

O/340/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
No. 2581295
BY KIT COSMETICS PTY LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 3, 35 & 44

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER No. 102338 BY
KIK TEXTILIEN UND NON FOOD GMBH**

BACKGROUND

1) On 16 May 2011 Kit Cosmetics Pty Limited (hereinafter the applicant) applied to register the following mark:



2) In respect of the following goods:

In Class 3: Cosmetics, toiletries and personal care products including lotions, gels, butters, creams, balms, soaking treatments, scrubs, exfoliating and other treatments for the hands, feet, face and body but excluding soaps; nail polishes, nail varnishes, nail care preparations including cuticle cream; cosmetic preparations including body gloss; cosmetic preparations for the shower and bath including bath milk and bath salts but excluding soaps (and not for medicinal purposes); all the foregoing goods sold separately.


In Class 35: Retail services including mail order services and retail services on a global computer network connected with cosmetics, toiletries and personal care products including lotions, gels, butters, creams, balms, soaking treatments, scrubs, exfoliating and other treatments for the hands, feet, face and body, nail polishes, nail varnishes, nail care preparations including cuticle cream, cosmetic preparations for the skin including body gloss, cosmetic preparations for the shower and bath including body wash, bath milk and bath salts (not for medicinal purposes), cosmetic accessories including brushes and eyelash curlers, hair care products, perfumery products, soaps, dentifrices, candles, bags including bags for toiletries, cosmetics, cosmetic accessories and personal care products; all the foregoing goods retailed separately.


In Class 44: Provision of beauty care; beauty salon services including manicures, pedicures, facials and body treatments; beauty care advisory services relating to cosmetics, toiletries, personal care products, hair care products, perfumery, nail polishes, nail varnishes and nail care preparations.

3) The application was examined and accepted, and subsequently published for opposition purposes on 11 July 2011 in Trade Marks Journal No.6894.

4) On 2 September 2011, Kik Textilien und non Food GmbH (the opponent), filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the registered proprietor of the following trade marks:

Mark	Number	Date of filing and registration date	Class	Specification relied upon
 <p data-bbox="188 1144 480 1167">Colours claimed red and white.</p>	CTM 7065519	15.07.08 / 28.08.2012	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
			8	Hand operated hand tools; hand-operated equipment for use in agriculture, horticulture and forestry; cutlery; side arms; razors.
			16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office machines (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes).
			21	Small hand-operated household or kitchen utensils (not of precious metal or coated therewith); Containers (not of precious metal or coated therewith) for household and kitchen use; combs and sponges; brushes (other than for painting); articles for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); goods of glass, porcelain or earthenware for household and kitchen purposes, works of art of glass, porcelain or

				earthenware.
			35	Retail services in relation to textiles, cosmetics, toys, stationery, household goods; presentation of various goods (except the transport thereof) for others, to facilitate the display and purchase of the aforesaid goods for customers.
	M821200	18.02.2010 (date of designation in UK)	16	Paper, cardboard and goods made from these materials (included in this class); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paintbrushes; typewriters and office requisites (except furniture); plastic materials for packaging (included in this class); printing type; printing blocks; instructional and teaching material (except apparatus).
			25	Clothing, footwear, headgear.

b) The opponent contends that it is well known for their offerings of fashion textiles, jewellery and other non-food products and has a reputation for being an innovative company. The opponent was founded in 1994 and has approximately 3,000 stores throughout Europe. The opponent contends that the mark applied for is similar to its registered marks shown above as the words differ by only one letter. They state that the first two letters are identical and the last letter of the two parties' marks, "K" and "T" respectively are soft and less clear. They contend that the goods in Class 3 are identical whilst the opponent's goods in Classes 8, 16 and 21 are similar. They also contend that the opponent's goods in Class 3 and the applicant's services in Class 35 are similar. They further contend that the opponent's goods in Classes 16 and 25 are complementary to the applicant's goods in Class 3. It contends that the mark in suit offends against Section 5(2)(b).

c) The opponent states that it has been offering its cosmetic products, personal care products, clothing and related goods since October 2000 and that over the past ten years the range of products sold under the opponent's mark has grown as has the number of retail outlets where the goods are offered for sale. As the marks and goods are similar there is a strong risk of confusion including risk of

association which would be detrimental to the opponent. For these reasons the mark in suit offends against Section 5(3).

