

O-556-16

TRADE MARKS ACT 1994

**IN THE MATTER OF THE APPLICATION BY
FIRETRAP LIMITED
UNDER NO. 3087448 FOR THE TRADE MARK**

DEADLY DENIM

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404546 BY
CONTER S.r.L.**

THE BACKGROUND AND THE PLEADINGS

1) On 24 December 2014 Wykamol Group Limited (“the Applicant”) filed application no. 3087448 to register the following trade mark:

DEADLY DENIM

The application was published for opposition purposes on 20 March 2015. Registration is sought for goods in several classes, but only the following goods are opposed in these proceedings:

Class 3: *Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; toiletries; make-up pencils; facial masks; tissues and wipes incorporating cleaning preparations; hair care, hair cleansing, hair styling and hair colouring products and preparations; skin care and skin cleansing products and preparations; shaving products and preparations; depilatory products and preparations; nail grooming and nail care products and preparations; tanning products and preparations; oral hygiene products and preparations; deodorants; anti-perspirants; toothpaste.*

2) The application is opposed by Conter S.r.L. (“the Opponent”). Following an amendment of its grounds of opposition, the opposition is based solely on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the earlier EU trade mark registration no. 10337574 (“the earlier mark”) for the following mark and goods:

DENIM

Class 3: *Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices; Abraders; Eau de Cologne;*

Lavender water; Eau de Cologne; Perfume water; Nail art stickers; Adhesives for cosmetic purposes; Adhesives for affixing false hair; Eyelashes (Adhesives for affixing false -); Scouring solutions; Ammonia [volatile alkali] [detergent]; Aloe vera preparations for cosmetic purposes; Amber [perfume]; Starch glaze for laundry purposes; Fabric softeners for laundry use; Canned pressurized air for cleaning and dusting purposes; Aromatics [essential oils]; Flavourings for beverages [essential oils]; Cake flavourings [essential oils]; Astringents for cosmetic purposes; Non-medicated lotions; Flower perfumes (Bases for -); Joss sticks; Cotton sticks for cosmetic purposes; Make-up; Whiting; Laundry blue; Javelle water; Laundry bleach; Carbides of metal [abrasives]; Silicon carbide [abrasive]; Polishing paper; Emery paper; Emery paper; Emery paper; Volcanic ash for cleaning; Non-slipping wax for floors; Shoemakers' wax; Wax (Depilatory -); Moustache wax; Laundry wax; Parquet floor wax; Parquet floor wax; Tailors' wax; Shoe wax; Polish for furniture and flooring; Eyelashes (False -); Face powder; Hair dyes; Colorants for toilet purposes; Corundum [abrasive]; Quillaia bark for washing; Cosmetics; Cosmetics for animals; Cosmetics for eye-lashes; Eyebrow cosmetics; Creams (Cosmetic -); Boot cream; Creams for leather; Polishing creams; Skin whitening creams; Washing soda, for cleaning; Bleaching preparations [decolorants] for cosmetic purposes; Dentifrices; Deodorants for pets; Deodorants for human beings or for animals; Detergents other than for use in manufacturing operations and for medical purposes; Diamantine [abrasive]; Heliotropine; Badian essence; Mint essence [essential oil]; Oil of turpentine for degreasing; Bergamot oil; Ethereal essences; Drying agents for dishwashing machines; Extracts of flowers [perfumes]; Massage gels other than for medical purposes; Dental bleaching gels; Petroleum jelly for cosmetic purposes; Geraniol; Cleaning chalk; Greases for cosmetic purposes; Henna [cosmetic dye]; Incense; Ionone [perfumery]; Hair spray; Nail polish; Almond milk for cosmetic purposes; Cleansing milk for toilet purposes; Scented wood; Non-slipping liquids for floors; Windscreen cleaning fluids; Soda lye; Aftershave; Hair lotions; Lotions for cosmetic purposes; Lip gloss; Shoe polish; Mascara; Cosmetic masks; Eyebrow pencils; Eyebrow pencils; Mint for perfumery; Transfers (Decorative -) for cosmetic purposes; Musk [perfumery]; Cosmetic kits; Neutralizers for permanent waving; Oils for toilet purposes; Essential oils; Cedarwood

