

O/0724/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003968811

BY GUANGZHOU XIKA TECHNOLOGY CO., LTD.

TO REGISTER:

CKA

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 445575 BY

CALVIN KLEIN TRADEMARK TRUST

BACKGROUND AND PLEADINGS

1. On 18 October 2023, Guangzhou Xika Technology Co., Ltd. (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 27 October 2023 and registration is sought for the following goods and services:

Class 3: Bath preparations, not for medical purposes; polish for furniture and flooring; essential oils; potpourris [fragrances]; air fragrancing preparations; beauty masks; essences for skin care; cleaning preparations; abrasives; cosmetics; cosmetics for animals; toothpaste; facial cleansers; body lotions.

2. On 29 January 2024, the applicant’s mark was opposed by Calvin Klein Trademark Trust (“the opponent”). The opposition is based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following marks:



UK registration no. 918021272

Filing date 11 February 2019; registration date 15 June 2019

Relying on all goods, namely:

Class 3: Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair;

shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations; oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.

("the opponent's first mark");



UK registration no. 3374267

Filing date 11 February 2019; registration date 3 May 2019

Relying on all goods, being those identical to the opponent's first mark's specification.

("the opponent's second mark");

CK BE

UK registration no. 900117515

Filing date 1 April 1996; registration date 30 April 1998

Relying on all goods, namely:

Class 3: Cosmetics and toiletries namely, eau de toilette; personal deodorants and anti-perspirants.

("the opponent's third mark");

CK ONE

UK registration no. 900117580

Filing date 1 April 1996; registration date 18 June 1998

Relying on some goods, namely:

Class 3: Cosmetics and toiletries namely, eau de toilette; skin moisturizer and skin care preparations, body lotions and creams, bath and shower gel; personal deodorants and anti-perspirants.

("the opponent's fourth mark"); and

CK ALL

UK registration no. 801322613

Filing date 1 September 2016; registration date 11 May 2017

Priority date: 23 June 2016 (US)

Relying on all goods, namely:

Class 3: Eau de toilette.

("the opponent's fifth mark").

3. The opponent's first, third, fourth and fifth marks are all comparable marks based on earlier EUTMs or International Registrations ("IR") designating the EU. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs or IRs designating the EU. These comparable marks enjoy the same filing and registration dates as their European counterparts.
4. The opponent's position under its section 5(2)(b) ground is that the marks are highly similar and that the goods at issue are identical or highly similar. In addition, the opponent relies on a claim that its earlier marks enjoy an enhanced degree of

distinctiveness and that they constitute a family of marks. As a result, the opponent claims that a likelihood of confusion between the marks at issue is inevitable.

5. Under the section 5(3) ground, the opponent claims that its marks enjoy a reputation. In respect of the goods in which this reputation vests, the opponent relies on the goods underlined above in respect of its first and second marks. Further, the opponent relies on all of the goods listed above in respect of its third through fifth marks. The opponent's position is that its reputation, together with the similarity of the marks and the identity/similarity of the goods, will lead the consumer to believe that the marks at issue are economically connected. It is, therefore, claimed that use of the applicant's mark would take unfair advantage of the reputation of the opponent's marks. In addition, the opponent claims that use of the applicant's mark would cause detriment to the reputation and/or distinctive character of its earlier marks. Lastly, it is noted that under this ground the opponent also relies on the family of marks argument.
6. The applicant filed a counterstatement wherein it denied the claims against it in detail. It is noted that the applicant also made a request that the opponent provide proof of use for all of its marks. As the opponent's first and second marks are not subject to the use provisions (a point I will discuss further where necessary below), this request applies only to the third through fifth marks.
7. The applicant is represented by Handsome I.P. Limited and the opponent is represented by Haseltine Lake Kempner LLP. Only the opponent filed evidence in chief. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying

assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

9. The opponent's evidence in chief came in the form of the witness statements of Dawn Buonocore-Atlas and Amanda Mallon, dated 4 June 2024 and 5 June 2024, respectively. I will deal with these statements in turn.

10. Ms Buonocore-Atlas is the Vice President, Enforcement and General Counsel of Calvin Klein, Inc. It is confirmed in her statement that Calvin Klein, Inc. acts as a servicer for the opponent and acts under a power of attorney for the same. Ms Buonocore-Atlas has been involved with the opponent for over 25 years. Ms Buonocore-Atlas's statement is accompanied by 42 exhibits, being DBA1 to DBA42, and was adduced in order to demonstrate that the opponent's marks have been genuinely used and that they enjoy a reputation in the relevant territory. In respect of the use of the marks, it is noted that the use covered by the evidence is by both the opponent itself and under license by COTY UK&I LTD. While no license covering this agreement has been provided, this is not strictly necessary and I may, instead, take the statement by Ms Buonocore-Atlas as confirmation of the same. As a result, I accept that any use by this third-party is with the consent of the opponent. For ease of reference, however, I will simply refer to any use by either party as simply use by the opponent.

11. Turning to Ms Mallon's evidence, I note that she is a trade mark attorney and Partner at the opponent's representative firm. Ms Mallon's evidence is accompanied by three exhibits, being AM1 to AM3, and was adduced in order to demonstrate that the goods at issue are similar.

12. I do not intend to summarise the opponent's evidence in full here (or its submissions, for that matter). However, I confirm that I have taken all filed

documents into account and will summarise them to the extent that I deem necessary below.

DECISION

Proof of use

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

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

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

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

14. Section 6A is also relevant. It reads:

“(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), (aa) 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)-(5A) [Repealed]

(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. Section 100 of the Act is also relevant. It reads:

“100. 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. Given their earlier filing dates, the opponent’s marks all qualify as earlier trade marks under the above provisions. As set out above, the applicant requested that the opponent provide proof of use in respect of all of its marks. However, given that

the opponent's first and second marks completed their registration process less than five years prior to the filing date of the applicant's mark, they are not subject to the use provisions set out above. The opponent can, therefore, rely on all of the goods highlighted in its notice of opposition. As a result, it is only the opponent's third, fourth and fifth marks that are subject to the use provisions on the basis that they completed their registration processes more than five years prior to the filing date of the applicant's mark.

17. As the opponent's marks that are subject to the proof of use provisions are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

"7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, 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 Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], 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], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles 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]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods

and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

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

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

19. Section 6A of the Act (cited above) confirms that the relevant period for the present assessment is the five-year period ending with the filing date of the applicant’s mark, being 18 October 2023. The relevant period is, therefore, 19 October 2018 to 18 October 2023.

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”¹ because the use would not be “viewed as warranted in the

¹ *Jumpman* BL O/222/16

economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Evidence of use

21. The marks at issue here are ‘CK BE’, CK ONE’ and ‘CK ALL’ (being the opponent’s third, fourth and fifth marks, respectively). The opponent has helpfully broken down its evidence so as to cover each of these brands individually. For ease of reference, I will summarise the evidence under separate sub-headings below.

CK BE

22. The evidence sets out that the opponent sells fragrances and body sprays under this mark. Images of such products are shown in evidence.² The mark shown on these goods is presented as the letters ‘ck’ in a large font above the word ‘be’, which is presented smaller. I do not consider that much turns on this as ‘CK BE’, as a whole, will still be deemed as an indicator of origin for the goods. Therefore, this is use of the mark as registered.³ However, if this is incorrect, it is my view that the different presentation does not alter the distinctive character of the mark.⁴

23. In respect of this brand, the evidence confirms that between 2018 and 2023, the opponent accrued an approximate turnover of £6,753,659 in the UK. In support of this, the opponent has provided a number of example invoices.⁵ These cover sales to recipients across the UK in locations such as Manchester, London and Southampton.