5) On 7 December 2011, the applicant filed a counterstatement which basically denied the opponent's contentions, and put the opponent to strict proof of use in relation to M749286 in respect of goods in classes 16 and 25.

6) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard, but both sides provided submissions which I shall refer to as and when required.

OPPONENT'S EVIDENCE

7) The opponent filed a witness statement, dated 7 February 2012, by Mechthild Gottkehaskamp who does not state what position he holds in the company but does state that he has been involved in the business for 17 years. Neither does he confirm that he has an understanding of English. He states that his company is well known for their retail services in relation to discount fashion textiles, jewellery and other non-food products including cosmetics. He states that the name KIK stands for quality at competitively low prices. He states that the company was founded in 1994 and that it currently has 3,100 stores in Germany, Austria, the Czech Republic, Hungary, Slovenia, Slovakia and Croatia. He states that the company intends to offer its products in the UK in the future. He states that initially his company offered textiles but has expanded into related fashion accessories such as jewellery and cosmetics. He offers his opinion on the similarity of the marks which does not assist my decision. He also provides the following exhibits:

- Exhibit A: This consists of a copy of a brochure providing details of the company and its products. This would appear to date from 2011 given some of the content. It provides an overview of the company and shows pictures of its shops which have mark CTM 7065519 upon them but does not show any individual products or labels.
- Exhibit B: Sample pages from the company website which are dated 31 January 2012, after the relevant date.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) I shall first consider the ground of opposition under Section 5(2)(b) of the Act which reads:

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

(a)....

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

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

11) The opponent is relying upon its trade marks CTM7065519 (filed 15 July 2008 and registered 28 August 2012) and M821200 which has a designation date of 18 February 2010. They are clearly earlier trade marks and because of the interplay between the date the application was advertised and the dates of registration/ designation they are not subject to the proof of use requirements set out in Section 6A of the Act.

12) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 (MEDION) and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;

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

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

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

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

13) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods and services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and services, the category of goods and services in question, how they are marketed, who the relevant consumer is and the nature of the purchasing act. Furthermore, I must compare the applicant's mark and the marks relied upon by the opponent on the basis

of their inherent characteristics assuming normal and fair use of the marks on the goods and services in their specifications.

14) In the instant case the opponent has not provided any evidence of use which is prior to the relevant date other than for the assertions of Mr Gottkehaskamp that goods are sold from a number of stores across a large swathe of Europe. It is not clear how many stores the opponent had at the relevant date and no turnover, market share or advertising figures have been provided. It cannot therefore, in relation to either of its marks benefit from an enhanced reputation. In my opinion, the opponent's marks have a reasonable degree of inherent distinctiveness in relation to the goods and services for which they are registered.

15) As the case law in paragraph 12 above indicates I must determine the average consumer for the goods and services of the parties. I must then determine the manner in which these goods and services are likely to be selected by the said average consumer. The goods and services of the applicant can be broadly said to be cosmetics, retailing of cosmetics and the provision of beauty care. The opponent's goods and services are also squarely aimed at the general public who would, in my opinion, be the average consumer. Clearly, there can be enormous variations in price and complexity of such goods. Overall, given the nature of the goods and services I believe that the vast majority of the goods or services of both parties will not be purchased or selected without a reasonable amount of care.

16) I shall now consider the goods and services of the two parties. For ease of reference, I set out the specifications of both parties below:

Applicant's Specification	Opponent's specifications
<p>In Class 3: Cosmetics, toiletries and personal care products including lotions, gels, butters, creams, balms, soaking treatments, scrubs, exfoliating and other treatments for the hands, feet, face and body but excluding soaps; nail polishes, nail varnishes, nail care preparations including cuticle cream; cosmetic preparations including body gloss; cosmetic preparations for the shower and bath including bath milk and bath salts but excluding soaps (and not for medicinal purposes); all the foregoing goods sold separately.</p>	<p>CTM 7065519: Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>M821200: Class 25: Clothing, footwear, headgear.</p>
<p>In Class 35: Retail services including mail order services and retail services on a global computer network connected with cosmetics, toiletries and personal care products including lotions, gels, butters, creams, balms, soaking treatments, scrubs, exfoliating and other treatments for the hands, feet, face and body, nail polishes, nail varnishes, nail care preparations including cuticle</p>	<p>CTM 7065519: Class 35: Retail services in relation to textiles, cosmetics, toys, stationery, household goods; presentation of various goods (except the transport thereof) for others, to facilitate the display and purchase of the aforesaid goods for</p>

<p>cream, cosmetic preparations for the skin including body gloss, cosmetic preparations for the shower and bath including body wash, bath milk and bath salts (not for medicinal purposes), cosmetic accessories including brushes and eyelash curlers, hair care products, perfumery products, soaps, dentifrices, candles, bags including bags for toiletries, cosmetics, cosmetic accessories and personal care products; all the foregoing goods retailed separately.</p>	<p>customers.</p>
<p>In Class 44: Provision of beauty care; beauty salon services including manicures, pedicures, facials and body treatments; beauty care advisory services relating to cosmetics, toiletries, personal care products, hair care products, perfumery, nail polishes, nail varnishes and nail care preparations.</p>	<p>CTM 7065519: Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</p> <p>M821200: Class 25: Clothing, footwear, headgear.</p>

17) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods 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 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 in the same or different sectors.

18) The question of complementary goods/services has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Case T- 325/06 the CFI stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in*

such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

19) I shall first consider the opponent’s CTM 7065519 specification to the mark in suit. In the original statement of grounds the opponent contended:

“In addition the goods for which registration is applied for in Class 3 are identical to the goods for which the earlier Community trade mark is applied for in Class 3 and are similar to the goods covered by the earlier Community trade mark in classes 8,16 and 21.”

20) There is no explanation given to the bizarre claim that cosmetics are similar to paper, adhesives and typewriters in Class 16 or combs, kitchen utensils or earthenware in class 21. I therefore dismiss these contentions. It is obvious however, that the opponent’s Class 3 specification includes “cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices” which to my mind encapsulates the whole of the applicant’s Class 3 specification and so these goods must be regarded as identical.

21) Similarly, the opponent’s Class 35 specification is obviously identical.

22) The opponent does not state which of its goods and services are similar to the applicant’s Class 44 services. I am therefore left to speculate as to the opponent’s best case in the absence of reasoned contentions by its trade mark attorney. I assume it is contended that the retailing of, broadly, cosmetics is similar to the manufacture. I accept that there is a degree of similarity between the two.

23) I now move onto compare the opponent’s International mark 821200 specification with that of the mark in suit. I will ignore the contention that Class 16 is similar to any of the goods or services sought to be registered and concentrate on the contention regarding Class 25. The opponent states that clothing is complimentary to cosmetics, and by extension to the retailing of them and the provision of beauty treatments. It points to the fact that there are a number of companies which produce both clothing and perfumes and cosmetics. Whilst I accept there are companies engaged in both clothing and cosmetics this does not make the goods and services complementary as the test is whether “there is a close connection between them, in the sense that one is indispensable or important for the use of the other”. Clearly, clothing and cosmetics do not meet these criteria.

24) In conclusion, regarding the opponent’s CTM 7065519 and the mark in suit, the class 3 goods and class 35 services are identical, whilst the opponent’s class 3 goods

are similar to the applicant's class 44 services. With regard to the opponent's International trade mark number 821200 the goods in Classes 16 and 25 for which this mark is registered are not similar to the goods and services of the mark in suit.

25) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

Applicant's Trade Mark	Opponent's Trade Marks
	<p data-bbox="784 491 911 520">7065519</p>  <p data-bbox="784 785 1143 814">Colours claimed red and white</p>
	<p data-bbox="784 821 894 850">821200</p> 

26) With regard to the similarity of 7065519 to the mark in suit the opponent contended:

“However, the dominant feature of the mark of the opponent is the word KIK and the presence in the mark of a tick replacing the dot over the “i” and the words Textil-Diskont underneath do not detract from this. The words Textil-Diskont means literally Textile Discount and is descriptive and should therefore be ignored in any event. When spoken because the emphasis is normally on the initial syllable of a short three letter mark such as KIK the initial KI is identical to the initial sound KI of Kit and because the word endings are usually softer, the “t” and the “k” are less distinct and the marks are likely to sound the same. In addition the word mark KIT is only one letter different to the word mark KIK and are visually very similar.”