(Essential oils of -); Lemon [Essential oils of -]; Oils for perfumes and scents; Oils for cleaning purposes; Oils for cosmetic purposes; Lemon [Essential oils of -]; Gaultheria oil; Jasmine oil; Lavender oil; Almond oil; Rose oil; Cotton wool for cosmetic purposes; Pastes for razor strops; Shoemakers' wax; Hydrogen peroxide for cosmetic purposes; Polishing stones; Polishing stones; Pumice stone; Alum stones [astringents]; Alum stones [astringents]; Pomades for cosmetic purposes; Pot-pourri; Sun-tanning preparations [cosmetics]; Baths (Cosmetic preparations for -); Douching preparations for personal sanitary or deodorant purposes [toiletries]; Laundry glaze; Dentures (Preparations for cleaning -); Polishing preparations; Hair waving preparations; Denture polishes; Sun tan lotion; Unblocking drain pipes (Preparations for -); Scale removing preparations for household purposes; Cosmetic preparations for slimming purposes; Colour-brightening chemicals for household purposes [laundry]; Antistatic preparations for household purposes; Skincare cosmetics; Depilatories; Perfumery; Laundry preparations; Antiperspirants [toiletries]; Abraders; Shining preparations [polish]; Plants (Preparations to make shiny the leaves of -); Fumigation preparations [perfumes]; Dry-cleaning preparations; Make-up; Preservatives for leather [polishes]; Dental rinses, non medicated; Nail care preparations; Cleaning agents for household purposes; Shaving preparations; Toiletries; Smoothing preparations [starching]; Laundry soaking preparations; Sachets for perfuming linen; Wallpaper cleaning preparations; Rust removers; Leather bleaching preparations; Degreasers other than for use in manufacturing processes; Make-up removing preparations; Color-removing preparations; Lacquer-removing preparations; Color-removing preparations; Lacquer-removing preparations; Perfumery; Air fragrancing preparations; Lipstick; Jewellers' rouge; Safrol; Starch for laundry purposes; Bath salts, not for medical purposes; Bleaching salts; Almond soap; Shaving soap; Soap; Soaps; Soap for foot perspiration; Antiperspirant soap; Deodorant soap; Disinfectant soap; Medicated soap; Soap for brightening textile; Shampoo; Shampoos for pets; Dry shampoos; Destainers; Emery; Bleaching soda; Furbishing preparations; Breath freshening sprays; Breath freshening strips; Cloths impregnated with a detergent for cleaning; Floor wax removers [scouring preparations]; Talcum powder, for toilet use; Emery cloth; Emery cloth; Glass cloth; Terpenes

[essential oils]; Dyes (Cosmetic -); Beard dyes; Tissues impregnated with cosmetic lotions; Turpentine, for degreasing; Tripoli stone for polishing; False nails.

Class 18: *Trunks and travelling bags; Umbrellas and parasols; Key bags; Vanity cases, not fitted; Trunks [luggage]; Baggage; Casual bags; Sling bags for carrying infants; Gym bags; Chain mesh purses; Tool bags of leather, empty; Baggage; Hand bags; Travelling sets [leatherware]; Briefcases; Satchels; Umbrella covers; Sling bags for carrying infants; Sling bags for carrying infants; Card cases [notecases]; Music cases; Wallets; Bags for campers; Beach bags; Baggage; Bags for climbers; Shopping bags; Wheeled shopping bags; Baggage; Briefcases; Briefcases; Garment bags for travel; Rucksacks.*

Class 25: *Non-slipping devices for footwear; Boas [necklets]; Studs for football boots; Frames (Hat -) [skeletons]; Swimming caps; Shower caps; Tips for footwear.*

3) The earlier mark was applied for on 23 July 2013 and its registration process was completed on 17 June 2014. The significance of these dates is that (1) the opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed less than five years before the publication of the Applicant's mark.

4) The Opponent claims that because of similarity between the respective marks and the identity or similarity between the respective goods there exists a likelihood of confusion. The Applicant filed a counterstatement, denying the grounds of opposition. The Opponent is represented by Mathys & Squire LLP. The Applicant is represented by Lane IP Limited. Neither side filed evidence. The Applicant filed written submissions during the evidence rounds. Neither side requested a hearing and both sides filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

SECTION 5(2)(b)

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

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

(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”.

6) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P (“*Bimbo*”):

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

7) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

8) 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

9) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“*Meric*”), the General Court (“the GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the 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 (Case T-104/01 *Oberhauser v OHIM — Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM — Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)”.

10) When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of “dessert sauce” did not include jam, or because the ordinary and natural description of jam was not “a dessert sauce”. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is

¹*British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

²*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

11) The Applicant's terms *bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; toiletries* coincide exactly with the same terms used in Class 3 of the Opponent's specification. The goods are identical. Even if the Applicant's *tissues and wipes incorporating cleaning preparations* are not covered exactly by the Opponent's *cleaning preparations*, they are nevertheless highly similar by virtue of their nature, purpose, and users, the fact that they are in competition, and their display side-by-side in stores, etc.

12) The Applicant's *make-up pencils; facial masks; tanning products and preparations* all fall within the Opponent's *cosmetics*. The goods are identical under the guidance in *Meric*.

