

O/744/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3638511
IN THE NAME OF DENG ZHITENG FOR THE TRADE MARK**

PandyCare

IN CLASS 3

AND

**OPPOSITION THERETO UNDER NO. 427362
BY HANSEN KIDS LLC**

Background and pleadings

1. Deng Zhiteng (“the applicant”) applied to register the trade mark PandyCare with the application number 3638511 in the UK on 8 May 2021. It was accepted and published in the Trade Marks Journal on 9 July 2021 in respect of the following goods:

Class 3: Personal deodorants; Tooth care preparations; Hair care lotions; Lip care preparations; Hair care preparations; Nail care preparations; Hair care creams; Sun care preparations; Skin care mousse; Cosmetics; Cosmetics and cosmetic preparations; Milks [cosmetics]; Eyebrow cosmetics; Cosmetic dyes; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetic pencils; Pencils (Cosmetic -); Nail cosmetics; Functional cosmetics; Multifunctional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Eye cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Natural cosmetics; Dyes (Cosmetic -); Cosmetic kits; Kits (Cosmetic -); Tonics [cosmetic]; Cosmetic rouges; Cosmetic moisturisers; Cosmetic masks; Cosmetic oils; Hair cosmetics; Mousses [cosmetics]; Decorative cosmetics; Colour cosmetics; Lip cosmetics; Organic cosmetics; Skin balms [cosmetic]; Cosmetic bath salts; Cleansing creams [cosmetic]; Non-medicated cosmetics; Cosmetic eye pencils; Suntan lotion [cosmetics]; Body paint (cosmetic); Bath powder [cosmetics]; Cosmetic massage creams; Cosmetic eye gels; Cosmetic hand creams; Facial washes [cosmetic]; Cosmetic facial lotions; Facial masks [cosmetic]; Cosmetic facial packs; Body scrubs [cosmetic]; Facial gels [cosmetics]; Cosmetic body mud; Humectant preparations [cosmetics]; Cosmetic skin enhancers; Cosmetic tanning preparations; Cosmetic face powders; Sun block [cosmetics]; Skin care cosmetics; Nail hardeners [cosmetics]; Moisturising concentrates [cosmetic]; Powder compacts [cosmetics]; Skin creams [cosmetic]; Nail primer [cosmetics]; Facial creams [cosmetics]; Facial lotions [cosmetic]; Cosmetic sunscreen preparations; Cosmetic facial masks; Cosmetic nail preparations; Lip stains [cosmetics]; Smoothing emulsions [cosmetics]; Cosmetic mud masks; Acne cleansers, cosmetic; Body creams [cosmetics]; Sun barriers [cosmetics]; Lip protectors [cosmetic]; Facial cleansers [cosmetic]; Skin masks [cosmetics]; Night creams [cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics]; Toning

creams [cosmetic]; Moisturising gels [cosmetic]; Cosmetic cotton wool; Skin fresheners [cosmetics]; Cosmetic nourishing creams; Face wash [cosmetic]; Facial scrubs [cosmetic]; Cosmetic suntan lotions; Face packs [cosmetic];Suntan oils [cosmetics]; Tanning oils [cosmetics]; Cosmetics containing keratin; Self-tanning preparations [cosmetics]; Lacquer for cosmetic purposes; Skin whitening preparations [cosmetic]; Cleaner for cosmetic brushes; Eyelashes (Cosmetic preparations for -); Cosmetics for personal use; Henna for cosmetic purposes; Sun blocking preparations [cosmetics]; Adhesives for cosmetic use; Greases for cosmetic purposes; Skin care creams [cosmetic]; Skin lightening compositions [cosmetic]; Sun blocking lipsticks [cosmetics]; Self tanning creams [cosmetic]; Moisturising body lotion [cosmetic]; Pre-moistened cosmetic tissues; Pre-moistened cosmetic towelettes; Serums for cosmetic purposes; Cosmetic sun-protecting preparations; Sunscreen [for cosmetic use]; Pencils for cosmetic use; After-sun oils [cosmetics]; Cosmetics containing hyaluronic acid; Procollagen for cosmetic purposes; Skin recovery creams [cosmetics]; Geraniol for cosmetic use.

