O/1042/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001652559 IN THE NAME OF TRY MERRY FOR THE FOLLOWING MARK:

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 436395 BY ANOMALY IP LLC

BACKGROUND AND PLEADINGS

1. Try Merry ("the holder") is the holder of the International Registration shown on the cover page of this decision ("the IR"). The IR was registered on 25 January 2022 and, with effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol of the Madrid Agreement. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 24 June 2022. The holder seeks protection in the UK for the following goods:

    Class 3: Laundry preparations; polishing preparations; degreasing preparations; abrasive preparations; soaps; perfumes; essential oils; cosmetics; hair lotions; dentifrices; depilatories; make-up removing products; lipstick; beauty masks; shaving products; preservatives for leather (polishes); creams for leather.

2. The IR is derived from an earlier trade mark registered in France under number 4788833, which has the filing date of 28 July 2021. As such, the IR has a priority date of 28 July 2021.

3. While the IR was initially sought to be protected in the UK by Elena Spirina, a change of ownership was recorded on the WIPO register on 3 November 2023 wherein the new owner was confirmed as being the holder. Further to this, the Tribunal wrote to the holder seeking undertakings that it (i) had sight of the forms and evidence filed, (ii), stood by the statements made in the Ms Spirina's counterstatement and that where the name of the original holder appeared, it should be read as the holder and (iii) was aware of and accepted the liability for costs for the whole proceedings in the event that the opposition succeeded. By way of an email dated 1 December 2023, the holder confirmed these three undertakings.

4. On 22 September 2022, the IR was opposed in its entirety by Maesa LLC. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act") and is reliant upon the following trade mark:

ANOMALY
International Trade Mark designating the UK under registration no. 1577470
International registration date: 15 January 2021
Date protection sought in the UK: 15 January 2021
Date protection granted in the UK: 9 December 2021
Priority date: 15 September 2020 (USA).
Relying on all goods, namely:

Class 3: Aftershave; cologne; perfume; body butter; body cream; body emulsions; body glitter; body lotion; body milk; body oil; body paint; body powder; body scrub; body sprays; body wash; deodorant for personal use; exfoliant creams; facial cleansers; facial scrubs; facial creams; facial oils; gels for cosmetic purposes; make-up remover; moisturising creams; moisturizing milk; spf sun block sprays; sunscreen preparations; bar soap; beauty gels; beauty soap; body masks; cosmetic body mud; cosmetic soaps; cosmetic sun-protecting preparations; cosmetic preparations for body care; facial lotion; facial washes; facial beauty masks; facial moisturizer with spf; liquid bath soaps; non-foaming cosmetic preparations for the face, namely, gels and balms; non-medicated exfoliating preparations for skin; non-medicated cleansers for personal use, namely, acne cleansers not for medical purposes; non-medicated hand soaps; non-medicated liquid soap; non-medicated skin toners; non-medicated skin care preparations, namely, gels, oils, creams, and balms; pre-moistened cosmetic wipes; skin cleansers; skin moisturizer; skin care preparations, namely, skin peels; dry shampoos; hair butter; hair care kits comprising non-medicated hair care preparations, namely, shampoo and conditioner; hair care kits comprising non-medicated hair care preparations,

namely, hair styling preparations; hair color; hair conditioner; hair creams; hair dye; hair gel; hair glaze; hair lotion; hair masks; hair mousse; hair oils; hair shampoo; hair spray; hair styling preparations; styling gels; hair curling preparations; hair pomades; heat protectant sprays for hair; heat protectant creams for hair; non-medicated hair serums; non-medicated scalp treatment oil; 2-in-1 shampoo and conditioner; hair rinse; hair texturizers.

5. As above, the initial opposition was filed by Maesa LLC, however, the mark relied upon was assigned to ANOMALY IP LLC ("the opponent") on 15 October 2021. This was recorded by WIPO on 13 December 2022. In confirming the assignment to the Tribunal, the opponent agreed to be substituted into these proceedings and to be bound by any adverse costs order which may arise as a result of the proceedings.

