

O/0950/24

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003883388
BY LAKELAND COSMETICS LIMITED
TO REGISTER:**

BugOff

AS A TRADE MARK IN CLASSES 3 AND 5

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 441457
BY S.C. JOHNSON & SON, INC**

BACKGROUND AND PLEADINGS

1. On 28 February 2023, LAKELAND COSMETICS LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 17 March 2023 in respect of a range of goods in classes 3 and 5 (as set out later in this decision from paragraph 23 onwards).

2. On 19 June 2023, the application was opposed by S.C. Johnson & Son, Inc (“the opponent”) based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). However, having elected not to file any evidence during the evidence rounds, the opponent subsequently confirmed that, for reasons of procedural economy, it withdrew its reliance on the grounds of opposition based upon Sections 5(3) and 5(4)(a) of the Act, and the proceedings continued under Section 5(2)(b) only.

3. The opponent relies on the following trade mark and all of the goods covered by the same, as shown below:

UK00801420026



Filing date: 12 June 2018

Registration date: 25 January 2019

Priority date: 31 May 2018, claimed from French trade mark no. 4457556.

Class 5: *Products for destroying weeds and vermin; insecticides; mothproofing products; insect repellents; fungicides; rodenticides; preparations for soothing and treating insect bites.*

4. In addition, the opponent relies on International Registration no. WO0000001420026. However, as that registration is identical to UK00801420026, in

the sense that it covers the same mark and the same goods, I will limit my considerations to the latter.

5. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an “earlier mark” in accordance with Section 6 of the Act. As the opponent’s earlier mark had not been registered for five years or more at the filing date of the applied-for mark, it is not subject to proof of use. Consequently, the opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

6. When it filed its opposition, the opponent correctly completed Section A of the Form TM7 which relates to oppositions under Section 5(1) and 5(2) and includes the following: (1) a box to be ticked indicating the sections of the Act upon which the opposition is based; (2) details regarding the earlier mark, including a representation; (3) the goods upon which the opposition is based; (4) a statement of use; and (5) an indication of which goods are being opposed. This is followed by a box (Q9) for applicants to include further information about why it is considered that there is a likelihood of confusion. Although the opponent provided the information required at 1-5, it did not include a statement of grounds and did not expand in any way on why the marks and goods are considered to be similar, or why it is considered that there is a likelihood of confusion.

7. The applicant filed a counterstatement, denying the claims made. In particular, the applicant contends that although both marks contain the element ‘OFF’, the average consumer will assess the marks globally and will not assume that the goods emanate from the same, or economically linked, undertakings, but as for the rest, the applicant states that it would set out its response in detail after the opponent had made clear the case the applicant has to meet.

8. The opponent is represented by Bird & Bird LLP. The applicant is represented by Stone King LLP.

9. Only the applicant filed evidence. This consists of a witness statement in the name of Gavin Lloyd Llewellyn, dated 20 December 2023, with one exhibit (GLL1). Mr Llewellyn is a Partner of Stone King LLP, the applicant’s representatives in these

proceedings and his evidence goes to the descriptiveness of the word 'OFF'. Along with this evidence, the applicant filed written submissions also dated 20 December 2023.

10. Neither party requested a hearing. Only the opponent filed submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

11. 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.

DECISION

Section 5(2)(b)

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

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

(a)...

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

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

13. Section 5A of the Act is as follows:

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

14. 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 OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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

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

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

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

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

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

15. 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:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all

the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

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

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

17. In *Gérard Meric v OHIM* Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for 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.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

20. It is also relevant to note the case-law in respect of how to construe words in specifications. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

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

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment, he set out the following summary of the correct approach to interpreting broad and/or vague terms:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded."

22. The goods covered by the opponent's earlier mark are *products for destroying weeds and vermin; insecticides; mothproofing products; insect repellents; fungicides; rodenticides; preparations for soothing and treating insect bites* in class 5.

23. The application seeks protection for various goods in class 3 and 5, as set out below.

Class 3

Cosmetics for animals; Bath preparations for animals; Skin care products for animals; Conditioning sprays for animals; Animal washes (non-medicated); Colognes for animals; Dental care preparations for animals; Breath fresheners for animals; Odour fresheners for animals; Animal grooming preparations; Shampoos for animals [non-medicated grooming preparations]; Pet odour removers; Pet stain removers; Shampoos for pets; Deodorants for pets; Non-medicated mouth washes for pets; Soaps, shampoos, conditioners, dry-cleaning powders and grooming products, all for animals and birds.