2. Hansen Kids LLC (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its two earlier UK comparable trade marks,¹ details of which are set out in the table below:

¹The earlier marks were originally registered at the EU Intellectual Property Office as European Union Trade Marks (“EUTM”s). On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. In instances such as this one where marks were registered as an EUTM at the end of the Implementation Period, they were automatically converted to comparable UK trade marks. The comparable UK marks are now recorded on the UK trade mark register and hold the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain.

Registration number	Trade Mark	Filing date/Registration date	Goods relied upon
UK00917785247 ("the earlier word mark")	ANDY PANDY	7 February 2018/30 May 2018 Priority claim from US registration number 87558757 from 7 August 2017	<i>Class 5: Disposable baby diapers.</i>
UK00914898795 ("the earlier logo mark")		10 December 2015/ 13 April 2016	Class 3: Non-medicated toilet preparations; soaps; toiletries; skin care products; non-medicated skin care preparations; skin and cosmetic creams; skin cleansers; washing preparations; kits and gift sets containing skin and/or hair care preparations; diaper rash cream; shampoo; body washes; non-medicated ointments and preparations for care of diaper rash; wipes; baby wipes; pre-moistened tissues or wipes. Class 5: Disposable baby diapers, disposable diaper liners, disposable diaper pants.

3. By virtue of their earlier filing dates, the above marks constitute earlier marks in accordance with section 6 of the Act.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar, and that as such there exists a likelihood of confusion, including a likelihood of association between the marks.

5. The applicant filed a counterstatement denying the claims made. Although a period of over five years had passed between earlier logo mark being registered and the application filing date, the applicant did not request that the opponent file proof of use in accordance with section 6A of the Act. The opponent may therefore enforce its protection under its earlier marks in respect of the full specifications relied upon within these proceedings.

6. Neither party filed evidence in these proceedings, and neither side filed written submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.

7. The applicant is unrepresented in these proceedings. The opponent is professionally represented by Murgitroyd & Company.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Decision

Section 5(2)(b)

9. Section 5(2)(b) of the Act is 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”.

10. Section 5A of the Act states:

Grounds for refusal relating to only some of the goods or services

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. 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.

The principles

(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 goods

12. 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 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”.

13. 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.

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that goods may be considered “complementary” where:

“...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”.

15. It is obvious that where two specifications contain identical terms, or different terms both with identical meanings, the goods should be considered identical. Furthermore, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

16. With these factors in mind, the goods for comparison are as follows:

Earlier goods	Contested goods
<p><i>Class 5: Disposable baby diapers.</i></p> <p><i>(Under the earlier word mark)</i></p>	<p><i>Class 3: Personal deodorants; Tooth care preparations; Hair care lotions; Lip care preparations; Hair care preparations; Nail care preparations; Hair care creams; Sun care preparations; Skin care mousse; Cosmetics; Cosmetics and cosmetic preparations; Milks [cosmetics]; Eyebrow cosmetics; Cosmetic dyes; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetic pencils; Pencils (Cosmetic -); Nail cosmetics; Functional cosmetics; Multifunctional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Eye cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Natural cosmetics; Dyes (Cosmetic -); Cosmetic kits; Kits (Cosmetic -); Tonics [cosmetic]; Cosmetic rouges; Cosmetic moisturisers; Cosmetic masks; Cosmetic oils; Hair cosmetics; Mousses [cosmetics]; Decorative cosmetics; Colour cosmetics; Lip</i></p>
<p><i>Class 3: Non-medicated toilet preparations; soaps; toiletries; skin care products; non-medicated skin care preparations; skin and cosmetic creams; skin cleansers; washing preparations; kits and gift sets containing skin and/or hair care preparations; diaper rash cream; shampoo; body washes; non-medicated ointments and preparations for care of diaper rash; wipes; baby wipes; pre-moistened tissues or wipes.</i></p> <p><i>Class 5: Disposable baby diapers, disposable diaper liners, disposable diaper pants.</i></p> <p><i>(Under the earlier logo mark)</i></p>	<p><i>Class 3: Personal deodorants; Tooth care preparations; Hair care lotions; Lip care preparations; Hair care preparations; Nail care preparations; Hair care creams; Sun care preparations; Skin care mousse; Cosmetics; Cosmetics and cosmetic preparations; Milks [cosmetics]; Eyebrow cosmetics; Cosmetic dyes; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetic pencils; Pencils (Cosmetic -); Nail cosmetics; Functional cosmetics; Multifunctional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Eye cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Natural cosmetics; Dyes (Cosmetic -); Cosmetic kits; Kits (Cosmetic -); Tonics [cosmetic]; Cosmetic rouges; Cosmetic moisturisers; Cosmetic masks; Cosmetic oils; Hair cosmetics; Mousses [cosmetics]; Decorative cosmetics; Colour cosmetics; Lip</i></p>