6. By relying on section 5(2)(b) as the sole ground of its opposition, the opponent claims that the marks at issue are similar and that the goods at issue are identical and/or similar. As a result, the opponent's claim is that these factors contribute to a likelihood of confusion between the marks at issue.

7. The holder filed a counterstatement wherein it denied the claims against it.

8. The opponent is represented by J A Kemp LLP and the holder is represented by Wallace LLP. Both parties filed evidence in these proceedings. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

9. 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

10. The opponent's evidence came in the form of the witness statement of Mr James Andrew Fish dated 16 November 2023. Mr Fish is a Chartered Trade Mark Attorney and Solicitor at the opponent's representative firm and is, therefore, duly authorised to file evidence on the opponent's behalf. Mr Fish's evidence is accompanied by two exhibits, being JAF1 and JAF2, and was introduced to demonstrate two points, the first being the etymology of the words in the parties' marks and the second being a search result of the UK IPO and WIPO's register regarding marks with the letter string 'ANOMAL-'.

11. The holder's evidence came in the form of the witness statement of Naazneen Schmittzehe dated 15 January 2024. Ms Schmittzehe is a Consultant Solicitor at the holder's representative and is, therefore, duly authorised to file evidence on the holder's behalf. Ms Schmittzehe's evidence is accompanied by four exhibits, being NS1 to NS4, and was adduced to demonstrate the difference in marketing strategies of the parties (namely in relation to the cost of the parties' goods) and to rebut the evidence put forward by the opponent.

12. I do not intend to summarise the parties' evidence (or submissions, for that matter) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUES

13. Before proceeding, I consider it necessary to discuss a number of preliminary issues stemming from points raised in the parties' pleadings, evidence and submissions. I raise these issues at this stage as none of them have any effect on the assessments that I must make throughout this decision. As such, I consider it necessary to deal with them at the outset with the proviso that I will not discuss them any further over the course of my decision.

Etymology of the words contained in the parties' marks.

14. As above, the opponent's evidence included evidence regarding the etymology of the words 'ANOMALY' and 'ANOMALIA'.[1] This evidence is noted, however, the assessments I must make regarding the marks throughout this decision is based on the average consumer's understanding of the words contained within them and not the detailed etymology of the words at issue. I accept that it may very well be the case that the words contained in the parties' marks share common origins and have similar meanings, however, this will be irrelevant if the average consumer is not aware of such origins or meanings. On this point, there is nothing to suggest whether average consumers would be aware of the etymology of the words at issue, and I will say no more about this point.

State of the register

15. The opponent's evidence introduces results from a search of the 'Trademarknow' database that was undertaken by Mr Fish on 16 November 2023. The search was directed at the letter string 'ANOMAL-' and covered both the UK and WIPO registers. The evidence shows four results,[2] two of those being the marks at issue here (with another being one which is owned by the opponent). The holder, in response, sought to file its own search results of the registers,[3] which shows 53 results.

16. In short, neither parties' evidence on this point has any bearing on these proceedings. Firstly, the opponent does not seem to suggest why it has adduced such evidence and I note that this point has not been picked up further in its written submissions. Secondly, if it was the case that the holder's introduction of further register evidence was to prove that the common use of marks with the letters 'ANOMAL-' has led to a weakening of the distinctive character of the opponent's mark, this is of no assistance either. I say this because state of the register evidence is, without anything further, commonly found to be of no assistance in

[1] JAF1
[2] JAF2
[3] NS4

proceedings before the Tribunal. On this point, I refer to the oft cited case of *Zero Industry Srl v OHIM*, Case T-400/06, wherein the General Court ("GC") set out that the mere fact that a number of trade marks exist on the register that contain similar words is not enough to establish that the distinctive character of that shared element has been weakened since evidence of this nature would not include indications as to how many of such trade marks are effectively used in the market. In the present case, nothing has been filed beyond the search results provided. To reiterate, this evidence is of no assistance to either party.

The opponent's mark as represented in the holder's counterstatement.