24. In addition, it is confirmed that the ‘CK BE’ goods have been sold via a number of large UK retailers such as Boots and Next. A list showing the UK retailers that sell

² DBA02

³ In accordance with the principle set out in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

⁴ As per the guidelines set out in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

⁵ DBA03

these goods is provided in evidence.⁶ I do not intend to repeat it in full here but I note that, as well as Boots and Next, it covers popular retailers such as Amazon, House of Fraser, Harrods, Superdrug and The Fragrance Shop. In support of this, the opponent has provided a number of screenshots taken from various retailers' websites showing the 'CK BE' products listed for sale. These screenshots were obtained from the internet archive facility, the Wayback Machine, and are dated between 12 November 2018 and 28 January 2022. The products shown are in line with the same products shown in the images discussed at paragraph 22 above.

25. I note that the opponent's 'CK BE' brand is shown in the December 2022 copy of 'Red Magazine'.⁷ While I am not aware of the reach of this magazine, I note that the opponent has provided a report setting out that the total brand reach for this magazine was 904,000 between January and December 2022.⁸

CK ONE

26. The evidence in respect of this brand follows a similar template to that of 'CK BE'. Firstly, the evidence confirms that, under this branding, the opponent sells fragrances, body lotions, deodorants, body sprays, body wash and skin moisturisers. Images of these products are shown in evidence.⁹ The branding shown here is similar to that for 'CK BE', being the letters 'ck' presented in a standard, large typeface with the word 'one' in a smaller font placed below it. As was the case above, I accept that this is either use of the mark as registered or as an acceptable variant of the same.

27. In respect of turnover, the opponent confirms that between 2018 and 2023, it accrued total sales worth approximately £45,765,442 in the UK. Again, in support

⁶ DBA04

⁷ DBA06

⁸ DBA42

⁹ DBA11

of this, a number of invoices have been provided.¹⁰ These show sales to customers in Nottingham, Liverpool, London, Macclesfield and Surrey.

28. As was the case with 'CK BE', the opponent has provided a list of retailers that sell 'CK ONE' products in the UK.¹¹ The narrative evidence, again, refers to Boots and Next. Having considered the printout provided, it repeats a number of retailers that were included on the 'CK BE' printout. However, I note that it includes additional large retailers such as John Lewis and Sephora.

29. Images of the 'CK ONE' products in situ in stores are shown in evidence.¹² This includes photographs of stands bearing the 'CK ONE' mark in Boots in November 2018 and in November and December 2022. On this point, I note that there are also images of the goods displayed in the Perfume Shop in October and December 2022, the Fragrance Shop in November and December 2022 and Superdrug in November and December 2022.¹³ In addition, screenshots taken from the Wayback Machine are provided showing the goods listed for sale on various retailers' websites.¹⁴ The printouts are dated 12 November 2018 to 8 December 2022. The goods shown include deodorants (including sticks and sprays), shower gel, eau de toilette and moisturiser. Lastly in respect of website evidence, I note that the opponent has provided screenshots taken from its own website (again from the Wayback Machine) that shows the goods as they appeared on the website between 12 March 2019 and 26 August 2022.¹⁵ In respect of this evidence, I confirm that the branding appears consistent with the branding I have discussed at paragraph 26 above.

30. The opponent sets out that it has been advertising its 'CK ONE' brand since 1994. On this point, I note that various social media posts advertising the brand are

¹⁰ DBA12

¹¹ DBA13

¹² DBA14

¹³ DBA20

¹⁴ DBA15

¹⁵ DBA16

shown in evidence.¹⁶ This includes posts by influencers, some of which are highlighted as being in paid partnership with Calvin Klein. While the level of exposure of some of these posts is at a high level, I have nothing to suggest who these influencers are and what their reach is across the relevant territory of the EU prior to IP Completion Day or the UK thereafter.

31. In terms of promotion, the opponent's 'CK ONE' goods are shown as receiving various press coverage in the evidence. This is shown via printouts of publications such as Elle Beauty (in March 2021), Heat Magazine's style section (in July 2022) and S Magazine (in July 2022).¹⁷ In addition, there are screenshots taken from the online websites of publications such as Cosmopolitan UK, the Guardian, the Sun, Marie Claire and Vogue, amongst others.¹⁸ All of these printouts show 'CK ONE' products. In respect of these publications, I note that the opponent has provided evidence as to their reach across the UK. For example, Heat Magazine has a weekly circulation of 72,795.¹⁹ While noted, even without such evidence, I would have been willing to accept that these publications are all popular UK-wide publications that attract a significant level of readership.

CK ALL

32. The 'CK ALL' evidence, like the other brands above, begins with a reproduction of images showing how the goods are branded.²⁰ Again, this is with the letters 'ck' presented in large lettering above the word 'all', in a smaller typeface. I consider such branding is acceptable as either use of the mark as registered or as a variant of the same. The narrative evidence confirms that under this range, the opponent sells fragrances.

¹⁶ DBA19

¹⁷ DBA17

¹⁸ DBA21

¹⁹ DBA42

²⁰ DBA26

33. In terms of turnover, the opponent confirms that, under this brand, it generated sales in the UK between 2018 and 2023 for an approximate sum of £2,100,046. Invoices to customers in the UK are provided in evidence and I note that these include sales to recipients in Nottingham, London, Macclesfield and Liverpool.²¹
34. The evidence confirms that the goods are sold in retailers such as Boots and Next. As was the case with the other brands above, the opponent has provided a printout showing the retailers that stock the 'CK ALL' goods.²² This includes Sephora, Amazon and House of Fraser. Screenshots of the goods listed for all on various retailers' websites are provided and I note that these are dated between 30 September 2020 and 21 January 2021.²³ I can confirm that these screenshots show goods consistent with the packaging I have discussed at paragraph 32 above.
35. The 'CK ALL' brand is shown as achieving press coverage via articles from UK-wide publications.²⁴ While these include the Telegraph and the Stylist, both of these articles are from outside the relevant period (the former being dated 17 June 2017 and the latter bearing a printout date of 29 May 2024 with an article date of 'seven years ago', implying it was posted in 2017). The only article from within the relevant period is one from Harper's Bazaar dated February 2023. This publication is shown in evidence as having a monthly average circulation of 66,607 readers in 2023.²⁵

Assessment of the evidence

36. In considering the evidence as a whole, it is clear that the brands covered have quite considerably differing levels of sales. The opponent's fourth mark (being its

²¹ DBA27

²² DBA28

²³ DBA29

²⁴ DBA31

²⁵ DBA42

'CK ONE' brand) has achieved the highest level of use with turnover in the region of £46 million during the relevant period. As for the other two marks, being the third ('CK BE') and fifth marks ('CK ALL'), the use associated with them is much lower, being £6.7 million and £2.1 million, respectively, during that same time frame. In addition to this, the evidence has shown that all three brands have been sold via a range of popular UK-wide retailers during the relevant period.

37. Plainly, the level of use in relation to the opponent's fourth mark is sufficient to demonstrate that the opponent has genuinely used said mark during the relevant period. I say this because this brand achieved a turnover of approximately £46 million during the relevant period. Whilst I recognise that the market for the relevant goods is considerable, this still represents a significant level of turnover. Further, this brand was sold in large UK-wide retailers such as John Lewis, Boots and Next which is a point in favour of a finding of genuine use.