	<p> <i>cosmetics; Organic cosmetics; Skin balms [cosmetic]; Cosmetic bath salts; Cleansing creams [cosmetic]; Non-medicated cosmetics; Cosmetic eye pencils; Suntan lotion [cosmetics]; Body paint (cosmetic); Bath powder [cosmetics]; Cosmetic massage creams; Cosmetic eye gels; Cosmetic hand creams; Facial washes [cosmetic]; Cosmetic facial lotions; Facial masks [cosmetic]; Cosmetic facial packs; Body scrubs [cosmetic]; Facial gels [cosmetics]; Cosmetic body mud; Humectant preparations [cosmetics]; Cosmetic skin enhancers; Cosmetic tanning preparations; Cosmetic face powders; Sun block [cosmetics]; Skin care cosmetics; Nail hardeners [cosmetics]; Moisturising concentrates [cosmetic]; Powder compacts [cosmetics]; Skin creams [cosmetic]; Nail primer [cosmetics]; Facial creams [cosmetics]; Facial lotions [cosmetic]; Cosmetic sunscreen preparations; Cosmetic facial masks; Cosmetic nail preparations; Lip stains [cosmetics]; Smoothing emulsions [cosmetics]; Cosmetic mud masks; Acne cleansers, cosmetic; Body creams [cosmetics]; Sun barriers [cosmetics]; Lip protectors [cosmetic]; Facial cleansers [cosmetic]; Skin masks [cosmetics]; Night creams [cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics]; Toning creams [cosmetic]; Moisturising gels [cosmetic]; Cosmetic cotton wool; Skin fresheners [cosmetics]; Cosmetic nourishing creams; Face wash [cosmetic]; Facial scrubs [cosmetic]; Cosmetic suntan lotions; Face packs [cosmetic]; Suntan oils [cosmetics]; Tanning oils [cosmetics]; Cosmetics containing keratin; Self-tanning preparations [cosmetics]; Lacquer for cosmetic purposes; Skin whitening preparations [cosmetic]; Cleaner for cosmetic brushes; Eyelashes (Cosmetic preparations for -); Cosmetics for personal use; Henna for cosmetic purposes; Sun blocking preparations</i> </p>
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	<p><i>[cosmetics]; Adhesives for cosmetic use; Greases for cosmetic purposes; Skin care creams [cosmetic]; Skin lightening compositions [cosmetic]; Sun blocking lipsticks [cosmetics]; Self tanning creams [cosmetic]; Moisturising body lotion [cosmetic]; Pre-moistened cosmetic tissues; Pre-moistened cosmetic towelettes; Serums for cosmetic purposes; Cosmetic sun-protecting preparations; Sunscreen [for cosmetic use]; Pencils for cosmetic use; After-sun oils [cosmetics]; Cosmetics containing hyaluronic acid; Procollagen for cosmetic purposes; Skin recovery creams [cosmetics]; Geraniol for cosmetic use.</i></p>
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The earlier word mark

17. The earlier word mark covers *disposable baby diapers* in class 5 only. I find these goods to be dissimilar in terms of nature, intended purpose and method of use to the majority of the contested goods. In addition, I do not find them to be in competition with, or to share complementarity with the same. Whilst there may be an overlap in users, those being the general public, and a small overlap in trade channels in that all of the goods may be sold in pharmacies and more general stores, I do not consider these general overlaps alone to be sufficient to give rise to a level of similarity between the goods. I therefore find all of the contested goods to be dissimilar to those covered by the earlier word mark, with the exception of:

Skin care mousse; Cosmetics; Cosmetics and cosmetic preparations; Milks [cosmetics]; Creams (Cosmetic -); Functional cosmetics; Multifunctional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Natural cosmetics; Cosmetic kits; Kits (Cosmetic -); Tonics [cosmetic]; Cosmetic moisturisers; Cosmetic oils; Organic cosmetics; Skin balms [cosmetic]; Cleansing creams [cosmetic]; Non-medicated cosmetics; Bath powder [cosmetics]; Humectant preparations [cosmetics]; Cosmetic skin enhancers;

Moisturising concentrates [cosmetic]; Skin creams [cosmetic]; Smoothing emulsions [cosmetics]; Body creams [cosmetics]; Moisturising gels [cosmetic]; Cosmetic nourishing creams; Cosmetics for personal use; Greases for cosmetic purposes; Skin care creams [cosmetic]; Moisturising body lotion [cosmetic]; Serums for cosmetic purposes; Skin recovery creams [cosmetics];

And

Pre-moistened cosmetic tissues; Pre-moistened cosmetic towelettes.

18. The first set of goods outlined above will all encompass either creams, balms, milks, mousses, greases or powders for use by parents on babies and young children's skin either when changing, or prior to dressing with a nappy (or 'diaper'), in order to prevent or soothe dry, sore, or irritated skin which may be caused by wearing the same. The users will therefore be shared with the users of the earlier goods *disposable baby diapers* to this extent, although the intended purpose of the goods will differ. I find diapers will be important for these goods where they are specifically designed to prevent or soothe diaper rash or irritation. In addition, it is my view that the consumer may easily believe that the goods will be offered by the same entity in these instances. As such there is a level of complementarity between them at this level. The goods may be sold in the same area of stores, but there will be no competition between them, and their nature will differ significantly. Overall, I find these goods, to the extent that they cover products designed for use on those wearing diapers, will be similar to the opponent's earlier goods *Disposable baby diapers* to at least a low degree.

19. In respect of the second sets of goods above, I note these will include baby wipes, which will again frequently be used by parents or guardians when changing nappies. The users will be shared, although I note there is no complementarity between the goods, as they are not important or indispensable to one another. The nature of the goods will somewhat differ, although there is some similarity with both being or including disposable cloth products. The intended purpose will differ; however, the goods are likely to share trade channels, be produced by the same entities and be sold near if not next to each other in shops. I find these goods to be similar to between a low and medium degree.

The earlier stylised mark

20. The earlier stylised mark includes, inter alia, the goods *non-medicated toilet preparations; soaps; toiletries; skin care products; non-medicated skin care preparations; skin and cosmetic creams*; as well as *wipes; baby wipes; pre-moistened tissues or wipes* in class 3. These goods are identical either self-evidently or in accordance with the principles set out in *Meric* to all of the contested goods, with the exception of the following items:

Eyebrow cosmetics; Cosmetic dyes; Cosmetic pencils; Pencils (Cosmetic -); Dyes (Cosmetic -); Cosmetic rouges; Decorative cosmetics; Colour cosmetics; Cosmetic eye pencils; Cosmetic face powders; Nail hardeners [cosmetics]; Powder compacts [cosmetics]; Nail primer [cosmetics]; Lip stains [cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics]; Cosmetic cotton wool; Suntan oils [cosmetics]; Tanning oils [cosmetics]; Lacquer for cosmetic purposes; Cleaner for cosmetic brushes; Eyelashes (Cosmetic preparations for -); Henna for cosmetic purposes; Adhesives for cosmetic use; Pencils for cosmetic use.

21. The contested goods *Eyebrow cosmetics; Cosmetic pencils; Pencils (Cosmetic -); Cosmetic rouges; Decorative cosmetics; Colour cosmetics; Cosmetic eye pencils; Cosmetic face powders; Powder compacts [cosmetics]; Lip stains [cosmetics]; Eyelashes (Cosmetic preparations for -); Pencils for cosmetic use* are all make up items. The nature of these goods will generally differ to that of the earlier goods. However, they will share a broad intended purpose with the earlier goods such as *cosmetic creams* in the sense that they are all used for changing and improving the appearance of the face or skin. Entities offering these goods will often be the same, and the goods will generally be near each other if not next to each other in stores. The goods will not be complementary and are unlikely to be in competition with one another due to the differences in their more specific intended purpose. On the one side, cosmetic creams will be used to add moisture or improve the texture of the skin, whereas the contested goods will be for the purpose of covering up flaws or adding

colour of definition. The users will be shared only to the extent that goods are all aimed at the general public. Overall, I find these goods to be similar to a low degree.