17. In its counterstatement, the holder makes reference to a comparison between the IR and the following mark:

18. While this representation of the opponent's mark is not too far removed from the mark as registered, it is not the same. The opponent's mark is a word only mark and while it is capable of being presented in any standard typeface, this does not extend to cover the dissection of the letter 'A' in the above example. As a result, the mark as presented by the holder in its counterstatement is not relevant to the assessment I must make here. I will, therefore, say no more about this representation.

The preliminary indication of the Tribunal

19. When dealing with proceedings where a preliminary indication has been issued, I would ordinarily refrain from reviewing the indication and would also not seek to mention it in the body of my decision. However, in the present case the holder referred to it directly in its evidence. As such, my exposure to the preliminary indication was inevitable and, therefore, I consider it necessary to mention it here. In Ms Schmittzehe's evidence, she states the following:

> "At the outset, I would point out that the marks are not similar and this is consistent with the UK IPO's position as set out in their letter of 29th August 2023 in which the UK IPO stated that there is '**insufficient similarity between the parties' marks to support a finding of a likelihood of confusion between the marks**.'"(original emphasis included)

20. For the avoidance of doubt, the preliminary indication does not reflect the UK IPO's position as claimed by Ms Schmittzehe in her evidence. On this point, I refer to the closing line of the Tribunal's letter wherein it stated that the preliminary indication was not binding and that in the event the proceedings were to continue, they would be dealt with by a different Hearing Officer. To confirm, I am not the Hearing Officer that made the initial preliminary indication and given that it is not binding on me, I am entitled to decide this matter in accordance with my own conclusions, be that in line with the preliminary indication or not. For the remainder of this decision, I will take no account of the preliminary indication and will mention it no further.

The business operations of the parties

21. The holder's position in respect of the goods at issue is that the parties' goods are sold at significantly different price ranges. On this point, I note that the holder claims that its own goods are sold at a significantly higher price range than the goods of the opponent and has provided evidence to that effect.[4] While this may be the case, the assessment I must make in respect of the goods at issue must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties.[5] For the avoidance of doubt, this assessment does not include having regard to the price point of the parties' goods. The fact that the respective goods are at odds with regard to their pricing does not mean that they could not be found within the same market, indeed, the broadly worded terms of the parties' specifications are such that they would cover expensive or

[4] NS1, NS2 and NS3
[5] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

inexpensive goods[6] (for example, luxury cosmetics are found within the same market as drugstore cosmetics i.e. the cosmetics market). As a result, the actual segment of the relevant market that the parties may actually (or intend to) operate in is not a relevant factor to my goods comparison. As above, I am required to compare the goods notionally and as they appear before me and I will say no more about this argument.

DECISION

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

22. 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."

23. 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."

[6] See *Compagnie des montres Longines, Francillon SA v OHIM,* Case T-505/12, in particular paragraph 56 wherein the GC found that the relevant market in which the goods fell could not be limited to the 'luxury' segment of that market, and that the category of goods was sufficiently broad to include both 'consumer' goods falling within a generally affordable price range and certain 'inexpensive' goods.

24. 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.

25. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than five years before the priority date of the IR, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the goods for which its mark is registered.

26. 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 the goods

27. The holder's goods can be found at paragraph one above whereas the opponent's goods can be found at paragraph four.

28. When making the comparison, all relevant factors relating to the goods 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".

29. 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.

30. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

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

31. I note that in its written submissions, the holder accepts that "cosmetics", "soaps", "perfumes", "essential oils", "hair lotions", "make-up removing products" and "beauty masks" in its own specification are identical to the opponent's goods. I accept this concession and will proceed on the basis that these goods are identical.

32. As for the remaining goods, I note that the holder submits that these are either similar to a low degree or dissimilar. In respect of the lowly similar goods, the holder lists "dentifrices", "depilatories", "lipstick" and "shaving products". As for the claimed dissimilar goods, the holder lists "laundry preparations", "polishing preparations", "degreasing preparations", "abrasive preparations", "preservatives for leather (polishes)" and "creams for leather". On the contrary, the opponent submits that all goods are identical or similar (though it does not submit the proposed level of similarity). While the concession as to at least some similarity for some goods is noted, I will proceed to consider the goods comparison in the ordinary way (save for the goods conceded to be identical).