13) The Applicant's *hair care, hair cleansing, hair styling and hair colouring products and preparations; skin care and skin cleansing products and preparations; shaving products and preparations; depilatory products and preparations; nail grooming and nail care products and preparations; oral hygiene products and preparations; deodorants; anti-perspirants; toothpaste* all fall within the Opponent's *toiletries*, and are thus identical.

The average consumer and the purchasing process

14) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

15) The parties’ competing goods are cosmetics, toiletries and cleaning products of various kinds. The average consumer will be a member of the general public. The purchasing act is likely to be primarily a visual one, as the goods will most often be self-selected from a shelf (or the online or catalogue equivalent) and the marks may be exposed visually in advertising, on websites etc. However, aural considerations will not be ignored in my assessment, as it is not unusual to find sales assistants and advisors involved in the purchasing process. Cosmetics, toiletries and cleaning products are likely to be available in a broad range of prices – though, as a general rule, they are relatively low value, fairly frequent purchases, and are unlikely to demand a higher level of attention to be paid in their selection than that necessary to establish suitable skin type, perfume, active ingredients, and so on. The purchasing process will be a normal, reasonably considered one.

Comparison of the marks

16) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo*, 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.”

17) It would be wrong, therefore, to dissect the trade marks artificially, 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.

18) The marks to be compared are shown below:

The contested mark	The earlier mark
DEADLY DENIM	DENIM

19) The *Oxford Dictionary of English* (3rd edition, 2010) defines the noun “denim” as “a hard-wearing cotton twill fabric, typically blue and used for jeans and other clothing”. The primary (literal) definition it gives for the word “deadly” is “causing or able to cause death”. It also gives the following figurative meanings: “extremely accurate, effective, or skilful” (e.g. “his aim is deadly”); “extremely boring” (e.g. “my end of the theatre is deadly at the moment”); “complete; total” (e.g. “she was in deadly earnest”. From my own experience I am confident that, as a member of the general public, the average consumer of the relevant goods would, given the right context, recognise all these meanings.

20) The meaning of DENIM is plain in both marks; it will be understood by the average consumer in the sense defined above. It is also clear that in the Applicant’s mark the adjective DEADLY qualifies the noun DENIM to form a grammatically complete phrase. Normally, one would expect that, from among its various potential meanings, the specific meaning of an adjective would become clearer and more concrete when it is used to qualify a particular noun. Unravelling the semantic content of DEADLY in this case, however, is more problematic. It is admittedly

possible to envisage specific (though unusual) concrete contexts in which expressions like “*denim able to cause death*”, “*extremely boring denim*” “*extremely effective denim*” or even “*total denim*” could all bear a clear and specific meaning – though the use of the figurative DEADLY to express these meanings would be fanciful. In the absence of context, however, it is difficult to attribute any specific meaning to the word “deadly” when the phrase “deadly denim” is encountered in isolation, as it is in the Applicant’s mark. This being so, it is also difficult to see any specific meaning or meanings that the average consumer might attribute to the whole phrase “deadly denim”, even though the potential conceptual content of both individual words will be known to him or her.

21) The Opponent submits that “as “*DEADLY*” is an adjective used to describe the quality of the goods applied for under the Application, the dominant and distinctive feature or the trade mark must be “*DENIM*”. It also contends that “*DEADLY indicates a negative connotation to the quality of the goods applied for*”. I am unable to share this view. As I have already commented, grammatically the word qualifies DENIM, could potentially have numerous context-dependent meanings, and there is no evidence before me that any particular specific meaning would present itself to the mind of the consumer in connection with the relevant goods.

22) Neither DEADLY nor DENIM are descriptive of the goods in issue. Both, therefore, have distinctive character. The opposed mark forms a balanced phrase, with neither of its constituent words strongly dominating the other. The earlier mark consists exclusively of the word DENIM, which is thus its sole element.

23) The most obvious and immediate visual difference between the marks is that the opposed mark consists of two words, making it roughly twice as long as the earlier mark’s single word. The Applicant, referring to the case law³, argues that it is widely established that the beginning of a sign is perceived first by the consumer, is therefore what catches the attention and, as such, it will be remembered more clearly than the rest of the sign – and in this case it is the less similar element which appears at the beginning of the Applicant’s mark. However, this is no more than a

³ See the General Court’s judgments in T-412/08 *Trubion* at para. 40 and T-109/07 *Spa Therapy* at para. 30.

rule of thumb, and does not hold in all cases. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks⁴. The common component DENIM contributes to a finding of a medium degree of visual similarity overall between the marks.

24) DENIM will be pronounced and heard in the same way in both marks. However, the initial word DEADLY in the opposed mark adds a different sound and a further two syllables to the original two syllables of the earlier mark, making it twice as long. Overall, there is a medium degree of aural similarity between the marks

25) I have explained above why I consider that the average consumer will find it difficult to attribute any specific meaning or meanings to the whole phrase “deadly denim”, even though the conceptual content of both constituent words will be known to him or her. The word DENIM contributes an element of conceptual similarity, and the word DEADLY an element of conceptual difference to the competing marks. Overall, there is a medium degree of conceptual similarity.