27) In considering the issues I take note of the comments in *Medion*:

“30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

- 31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.
- 32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.
- 33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

28) I also take into account the comments in LIMONCELLO:

- “41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).
- 42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

29) Whilst I am willing to accept that the dominant element of 7065519 is the word KIK I do not accept that I can simply ignore the words “Textil-Diskont”. Nor do I accept that the average consumer would view the tick or swoosh above the letter “I” in KIK as simply replacing the dot. I accept that the dominant element of the opponent’s mark and the mark in suit are short three letter words but it is accepted that any differences in such short marks assume greater significance. Further, I do not accept the contention that the letter “T” at the end of the mark in suit will be lost because it is soft. On the contrary I believe that the “t” sound will be quite pronounced. I must also take into account that the dominant element of the opponent’s mark sounds and looks very similar to the well known word “KICK” and I believe will be pronounced as such, whereas the mark in suit is an equally well known word. The opponent’s mark will either be seen as the word KICK and assume its meaning or it will be viewed as a foreign word with no conceptual meaning, in either case there is a difference to the mark in suit. There are visual and aural similarities, but there are also significant differences which combined with the conceptual differences mean that overall the marks are not similar.

30) Clearly, the opponent's mark 821200 is much closer to the mark in suit as it lacks the additional words and device element of the opponent's other mark. There are still visual and aural differences as well as conceptual differences but these are not as significant and overall I believe that these marks have a degree of similarity.

31) When determining whether there is a likelihood of confusion I have to take a number of factors into consideration. There is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. I must consider whether the opponent's trade marks have a distinctive nature, the average consumer for the goods and services, the nature of the purchasing process and the issue of imperfect recollection. I must also take into account that these goods and services will not be chosen without a reasonable amount of care. In the instant case the opponent's marks have a reasonable degree of inherent distinctiveness.

32) With regard to the opponent's mark 7065519 I accept that the goods in Class 3 and the services in Class 35 are identical to those of the mark in suit whilst the opponent's goods in Class 3 are similar to the services in Class 44 of the mark in suit, however, even in respect of these goods and services the differences between the trade marks are such there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) with regard to CTM 7065519 fails.

33) With regard to the opponent's mark M821200 the goods for which this mark is registered are not similar to the goods and services of the mark in suit. Therefore despite a degree of similarity between the trade marks there is no likelihood of confusion on the part of the public, or a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) with regard to M821200 fails.

34) I shall now turn to consider the ground of opposition under Section 5(3) of the Act which states:

“(3) A trade mark which –

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

35) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* [2000] RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00 and, more recently *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch) and *Electrocoin*

Automatics Limited and Coinworld Limited and others [2005] FSR 7. Guidance in relation to reputation under Section 5(3) has been set out in *General Motors Corporation v Yplon SA* in paragraphs 23 to 27. Paragraphs 26 & 27 indicate the standard that must be reached:-

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

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

36) The onus is upon an opponent to prove that its earlier trade marks enjoy a significant reputation or recognition by a significant part of the public and it needs to furnish the evidence to support this claim. I have outlined the issues with the evidence which the opponent has filed (see paragraph 14 above). The opponent has failed to provide any credible evidence of use of the marks relied upon or reputation in the UK at the relevant date. To my mind the opponent has failed to clear the first hurdle, and so the opposition under Section 5(3) fails.

CONCLUSION

37) The opposition has failed under all grounds.

COSTS

38) The applicant has been successful and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Considering the other side's evidence	£300
Preparing submissions	£500
TOTAL	£1100

39) I order Kik Textilien und non Food GmbH to pay Kit Cosmetics Pty Limited the sum of £1100. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated 12th of September 2012

**George W Salthouse
For the Registrar,
the Comptroller-General**