38. I turn now to the third and fifth marks. As above, these marks achieved a respective turnover of £6.7 million and £2.1 million throughout the entirety of the relevant period. When considered in the context of the market at issue (being the fragrance market), the turnover figures represent a relatively low level of use. I say this because whilst I have no evidence on the point, the relevant market is likely to involve goods that are sold at high volumes and at a high level of frequency. That being said, I remind myself that use need not be quantitatively significant in order for it to be deemed genuine. In support of the opponent's use in respect of these marks, I note that there have been efforts to sell the goods via popular UK-wide retailers. As a result, I am content to conclude that the opponent has genuinely used its fourth and fifth marks in the UK.

39. Turning to the terms that have been genuinely used in the UK, I am of the view that I can deal with this relatively briefly. I say this because the evidence is clear in that the opponent's third mark has been used for deodorants and perfume sprays only, its fourth mark has been used for perfume sprays, moisturisers, shower gels and

deodorants and its fifth mark has been used for perfumes only. For the avoidance of doubt, all of these products are shown as being for humans so I consider it appropriate to limit them accordingly. I do so on the basis that these terms, if unlimited, would cover use on animals or in homes, being uses of the goods that are not borne out in the evidence. In light of this, I find that the opposition in respect of these marks may proceed in respect of the following goods:

The opponent's third mark

Class 3: Cosmetics and toiletries namely, eau de toilette; personal deodorants; all of the aforesaid for human use.

The opponent's fourth mark

Class 3: Cosmetics and toiletries namely, eau de toilette; skin moisturizer, shower gel; personal deodorants; all of the aforesaid for human use.

The opponent's fifth mark

Class 3: Eau de toilette; all of the aforesaid for human use.

Section 5(2)(b): legislation and case law

40. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

41. Section 5A of the Act states as follows:

“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.”

42. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

43. The competing goods and services are as follows:

The opponent's goods	The applicant's goods and services
<p><i>The opponent's first and second marks</i></p> <p><u>Class 3</u> Soaps; detergents; bleaching preparations, cleaning preparations; perfumery, toilet water, aftershave, cologne; essential oils; aromatherapy products, not for medical use; massage preparations, not for medical use; deodorants and antiperspirants; preparations for the care of the scalp and hair; shampoos and conditioners; hair colourants; hair styling products; toothpaste; mouthwash, not for medical use; preparations for the care of the mouth and teeth; non-medicated toilet preparations; bath and shower preparations; skin care preparations;</p>	<p><u>Class 3</u> Bath preparations, not for medical purposes; polish for furniture and flooring; essential oils; potpourris [fragrances]; air fragrancing preparations; beauty masks; essences for skin care; cleaning preparations; abrasives; cosmetics; cosmetics for animals; toothpaste; facial cleansers; body lotions.</p>

<p>oils, creams and lotions for the skin; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations; cosmetics; make-up and make-up removing preparations; petroleum jelly; lip care preparations; talcum powder; cotton wool, cotton sticks; cosmetic pads, tissues or wipes; pre-moistened or impregnated cleansing pads, tissues or wipes; beauty masks, facial packs.</p> <p><i>The opponent's third mark</i></p> <p><u>Class 3</u> Cosmetics and toiletries namely, eau de toilette; personal deodorants; all of the aforesaid for human use.</p> <p><i>The opponent's fourth mark</i></p> <p><u>Class 3</u> Cosmetics and toiletries namely, eau de toilette; skin moisturizer, shower gel; personal deodorants; all of the aforesaid for human use.</p>	
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<p><i>The opponent's fifth mark</i></p> <p><u>Class 3</u></p> <p>Eau de toilette; all of the aforesaid for human use.</p>	
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44. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 that:

“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”.

45. 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.

46. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court 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 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.”

47. I have submissions from the opponent in respect of the goods comparison. Further, I note that the opponent has also filed evidence seeking to demonstrate a level of similarity between the goods at issue. The evidence is noted but I do not consider it of any real assistance to the opponent. I say this not as a criticism of the opponent but because said evidence seeks to demonstrate overlaps in factors that, in my view, do not require any evidence. For example, the evidence, at Exhibit AM01, seeks to demonstrate an overlap in trade channels between perfumes and shower gel. It is my view that this overlap is something that is common in the trade so is a finding I am capable of making without evidence.

48. While I do not have any submissions from the applicant, I note that it did provide comment on the goods comparison in its counterstatement. While I do not intend to reproduce the comments in full, I do note that the applicant has conceded that the following goods in its own specification are identical to some of the goods in the opponent's first and second marks' specifications:

“Bath preparations, not for medical purposes; essential oils; beauty masks; cleaning preparations; cosmetics; toothpaste.”

49. In addition, I note that “cosmetics” in the applicant’s specification is conceded as being similar to “cosmetics, namely eau de toilette” and “eau de toilette” in the opponent’s third through fifth mark’s specifications.

50. In respect of the position of both parties, I can confirm that while I will not reproduce the evidence, submissions or comments in full, I have taken them into account in making the following comparison. Before moving on to my comparison, for reasons that will become obvious below, I will endeavour to compare the applicant’s goods to goods across all of the opponent’s marks’ specifications.

Bath preparations, not for medical purposes; essential oils; beauty masks; cleaning preparations; cosmetics; toothpaste.

51. As above, these goods have been conceded as being identical to goods in the opponent’s first and second mark’s specification. It is on this basis that I will proceed.

52. In respect of the term “cosmetics”, I remind myself that the applicant conceded similarity between such a term and “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification. While noted, I am of the view that the opponent’s goods are types of cosmetics (especially given the categorisation as such in the term of the third and fourth marks) so will, therefore, fall within the broader term of the applicant. As such, I find that these goods are identical under the principle outlined in the case of *Meric*. If this is incorrect, I am of the view that the goods are similar to a medium degree. I say this because “cosmetics” is such a broad term it will inevitably cover goods applied to the skin which may also be intended to make the user smell nice (scented balms or creams, for example). As such, there is some

overlap in method of use and purpose. Further, the goods share an overlap in trade channels on the basis that a producer of various types of cosmetics is also likely to produce and sell perfumes. Such goods are likely to also be sold via the same retailers and, while not directly next to each other in stores, they will be found in the same sections. I consider that such practices are common in the trade. The goods will be sought by the same set of consumers meaning that they overlap in user too.

53. As for the terms “*bath preparations, not for medical purposes*”, “*essential oils*”, “*beauty masks*” and “*cleaning preparations*”, I consider that they share a degree of similarity with the terms “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification. My reasoning for this follows my back up finding in the preceding paragraph, namely that there is some overlap in method of use and purpose as well as overlaps in trade channels and user. As such, I consider that these goods are similar to a medium degree.

54. Lastly, I am of the view that “toothpaste” is dissimilar to the terms in the opponent’s third through fifth marks’ specifications. Firstly, the goods differ in nature, method of use and purpose with “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification. This is because toothpaste is commonly a thick paste applied to a toothbrush that is then brushed into the teeth and gums for the purpose of cleaning the user’s teeth. The same cannot be said for the opponents’ goods. While these goods will be sold via the same retailers (such as larger pharmacies and supermarkets, for example), this is not sufficient to give rise to a meaningful overlap in trade channels. If it were, I consider that this would offer far too broad a level of protection for any goods that are sold in large retail environments. Further, the goods will all be selected by members of the general public at large. However, given the broad nature of these userbases, I consider that any overlap in user is fleeting.

Essences for skin care; facial cleansers; body lotions.

55. All of the above goods are types of cosmetics and, as such, they are identical under the principle outlined in *Meric* with the term “cosmetics” that appears in the opponent’s first and second mark’s specification.