The distinctiveness of the earlier mark

26) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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

⁴ Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-438/07:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

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)."

27) In its written submissions the Opponent claims that the earlier mark has "*a high degree of recognition*". However, no evidence was filed, and I therefore have no evidence of distinctiveness enhanced through use to consider. This leaves the question of inherent distinctive character. I see no merit in the Applicant's submission that "*the Opponent's mark, comprised purely of the common English term DENIM, is descriptive and lacks the required level of distinctiveness to function as a trade mark for the goods covered.*" The word DENIM is neither descriptive nor allusive of the Class 3 goods of the earlier mark relied on in these proceedings. It has a normal degree of inherent distinctive character.

Likelihood of Confusion

28) In its submissions the Opponent draws my attention to a number of EUIPO Opposition Division and Board of Appeal decisions involving its DENIM mark. The general rule is that each mark must be assessed independently against the relevant legal criteria and will stand or fall on its own merits. References to other cases involving different mark comparisons and different circumstances are not generally of

assistance and, for various reasons, none of the decisions referred to by the Opponent are in any case on all fours with the present case. I am not, of course, bound by these decisions, and I must reach my decision in the present proceedings on the particular facts of the present case and on the particular marks that are before me.

29) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

30) I have found that neither DEADLY nor DENIM are descriptive of the goods in issue, and that both words are therefore distinctive elements of the Applicant's mark. I have found the earlier mark to have a normal degree of distinctive character. I have found a medium degree of visual, aural and conceptual similarity between the competing marks. Bearing in mind my findings on the purchasing process, the degree of care and attention which the average consumer will show, and the principle of imperfect recollection, I nevertheless consider that the presence of the distinctive word DEADLY in the opposed mark, which moreover makes it twice as long as the earlier mark, will not be overlooked or discounted by the average consumer. The competing marks will not be directly confused, even where the competing goods are identical or highly similar.

31) That leaves the question of indirect confusion to be considered. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

32) I have found that it is difficult to see any specific meaning or meanings that the average consumer would find in the whole phrase “deadly denim” used in connection with the relevant Class 3 goods, even though the conceptual content of both individual words will be known to him or her. The key point here is that, although consumers may recognize DEADLY DENIM as a complete and alliterative phrase in which the adjective DEADLY qualifies the noun DENIM, they will not see the phrase

as forming a unit having a different meaning as compared with its components taken separately⁵. DENIM will continue to play an independent distinctive role.

33) Although I have found the word DEADLY is itself also distinctive in relation to the goods at issue, my own experience as a consumer of these everyday goods informs me that any consumer visiting the shelves of a supermarket or store selling the Class 3 goods at issue in these proceedings will be aware of how sub-brands are widely used on such products. I find that the independent distinctive character of the word DENIM in relation to the relevant goods is such that consumers will not regard it as a coincidence when they encounter it linked with DEADLY in the opposed mark and used in relation to goods which I have found identical or similar with those of the earlier mark. Given my findings on the average consumer and the purchasing process, the presence in the opposed mark of the distinctive word DENIM will signal to the relevant consumer that the goods offered under that mark are supplied by the same undertaking as those offered under the earlier mark, or by an undertaking economically linked with the latter undertaking. There will be indirect confusion. Accordingly, **the opposition succeeds in respect of all the goods opposed.**

OUTCOME

The opposition has succeeded in respect of all the goods opposed, which are as follows; these goods may therefore not proceed to registration:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; toiletries; make-up pencils; facial masks; tissues and wipes incorporating cleaning preparations; hair care, hair cleansing, hair styling and hair colouring products and preparations; skin care and skin cleansing products and preparations; shaving products and preparations; depilatory products and preparations; nail grooming and nail care products and preparations; tanning products and preparations; oral hygiene products and preparations; deodorants; anti-perspirants; toothpaste.

⁵ See *Bimbo* at paragraph 25.

The remaining goods of the application, which were not opposed may proceed to registration.

COSTS

35) Conter S.r.L. has been successful and is entitled to a contribution towards its costs. I bear in mind that the Opponent's original additional claim on the basis of section 5(4)(a) of the Act, which made an opposition fee of £200 payable, was struck out when the Opponent chose not to file evidence, and that a claim pursued under section 5(2)(b) alone would normally have incurred a fee of only £100. I also bear in mind that the pleadings and submissions were relatively short and straightforward. I hereby order Wykamol Group Limited to pay Conter S.r.L. the sum of £700. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£300
Preparing written submissions	£300

The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of November 2016

Martin Boyle
For the Registrar,
The Comptroller-General