O/1159/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00003908218
IN THE NAME OF TEDEBEBE INTERNATIONAL GROUP LIMITED
FOR THE FOLLOWING TRADE MARK:

Slobber

IN CLASSES 3, 31 & 35

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 506395 BY
TURTLE WAX, INC.

BACKGROUND AND PLEADINGS

1. On 5 May 2023, TEDEBEBE INTERNATIONAL GROUP LIMITED ("the proprietor") applied to register the trade mark on the cover page of this decision in the UK ("the contested mark"). The application was published for opposition purposes on 19 May 2023 and registration was granted on 28 July 2023. The contested mark stands registered for the following goods and services.

Class 3:	Pet stain removers; odour fresheners for animals; deodorants for animals; cosmetics for animals; dental care preparations for animals; skin care products for animals; bath lotion; shampoo for animals; pet odor removers; conditioning sprays for animals; non-medicated pet shampoos; animal grooming preparations; breath fresheners for animals; non-medicated mouth washes for pets; deodorants for human beings or for animals.
Class 31:	Pet foodstuffs; litter for cats; food products for animals; pet foods in the form of chews; animal biscuits; living animals; edible bones and sticks for pets; foodstuffs (animal -); beverages for animals; forage; pet treats in the nature of bully sticks; beverages for pets; animal feeds; processed grains for consumption by animals; pet food for dogs.
Class 35:	Business management and consultancy; retail services in relation to animal grooming preparations; advertising; retail services in relation to fodder for animals; provision of an on-line marketplace for buyers and sellers of goods and services; wholesale services in relation to bedding for animals; retail services in relation to bedding for animals; wholesale services in relation to beauty implements for animals; wholesale services in relation to fodder for animals; wholesale services in relation to animal grooming preparations; retail services in relation to hygienic implements for animals; promotion of goods and services for others; retail services in relation to beauty implements for animals; retail

services in relation to pet products; retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies.

2. On 7 August 2023, Turtle Wax, Inc. ("the applicant") applied to have the contested mark declared invalid under section 47(2)(a) of the Trade Marks Act 1994 ("the Act"). The application was brought under section 5(2)(b) of the Act, is targeted against only those good and services I have underlined above and is reliant upon the following trade marks:

SMUDGES & SLOBBER
UK registration no. 3332451
Filing date 17 August 2018; registration date 9 November 2018
("the applicant's first mark"); and

SMUDGES & SLOBBER
UK registration no. 917999608[1]
Filing date 13 December 2018; registration date 9 May 2019
("the applicant's second mark").

3. Both marks are registered for the same goods and the applicant relies upon all of those as the basis for its application. These goods are as follows:

Class 3:	Combination cleaner and deodorizer for mirrors, glass, windows, and hard surfaces; disposable wipes impregnated with cleaning compounds for use on mirrors, glass, windows, and hard surfaces.
Class 5:	Deodorizer for mirrors, glass, windows, and hard surfaces.

[1] The applicant's second mark is a comparable mark based upon an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. This comparable mark enjoys the same filing and registration dates as its European counterpart.

4. In bringing the application, the applicant claims that the marks are highly similar and that the underlined goods and services are identical and highly similar to the goods of the earlier marks. As a result, the applicant claims that there is a risk of confusion between the marks, which includes a likelihood of association.

5. The applicant filed a counterstatement wherein it denied the claims against it.

6. The applicant is represented by Forresters IP LLP and the proprietor is represented by Pawel Wowra. Neither party filed evidence. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful consideration of the papers.

7. 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

8. Section 5(2)(b) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

> "47. –
>
> […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) […]

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

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

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year

period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

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

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

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for

registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

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

9. 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.”

10. 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.”

11. 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.

12. The applicant’s marks qualify as earlier trade marks under the above provisions. As the applicant’s marks had not completed their registration processes more than

five years before the filing date of the applicant's mark or the date of the application in issue, they are not subject to proof of use pursuant to section 47(2B) of the Act. Consequently, the applicant may rely on all of the goods for which its marks are registered.

13. 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 and services

14. The competing goods are as follows:

The applicant's goods	The proprietor's goods and services
<u>Class 3</u> Combination cleaner and deodorizer for mirrors, glass, windows, and hard	<u>Class 3</u> Pet stain removers; pet odor removers.

surfaces; disposable wipes impregnated with cleaning compounds for use on mirrors, glass, windows, and hard surfaces. Class 5 Deodorizer for mirrors, glass, windows, and hard surfaces.	Class 35 Provision of an on-line marketplace for buyers and sellers of goods and services; promotion of goods and services for others.