56. In addition, I consider that the above goods share a degree of similarity with the terms “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification. I say this because these goods share some overlaps in method of use and purpose, being goods that are applied to the skin that may be used to enhance the user’s smell. Further, they share an overlap in trade channels on the basis that a producer of various types of cosmetics will also produce and sell perfumes, for example. Such goods are likely to also be sold via the same retailers and, while they will not commonly be placed directly next to each other in stores, they will be found in the same sections. On this point, I appreciate that these goods may also be sold together as part of a set. Lastly, the goods will be sought by the same set of consumers meaning that they overlap in user too. Taking all of this into account, I consider that these goods are similar to a medium degree.

Abrasives.

57. It is my primary view that an ‘abrasive’ in class 3 can cover goods that utilise abrasive materials that are used to remove dead skin cells so as to smoothen the skin. The above term can, therefore, cover a type of cosmetic such as exfoliating creams, for example. As such, I find that it falls within the term “cosmetics” in the opponent’s first and second marks’ specification meaning that these goods are identical under the principle outlined in *Meric*. However, if this is incorrect and abrasives are intended to cover implements such as emery boards or nail files (being goods with abrasive qualities) and not abrasive cosmetics such as

exfoliating cream, I consider that these goods will only be similar to a low degree. This is because such goods clearly differ in nature, method of use and purpose. However, they will overlap in trade channels and users. In respect of trade channels, I consider it likely that producers of cosmetics will also produce cosmetic implements such as emery boards and nail files. Further, those goods are likely to be selected by the same sets of consumers as those looking to file their nails or remove dead skin from their feet, for example, will also require some form of nail care or skin care cosmetic to apply afterwards.

58. It is my view that “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification also share a low degree of similarity with the above goods. I say this because undertakings that produce a variety of goods such as perfumes will also produce abrasive goods in class 3 (regardless of whether those goods are intended to cover exfoliating creams or nail files). As such, I find that the overlap in trade channels remains at play here. Further, such goods will be selected by the same consumers, being members of the general public at large, especially those with an interest in health and beauty.

Cosmetics for animals.

59. While the above term covers goods used for animals, the term “cosmetics” in the opponent’s first and second marks’ specifications is not limited in anyway so may, therefore cover cosmetics for animals. As such, the above term of the applicant is encompassed by the opponent’s goods, meaning that these goods are identical under the principle outlined in *Meric*.

60. As I have set out above, the goods in the remaining marks of the opponent are limited to exclude perfumes or deodorants for animals. So while the applicant’s term may cover goods that improve the smell of animals (such as perfume for animals, for example), I find that they are incapable of covering the same goods

as “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification. Despite this, I consider that there is some degree of overlap in nature with the aforementioned goods of the opponent. That being said, it is my understanding that the actual ingredients used are likely to differ to a degree as those in the applicant’s goods will be tailored for use on animals. Therefore, any overlap in nature is likely to be limited. As for the method of use and purpose, I am of the view that as the applicant’s goods may technically cover perfumes, there is some degree of overlap here in that they are goods sprayed onto the recipient with the intention to make them smell nice. Again, any overlap is limited to a degree due to the intention for use on humans or animals. In respect of trade channels, I am of the view that this differs and I have nothing to suggest that producers of cosmetics for animals will also produce and sell perfumes for humans. As for user, I accept that those who select the applicant’s goods will also buy perfume for themselves. However, I do not consider that this is a material overlap. Overall, I am of the view that the limited overlaps are only sufficient to give rise to that these goods are similar to a low degree.

Potpourris [fragrances]; air fragrancing preparations.

61. The above goods are those that are used to fragrance a space or room. The opponent’s first and second marks cover “perfumery” at large. Such a term is not limited to use on the human body so may, therefore, technically cover the above goods. As a result, I find that the above goods are identical under the principle outlined in *Meric* with the opponent’s term.

62. The goods in the remaining specifications of the opponent are all limited to use on the human body. That being said, they are still similar to a degree with the above goods. I say this because both of the above terms and “cosmetics and toiletries namely, eau de toilette” in the opponent’s third and fourth marks’ specifications and “eau de toilette” in its fifth mark’s specification are perfumery goods so there is

some, albeit limited, degree of overlap in nature. Additionally, while the applicant's goods are for making a room/space smell nice whereas the opponent's are for human use, there is some general overlap in purpose as both parties' goods are intended to make something (be that a room or a person) smell nice. In addition, as far as I understand it, an undertaking that produces and sells perfumes for the body is also likely to sell perfume goods for use in the home. Such goods will be found in the same retail environments. Further, the goods will be selected by the same user as someone seeking to fragrance themselves is also likely to fragrance their home. As a result, I find that these goods are similar to a medium degree.

Polish for furniture and flooring.

63. The opponent's submissions set out that the above term is similar to those covered by the opponent's mark. While it has not specifically identified which term in its own specifications cover the above goods, I note that the opponent's first and second marks include the term "cleaning preparations". This is not limited in any way so may be said to be a cleaning preparation for use in the home which, can include various types of polish. As a result, I find that these goods are identical under the principle outlined in *Meric*.

64. Turning to the opponent's third through fifth mark's specifications, I see no reason why any of the goods within these specifications share any obvious overlaps with the above. In short, the applicant's term covers goods used to clean furniture and the floor. Such goods do not overlap in nature, method of use or purpose with the opponent's "cosmetics and toiletries namely, eau de toilette" or "eau de toilettes". While large supermarkets may sell both types of goods, this is not sufficient to give rise to a meaningful overlap in trade channels. As for user, the userbases for both parties' goods are so broad that any overlap here is fleeting. Lastly, I do not consider that there is any degree of competition or complementarity between these goods. As a result, I find that the above goods are dissimilar.

The average consumer and the nature of the purchasing act

65. The case law, as set out earlier, requires that I determine 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 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. (as he then was) 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.”

66. The opponent submits that the average consumer of the goods at issue is the general public at large. I agree. In terms of the method of selection, the goods will be available via general retailers such as pharmacies, supermarkets and perfume shops. I also find that the goods relating to animals may be selected from pet shops or, even though they are not medical in nature, acquired from veterinarians. The goods will be displayed on shelves or in glass cabinets where they will be self-selected by the consumer. In addition, I note that the goods will also be available online where they will be selected after the consumer views an image on a webpage. In both scenarios, the visual component will dominate the selection process, though I do not discount an aural component playing a role via word-of-mouth recommendations, advice from sales assistants or, in the case of the goods relating to animals, advice from veterinarians.

67. The goods at issue will range in cost and frequency, including frequently selected cheap goods such as toothpaste as well as more expensive and infrequently selected perfumes. These are all goods used on the human body or in the home (such as potpourri and polishing goods, for example) so regardless of their price, the consumer will consider a range of factors. These factors include consideration as to the ingredients of the products, their purpose, their cleaning properties (for cleaning preparations, for example) their scent (for perfume goods), their suitability for the animal involved (for the animal goods only) and whether they have been tested on animals (for the goods that are used on the human body). In respect of the level of attention paid, the opponent submits that the consumer will pay an average degree of attention. In light of the range of factors discussed above, I agree. That being said, I would instead categorise this as a medium degree of attention.

Comparison of the marks

68. It is clear from *Sabel 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 the trade marks, bearing in mind their distinctive and dominant components.


69. 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.”

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

71. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 <p data-bbox="309 1144 778 1234">("the opponent's first and second mark")</p> <p data-bbox="496 1308 595 1341">CK BE</p> <p data-bbox="341 1361 750 1397">("the opponent's third mark")</p> <p data-bbox="483 1473 608 1507">CK ONE</p> <p data-bbox="331 1527 759 1563">("the opponent's fourth mark")</p> <p data-bbox="488 1639 603 1673">CK ALL</p> <p data-bbox="347 1693 743 1729">("the opponent's fifth mark")</p>	<p data-bbox="1086 1303 1153 1337">CKA</p>

72. As was the case with the goods comparison above, I have submissions from the opponent as well as comments from the applicant via its counterstatement. While

I will not reproduce those submissions/comments here, I can confirm that I have taken these into account

Overall impression

73. The applicant's mark is a word only mark that consists of the three letters 'CKA'.

The mark has no other elements that contribute to its overall impression, which lies across the letters equally.