22. The contested goods, namely *Cosmetic dyes; Dyes (Cosmetic -); and Henna for cosmetic purposes* are all goods that may be used to change the colour of the hair. The earlier goods include *shampoo*. All of the goods are for use on the hair, and I note the goods will have a similar nature and will share a similar purpose at a very high level, that being for improving the look of the same. Whilst the earlier goods are primarily for the purpose of cleaning hair, I note that often shampoos will include tints or colour lightening properties, and so there may be a small element of competition between the goods. I find these goods will often be provided by the same entities and are likely to be placed at least near each other in the same section of larger supermarkets, as well as in more focused shops or pharmacies. Overall, I find these goods to be similar to the opponent's goods to between a low and medium degree.

23. The contested goods *Nail hardeners [cosmetics]; Nail primer [cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics] Lacquer for cosmetic purposes; Adhesives for cosmetic use* may all be used for the purpose of changing the appearance of nails. The earlier goods include *skin and cosmetic creams* which will include nail and cuticle creams. These goods will often be used together, although I do not find them to be complementary. They all share the high level intended purpose of improving the look of nails, although the earlier goods will be for the purpose of improving the quality and texture of the nails and skin, whereas the contested goods may be for the purpose of lengthening or applying colour to the nails themselves. The goods are not in competition with one another, but they will likely be sold near each other in stores and be offered by the same entities. The nature of the goods will differ, as will be method of use. Overall, I find the goods to be similar to a low degree.

24. The earlier goods including *skin and cosmetic creams* will, in my view, include tanning creams. Whilst I find the nature of tanning creams to differ to the contested goods *suntan oils [cosmetics]; tanning oils [cosmetics];* I find that all other factors will be shared. I therefore find these goods to be similar to a high degree.

25. The contested goods *cosmetic cotton wool* will share a purpose with the earlier *wipes* (which in my view will include *makeup wipes*) in that they may all be used on the face for the removal of makeup. The method of use will also be very similar. The users will be shared to the extent that they will all be used by the general public, particularly those who wear make-up. They are likely to be sold next each other in stores. The nature will differ to an extent as although they may all be made from cotton, cosmetic cotton wool will generally be sold in a ball or circular pad, and wipes will usually take the form of a flat rectangular or square sheet which are generally pre-soaked in a makeup removing substance. Due to the shared purpose, there may be a small element of competition between the goods, with the consumer opting for one over the other to remove make up. I do not find the goods to be complementary. Overall, I find the goods to be similar to a medium degree.

26. In respect of the remaining goods, namely *cleaner for cosmetic brushes*, I consider that the intended purpose of the goods will be shared with the earlier *wipes*, as these will include cleansing wipes for cleaning cosmetic brushes. Again, it is my view that they will be sold at least near each other if not next to each other in stores, and that they will be in competition. I also consider the goods are likely to be offered by the same entities, but the nature may be different. Overall, I find the goods to be similar to between a medium and high degree.

Comparison of marks


27. 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 Court of Justice of the European Union 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.”

28. 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.

29. The respective trade marks are shown below:

Earlier trade marks	Contested trade mark
ANDY PANDY	PandyCare
	

30. The earlier word mark consists of the two words ANDY PANDY. These elements hang together as a first name and surname to convey a full name. I consider that as a general rule, surnames are more distinctive than forenames and that the surname PANDY appears to be more unusual than the forename ANDY. However, it is also true that the consumer tends to pay more attention to the beginning of marks. It is my view that in this instance the overall impression of the mark rests in the combination of the two elements and the mark as a whole, with neither element appearing to dominate the same.

31. The earlier logo mark comprises the slightly stylised word element ANDY PANDY in addition to an image of a waving panda sat next to bamboo. I find the word element to be the most dominant and distinctive element in the mark, but I do not consider the device element to be negligible, and I note it still plays a significant role in the overall impression of the mark.

32. The contested mark is the word PandyCare. Whilst this is displayed as one word, it clearly comprises the two immediately distinguishable individual elements ‘Pandy’ and ‘Care’. The word ‘Care’ is not distinctive in respect of the goods, and as such the element Pandy is the most dominant and distinctive element in the contested mark.