15. Section 60A of the Act sets out that goods or services are not to be considered similar simply because they appear in the same classes. Alternatively, section 60A also states that goods or services are not to be considered dissimilar simply because they appear in different classes.

16. 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".

17. 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.

18. While neither party filed any evidence or written submissions, I note that their filed documents did include comments as to the claimed identity/similarity and dissimilarity of the goods and services at issue. The applicant's comments in respect of the proprietor's class 3 goods set out that they are goods used to clean and deodorise surfaces that have been affected by pet stains and smells. As for the services, the applicant claims that the proprietor's class 35 services could include the goods covered by the earlier marks and, thus, be deemed similar since the specification is so broad and encompasses an undefined list. As for the proprietor, I note that its comments in its counterstatement are more detailed. While I will not discuss them in full, I note that arguments have been put forward in order to highlight the claim that the goods and services have different natures, purpose and methods of use. Further, the proprietor argues that the goods and services are not complementary and neither are they in competition.

19. I can confirm that I have taken both parties' comments into account when making the following comparison.

<u>Class 3</u>

Pet stain removers; pet odor removers.

20. I will compare the above goods to the applicant's term of "combination cleaner and deodorizer for mirrors, glass, windows, and hard surfaces". My first consideration

as to whether the applicant's term can be considered one that is used to clean pet stains and deodorise pet odours. Firstly, I do not consider that pet stains or pet odour removers will be used on mirrors, glass or windows. That being said, the applicant's term includes a reference to 'hard surfaces' which could include wooden floors or tiles. It is this aspect of the term that I will focus on here.

21. In short, I see no reason why a pet stain or pet odour removers are limited to just removing stains or odours on carpets, upholstery or other soft surfaces. Firstly, to remove a stain is to clean the affected surface in order to remove it. Therefore, I consider that stain removers are types of cleaning products. Secondly, hard surfaces are fully capable of being stained. So if a dog was to urinate on a hard wood floor, for example, then it remains possible that the urine would stain the wood floor, thereby requiring a 'stain removal'. The user looking to remove the stain would still seek to use a pet stain remover to try and remove the stain. Further, if there was any odour as a result of the urine soaking into the wood, they would also seek to deodorise the floor. As result, I consider that the proprietor's term is one that can be said to cover cleaning products or deodorisers for use on hard surfaces. As such, I consider that the applicant's term can be said to fall within the proprietor's meaning that the goods are identical under the principle outlined in the case of *Meric*.[2]

22. In the event that I am wrong to find identity on the basis that a pet stain or pet odour remover cannot reasonably be said to be used on hard surfaces, then I consider the goods to be similar. I say this on the basis that both sets of goods are likely to overlap in nature and method of use as they both cover cleaning/deodorising products that are likely to consist of the same ingredients and used in the same way. While the subject of the mess/stain that is being cleaned or deodorised will differ, both sets of goods will aim to clean or deodorise something. As such, there exists some degree of overlap in purpose. As both are general household cleaning products, they will overlap in user. Lastly, in considering trade channels, I have nothing before me to suggest that a producer of pet stain/odour removers will also produce general household cleaning items. That being said, I consider it likely that

[2] See *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05

the goods will be available in the same sections of supermarkets (household cleaning aisles, for example) and there will, therefore, be some overlap in distribution channels. Taking all of this into account, if I am wrong to find identity then I find that the goods are still similar to a high degree.

<u>Class 35</u>

Provision of an on-line marketplace for buyers and sellers of goods and services.

23. I agree with the applicant to the extent that the above term is broad enough to cover an online marketplace that sells the goods covered by the applicant's specification. That being said, this does not mean that the goods and services are automatically similar. Clearly, the natures, methods of use and purpose of the goods and services all differ. As for trade channels, I have nothing before me to suggest that a producer of the applicant's goods would offer an online marketplace wherein third parties can sell those same goods. Further, I do not consider that the producer of the applicant's goods would sell them via an online marketplace but would, instead, offer the via their own, or third party retail services. On this point, I appreciate that companies such as Amazon may sell cleaning products and also offer an online marketplace for all types of goods, however, I have nothing before me by way of evidence to suggest that such a practice is common in the trade. The goods and services are not complementary as while the applicant's goods may appear on an online marketplace, they are commonly sold via retail services or in physical stores (such as supermarkets) and, therefore, they are not important to one another.[3] Further, I have no reason to believe why the goods and services would be in competition and, without anything to suggest otherwise, I find that they are not. Lastly, I do appreciate that there is an overlap in user in that members of the general public at large will buy the applicant's goods and use the proprietor's services. However, this overlap alone is not, in my view, sufficient to warrant a finding that the goods and services are similar to any degree. They are, therefore, dissimilar.