24. Eventually, in its submissions in lieu, the opponent provided some reasons as to why it claims that the applied-for goods in class 3 are identical or similar to the opponent's goods in class 5. It stated:

“17. The Contested Goods in class 3 all fall within the category of cleaning products for animals. The Opponent's Goods include “products for destroying vermin”, “insecticides”, “insect repellents”, and “preparations for soothing and treating insect bites”, all of which are broad terms that encompass or are highly similar to cleaning products for animals, a common purpose of which is to remove fleas, ticks, lice and mites from animals and to soothe the animal's irritated bitten skin. As such, it is clear that, contrary to the Applicant's Submissions, all of Contested Goods in class 3 belong to the same homogenous group as the Opponent's Goods and are therefore at least highly similar.

18. Furthermore, the following Contested Goods in class 3 are broad terms which arguably encompass and are therefore identical to the Opponent's Goods (in particular to “products for destroying vermin”, “insecticides”, “insect repellents”, and “preparations for soothing and treating insect bites”): “Bath preparations for animals; Skin care products for animals; Conditioning sprays for animals; Animal washes (non-medicated); Animal grooming preparations;

Shampoos for animals [non-medicated grooming preparations]; Shampoos for pets; Soaps, shampoos, conditioners, dry-cleaning powders and grooming products, all for animals and birds”.

25. Having the opponent not reveal its arguments until after the evidence rounds had been concluded, this left the applicant substantially in the dark about why the goods are claimed to be identical or similar. It seems to me therefore that the applicant did the best it could, somewhat in the dark, when it addressed the similarity between the applied-for goods in class 3 and the opponent’s goods in class 5 in its written submissions. It stated:

“The Applicant contends that none of the Applicant’s Class 3 goods is identical or similar to the Opponent’s goods. The Applicant’s Class 3 goods are all in the nature of non-medicated cosmetic products intended for giving animals a pleasing appearance and odour.”

26. Whilst the opponent is right in saying that Section 60A of the Act makes it clear that whether or not the goods are in the same class is not decisive in determining whether they are similar or dissimilar, the approach the opponent has taken does not conform with the principle that it is necessary to focus on the ordinary and natural, or core meaning, of the goods.

27. The applicant’s goods in class 3 are essentially animal grooming preparations. Whilst some of the applied-for goods perform a cleaning function, for example to wash or bath the animal, the same cannot be said for the earlier goods in class 5 that have been identified by the opponent as being similar or identical to the applicant’s goods, namely “*products for destroying vermin*”, “*insecticides*”, “*insect repellents*”, and “*preparations for soothing and treating insect bites*”. Although the opponent’s terms are sufficiently broad to cover goods for use on animals, they are not used to wash or clean the animal - the meaning of cleaning being that of freeing someone or something from dirt, marks, or stains - and cannot be described as cleaning products for animals. I therefore reject the opponent’s argument.

28. The dictionary definition of “vermin” is “small animals and insects that can be harmful and are difficult to control when they appear in large numbers: Flies, lice, and cockroaches can all be described as vermin.” The opponent’s “products for destroying vermin” and “insecticides” are all pest control preparations that can be used on animals to destroy insects, flies and lice. Although I do not consider these goods to be identical to the applied-for animal grooming goods, to the extent that both sets of goods can be used on animals, and therefore target the same pet-owning public and can be sold in the same pet shops, they are similar to a certain degree. However, the nature, purpose and methods of the goods are different, the goods are not in competition, and it is not obvious to me that they are complementary. I consider these goods to be similar to a low degree.

Class 5

Veterinary preparations and substances; Disinfectants and antiseptics; Disinfectants for veterinary use; Antiseptic preparations; Antiseptic washing preparations; Hygienic preparations for veterinary use; Sanitary preparations for veterinary use; Pharmaceutical preparations for veterinary use; Pharmaceutical preparations for animals; Pharmaceutical preparations for animal skincare; Skin treatment [medicated] for animals; Antiseptic cleansers; Disinfectants, deodorants and medicated cleansing products and grooming products, all for animals and birds; Antibacterial sprays; Medicated animal grooming preparations; Medicated shampoos for pets; Insecticidal animal shampoos; Animal washes [insecticides]; Dog washes being insecticides; Insecticidal veterinary washes; Lotions for veterinary purposes; Dog lotions for veterinary purposes; Ointments and lotions, all for use on animals; Fungicidal preparations; Insecticides; Insecticides and parasiticides for animals and birds; Antiparasitic preparations for pets; Flea exterminating preparations; Antiparasitic collars for animals; Flea collars; Animal flea collars; Flea and tick spot-on treatments; Flea powders; Powders for killing fleas on animals; Flea spray; Flea tablets for oral administration; Flea bombs; Repellents for animals; Insect repellents for use on animals; Insect repelling tags; Pharmaceutical preparations for the treatment of worms in pets; Veterinary preparations for treatment of intestinal bacteria; Dietary supplements for animals; Vitamins for animals; Medicated supplements for foodstuffs for animals.

