

O-222-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2438322
BY IAIN LAMONT
TO REGISTER THE TRADE MARK**

Lash Xpert

IN CLASSES 3 AND 25

AND

**THE OPPOSITION THERETO
UNDER NO 95164
BY THE PROCTOR AND GAMBLE COMPANY**

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Introduction

1. On 13 November 2006, Iain Lamont applied to register the above trade mark. The trade mark was published for opposition purposes on 2 February 2007 with the following specification:

cosmetic and beauty products;

retail services connected with the sale of cosmetic and beauty products.

The above goods are in classes 3 and 35, respectively, of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. On 2 May 2007, The Proctor and Gamble Company which I will refer to as PG, filed a notice of opposition to the registration of the trade mark in its entirety. PG claims that registration of the trade mark would be contrary to section 5(2)(b) of the Act since there would be a likelihood of confusion on the part of the public. It relies upon the following earlier marks:

a) Community Trade Mark (CTM) No 3698396

MAX FACTOR
THE MAKE-UP OF MAKE-UP ARTISTS

which was filed on 5 March 2004 and registered on 27 July 2005. Since its date of registration is less than five years before the application in suit was published in the *Trade Marks Journal*, there is no requirement for PG to prove use of its mark.

CTM No 3698396 is registered for:

toilet soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for the cleaning, care and beautification of the skin, scalp and hair.

PG claims the 'X' is the dominant element of its trade mark and that a highly stylised 'X' also appears in the application; because the 'X' is primarily the dominant element of both trade marks, the marks are visually similar. There is similarity, if not identity, of goods and services.

b) CTM No 301176

PERT

which was filed on 27 June 1996 and was registered on 19 November 2003. It is also not subject to proof of its use. CTM No is registered for:

soaps, all perfumery products, agents for the body and beauty care, shampoos, hair lotions and other hair care products, essential oils, cosmetics, bath preparations, dentifrices.

PG claims that its trade mark PERT is contained within the application in its entirety, there being visual and aural similarity and a similarity, if not identity, of goods and services.

3. PG also claims that registration of the trade mark would be contrary to section 5(4)(a) of the Act. It relies upon the trade mark:



(which is the 'X' in CTM 3698396). PG claims it has used this trade mark throughout the UK in respect of "soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for the cleaning, care and beautification of the skin, scalp and hair, agents for the body and beauty care, shampoos and other hair care products, bath preparations, dentifrices" since 1 February 2004. It claims that, through its substantial use and marketing of the 'X', PG has acquired a significant reputation and goodwill in relation to these goods.

4. Mr Lamont filed a counterstatement, denying the grounds of opposition:

"The LashXpert trademark is intended to be read and would be read as Lash Expert. The name clearly implies the products would be applicable to lashes/eyelashes. LashXpert products are only applicable to eyelashes and are synthetic fibres which are bonded to natural eyelashes to achieve a visibly enhanced appearance. They cannot be applied by the end user and must be applied by trained therapists. The opponents do not offer any product of this type.

The highlighted X in the trademark is clearly designed to represent 2 eyelashes.

LashXpert v Pert

There is little visual or aural similarity and the words have 2 quite different meanings. LashXpert products are totally different to those listed on the opponents registration.

LashXpert v MaXfactor

There is no aural similarity. The words have quite different meanings. The X is noticeably different. LashXpert products are totally different to those listed in the opponents registration.

LashXpert v X

There is little visual similarity and none in the context used. The Maxfactor X is clearly intended to represent some liquid makeup squeezed out in an X shape. LashXpert is clearly 2 eyelashes.

In light of above we can see no consumer confusion or any evidence of passing off."

5. Only PG filed evidence. The parties were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and from any written submissions. Neither side requested a hearing and only the PG filed written submissions. I have borne in mind the above statements made by Mr Lamont in reaching my decision.

Evidence of PG

6. This consists of a witness statement and supporting exhibits by Carl J. Roof. Mr Roof is Associate General Counsel and Global Trademark Director of The Proctor & Gamble Company. He states that the trade marks MAX FACTOR THE MAKE UP OF MAKE UP ARTISTS (which I will refer to as the MAX mark) and the stylised 'X' were first launched by PG in the UK from at least as early as February 2004. The products bearing these marks

are aimed at the mass market and are sold through a large number of grocery retailers, chemists, perfumery and department stores including Boots, Asda, Tesco, Sainsbury's SuperDrug and Debenhams. Mr Roof exhibits at CJR1 a list of 3728 retail outlets carrying the goods bearing the trade marks; however, this is dated a year after the relevant date and includes a number of outlets in the Republic of Ireland. I note that the PERT trade mark is not mentioned in the evidence.