33. While the holder's term of "lipstick" is a cosmetic, I note that it has no direct counterpart in the opponent's specification. Having said that, the opponent's specification does include a range of cosmetic goods such as "facial oils", "make-up remover", "moisturising creams" and "cosmetic preparations for body care", to

name just a few. In my view, while the nature, method of use and purpose of the goods are all different, there is an overlap in user and trade channels between the goods. I say this because a user looking to buy the opponent's goods is also likely to wear lipstick. As for trade channels, it is my understanding that it is common in the trade for undertakings that produce lipsticks to also produce a wide range of other types of cosmetics, such as the opponent's goods. Lastly, the goods are not competitive in nature and I do not consider that they are complementary either. I say this because while goods such as make-up removers (representing the opponent's best case on this point) may be used to remove lipstick, I do not consider that they are necessarily important or indispensable to the lipstick product itself, or vice versa. Overall, I agree with the holder that these goods are similar to a low degree.

34. "Dentifrices" in the holder's specification cover toothpastes or tooth powders. I note that the opponent's specification includes the term "gels for cosmetic purposes". While I do not consider that this covers toothpaste, it is broad enough to cover goods such as teeth whitening gels. I say this because cosmetic products are used for the beautification of the user and, in my view, this includes the whitening of the user's teeth. In my view, tooth whitening gels are likely to be produced and sold by the same undertaking that produces and sells toothpaste. As such, there is an overlap in trade channels. Further, the user is also likely to overlap as they will be sought by the same consumer. As for nature and method of use, I consider that these differ as while both may be gels applied to the teeth, their ingredients and the way in which they are actually used will not be the same. As for purpose, there is some overlap here on the basis that toothpaste often contains teeth whitening benefits. Having said that, the overlap in not direct because the primary purpose of the holder's term is to clean the teeth. The goods are not competitive and neither are they complementary. Taking all of this into account, I am of the view that the goods are similar to between a low and medium degree. Failing that, I note that the holder has conceded a low degree of similarity in respect of these goods so, at worse, they will be similar to a low degree.

35. I move now to consider the last two terms for which the concession of a low degree of similarity was made, being "depilatories" and "shaving products" in the holder's

specification. These goods are those used for the removal of hair. As grooming products, I consider that they are cosmetic products used in order to take care of the user's body (i.e. to remove body or facial hair). Having considered the opponent's specification, I note that it includes the broad term "cosmetic preparations for body care". It is my view that as the holder's terms are all grooming products for the care of the body, they fall within the broad term of the opponent. As a result, I consider that these goods are identical under the principle outlined in *Meric*. Alternatively, if I am wrong to find identity then I consider that the goods are similar to a medium degree. I say this because the goods are likely to share overlaps in purpose in that they are both used for the care of the body (be that the removal of hair or otherwise). Further, the user and trade channels overlap as they will be sought by the same consumer and are likely to be produced and sold by the same undertakings. Again, even if I am wrong to have reached the above conclusions then the holder's concessions are such that these goods are, at least, similar to a low degree.

36. In considering the terms of "laundry preparations", "polishing preparations", "preservatives for leather (polishes)" and "creams for leather" in the holder's specification, I am of the view that they are dissimilar to all of the goods in the opponent's specification. I say this because the opponent's goods are all expressly for use on the human body whereas the above goods of the holder are not[7]. As such, I consider that the nature, method of use, purpose and trade channels all differ. While I appreciate that all of the goods will be sought by members of the general public at large, I do not consider that this is sufficient to give rise to a finding of similarity between them. As a result, these goods are dissimilar.