29. In its written submissions, the applicant says that it does not deny that the goods highlighted in grey above are similar to the opponent's goods and accepts that (a) the opponent's *insecticides; fungicides* are similar to the applied-for *Disinfectants; Disinfectants and antiseptics; Disinfectants for veterinary use; Antiseptic washing preparations; Hygienic preparations for veterinary use; Sanitary preparations for veterinary use; Disinfectants and medicated cleansing products and grooming products, all for animals and birds; Antibacterial sprays; Medicated animal grooming preparations; Medicated shampoos for pets; Insecticidal animal shampoos; Animal washes [insecticides]; Dog washes being insecticides; Insecticidal veterinary washes; Fungicidal preparations; Insecticides; Insecticides and parasiticides for animals and birds; Antiparasitic preparations for pets; Flea exterminating preparations; Flea powders; Powders for killing fleas on animals; Flea spray; Flea bombs;* (b) the opponent's *Mothproofing products; Insect repellents* are similar to the applied-for *Antiparasitic collars for animals; Flea collars; Animal flea collars; Repellents for animals; Insect repellents for use on animals; Insect repelling tags* and (c) the opponent's *Preparations for soothing and treating insect bites* are similar to the applied-for *Veterinary preparations and substances; Antiseptic preparations; Pharmaceutical preparations for veterinary use; Pharmaceutical preparations for animals; Pharmaceutical preparations for animal skincare; Skin treatment [medicated] for animals; Antiseptic cleansers; Lotions for veterinary purposes; Dog lotions for veterinary purposes; Ointments and lotions, all for use on animals; Flea and tick spot-on treatments.*

30. As regards the goods at point (a) I consider that most of the goods in relation to which the applicant conceded similarity are insecticides and fungicides and fall within the opponent's broader terms *insecticides* and *fungicides*. These goods are **identical (Merici)**. Insofar as the applied-for disinfectant and antiseptic products are used to destroy bacteria and microorganisms rather than insects and fungus, they are similar to a **medium degree** to the opponent's *insecticides* (which covers preparations for destroying fleas and lice) and *fungicides*, because although the goods have a different nature, purpose, and methods of use, they are both medicated products which are used on animals to prevent or combat the spread of diseases (or notionally cover these goods). Further, the goods target the same pet-owning public, are distributed through the same trade channels and are complementary to a certain degree. As regards to

the goods at point (b) and (c) I consider that all of the goods in relation to which the applicant conceded similarity fall within the opponent's broader terms and are **identical** (*Meric*).

31. This leaves *deodorants, all for animals and birds; Flea tablets for oral administration; Pharmaceutical preparations for the treatment of worms in pets; Veterinary preparations for treatment of intestinal bacteria; Dietary supplements for animals; Vitamins for animals; Medicated supplements for foodstuffs for animals*. Similarly to what I found above, although these goods and the opponent's *insecticides; fungicides* have a different nature, purpose, and methods of use, at a very high level, they are all (or notionally cover) medicated products for veterinary use. Further, the goods target the same pet-owning public and are distributed through the same trade channels. These goods are similar to a **low degree**.

Average consumer

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

33. The average consumer for the parties' goods will be a member of the general public, a veterinary or a pet groomer. When selecting the goods, the consumer will take a number of factors into account, such as safety and efficacy (for medicated

products) and smell and ingredients for non-medicated pet grooming products, as they can influence the pet's skin and coat health. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process.

34. The goods are likely to be selected from the shelves of retail outlets (or their online equivalents) or following the perusal of marketing material. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as word-of-mouth recommendations may be made.


Comparison of marks

35. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in 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.”

36. 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.