7. Combined sales figures are given for the two marks, rather than for each mark:

2004-2005	£75,526,520	10,430,390 units
2005-2006	£80,426,354	11,456,355 units
2006-2007	£90,223,881	12,187,127 units

(the application date is 13 November 2006).

8. The goods are promoted via television, radio, printed matter, outdoor advertising and on-line advertising, with television being the primary advertising medium. Mr Roof states that most major women's and lifestyle magazines carry advertisements for the goods. In support of this claim is exhibit CJR 2, which consists of samples of four advertisements appearing in the UK, with a date range of October 2004 to September 2005; Mr Roof says that the 'X' features prominently in each advertisement. Two of the advertisements feature the MAX mark with a different 'X'. I note that in the two advertisements where the 'X' appears as it does in PG's registration, one is for liquid foundation and the other is on a Boots' coupon. In the other two instances the 'X' is quite different, appearing as brush strokes of mascara, which is the type of cosmetic product that these two particular advertisements promote.

9. Mr Roof exhibits a selection of print-outs from PG's websites, www.maxfactor.co.uk and www.uk.pg.com. Each of these prints (exhibits CJR 3) carries the text "© 2007 Procter & Gamble. All rights reserved". Some were clearly printed on 4 January 2008. All post-date the relevant date (13 November 2006) and are therefore not of assistance in these proceedings as they cannot tell me the position prior to, or at, the relevant date.

10. Finally, Mr Roof exhibits (CJR 4) details of a customer awareness survey undertaken by PG in relation to the MAX trade mark. This exhibit consists of a single sheet containing tabulated figures and abbreviated text. He states, at paragraph 11 of his witness statement, that "12% of respondents recalled the MAX FACTOR trade mark to mind unaided as the first colour cosmetic brand which came to mind (top of mind; 40% of respondents mentioned MAXFACTOR unaided as a known colour cosmetic brand; 96% of respondents recognised the MAXFACTOR brand when aided and 61% recognised MAXFACTOR advertising when aided."

11. It is not clear to me when the survey was undertaken. From the presence of "1'07" to "12'07", I surmise that it may have been during 2007, which is after the relevant date. It appears only women aged 20 to 39 years of age were targeted, but I do not know where the survey was done; what the respondents were shown and asked; how many gave an answer and how many declined; or what any of the abbreviations and missing text might mean. The head note of *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293 indicates the way that a survey should be conducted:

“If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed.”

I am of the view that the survey satisfies none of the requirements identified above. Were there any advertisements for PG’s goods bearing the mark in the vicinity? Were the interviewees in the process of buying cosmetics? Were they asked about cosmetic brands, thereby leading the respondent into a field of speculation they would never have embarked upon had the question not been put? There is nothing from which I can extrapolate to indicate the average relevant consumer’s reaction. In *Citibank NA and Citicorp v Citybond Holdings PLC* [2007] R.P.C. 13, Mr Geoffrey Hobbs QC, sitting as the appointed person stated:

“34. If the research work provides no sufficient or proper basis for extrapolation, the responses of individual interviewees can really only be taken into account for what they may individually be thought to be worth. That may be little or nothing. This was forcefully pointed out by the Full Court of the Federal Court of Australia in *Arnotts Ltd. v. Trade Practices Commission* (1990) 97 ALR 555 where the Court observed at p.606:

“One theoretical possibility, in a case like the present, would be for a party to call such of the 1200 respondents to the Roy Morgan survey as were contactable. This course would have the advantage of providing a fairly selected group of witnesses, subject to any distortion which might be caused by difficulties in locating respondents. But it would add enormously to the cost and duration of a trial. The second possibility would be for a party to call evidence from a lesser number of selected witnesses. This course was taken in *Ritz*. The plaintiff there called 152 members of the public. The majority of these witnesses were stopped in a public place by a representative of the plaintiff and questioned as to the significance to them of the word “Ritz”. It seems that those who gave answers favourable to the plaintiff’s case were asked to give evidence. Those who did not, were not. As a result, the evidence of these persons was of negligible value. All that it established was that, with the expenditure of sufficient effort and money, 152 people could be found somewhere in Australia who claimed to associate the word “Ritz” with the plaintiff. The 152 witnesses were not a fair sample of the general public; so that, as McLelland J noted (NSWLR at 215) there was “no ground in the evidence for any extrapolation on a statistical basis, or on the basis of any mathematical or logical probability, of the views of the ‘public’ witnesses (or any selection from them) as representing the views of the relevant class of the Australian public or a significant section of that class”. The plaintiff was not

even willing to reveal the total number of persons interviewed; for all the judge knew, the persons who associated the word “Ritz” with the plaintiff may have been a tiny minority. The tender of such partisanly selected evidence was an absurdity.”