That being said, it is my view that the joined word Care will not go unnoticed in by the consumer, and as such it is not negligible, although it plays significantly lesser role in the marks overall impression.

Visual comparison

33. Visually the earlier word mark and the contested mark coincide by way of the inclusion of the word 'Pandy'. Whilst this is at the beginning of the contested mark, it is at the end of the earlier word mark. The earlier word mark differs to the contested mark by way of the additional word 'Andy' at the beginning of the same, and the omission of the word 'Care' at the end of the mark. Overall, I find the earlier word mark visually similar to the contested mark to a medium degree.

34. The earlier logo mark also features the similarities and differences with the contested mark that I have outlined above, although in this instance the wording is presented in a slightly stylised font, and there is the addition of the large panda device which does not feature in the contested mark. The contested mark is a word mark, and fair and notional use of this mark would include its use in range of fonts, and as such the stylisation of the wording in the earlier logo mark does little to differentiate the marks visually. However, the panda device does add to the visual differences. Overall, I find the earlier logo mark visually similar to the contested mark to between a low and medium degree.

Aural comparison

35. Both earlier marks will be pronounced as two words and four syllables as AND-EE PAND-EE. The later mark will be pronounced as PAND-EE CAIR. It is my view that the despite the lack of distinctiveness in the word CARE in the later mark, the joining of the words means it is likely to be verbalised by the consumer. However, even if the 'Care' element is not verbalised in the later mark, both earlier marks still differ to the contested mark by way of the inclusion of the additional initial word comprising two syllables. Overall, I find all of the marks to be aurally similar to a medium degree.

Conceptual comparison

36. Whilst for me, the earlier mark brings to mind the concept of the fictional children's television character Andy Pandy, it is my view that there will be a significant portion of UK consumers who will not be particularly familiar with this character, and to whom it will not be brought to mind. For these consumers, the earlier mark will therefore just be considered as a name, albeit one that rhymes. I refer to the case of *Luciano Sandrone v EUIPO*² wherein the GC stated that:

“85. [...] a first name or a surname which does not convey a ‘general and abstract idea’ and which is devoid of semantic content, is lacking any ‘concept’, so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM—McKenzie (McKENZIE)*, T502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM—Cortefiel (PEDRO)*, T38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T707/16, not published, EU:T:2018:424, paragraph 65).”

37. With the above case law in mind, it is my view there will be a significant portion of consumers to whom the earlier word mark will be considered simply as a name and

² Case T-268/18

will hold no specific concept. The earlier logo mark introduces the concept of a panda that is not present, and in my view will not be evoked, by the later mark.

38. I note that the word Pandy is defined in the dictionary as meaning “(in schools) a stroke on the hand with a strap as a punishment”.³ However, it is my view that for the majority of consumers this meaning is unlikely to be evoked by the mark PandyCare, particularly as this defines an outdated punishment and is a term that is unlikely to be used in modern parlance. The word ‘Care’ used in the later mark will clearly evoke a meaning, albeit one that is relatively weak in the context of the goods. Overall, I find both earlier marks to be conceptually dissimilar to the later mark.

39. For the avoidance of doubt, I note here that even where the earlier mark will evoke the children’s television character Andy Pandy to the consumer, I find the contested mark will not. The outcome of the conceptual comparison would therefore not be significantly altered on this basis, and particularly I note this finding would not further assist the opponent.

Average consumer and the purchasing act

39. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

40. 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

³ [Pandy definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com) [accessed 28 August 2022]

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.”

41. Before making a decision on the likelihood of confusion, I must first identify the relevant consumer of the goods. It is my view the consumer will primarily comprise members of the general public, although there will also be professionals such as beauticians, make-up artists and hairdressers also purchasing the goods for use in their jobs. I consider that the general public will consider factors such as fragrance, colour, and consistency of the cosmetic goods, in addition to suitability of the goods for use with their, or their dependents skin type, and the practicality and reliability of the same. For the most part, a medium degree of attention will be paid. However, I note there are also goods such as ‘cosmetic soaps’ which may be purchased more frequently and at a lower price point that will receive only a low to medium level of attention from the general public. I find that the professional consumer will pay a higher level of attention, that being at least medium or above, due to the liability and responsibility involved with using the goods on customers and clients.