74. The opponent's first and second marks are identical. They are figurative marks that consists of the letters 'ck'. The letter 'c' is slightly smaller than the letter 'k', with both being presented in a standard black typeface. While not a point raised by the applicant, I would be remiss if I did not mention the fact that integrated into the vertical line of the letter 'k', there appears to be a number '1'. For the avoidance of doubt, this is something I have picked up on after a detailed consideration of the marks and having considered the evidence (which includes these marks) in detail. I am of the view that this element is something that will be ignored by the majority of consumers.²⁶ As such, I find that the overall impression of the mark lies in the letters 'ck', with the presentation and stylisation used playing a very minor role. For the avoidance of doubt, the number '1' does not form part of this presentation or stylisation.

75. The opponent's third through fifth marks are all word only marks. They are, respectively, 'CK BE', 'CK ONE' and 'CK ALL'. I see no reason to find that 'CK' dominates these marks as the words 'BE', 'ONE' or 'ALL' are not descriptive or allusive to opponent's goods. Further, the use of two single letters, being 'CK', is not particularly remarkable to the point that it dominates these marks. As such, I

²⁶ On this point, I will say that even if some consumers do perceive the number '1', they will not constitute a significant proportion. As such, it follows that a significant proportion of consumers will not notice this and it is upon these consumers that I will focus. I do so because it represents the opponent's best case and, as per the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, I am entitled to find confusion if it is found that a significant proportion of consumers are confused.

consider that the overall impressions of these marks lie equally across both the 'CK' and word elements.

Visual comparison

76. The opponent's first and second marks are figurative representations of the letters 'ck'. The applicant's mark is a word only mark that can be used in any typeface. Visually, the marks share the letters 'ck' but differ in the presence of the letter 'A' at the end of the applicant's mark. While the presence of the letter 'A' will not go unnoticed, I am of the view that the identical letters, especially given their placement at the beginning of the applicant's mark,²⁷ are a significant point of similarity that lead me to find that the marks are visually similar to between a medium and high degree.

77. In comparing the applicant's mark with the remaining marks of the opponent, I note that they too share the letters 'CK' at the beginnings of the marks. These marks differ in the presence of the letter 'A' in the applicant's mark and the words 'BE', 'ONE' and 'ALL' in the opponent's marks. On balance, I am of the view that the identical beginnings of the marks are sufficient, despite the differences in the marks, to give rise to a finding that the marks at issue are visually similar to a medium degree.

Aural comparison

78. Aurally, the opponent's first and second marks will be pronounced as a combination of its letters, being 'C-K'. The same goes for the applicant's mark, being 'C-K-A'. The marks' first two syllables are clearly identical whereas the third syllable in the applicant's mark has no counterpart in the opponent's marks. I consider that the identity of the first two elements is significant but as was the case

²⁷ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

with the visual comparison above, the letter 'A' will not be overlooked. As a result, I find that these marks are similar to be aurally similar to between a medium and high degree.

79. Turning to the opponent's third through fifth marks, these are all three syllables in length and will be pronounced as the two letters 'C' and 'K' followed by the words 'BE', 'ONE' and 'ALL', all of which will be pronounced in the ordinary way. As above, the applicant's mark will be pronounced as a combination of its letters. The marks are of the same lengths and while their first two syllables are identical, the third syllables across all marks differ entirely.²⁸ It is my view that this additional point of difference in the opponent's mark is sufficient to lower the level of aural similarity to below that I have found in the preceding paragraph. Overall, it is my view that these marks are aurally similar to a medium degree.

Conceptual comparison

80. The applicant's mark, being 'CKA', will be viewed as an initialism with no obvious meaning. The same goes for the opponent's first and second marks, being the letters 'CK'. Given that none of these marks have any conceptual meaning, I find that they are incapable of a conceptual comparison. They are, therefore, conceptually neutral.

81. As for the opponent's third through fifth marks, the same applies in respect of the 'CK' element, in that this will be viewed as an initialism that carries no concept. However, the words 'BE', 'ONE' and 'ALL' are ordinary dictionary words that will be attributed their normal meanings. I appreciate that the consumer will recognise the dictionary words 'BE', 'ONE' and 'ALL' but, when taken in the context of the marks as wholes, I do not consider that they will carry any clear meaning. In

²⁸ On this point, I appreciate that the letter 'A' appears in 'ALL'. However, it is my view that the actual pronunciation of this letter will differ in that 'A', as a letter, will be pronounced similarly to how it appears in the word 'PAINT', whereas 'A' in 'ALL' will be pronounced with more of an 'O' sound, for example, 'ORL'.

comparing these marks with the applicant's mark, I find that they are conceptually neutral given that the marks, as wholes, carry no obvious meaning. I say this despite the fact that the second words in the opponent's marks are known words.

Distinctive character of the opponent's marks

82. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

83. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a

characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has filed evidence of the use of its marks and has argued that its marks all enjoy an enhanced degree of distinctive character. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent's marks has been enhanced through use. Before doing so, I will consider the inherent position.

84. The opponent's first and second marks are figurative but consist solely of the letters 'ck' in a standard typeface. The use of two single letters is, from a trade mark perspective, unremarkable. That being said, the letters are not allusive or descriptive of any of the goods relied upon above. Therefore, I am of the view the distinctiveness of such letters sits at a medium degree. As for the stylisation used, I have found this to play a very minor role in the overall impression of the mark and, as such, I do not consider that it contributes to the mark's distinctiveness to any material degree beyond the letters 'ck'. Therefore, I find that the distinctiveness of the mark as a whole is at a medium degree.

85. Turning to the opponent's remaining marks, I find that, as above, the 'CK' element sits at a medium degree of distinctiveness. In respect of the additional words, being 'BE', 'ONE' or 'ALL', these are well-known words and while they are not descriptive or allusive, they are not remarkable from a trade mark perspective. While they will contribute to the distinctiveness of the mark as a whole, I do not consider that the combination of a two-letter initialism and an ordinary dictionary word is distinctive to any higher degree than medium. As such, I find that the distinctiveness of the opponent's third through fifth marks sits at a medium degree.

86. I turn now to consider the position in respect of the opponent's claim that its marks enjoy an enhanced degree of distinctive character. For reasons that will become obvious below, I will first discuss the third through fifth marks and determine the

level of enhanced distinctiveness (if any) for those marks. I will then move to assess the position in respect of the opponent's first and second marks.

The opponent's third through fifth marks

87. I have summarised the evidence in respect of these marks at paragraphs 21 to 35 above. I do not intend to reproduce that evidence in full but have borne it in mind in reaching my decision on enhanced distinctiveness.

88. In considering the opponent's evidence in respect of these marks, I will first set out that while I have found genuine use for the opponent's third through fifth marks, I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine whereas a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking.

89. In the present case, I am of the view that the evidence in respect of the opponent's fourth mark (being 'CK ONE') is clearly sufficient enough to the point to an enhancing of that mark's distinctive character. While the use is at a significant level (in the tens of millions of pounds), it is not so high so as to warrant a finding that this mark enjoys an outright high level of enhanced distinctive character. Instead, it is my view that the level of use shown gives rise to a finding that this mark enjoys a relatively high degree of distinctive character that relates to the following goods:

Class 3: Cosmetics and toiletries namely, eau de toilette; skin moisturizer, shower gel; personal deodorants; all of the aforesaid for human use.