For these reasons, I am unable to take account of exhibit CJR 4, or Mr Roof’s statement in relation to the exhibit.

Decision

Section 5(2)(b) of the Act – likelihood of confusion

12. The relevant part of section 5(2)(b) of the Act is as follows:

“(2) A trade mark shall not be registered if because –

(a) –

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade marks 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.”

Section 6(1)(a) of the Act defines an earlier mark as:

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

PG’s trade marks upon which it relies are earlier marks as per section 6(1)(a).

13. The leading authorities which guide me in this ground are from the European Court of Justice (ECJ): *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, *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 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). They represent settled case law and for the benefit of the applicant, who is not professionally represented in these proceedings, it is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) 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; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

k) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods and services

14. PG relies upon two earlier trade marks for which there is no requirement to prove use. I am therefore required to compare the goods and services covered by PG's earlier marks without restriction. The application is for cosmetic and beauty products (class 3) and retail services connected with the sale of cosmetic and beauty products (class 35). The MAX mark is registered for toilet soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for the cleaning, care and beautification of the skin, scalp and hair (class 3) and the PERT mark is registered for soaps, all perfumery products, agents for the body and beauty care, shampoos, hair lotions and other hair care products, essential oils, cosmetics, bath preparations, dentifrices. The goods covered by the application in class 3 are identical to those covered by the earlier marks. The services covered by the application in class 35 are highly similar to the class 3 goods of PG's earlier marks. In this particular market sector, it is commonplace to find cosmetic house franchises within department stores, each with their own beauty consultants selling only that house's products.

15. Mr Lamont states in his counterstatement that his products are totally different from PG's and that PG does not sell synthetic fibres which are bonded to natural eyelashes by trained therapists. Mr Lamont's specification is not limited in this way – it is for “cosmetic and beauty products” – and therefore covers exactly the same goods as PG's earlier marks. However, even if his specification were limited to synthetic fibres for bonding to natural eyelashes by trained therapists, it would still be encompassed by the term “cosmetics” in PG's earlier registrations. ‘Cosmetics’ covers false eyelashes and it would be splitting hairs to say that synthetic fibres for attaching to real eyelashes did not constitute false eyelashes. PG does not have to prove on what particular products in its specification it has used the marks; it is sufficient for the purposes of my comparison, following the case law cited above, that such goods are covered by its specifications. This is the principle of notional and fair use; a proprietor of a trade mark has five years in which to trade in the goods for which a mark is registered without having to prove that he has yet done so, or how he has done so, before that five years is up. The Court of First Instance (CFI), in *Saint-Gobain SA v Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) Case T-364/05* stated:

“67. With regard to the conditions under which the goods at issue are marketed, the applicant's argument that the goods covered by the earlier mark are sold almost exclusively in shops and supermarkets, whereas the mark applied for refers solely to goods sold by mail order, is without foundation. As has already been held, on a comparison of the goods, nothing prevents the goods covered by the earlier mark from also being sold by mail order. In addition, it is apparent from the file that the intervener makes almost 5% of its sales by mail order. Furthermore, it is important to reiterate that the comparison between the goods in question is to be made on the basis of the description of the goods set out in the registration of the earlier mark. That description in no way limits the methods by which the goods covered by the earlier mark are likely to be marketed.”

At the relevant date, PG was entitled to market or sell cosmetics in whichever way it might choose, including sale via application of the goods to the customer by trained beauty therapists. I find that all of the goods and services in the application are either identical or highly similar to the goods of the earlier marks upon which PG relies.