37. The respective marks are shown below:

The application	The opponent's mark
BugOff	

38. The parties made submissions regarding the comparison of the marks, which I will refer to where relevant.

Overall impression

39. The application consists of the words 'Bug' and 'Off'. Although the words are conjoined each of them begins with a capital letter which emphasise that they are separated and easily comprehensible. The distinctive character of the application lies jointly in the words 'Bug' and 'Off' and in their combination.

40. The opponent's earlier mark consists of the word 'OFF' followed by an exclamation mark on a lozenge grey device. The word 'OFF' and the exclamation mark are presented in white, in bold in a slightly stylised typeface. I consider that the word 'OFF!' has the greatest impact in the overall impression, given its size and position. The lozenge device acts as a background and is unlikely to be given any origin significance, whilst the stylisation is minimal and will have very little weight in the overall impression.

Visual, aural and conceptual similarity

41. The opponent states that visually, aurally and conceptually, the respective marks coincide in the identical word "Off", that "*the minimal stylisation and additional exclamation mark in the Earlier Mark do not detract from this shared identity*" and that "*the respective marks are visually, aurally and conceptually similar to an above-average degree.*"

42. Visually, the marks coincide in that they share the word 'OFF'. However, in other respects the marks are different. The word 'Bug', present in the application, is absent

in the opponent's mark. The exclamation mark, the stylisation of the word 'OFF', the lozenge device and the colour contrast present in the opponent's mark, are absent in the application. Admittedly, the application is a word only mark and can be used in any standard typeface, including that used by the opponent's earlier mark. However, this does not overcome the impact of the differences between the marks. In this connection, even if my finding that the distinctive character of the application lies in the combination of the words 'Bug' and 'Off' means that the case law that the beginnings of marks tend to have more impact than the ends (see *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02) is not fully applicable here, the differentiating element 'Bug' has at least as much weight as the shared element 'Off' and stands equal to it. Overall, I consider the marks to be visually similar to a low degree.

43. Aurally, the graphic elements of the opponent's mark will not be pronounced, and the word elements of the marks will be articulated as OO-FF and BUUG-OO-FF. Overall, I consider the marks to be visually similar to a low to medium degree.

44. Turning to the conceptual comparison, the opponent commented as follows:

“Contrary to the Applicant's Submissions, the word “Off” on its own in the Contested Mark and Earlier Marks has little to no meaning in relation to the relevant goods, at most alluding to the intended removal of an unspecified thing or substance. Whereas by contrast the words “BugOff” will be understood to allude to the fact that at least some of the relevant goods relate to the removal of bugs/insects.

The Applicant's Evidence consists of examples of third parties using the word “Off” in combination with descriptive words, such as “Dust-Off”, “Easy-Off”, “Scent Off”, etc. The Applicant argues that such evidence demonstrates that the word “Off” is commonly used in the context of repellent, destruction and cleaning products to allude to their properties and intended use. However, the evidence in fact demonstrates third party use of the word “Off” in combination with descriptive elements, which indicates that the descriptive elements are crucial to conveying the intended purpose of the product to the consumer.

Visually, aurally and conceptually, the respective marks coincide in the identical word “Off”. The minimal stylisation and additional exclamation mark in the Earlier Marks do not detract from this shared identity. As such, the respective marks are visually, aurally and conceptually similar to an above-average degree.”

45. The applicant states:

“Thirdly, as to the conceptual comparison, both marks contain the identical letters O-F-F. The word “off” is a common English word which alludes to the properties and intended use of the goods. The Applicant's Mark presents the notion of keeping insects at bay or of removing insects from an article. The Earlier Marks present the notion of repelling or removing something, which could be insects, animals, dirt or anything, and the exclamation mark has the effect of turning the Earlier Marks into an imperative.

In the case of the Applicant's Mark, neither word element carries greater weight and neither has an independent distinctive role in the sign. The distinctiveness of the Applicant's Mark lies in the combination of the two, conjoined word elements.

Given that the word element OFF is common to all the marks at issue, the marks share the concept of repelling or removing. They are therefore conceptually similar to no more than an average degree.”