[3] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06

Promotion of goods and services for others.

24. Again, I appreciate that these services may cover promotional of the applicant's goods. However, the nature of the applicant's goods and the above services clearly differ. So too do the methods of use and purposes. I do not consider that the trade channels overlap either. I accept that a producer of the applicant's goods will seek promotional services, however, the services will generally be provided by a separate undertaking, being one that focuses on promotion or advertising. As for user, it is my understanding that the above services will commonly be sought by business users looking to promote their goods or services whereas the applicant's goods will be sought by members of the general public at large. Moving to consider complementarity, I accept that the promotion of goods is often important to the goods themselves, however, I have nothing to suggest that end consumers would believe that the service and the goods are provided by the same undertaking. As such, I see no reason to find that the goods and services are complementary in nature. Lastly, I do not consider that the goods and services are competitive either. As a result, I consider that these goods and services are dissimilar.

Conclusion in respect of the goods and services

25. Bearing in mind that some similarity of goods and services is essential for finding a likelihood of confusion under section 5(2)(b) grounds,[4] my findings above mean that the application must fail in respect of the class 35 services. Therefore, the application may only proceed in respect of the following goods:

Class 3: Pet stain removers; pet odor removers.

The average consumer and the nature of the purchasing act

26. 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

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

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."

27. The goods at issue are ordinary consumer goods that will be selected by the general public at large who will select them via general or specialist retailers (such as pet shops) and their online equivalents. In physical stores, the goods will be displayed on shelves where they will be self-selected by the consumer. When the purchase takes place online, the goods will be selected after viewing an image 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.

28. The goods are likely to be selected on a fairly frequent basis and at a relatively inexpensive cost. When selecting the goods, the consumers are likely to consider factors such as the method of use, active ingredients and the scent (on the basis that cleaning products often offer some form of additional scented qualities). Taking this into account and bearing in mind that the goods at issue are those that will be used in the user's home, I find that the average consumer will pay a medium degree of attention when selecting the same.

Comparison of the marks

29. 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

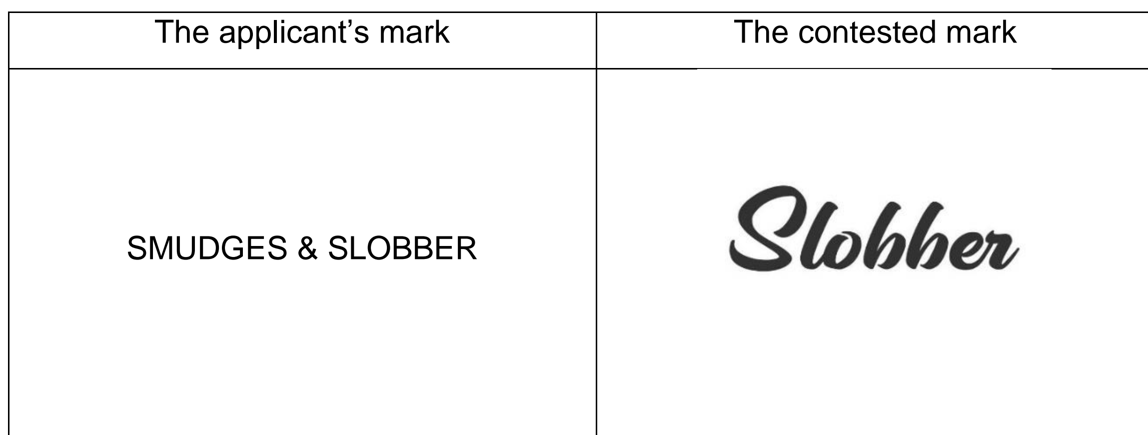
conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

30. 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."

31. 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.

32. The applicant's marks are identical and, therefore, I will proceed to consider them as one, namely "the applicant's mark".[5] As such, the respective trade marks are as follows:



The applicant's mark	The contested mark
SMUDGES & SLOBBER	Slobber

[5] For the avoidance of doubt, any reference to the applicant's mark throughout the remainder of this decision is to be taken as a reference to them both.

33. Again, neither party filed evidence or written submissions in this matter but I note that, in their filed application and defence, they did make comment as to the similarity of the marks. The applicant's comments are simply that the marks are highly similar. As was the case with the goods and services comparison, the proprietor's comments are more detailed and while I confirm that I have given them due consideration, I will not repeat them in full here.