90. While that may be the case for the opponent's fourth mark, I am of the view that the evidence in respect of the opponent's third and fifth marks is at too low a level of warrant a finding that they enjoy an enhanced degree of distinctive character. Therefore, the inherent position in respect of those marks applies.

The opponent's first and second marks

91. I turn now to the opponent's first and second marks. The opponent has provided evidence specific to this mark but, before getting into that, I consider it necessary to consider whether the use of the opponent's third through fifth marks can contribute to the use of the opponent's first and second marks. In considering this point, I note that the opponent's third through fifth marks have been used predominantly in the following ways:



92. While the 'ck' element is stylised slightly differently to the way it is presented in the opponent's first and second marks, I repeat here what I have above in that the consumers would not readily identify the number '1' within the opponent's first and second marks. As a result, the distinctiveness of the first and second marks lies in the letters 'ck'. While 'be', 'one' and 'all' in the above examples contribute to the use of the above marks, I consider that the way in which 'ck' is used is such that it can be said to also contribute as use of the opponent's first and second marks. Therefore, all of the evidence discussed in respect of the opponents' third through fifth marks is relevant here. This is not the end of the matter, however, as the

opponent has provided specific evidence relating to its first and second marks, which I will discuss below.

93. The opponent confirms that it has been selling goods under its first and second marks for a range of goods, including fragrances and clothing. In terms of marketing, the opponent confirms that in 2020 alone, it spent £355,000 promoting these marks in the UK. The goods for this campaign were under the 'CK EVERYONE' range but the opponent sets out that its first and second marks were used on the goods. On this point, I note that, having considered the evidence, every example of these products includes the opponent's first and second marks on their packaging.

94. In respect of the promotional campaign, the opponent sets out that it achieved the following level of exposure:

Platform	Approximate Impressions
TV (Video on Demand):	4,985,011
Social Media Posts:	36,442,571
Social Media and YouTube Sampling:	1,443,746
Total:	42,871,328

95. The evidence in respect of this campaign sets out that it ran for two months, however, the impressions figures are shown as being over two years. It is not clear to me if this is accurate or is, instead, a simple typographical error. I say this because if the campaign ran for two months, I suspect that there would not be any impressions beyond the length of the campaign since those adverts would no longer be in circulation. I have nothing to suggest which time period is correct but will bear this point in mind going forward.

96. Examples of the campaign are provided in evidence, by way of screenshots of the various platform on which it ran.²⁹ Having considered these, I note that they all show the opponent's first and second marks above the word 'EVERYONE'.

97. In respect of this branding, I note that the opponent has provided excerpts from UK based publications such as ES Magazine, Stylist Magazine and The Observer (all of which from January 2020) as well as Best Magazine (in February 2020).³⁰ All of these show the opponent's first and second marks on perfume goods. In addition, I note that articles from ELLE and Fashion Network, POPSUGAR, Stylist and Men's Health are provided that discuss the 'CK EVERYONE' brand.³¹ These articles are all from prior to the relevant date to these proceedings (namely between January 2020 and January 2023) and show the opponent's first and second marks on fragrances.

98. The 'CK EVERYONE' perfume was awarded to Consumer Choice award for the Men's category at the Fragrance Foundation's 'Fifi Awards' in 2021. A printout confirming this award is provided in evidence.³² While this is noted, the evidence shows it to be an award body located in New York, USA. It is, therefore, not a UK based award so is of no real assistance here.

99. Taking all of the evidence specific to the opponent's first and second marks I have summarised above into account as well as the evidence in respect of the opponent's third through fifth marks (being that summarised in full at paragraphs 21 to 35 above), I am of the view that the level of use that can be attributed to these marks is significant. I say this not only as a result of the turnover figures provided in respect of the third through fifth marks but also in relation to the relatively intense (albeit short lived) marketing campaigns specific to the first and second marks and the press coverage in respect of the same. On this point, I note that while the

²⁹ See DBA34, 35 and 37. Also, at DBA36 is a detailed analytics report for the social media and YouTube sampling.

³⁰ DBA38

³¹ DBA39

³² DBA40

opponent's evidence sets out that it sold clothing under this brand (being goods that are not at issue here), the entirety of the evidence in respect of these marks relates to fragrances, being a type of perfumery. Overall, I consider that the distinctiveness of the opponent's first and second marks has been enhanced to a high degree, but only in respect of the following goods:³³

Class 3: Perfumery; skin care preparations; shower gel;³⁴ personal deodorants; all of the aforesaid for human use.

100. Even if I am wrong in my finding that the use of the opponent's third through fifth marks can be taken into account in this assessment, I would still have found that the distinctiveness of the opponent's first and second marks had been enhanced to a higher than medium degree for the above goods based upon the evidence of use in respect of those marks alone.

Family of marks

101. Before proceeding to consider a likelihood of confusion in the ordinary way, I wish to first address the opponent's family of marks argument. On this point, I refer to the case of *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, wherein the CJEU stated that:

"62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics

³³ As was the case with genuine use above, I consider it appropriate to limit any enhanced distinctive character to goods for use on humans only.

³⁴ Being a suitable sub-category of goods within the relied upon "bath and shower preparations"

which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled

to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

102. I accept that the evidence before me demonstrates that opponent's marks are all present on the market. Further, there are essentially four marks relied upon (on the basis that the opponent's first and second marks are identical) meaning that the opponent clearly has a sufficient number of marks that can be said to be capable of demonstrating a family. That being said, I am of the view that the applicant's mark does not follow the pattern to that covered by the opponent's marks. I say this because in the opponent's marks, the common letters, being 'CK', are either presented solus or form their own element separate from the word that follows them (being 'BE', 'ONE' and 'ALL'). However, the applicant's mark is simply three letters, being 'CKA'. The common letters 'CK' are not separate and, further, the point of difference is a single letter, not a word (as is the case in the opponent's family of marks). As a result, I do not consider that consumers would view that marks at issue and believe them to form part of the same family of marks. As such, the family of marks argument is of no assistance to the opponent.

Likelihood of confusion

103. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier registrations, the average consumer for the goods and the

nature of the purchasing process. In doing so, I must be alive to 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 that they have retained in their mind.

104. In respect of the goods at issue, I have found them to be either identical or similar to varying degrees, depending on what specifications the applicant's goods were compared to. On this point, I note that some of the applicant's goods have been found to be dissimilar to the goods in the opponent's third through fifth marks. The average consumer base is formed of members of the general public who will select the goods by primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. In respect of the similarity of the marks, I have found the applicant's mark and the opponent's first and second marks to be visually and aurally similar to between a medium and high degree and conceptually neutral. In respect of the opponent's third through fifth marks, I have found these to be visually and aurally similar to a medium degree and conceptually neutral with the applicant's mark. Lastly, I have found the opponent's marks all possess a medium degree of inherent distinctive character. As for the opponent's first and second marks, I have found that these have been enhanced to a high degree (or higher than medium degree) of distinctive character for some goods (being those at paragraph 99 above) whereas its fourth mark has been enhanced to relatively high degree for some goods (being those at paragraph 89 above).

105. Taking all of the above factors into account and even bearing in mind the principle of imperfect recollection, I do not consider that the marks at issue will be misremembered or inaccurately recalled for one another. While the shared use of the letters 'CK' will be noticed across all of the marks, the differences would not be overlooked. I say this even where the point of difference is just one letter (in comparing the first and second marks and the applicant's mark, for example). Further, I am of the view that when seeking to remember the applicant's mark,

consumers will pin their recollection of the applicant's mark on the entirety of its verbal element, being 'CKA' and not 'CK'. The same goes for the opponent's third through fifth marks, namely that the words 'BE', 'ONE' and 'ALL' will be remembered. I consider that this applies regardless of the identity between the goods at issue and even where the opponent's marks enjoy a higher degree of distinctive character. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks.

106. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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'.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

107. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

108. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

109. In considering the issue of indirect confusion, I consider it necessary to undertake my assessment by separating the opponent's marks into different groupings. In doing so, I will deal with the opponent's third and fifth marks first, then I will consider the opponent's fourth mark before concluding the opponent's first and second marks. The reason for this approach is that each of these marks can

be placed into different groups based on the levels of distinctiveness associated with them.

The opponent's third and fifth marks

110. Inherently, I do not consider that the use of 'CK' in the opponent's third and fifth marks is remarkable. As such, I do not consider that it is sufficient to give rise to a finding that consumers would believe 'CK BE' and 'CK ALL' shared the same or economically linked origins as 'CKA'. In addition, I do not consider that changing the marks from 'CK BE' or 'CK ALL' to 'CKA', or vice versa, is something that consumers would consider a logical step to indicate a sub-brand or brand extension of one another. As such, I do not consider that there exists a likelihood of indirect confusion between these marks, regardless of whether they are considered on identical goods.

The opponent's fourth mark

111. I appreciate that I have found that the opponent's fourth mark enjoys an enhanced degree of distinctive character. However, this lies in the entirety of the mark itself, being 'CK ONE' and not solely in the 'CK' element. As it is the 'CK' element that is the shared element between the marks, it cannot be said that the common use of this element can be said to so strikingly distinctive that consumers would only believe one undertaking would use it in this context. In addition, I do not consider that changing the marks from 'CK ONE' to 'CKA', or vice versa, is something that consumers would consider a logical step to indicate a sub-brand or brand extension of one another. As such, I do not consider that there exists a likelihood of indirect confusion between these marks, regardless of whether they are considered on identical goods.

The opponent's first and second marks

112. As set out above, the distinctiveness of these marks sits at a high degree as a result of the opponent's use of the same. It is my view that, in this scenario, the distinctiveness of the common element is one that can be said to be so strikingly distinctive that the average consumer would believe that only one undertaking would use the letters 'CK', especially when it comes to the goods for which the opponent's marks enjoy an enhanced degree of distinctiveness. In this scenario, I consider that consumers would notice the shared use of this distinctive element and believe that the user of the 'CKA' mark was either the user of the distinctive 'CK' marks or an economically connected undertaking. As a result, having taken all of the above into account and even bearing in mind the comments reproduced at paragraph 108 above, I am of the view that there exists a likelihood of indirect confusion between these marks.

113. The above being said, I am of the view that this finding applies only in circumstances where the opponent's marks enjoy an enhanced degree of distinctiveness. On this point, I remind myself that the enhanced level of distinctiveness is associated with the following goods:

Class 3: Perfumery; skin care preparations; shower gel; personal deodorants; all of the aforesaid for human use.

114. While not directly compared in my goods comparison above, they mirror very closely the goods that were compared under the opponent's third through fifth marks. Adopting those same levels of similarity here,³⁵ I find that the goods for which the opponent's first and second marks are highly distinctive for are identical (or, if not, similar to a medium degree) to the applicant's term of "cosmetics", similar to a medium degree with the applicant's terms of "bath preparations, not for

³⁵ For the avoidance of doubt, I refer to the comparisons at paragraphs 52 to 54, 56, 58, 60, 62 & 64 of my decision.

medical purposes”, “essential oils”, “potpourris [fragrances]”, “air fragrancng preparations”, “beauty masks”, “essences for skin care”, “cleaning preparations”, “facial cleansers” and “body lotions”, similar to a low degree with “abrasives”, and “cosmetics for animals” and dissimilar to the applicant’s terms of “toothpaste” and “polish for furniture and flooring”.

115. Plainly, the above finding of confusion applies to the identical goods. As for the lowly similar goods, I am of the view that the levels of visual and aural similarity between the marks (being medium to high) are sufficient to offset the low level of similarity of the goods. In addition, I am of the view that the low level of similarity can also be offset by the identity of the distinctive ‘CK’ element.³⁶ As a result, I find that the marks will be confused in respect of these goods also. As a likelihood of confusion under the present ground can only apply in circumstances where there is a degree of similarity between goods,³⁷ there can be no confusion in respect of the goods that I have found dissimilar to the opponent’s goods for which there is enhanced distinctiveness.

116. In conclusion, I find that the present ground of opposition succeeds in respect of the following goods:

Class 3: Bath preparations, not for medical purposes; essential oils; potpourris [fragrances]; air fragrancng preparations; beauty masks; essences for skin care; cleaning preparations; abrasives; cosmetics; cosmetics for animals; facial cleansers; body lotions.

³⁶ On this point, I appreciate that there may be more distance between the opponent’s goods and the applicant’s “cosmetics for animals”. However, I do not consider it unreasonable to suggest that consumers would be confused into thinking that the distinctive ‘CK’ brand extended its brand to produce and sell cosmetics for animals under ‘CKA’.

³⁷ See paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

Section 5(3)

117. Section 5(3) of the Act states:

“5(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 repute of the earlier trade mark.”

118. 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, Case C-323/09, Marks and Spencer v Interflora, Case C383/12P, Environmental Manufacturing LLP v OHIM*. 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 Salomon*, 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 and Environmental Manufacturing, paragraph 34.

(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 holder 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).

119. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the marks are similar. Secondly, the opponent must show that its marks have achieved a level of knowledge/reputation amongst a significant part of the public throughout the relevant territory. Thirdly, it must be established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the applicant's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

120. I have assessed the opponent's evidence of use at paragraphs 21 to 35 above (when assessing genuine use for the opponent's third through fifth marks) and at paragraphs 91 to 98 (when assessing enhanced distinctive character for the opponent's first and second marks). I do not intend to repeat those summaries here.

121. In considering the third and fifth marks, I remind myself that while the evidence was sufficient for genuine use, the present assessment is, much like the assessment for an enhanced distinctive character, far more onerous than that required for genuine use. Following the same reasoning I have given above at paragraph 90 I find that the opponent's evidence in respect of these marks is at too low a level in order to warrant a finding that those marks enjoyed a reputation in the relevant territory as at the relevant date.

122. In respect of the opponent's first, second and fourth marks, however, I remind myself that the evidence in respect of these marks was sufficient to give rise to a finding that they enjoyed a higher degree of distinctive character. The levels found differed in that the fourth mark enjoyed a relatively high degree of distinctive character and the first and second marks enjoyed a high degree of distinctive character. Following the same reasons set out in those assessments, I find that the opponent's fourth mark enjoys a relatively strong reputation whereas the opponent's first and second marks enjoy a strong reputation. It is my view that the reputation is in relation to the following goods:

The opponent's first and second marks

Class 3: Perfumery; skin care preparations; shower gel; personal deodorants; all of the aforesaid for human use.

The opponent's fourth mark

Class 3: Cosmetics and toiletries namely, eau de toilette; skin moisturizer, shower gel; personal deodorants; all of the aforesaid for human use.

Link

123. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

124. The applicant's mark is visually and aurally similar to between a medium and high degree and conceptually neutral with the opponent's first and second marks. It is visually and aurally similar to a medium degree and conceptually neutral with the opponent's fourth mark.

The nature of the goods or services for which the conflicting 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.