37. Lastly, I move to consider the terms of "degreasing preparations" and "abrasive preparations" in the holder's specifications. These are broad terms and I appreciate that cosmetic goods may be used to 'degrease', scrub or exfoliate the skin. However, I am of the view that to interpret the terms in this way would result in a liberal interpretation that goes beyond the natural, or core, meaning of the terms.[8]

[7] On this point, I wish to point out that while laundry preparations may be scented, they do not cover (or fall within) the term of "perfumes", being a term in the opponent's specification.
[8] *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch)

Instead, I consider that the above goods will be understood as covering abrasive and degreasing products such as sandpaper or glass cloth and turpentine or kitchen degreasers, respectively. Such goods are entirely different from the opponent's goods and I, therefore, see no obvious reason as to why they would share any overlaps in the relevant factors. These goods are, therefore, dissimilar.

38. Where there is no similarity of goods, there can be no likelihood of confusion in respect of oppositions brought under section 5(2)(b) grounds.[9] As a result, my findings above mean that the opposition fails in respect of the following goods, being those that I have found dissimilar:

Class 3:	Laundry preparations; polishing preparations; degreasing preparations; abrasive preparations; preservatives for leather (polishes); creams for leather.

The average consumer and the nature of the purchasing act

39. 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. 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."

[9] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

40. The goods at issue are ordinary consumers goods that will be selected by the general public at large. The goods will all be available via general or specialist retailers (such as beauticians, hair dressers and perfumeries or make-up shops) and their online equivalents (where available). In physical stores, the goods will be displayed on shelves where they will be self-selected by the consumer. When the selection takes place online, the goods will be selected after viewing an image of it on a webpage. Clearly, the visual component will dominate the selection process, though I do not discount the aural component entirely as suggestions may come via word of mouth recommendations or advice from sales assistants, especially in beauticians or hair dressers where the goods may be selected after a discussion with the hair dresser or beautician. Regardless of the importance of the aural component, the consumer will still view the goods.

41. The goods are likely to be selected on a fairly frequent basis and at a varying cost (though I do not consider that this extends to highly expensive goods). When selecting the goods, the consumer is likely to consider factors such as the ingredients used, the desired effects on the skin/hair (for skincare and haircare goods), scent (mainly for perfume goods but may equally apply to skincare goods) and whether the goods have been tested on animals. Even where the goods may be low cost, I consider that they will all attract a medium degree of attention on the basis that they will all be used on the human body.

Comparison of the marks

42. 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.

43. 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."

44. 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.

45. The respective trade marks are shown below:

The opponent's mark	The IR
ANOMALY	

46. I have submissions from both parties in respect of the comparison of the marks. While I do not intend to reproduce those here, I confirm that I have taken them into account in making the below comparisons.

Overall impression

47. The opponent's mark is a word only mark consisting solely of the word 'ANOMALY'. As there are no other elements present, it follows that the overall impression of the mark lies in the word itself.

48. As for the IR, this is a figurative mark that consists of a device element followed by the word 'ANOMALIA' which is presented in a black, fairly standard typeface. While

the device element sits at the beginning of the mark, consumers will be drawn to the element of the mark that can be read, being the word 'ANOMALIA'. As a result, it is the word that dominates the overall impression of the mark with the device element playing a lesser role. As for the stylisation used in the word element, this is very limited and will not, in my view, contribute to the overall impression of the mark.

Visual comparison

49. Visually, the marks share the identical letter string of 'ANOMAL' which forms six of the seven first letters of the opponent's mark and six of the first eight letters in the word element in the IR. The marks differ in the presence of the letter 'Y' in the opponent's mark and 'IA' in the IR, both of which follow the shared letter string. Additionally, the device element at the beginning of the IR has no counterpart in the opponent's mark and while I have found this to play a lesser role, it still contributes as a point of visual difference. As for the stylisation used in the IR, I consider this fairly banal and by virtue of the opponent's mark being registered as a word only mark, it is protected for use in any standard typeface, therefore, whilst it is not legitimate to perform a comparison between a word mark and a stylised word mark by considering specific ways in which the word might be presented, the point is that the word mark is not limited to any particular typeface and therefore the typeface in which the figurative mark is written does not provide a point of distinction in itself.[10] Taking all of this into account and bearing in mind the overall impression of the marks, I consider that the marks are visually similar to between a medium and high degree overall.