Overall impression

34. The contested mark is a figurative mark that consists of the word 'Slobber' in a dark grey stylised typeface. This element sits on a white background. The mark will, plainly, be dominated by the word 'Slobber', however, I am of the view that the stylisation used will play a role (albeit a lesser one) within the mark itself. As for the white background, this will simply be viewed as a banal element and will, therefore, have no impact on the mark as a whole.

35. The applicant's mark is a word only mark that consists of the words and character 'SMUDGES & SLOBBER'. I am of the view that neither word plays a greater role than the other and, instead, find that the overall impression of the mark is dominated by this phrase as a whole.

Visual comparison

36. Visually, the marks share the word 'Slobber'. While the applicant's mark is a word only mark and, therefore, capable of being presented in title case, I am of the view that the fair and notional protection of the same does not extend to use of the word in the same stylisation as that used by the proprietor. The way in which the words are presented is, therefore, a point of difference.[6] In addition, the marks differ in the presence of the word 'SMUDGES' and the ampersand in the applicant's mark, neither of which have any counterpart in the contested mark. On this point, I remind myself that consumers tend to focus on the beginnings of marks,[7] being where the

[6] On this point, the applicant's mark, being registered in black and white, may be used in any colour including the same shade of grey as used by the proprietor.
[7] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

points of difference in the applicant's mark lie. Taking all of this into account, I am of the view that the marks are similar to no more than a medium degree.

Aural comparison

37. The contested mark consists of two syllables that will be pronounced in the ordinary way. As for the applicant's mark, the ampersand (&) will be pronounced as 'AND' meaning that the applicant's mark consists of five syllables, being 'SMUDGES AND SLOBBER'. This will be pronounced in the ordinary way. The last two syllables of the applicant's mark are identical to the entirety of the aural element of the contested mark. While that may be the case, the other syllables in the applicant's mark (of which there are three) have no counterpart in the contested mark. The differences result in the applicant's mark being, aurally, more than twice as long as the contested mark. Further, the differences sit at the beginning of the mark which, as above, is the point upon which consumers will focus. Taking all of this into account, I find that the marks are aurally similar to between a low and medium degree.

Conceptual comparison

38. In its counterstatement, the proprietor argues that the marks hold no intrinsic meaning or relevance to the associated goods so the conceptual comparison between them is irrelevant. I disagree. While I am mindful that conceptual comparisons are usually made without reference to the goods or services at issue,[8] in the present case, I consider that the goods at issue will impact upon the consumers' understanding of the marks. I say this because in the context of cleaning products, 'SMUDGES' will be understood as smears or dirty marks on a surface.[9] Further, the word 'SLOBBER' will be understood as saliva falling from the mouth[10] and in the context of pet stain or odour removers, the 'slobber' will be understood as being that of an animal.

[8] See the decision of Professor Phillip Johnson, sitting as the Appointed Person in *EMILIANA* (BL O/052/22)
[9] https://www.collinsdictionary.com/dictionary/english/smudge
[10] https://www.collinsdictionary.com/dictionary/english/slobber

39. When considering the applicant's mark as a whole, I am of the view that consumers will understand the meaning of the words, individually, but when viewed in combination, will not perceive them to form any unitary meaning. Instead, the consumer will simply consider them to be references to the subject of the cleaning product, i.e. the stains or marks that the cleaning products are designed to remove. As for the contested mark, a similar approach will apply in that the consumer will understand 'Slobber' to be a reference to the fact that the goods are designed to remove the slobber (be that or a person or of an animal).

40. In comparing these concepts, I am of the view that the meaning behind 'SLOBBER' will be identical in both marks. However, this will be offset by the presence of the word 'SMUDGES' in the applicant's mark. Given that this plays an equal role with 'SLOBBER' in the overall impression of that mark, I am of the view that it constitutes a significant point of conceptual difference. As a result, I consider that the marks are conceptually similar to a medium degree.

Distinctive character of the applicant's mark

41. 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)."

42. 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 applicant has not filed any evidence of use and, therefore, I have only the inherent position to consider.

43. The applicant's mark consists of the words and character 'SMUDGES & SLOBBER'. Both words are ordinary dictionary words and, as above, they do not combine to form a unitary meaning. While the meaning of the words themselves will be known to consumers and, in my view, will allude to the goods at issue (in that they refer to the type of mark, smear or stain that the goods are designed to remove), the combination of words is somewhat unusual. So while I do not consider that the allusive nature of the individual words will be ignored outright, I consider that the unusual impression created by the combination offsets this to be point that leads me to conclude that the mark is inherently distinctive to a medium degree.

Likelihood of confusion

44. 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 applicant'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.