125. The comparison I have conducted above in respect of the opponent's fourth mark remains relevant here as the goods for which the opponent enjoys a reputation are the same as those that were at issue under the section 5(2)(b) ground. I remind myself that under that assessment, I found that "cosmetics, namely eau de toilette" was:

- a. Identical (or similar to a medium degree) to "cosmetics" in the applicant's specification;
- b. Similar to a medium degree with "bath preparations, not for medical purposes", "essential oils", "potpourris [fragrances]", "air fragrancing preparations", "beauty masks", "essences for skin care", "cleaning preparations", "facial cleansers" and "body lotions" in the applicant's specification;

- c. Similar to a low degree with “abrasives” and “cosmetics for animals”; and
- d. Dissimilar to “toothpaste” and “polish for furniture and flooring” in the applicant’s specification.

126. While I conducted a full goods comparison in respect of the first and second marks of the opponent, those findings are not necessarily applicable here as the goods at issue under my comparison above are broader than those for which those marks enjoy a reputation. Having said that, for similar reasons to that given at paragraph 114 above when discussing indirect confusion, I will simply adopt the same comparison that was applicable to the opponent’s fourth mark (being the outcomes repeated in the preceding paragraph). I take this approach because the reputed term of “perfumery; all of the aforesaid for human use” in the opponent’s first and second marks’ specifications cover “eau de toilettes”. As this formed the basis of the comparison of the opponent’s fourth mark (albeit categorised as “cosmetics and toiletries, namely eau de toilette”), I am of the view that the same findings can be said to be relevant here.

127. In respect of the dissimilar goods, I remind myself that goods need not be similar in order for the present ground to succeed. In considering the degree of closeness between these goods and the reputed goods of the opponent, I am of the view that the goods will likely be selected by the same section of the relevant public, being members of the general public at large. That being said, the userbase for all of these goods is incredibly broad so this is not an overly compelling factor. Lastly, I will say that while “toothpaste” can be said to be in the same sector as the opponent’s reputed goods (being the ‘health and beauty’ sector, generally), the remaining term of “polish for furniture and flooring” is not.

The strength of the earlier mark's reputation.

128. The opponent's fourth mark enjoys a relatively strong reputation whereas its first and second marks enjoy a strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use.

129. I have found that the opponent's marks are inherently distinctive to a medium degree. However, I have found that this has been enhanced to a relatively high degree (for the opponent's fourth mark) and a high degree (for the opponent's first and second marks) due to the use made of them.

Whether there is a likelihood of confusion

130. While I found that there was no likelihood of confusion in respect of the opponent's fourth mark, I did find that there was a likelihood of indirect confusion between the applicant's mark and the opponent's first and second marks in respect of those goods for which the opponent was found to enjoy an enhanced degree of distinctive character.

Conclusion on link

131. In assessing the marks at issue, I consider that it is the first and second marks that offer the best case for the existence of a link. I say this because they are the marks for which I have found there to be a likelihood of confusion.

132. Where I have found confusion, I consider that a link between the marks is inevitable. For the avoidance of doubt, I will say this in reaching this finding, I rely on the same reasons given at paragraphs 112 to 116 above. As such, I find that

there is a sufficient link between the marks in respect of all goods that are identical or similar (even to a low degree).

133. As for the dissimilar goods, I remind myself that I was unable to find confusion in respect of those under the section 5(2)(b) ground above. While I appreciate that the present ground is capable of succeeding in respect of goods that are dissimilar, I do not consider that is the case here. I say this because whilst I acknowledge that the opponent enjoys a strong reputation and that its marks are highly distinctive, I am of the view that the distance between the dissimilar goods and the reputed goods of the opponent is such that consumers would not believe that the goods originate from the same undertaking (being the basis for the opponent's claim as to the existence of a link). In short, I do not consider that the consumer will believe that the reputed 'ck' brand would extend its brand beyond its reputed goods in order to produce and sell toothpastes or polishes for furniture and flooring, despite the former term technically falling in the 'health and beauty' sector. Such a connection is, in my view, not reasonable.

134. As a result of what I have said above, the present ground may proceed to the issue of damage. However, this is only in relation to the following goods:

Class 3: Bath preparations, not for medical purposes; essential oils; potpourris [fragrances]; air fragrancing preparations; beauty masks; essences for skin care; cleaning preparations; abrasives; cosmetics; cosmetics for animals; facial cleansers; body lotions.

135. For the remaining goods, being those where no link is made, I will say here that without a link between the marks, there can be no damage. Therefore, the present ground fails at this stage in respect of the following goods:

Class 3: Toothpaste; polish for furniture and flooring.

Damage

136. The opponent has pleaded that use of the applicant's mark would, without due cause, lead to an unfair advantage in favour of the applicant and cause a detriment to the distinctive character or reputation of the opponent's marks.

Unfair Advantage

137. I bear in mind that unfair advantage has no effect on the consumers of the opponent. Instead, the taking of unfair advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to select the goods of the applicant's mark than they would otherwise have been if they had not been reminded of the opponent's marks.

138. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

139. In the present case, I have found that there would be a link between the marks on the basis that consumers would wrongly believe them to derive from the same undertakings. In such circumstances, I consider it inevitable that use of the applicant's mark in respect of the goods for which there is a link would give rise to an unfair advantage. This is on the basis that the consumers may engage the goods of the applicant based on the strength of the reputation of the opponent's marks, without the applicant needing to go to the effort and expense of promoting and marketing its goods itself.

140. The applicant would have a defence if it could establish that it had a due cause in filing for its mark. However, no arguments have been put forward to this effect. The applicant's use is not, therefore, with due cause.

141. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. The section 5(3) ground of the present opposition, therefore, succeeds in relation to goods listed at paragraph 134 above.

Final remarks under the section 5(3) ground

142. I wish to set out that even if I am wrong in my primary finding that the opponent's first and second marks have a strong reputation/high degree of enhanced distinctiveness and, instead, benefit from only a relatively strong reputation/higher than medium level of distinctiveness, my finding would have been the same for the same reasons outlined above.

143. Lastly, I appreciate that I did not consider whether there exists a link between the opponent's fourth mark and the applicant's mark. However, for the sake of completeness, I will briefly state that despite the relatively high distinctiveness and relatively strong reputation that vested in the opponent's fourth mark, there would

be no link between the marks at issue. I say this because the way in which the present ground was specifically pleaded (that the marks were economically connected) means that, because I found no indirect confusion between them, there cannot be a link on this basis.

CONCLUSION

144. The opposition succeeds against a majority of the goods for which registration was sought. As a result, the applicant's mark is, subject to any successful appeal of my decision, refused registration for the following goods:

Class 3: Bath preparations, not for medical purposes; essential oils; potpourris [fragrances]; air fragrancing preparations; beauty masks; essences for skin care; cleaning preparations; abrasives; cosmetics; cosmetics for animals; facial cleansers; body lotions.

145. However, the applicant's mark may proceed to registration for the following goods, being those against which the opposition has failed:

Class 3: Toothpaste; polish for furniture and flooring.

COSTS

146. The opponent has enjoyed the greater degree of success and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. Given that the applicant successfully defended its mark in respect of some terms, I consider it appropriate to apply a slight reduction to the costs award in order to reflect this.

147. In the circumstances, I award the opponent the sum of £1,400 as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the counterstatement:	£300
Filing evidence:	£600
Filing written submissions in lieu:	£400
<u>Sub-total:</u>	<u>£1,300</u>
<i>Reduction:</i>	<i>£100</i>
Official fees (not subject to the reduction):	£200
Total:	£1,400

148. I hereby order Guangzhou Xika Technology Co., Ltd. To pay Calvin Klein Trademark Trust the sum of £1,400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 1st day of August 2025

A COOPER
For the Registrar