42. It is my view that the goods will primarily be purchased visually, either online or in physical retail stores. However, I accept that there may be aural aspects to the purchasing process, such as verbal recommendations or assistance from retail staff, and that in the case of professional consumers, orders may be placed by telephone. I cannot therefore completely discount the aural comparison.

Distinctive character of the earlier trade mark

43. 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).

44. The earlier word mark comprises a first name and surname. Whilst for some it may evoke a children's television character and for others it will not, in either scenario it is neither descriptive nor is it allusive of the goods themselves. The surname 'Pandy' does not appear to be overly common, and this fact, along with the fact it rhymes with the first name 'Andy' elevates inherent the distinctiveness of the mark slightly to an above medium degree. Whilst I note the addition of the panda device in the earlier word mark, I do not consider this adds significantly to the inherent distinctiveness of the logo mark as a whole, which in my view also holds a slightly above medium level of distinctiveness in respect of the goods.

45. The opponent has not filed any evidence in these proceedings, and so it is not possible to find that the distinctiveness of the earlier marks has been increased to above their inherent level by virtue of the use made of the same.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

46. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 11 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the relevant consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion,

and that the distinctiveness of the common elements is key.⁴ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are selected will have a bearing on how likely the average consumer is to be confused.

47. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁵

48. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

49. I found the goods under the earlier marks to range from identical to similar to a low degree to those covered by the contested mark. I found the earlier word mark to be similar to the contested mark to a medium degree visually, and the earlier logo mark to be similar to the contested mark visually to between a low and medium degree. I found all of the marks to be aurally similar to a medium degree, and to be conceptually dissimilar. However, I note at this point that, for at least a significant portion of consumer the conceptual difference between the marks will be based on the concept of 'care', which is weak and will make little impact in respect of the goods for which the marks are registered and applied for. I therefore put little weight on these conceptual differences between the marks in this instance. I found both the earlier marks to hold a slightly above medium degree of inherent distinctive character, but I did not find this

⁴ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

⁵ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

to have been enhanced through use. I found the level of attention paid by relevant consumer varies in respect of the goods and the consumer group, those being the general public and the professional consumer, and this ranges from low to medium, to a medium or higher degree.

50. With consideration to all of the factors, and notwithstanding the consumers imperfect recollection, and the points in the opponent's favour, it is my view that the differences between the marks, particularly the visual and aural differences, are too great for the consumer to fail to notice or fail to recall the same. I therefore find no likelihood of direct confusion between the marks.

51. I therefore consider if there may be indirect confusion between the marks. Three examples of when indirect confusion may occur were set out by Mr Iain Purvis Q.C. in *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10. In this case, Mr Iain Purvis Q.C. set out at paragraph 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).”

52. Whilst I note the examples set out above are not an exhaustive list of instances in which indirect confusion may occur, I find in this instance, none of the above apply.

53. I consider if there is another basis on which to find indirect confusion will occur. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) 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.”

54. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [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.

55. I have carefully considered the case law above, in addition to all of the factors of this case, and I note in this instance that I do not find the shared element ‘Pandy’ plays an independent role within the earlier marks. It is my view that the use of Pandy would not be viewed by the consumer as an indication that the marks derive from the same economic undertaking, even in the case of identical goods. I find no proper basis for a likelihood of indirect confusion in this instance, and it is my view that at best, if consumers noticed the use of the word ‘Pandy’ in the earlier marks and in the later mark, this would be put down to coincidence, and would not indicate an economic connection between the same.

The opposition based on section 5(2)(b) of the Act fails.

Final Remarks

56. The opposition has failed in its entirety, and subject to any successful appeal, the application will proceed to registration in respect of all of the goods as filed.

COSTS

57. The applicant has been successful and would usually be entitled to a contribution towards its costs. On 1 July 2022, the Tribunal wrote to the applicant as follows:

What to do if you intend to request costs

If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to tribunalhearings@ipo.gov.uk.

If there is to be a “decision from the papers” this should be provided by **29 July 2022**.

If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.

58. The applicant did not return a completed costs pro-forma by the deadline set. I therefore make no award of costs in this instance.

Dated this 31st day of August 2022

Rosie Le Breton

For the Registrar