45. I have found the goods at issue to be identical but, if I am wrong on this point, then they are similar to a high degree. 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) and after having paid a medium degree of attention. I have found the marks at issue to be visually similar to no more than a medium degree, aurally similar to between a low and medium degree and conceptually similar to a medium degree. I have found the applicant's mark to be inherently distinctive to a medium degree.

46. In considering the issue of direct confusion, I am of the view that I can deal with it briefly. Despite the fact that the goods are identical (or, at worst, similar to a high degree) and even bearing in mind the possibility of imperfect recollection, the differences between the marks are too great for an average consumer paying a medium degree of attention to mistake or mis-recall the contested mark as the applicant's mark, or vice versa. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks.

47. I now proceed to consider whether there exists a likelihood of indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

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

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

48. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there

must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

49. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs. Having said that, the applicant has not made any submissions as to any other scenario wherein a likelihood of indirect confusion may apply.[11] Without any specific argument on this point, I do not consider it is incumbent upon me to formulate the applicant's case on its behalf. To do so would not only be inappropriate in the circumstances but entirely unfair to the proprietor. As such, I will only give due consideration to the scenarios set out in *L.A. Sugar*.

50. In my judgment, none of the scenarios set out in *L.A. Sugar* apply. The shared word 'SLOBBER' is not so distinctive that consumers would assume that no one else but the applicant would use it in a trade mark at all. One of the points of difference, being 'SMUDGES' is, in my view, just as distinctive as 'SLOBBER'. Further, I see no reason why consumers would consider it logical for an undertaking that uses the mark 'SMUDGES & SLOBBER' to remove the equally distinctive word 'SMUDGES' (and the ampersand) from its beginning to create, arguably a mark with a lesser degree of distinctive character. Conversely, I am of the view that consumers would also consider it illogical for a brand known as simply 'SLOBBER' to add 'SMUDGES &' to the beginning of its mark. 'SMUDGES' may indeed indicate a type of mark that the cleaning products are designed to remove, however, I do not consider its addition (together with '&') before 'SLOBBER' would point to a brand extension or sub-brand. In the context of the mark as a whole, I appreciate that the addition of 'SMUDGES' may allude to an additional type of stain that the goods may be used to clean (as well as being used to clean up 'slobber'). However, this does not, in my view, indicate a sub-brand or brand extension. I say this because, in this context and bearing in mind the goods at issue, the words will be viewed as allusive meaning that the shared use of 'Slobber' (being the stain the product is meant to clean or remove) would be seen as coincidental as opposed to an indication that the marks share the same origin. Lastly, I will say that even if the

[11] On this point, I note that the applicant has failed to make any submissions as to why it considers there to be a likelihood of indirect confusion at all.

consumer was to call to mind the applicant's mark when confronted by the contested mark (or vice versa), this is not sufficient. I say this because the calling to mind of another mark is considered mere association and not indirect confusion.[12] Taking all of the above into account and bearing in mind (1) the comments of Mr Mellor Q.C. and Arnold LJ referred to at paragraph 49 above and (2) the fact that the applicant has offered no explanation in support of its claim for a likelihood of indirect confusion, I am of the view that there exists no indirect confusion between the marks at issue, even when the goods upon which the consumer views the marks are identical

51. For the avoidance of doubt, I have given consideration to the application of the *Medion* principle[13] to the present case. I appreciate that this point has not been pleaded or raised by the applicant, however, even if it were, it would offer no assistance. I say this because while the applicant's mark does not form a unit, I do not accept that it automatically follows that 'SLOBBER' must have distinctive significance independent of the whole of the mark. As I have set out above, 'SMUDGES & SLOBBER' is an unusual combination of allusive words and I consider that, standing back and looking at the mark as a whole (as most average consumers would), 'SMUDGES & SLOBBER would be seen as one, not two signs. As such, I do not consider that the *Medion* principle applies.

CONCLUSION

52. The application fails in its entirety and the contested mark is, subject to any successful appeal of my decision, permitted to remain on the trade marks register for all of the goods and services for which it is registered.

COSTS

53. The proprietor has succeeded in full and, therefore, is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice

[12] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[13] The correct approach to which being set out by Arnold J (as he then was) at paragraphs 18 to 21 of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

1/2023. I note that the only task the proprietor was required to undertake was to review the application for invalidity and to prepare a counterstatement in response to the same. For such a task, I award the proprietor the sum of £400 as a contribution towards its costs.

54. I hereby order Turtle Wax, Inc. to pay TEDEBEBE INTERNATIONAL GROUP LIMITED the sum of £400. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 4th day of December 2024

A COOPER
For the Registrar