46. The word ‘off’ has several meanings in English,¹ from “*away from a place or position, especially the present place, position, or time*” (i.e. **run off, drive off**) (meaning 1) to “*used with actions in which something is removed or removes itself from another thing*” (i.e. take your **jacket off**, one of my **buttons has come off**) (meaning 2), to “*(especially of machines, electrical devices, lights, etc.) not operating because of not being switched on*” (i.e. make sure **the computers are all off** before you go home) (meaning 3), to “*(of money) taken away from the original price*” (i.e. you

¹ Cambridge online dictionary

can **get some money off** if you pay cash) (meaning 4), to *“not at work; at home or on holiday: take/have something off”* (i.e. I'm going to **take/have some time off** to work on my house. Off sick: She was **off sick** last week) (meaning 5), to *“in such a way as to be separated: shut/close something off”* (i.e. the police have **shut/closed off** all streets leading to the city) (meaning 6), to *“in such a way as to be completely absent, especially because of having been used or killed”* (i.e. kill something off: It says on the bottle that it **kills off all known germs**. Pay something off: It'll take some time before she manages to **pay off all her debts**) (meaning 7), to *“in such a way as to get rid of something”* (i.e. walk something off. We went out for a while to **walk off some of our dinner**. Sleep something off: He's gone to **sleep off a headache**) (meaning 8). There are many other meanings of the word 'off', which I am not going to detail, but the gist of it is that it is a very common word whose meaning depends on the context in which it is used. Oxford English dictionary also states:

“General uses. Off has been used since the Middle English period with many verbs, e.g. buy, come, dash, get, go, look, mark, palm, pass, rattle, show, take, etc.: see the first element. In most of these the basic uses of off correspond to those given below, while (as with other phrasal verbs) the further developments take a more idiomatic turn.”

47. In addition to the word 'off' the earlier mark contains an exclamation mark. An exclamation mark is used to convey the idea that the word or phrase which precedes it is an exclamation, that is to say, *“something you say or shout suddenly because of surprise, fear, pleasure, etc”*.

48. It seems to me that in the context of the opponent's mark, the presence of the exclamation mark after the word 'OFF' will be perceived, in the context of goods whose purpose is to get rid of insects, vermin, and insect bites, as someone giving a sudden order or exclamation of fear and frustration telling insects, vermin or insect bites to go away and alluding to the purpose of the goods, namely the intended removal of pests or insect bites.

49. In the applicant's mark, the word 'Off' is preceded by the word 'Bug' to create the unit 'BugOff'. I have already set out the meaning of 'off'. The word 'Bug' has various

meanings, the first two of which are “*an insect or similar small creature*” and “*a bug is an illness which is caused by small organisms such as bacteria*” (Collins online dictionary). I agree with the applicant that in the context of the goods concerned, which are either pet grooming products for cleaning pets and give them a nice smell, or disinfectants, antibacterials, antiseptics, insecticides and fungicides for animals, the mark as a whole will convey the notion of keeping bugs away or removing them.

50. Whilst in both marks the word ‘off’ is used to convey a message which is allusive of the purpose of the goods, namely the intended removal of insects and other pests, the marks convey that message in a different way, because the opponent’s mark will convey the concept of someone giving a sudden order or exclamation of fear and frustration telling insects, vermin or insect bites to go away, whereas the applicant’s mark will convey the concept of a product which keep bugs away. I agree with the applicant that there is no more than a medium degree of conceptual similarity.

Distinctive character of earlier mark

51. 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).”

52. Registered trade marks possess various 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 a mark can be enhanced by virtue of the use made of it.

53. As it will be recalled, I have concluded that the earlier mark ‘OFF!’ is allusive, with regard to the goods concerned, of their purpose, as it will convey the concept of someone giving a sudden order or exclamation of fear and frustration telling insects, vermin or insect bites to go away. It does not, however, directly describe some of the goods’ characteristics. I consider the earlier mark to be distinctive to a low degree.

54. I also note that the evidence filed by Mr Llewellyn is aimed at supporting the applicant’s contention that the word “off” is an allusive term which is commonly used by product manufacturers in the names of products to allude to the properties and intended use of those products. That evidence consists of results of internet searches conducted on 21 August 2023, nearly six months after the filing date of the contested application (i.e. 28 February 2023), and show products offered for sale on that date. Since the relevant date for the assessment that I am required to make is the filing date of the contested application, I do not consider Mr Llewellyn’s evidence to be relevant because it refers to products available for sale after that date; hence, I will say no more about it.

Likelihood of confusion

55. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services 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 marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

56. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. (as he then was) 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).”

57. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

58. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

59. Earlier in this decision I found that:

- a) The goods vary from being identical to similar to a low degree.
- b) The average consumer for the goods is predominantly a member of the general public, a veterinary or a pet groomer, who will pay at least a medium degree of attention during the purchasing process.
- c) The purchasing process is predominantly visual, although I do not discount an

aural component to the purchase.