Aural comparison

50. The opponent's mark consists of the ordinary word 'ANOMALY' which has four syllables that will be pronounced in the ordinary way as 'AH-NOM-AH-LEE'. While the device element in the IR may be perceived as a letter 'A' or a combination of 'AM', I do not consider that consumers will seek to pronounce it. As a result, the

[10] See the decision of the Appointed Person in *HERNO S.p.A. v Miss Sparrow Ltd,* BL O/954/22, paragraphs 23 and 34.

aural element of the IR lies solely in the word 'ANOMALIA'. I consider that this may be pronounced as 'AH-NO-MAHL-YAH' by some consumers but as 'AH-NOM-AH-LEE-AH' by others. I consider that both of these groups of consumers make up significant proportions of the average consumer base. In light of this, and because the latter pronunciation forms the opponent's best case, I will proceed in reliance upon the consumers that pronounce it as 'AH-NOM-AH-LEE-AH'.[11] As such, the marks are of similar lengths and the entirety of the opponent's aural element is reproduced in the first four of the five syllables of the IR. As a result, I consider that the marks are aurally similar to a high degree.

Conceptual comparison

51. The opponent's mark consists solely of the word 'ANOMALY', the meaning of which will be immediately graspable by average consumers as '*something different from what is usual or expected'* or '*a deviation from the normal or usual order'*.[12] As for the IR, the concept will be derived solely from the word 'ANOMALIA'. While it has no dictionary meaning, I am of the view that consumers will likely consider it a play on the word 'ANOMALY' or potentially a deliberate misspelling of the same. I say this because when confronted with 'ANOMALIA', consumers will seek to attribute a concept to it and the readily apparent commonality between this word and 'ANOMALY' will lead to such a connection being made.[13] While the shared link to the concept of 'ANOMALY' will be noticed, I consider that the differences are such that they will not be viewed as conceptually identical because consumers will identify some difference between them (though I suspect they will not understand what the alteration from 'Y' to 'IA' at the end of the marks actually means). Overall, I consider that the shared understanding of the word 'ANOMALY' means that these marks are conceptually similar to a high degree.

[11] In taking this approach, I refer to the case of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 wherein Kitchin LJ set out that if the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement. While an infringement case, this principle applies to section 5(2)(b) oppositions. Therefore, if these consumers are confused then I am entitled to find that the opposition succeeds regardless of whether the other group of consumers would be.

[12] https://www.collinsdictionary.com/dictionary/english/anomaly

[13] As regards the conceptual comparison, see *Usinor SA v OHIM*, Case T-189/05, paragraph 62, in which the GC found that the average consumer, when perceiving a verbal sign, will break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him.

Distinctive character of the opponent's mark

52. 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)."

53. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not filed any evidence of use and, therefore, I have only the inherent position to consider. I note that in making submissions in respect of the distinctive character of the mark, the holder appears to focus on the fact that the IR is not a word in the English language and, therefore, is highly distinctive. While noted, this is not relevant to the

assessment that I must make here and it is, instead, the distinctiveness of the opponent's mark that is in issue.

54. The opponent's mark consists solely of the word 'ANOMALY'. While this has no descriptive or allusive qualities to the goods upon which the opponent relies, it will be understood as an ordinary dictionary word with a well-known meaning. As a result, I do not consider that its use from a trade mark perspective is particularly remarkable. As such, I do not consider that it is a mark that qualifies as one that enjoys a high level of distinctive character. Instead, I find that the inherent distinctive character of the opponent's mark sits at a medium degree.

Likelihood of confusion

55. 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 opponent's mark, 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 minds.

