; conditioners; combined shampoo and conditioners; hair lotions; hair colouring preparations; hair straightening preparations; hair sprays; hair mousses; hair lacquers; foot sprays; perfumes, eau de toilettes; essential oils; stretch mark creams.

UK no. 3360286 for the trade mark shown below (the “fourth earlier trade mark”) which was applied for on 12 December 2018 and registered on 8 March 2019:



Goods relied upon - Non-medicated toilet preparations; preparations for cleansing the skin; preparations for cleansing the skin and having anti-bacterial properties; facial and body moisturising preparations; body creams, milks, lotions; massage oils; aromatic and fragrance preparations; hand creams; emollient creams and washes; soap; liquid soap; personal cleaning wipes; bath creams; bath foams; bath salts; bath oils; bath herbs; bath wash; bubble bath; shower gels; shower creams; shaving

preparations; shave gels; shaving creams; shaving foams; after-shave preparations; talc; deodorants and anti-perspirants; hair preparations; hair care preparations; shampoos; conditioners; combined shampoo and conditioners; hair lotions; hair colouring preparations; hair straightening preparations; hair sprays; hair mousses; hair lacquers; foot sprays; perfumes, eau de toilettes; essential oils; stretch mark creams.