- d) The competing marks are visually similar to a low degree, aurally similar to a low to medium degree and conceptually similar to no more than a medium degree.
- e) The earlier mark is distinctive to a low degree.

60. I keep all these findings in mind when considering whether a likelihood of confusion exists.

61. The opponent's submissions on the likelihood of confusion are very brief. It states:

"[...] the Opponent submits that there is a likelihood of confusion between the Contested Mark and the Earlier Marks. The average consumer is likely to believe that the Contested Goods provided under the Contested Mark originate from or are otherwise authorised by the Opponent.

In the alternative, the Opponent submits that there is a likelihood of indirect confusion between the Contested Mark and the Earlier Marks, on the basis that the average consumer is likely to believe that the Contested Mark is another brand belonging to the Opponent, such as a sub-brand of goods specifically directed at removing bugs."

62. The opponent seems to claim that the first paragraph referring to the average consumer believing that the goods provided under the applicant's mark originate from or are otherwise authorised by the opponent, is a case of direct confusion, since it refers in the alternative to indirect confusion. Direct confusion involves the average consumer mistaking one mark for the other and involves no process of reasoning. In my view, if the average consumer believes that the goods provided under the applicant's mark originate from or are otherwise authorised by the opponent, that belief implies the realisation that the marks are not the same and is more akin to indirect confusion (rather than direct confusion). I consider therefore that the opponent did not plead a case of likelihood of confusion based on direct confusion. That would be

sufficient to dismiss the likelihood of direct confusion. However, if I am wrong on that, I consider that there is no likelihood of direct confusion in any event. Taking into account the visual differences between the marks, the fact that the relevant public will examine the goods at issue mainly from a visual point of view and perceive (or retain) the differentiating element 'Bug' at the beginning of the applicant's mark, it is unlikely that the average consumer will mistake one mark for another.

63. Turning to indirect confusion, the opponent states that the average consumer is likely to believe that the application is another brand belonging to the opponent, such as a sub-brand of goods specifically directed at removing bugs.

64. The applicant denied the risk of indirect confusion submitting that the overall impression created by the marks is different and that there is insufficient commonality between the marks for a likelihood of confusion to arise because the only point of similarity between them lies in the common element OFF, which has a low degree of distinctiveness in relation to the goods at issue. The applicant also relies on *Duebros Limited v Heirler Cenovis GmbH* for the proposition that a finding of indirect confusion should not be made merely because two marks share a common element, and it is not sufficient that a mark merely calls to mind another mark, which is mere association, not association in the sense of indirect confusion required to establish a likelihood of confusion. Finally, the applicant submits that consumers who recognise that the marks at issue share the common, but allusive, element OFF would, if anything, merely associate them in the sense that one mark might call the other mark to mind but would not perceive an economic connection between the goods or their trade origin on the basis of the coincidence of an allusive and commonly used English word.

65. I have considered both side's arguments. However, I am not convinced that the application will be seen as a sub-brand of the earlier mark for goods specifically directed at removing bugs. The earlier mark 'OFF!' is low in distinctiveness and the word 'off' is used in both marks in an allusive manner to convey a similar message, namely that the purpose of the goods concerned is to get rid of insects, pests, bacteria and bugs. Bearing in mind the goods for which the marks are registered or applied for respectively, the conceptually similar message is therefore highly allusive and very low in distinctiveness. In addition to that, the similar message is conveyed in the

application in a distinctively different manner creating a different overall impression. In the application the word 'Off' is supplemented by the word 'Bug'. Although it is arguably descriptive in relation to some of the goods which are used to remove or destroy bugs, when put together with the word 'Off', the combination 'Bug' and 'Off' becomes a unitary whole and the word 'Bug' will take trade mark significance for the average consumer. Consequently, it is my conclusion that the presence in both marks of the element 'Off' with a low degree of distinctiveness will be put down to coincidence rather than common trade origin. Accordingly, I do not consider that there is a likelihood of confusion in this case.

OUTCOME

66. The opposition has failed. Subject to any successful appeal against my decision, the application will proceed to registration.

COSTS

67. The applicant has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £950, calculated as follows:

Preparing a statement and considering the other side's statement: £450

Preparing written submissions: £500

Total: £950

68. I therefore order S.C. Johnson & Son, Inc to pay LAKELAND COSMETICS LIMITED the sum of £950. This sum is to 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 3rd day of October 2024

TERESA PERKS

For the Registrar