56. I have found the goods to be either identical or similar to varying degrees, including low. The average consumer base is formed of members of the general public who will select the goods via primarily visual means (although I do not discount an aural component, especially in certain purchasing scenarios) after having paid a medium

degree of attention. I have found the marks at issue to be visually similar to between a medium and high degree and aurally and conceptually similar to a high degree. I have found the opponent's mark to enjoy a medium degree of inherent distinctive character.

57. Firstly, I appreciate that the word 'ANOMALIA' in the IR is presented in a figurative manner and in a slightly stylised typeface. However, as I have already noted, the opponent's mark is a word only mark and the notional and fair use of the same means that the stylised typeface used in the IR does not provide a point of distinction between the two marks. Secondly, the device element in the IR is fairly banal and despite sitting at the beginning of the mark, it will not be used by consumers in order to assist them in accurately recalling the parties' marks, particularly when taking into account the notion of imperfect recollection. I also take into account that consumers will be drawn to the element of the mark that can be read, and I remind myself of my findings regarding the role that the device element plays in the IR. I therefore am of the view that the presence of the device element does not preclude a finding of direct confusion.

58. In light of the above, it is my view that it is the verbal elements of the marks, being 'ANOMALY' in the opponent's mark and 'ANOMALIA' in the IR, that will be used by consumers seeking to recall the marks (be that when they are recalled visually or aurally).[14] Put simply, these words are highly similar from both a visual and aural perspective.[15] They share the same six letter string (which makes up six of the seven letters in the opponent's mark and six of the eight letters in the IR) and differ only in their ends. On this point, I refer to the case of *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 wherein the GC set out that beginnings of words tend to have more visual and aural impacts than the ends.[16] As for the concepts associated with these words, I have set out above that despite the differences in the ends of the words, the consumer will take away a shared connection to the

[14] In saying this, I am mindful to point out that I do not consider that this results in an artificial dissection of the IR. Instead, for the reasons set out in the preceding paragraph, this is as a result of what I consider consumers will seek to pin their recollection of the marks on.
[15] I appreciate that my finding of visual similarity resulted in similarity to between a medium and high degree, however, this comment relates to the similarity of the words themselves.
[16] See also the cases of *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07.

word ‘anomaly’ (be that directly in the case of the opponent’s mark or indirectly in the case of the IR). Taking all of the above into account and bearing in mind the principle of imperfect recollection, I consider it likely that in seeking to recollect the parties’ marks for one another, consumers are liable to misremember which mark is which due to the high similarity between their word elements. Consequently, I consider that there exists a likelihood of direct confusion between the marks at issue. Given the higher level of similarity between the marks, I am of the view that this finding applies in circumstances where the marks are viewed on goods that are only similar to a low degree.

CONCLUSION

59. The opposition succeeds in respect of all of the goods that have been found to be identical or similar. Therefore, the IR is, subject to any successful appeal of my decision, refused protection in the UK for the following:

Class 3:	Soaps; perfumes; essential oils; cosmetics; hair lotions; dentifrices; depilatories; make-up removing products; lipstick; beauty masks; shaving products.

60. That being said, the IR may proceed (again, subject to any successful appeal of my decision) to protection in the UK for the following goods, which I have found to be dissimilar:

Class 3:	Laundry preparations; polishing preparations; degreasing preparations; abrasive preparations; preservatives for leather (polishes); creams for leather.

COSTS

61. The opponent has succeeded in opposing the majority of the holder’s goods. Therefore, I consider that the opponent is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. Given that the

holder has succeeded in defending some of the terms opposed, I consider it appropriate to reduce the costs award to a degree in order to reflect the holder's success.

62. In the circumstances, I hereby award the opponent the sum of £800 as a contribution towards its costs. The sum is calculated as follows:

Preparing the notice of opposition and considering the counterstatement:	£200
Preparing evidence:	£500
Written submissions in lieu:	£300
Sub-Total:	£1,000
Reduction:	*-£300*
Official fees (not subject to a reduction):	£100
Total:	**£800**

63. I hereby order Try Merry to pay ANOMALY IP LLC the sum of £800. 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 5th day of November 2024

A COOPER

For the Registrar