Average consumer and the purchasing process

16. PG submits that its goods are sold to the general public. Cosmetics can vary enormously in price, but even at the less expensive end of the market, I consider that the purchasing process will involve a fairly close inspection of the goods and thus a reasonably high level of attention. Those who wish to enhance their appearance, for example, by applying false eyelashes, of whatever durability, are likely to make a considered purchase, since the desired effect will be important to them. That purchase is also much more likely to be a visual purchase than an oral purchase. However, the term ‘cosmetic’ is not limited to the obvious staples of a make-up bag, but covers a broader interpretation, including for example soaps and preparations for beautifying the skin (see the judgment of the CFI in *La Mer Technology, Inc OHIM*, Case T-418/03). Close attention is likely to be paid to such goods, which are usually selected visually, since the purchase may involve a scrutiny of the promised effect on the user.

17. Mr Lamont submits that his goods cannot be applied by the end user and must be applied by trained therapists. Leaving aside the fact that the specification of his trade mark application is not limited in this way, as discussed above, I must bear in mind not only the intermediate user, the trained therapist, but also the end consumer, who is the person with the enhanced eyelashes. In *Björnekulla Fruktindustrier AB v Procordia Food AB*, [2004] R.P.C. 45, the ECJ stated:

“24 In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

25 Accordingly, the relevant circles comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.”

In Mr Lamont’s counter statement, he clearly has it in mind that the consumer of his goods is the intermediary, rather than the beneficiary of the eyelash thickening treatment. Accordingly, I take that into account; the level of attention of a trained beauty therapist in selecting a product will be high. However, the end consumer is likely to be involved in the selection of the appropriate treatment, based perhaps on previous purchases or the recommendation of the therapist. I cannot discount the perception of the end user. Finally, neither the application nor the earlier marks are limited in any way and therefore cover cosmetics for purchase by the general public as much as they cover specialist goods for application by trained professionals. My overall assessment of the level of attention of the average, relevant consumer is that it is reasonably high.

Similarity of marks

18. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant. The likelihood of confusion must be appreciated globally by 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 and how they are marketed. However, I should guard against dissecting the marks so as to distort the average consumer's perception of them; the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. Since the earlier rights upon which PG relies are entirely different to each other, I will make a separate comparison with the application for each of PG's marks.

19. The PERT mark

The marks to be compared are:

PG's

Mr Lamont's

PERT



Lash Xpert

Visually, the earlier mark consists entirely of the word PERT. The application consists of the word LASH together with an enlarged, stylised, 'X' and the word PERT. The points of visual similarity between the marks converge upon PERT. It is possible to see the application as two words, 'LASH' and 'PERT', separated by a stylised X (although Mr Lamont submits that the stylised X represents two eyelashes, I am doubtful the average consumer would see it that way). However, I consider that the 'X' clearly has a job to do within the mark and that is to act as a replacement for the letters 'ex'. The mark's visual significance is LASH EXPERT. PG submits that the application contains its PERT mark in its entirety. This is undeniable; however, such an interpretation of the similarity which exists between PERT and LASHXPERT would depend upon the onlooker artificially dismembering the application and ignoring the substitution of the 'X' for 'ex'. Since the 'X' in the application makes an important contribution to the overall distinctive character of the marks, I consider that the average consumer is unlikely to ignore the 'X' and will naturally make sense of its position with what follows it ('pert'). There is a degree of visual similarity between the marks which is offset by the effect of the 'X' upon 'pert' in the application.

20. Aurally, PG claims that "the emphasis of both marks falls on PERT when both marks are spoken". I disagree. If the applicant's mark were to be heard, the stress in normal English speech will be upon 'ex' (or X) or spread equally between the two syllables. I have never heard the word expert spoken with the second syllable as the more emphatic of the two. I view it as highly unlikely that the application will be referred to orally as LASH PERT. Any aural similarity is likely be slender, at most, since the X is likely to be spoken.

21. In its submissions on the conceptual meanings of the marks, PG states that PERT has its own dictionary definition, meaning 'firm'. PG does not reveal its source. In the 2000 edition of *Collins English Dictionary*, 'pert' is defined as:

- “1. saucy, impudent, or forward.
2. jaunty: *a pert little hat.*
3. *Obsolete* clever or brisk.”

and the 2006 edition of *The Concise Oxford Dictionary* defines it similarly:

- “1. **pert** *adj.*
(of a girl or young woman) attractively lively or cheeky. • impudent or cheeky: no need to be pert, miss.”

It is possible that ‘firm’, which PG submits is the meaning of ‘pert’, is an additional, cosmetic trade term, but I have no evidence on the point to assist me. PG says that the applicant’s synthetic fibres “would need to be firm in nature otherwise they would not “bond” to the users natural eyelashes. The Opponent therefore asserts that both the Opponent’s mark and the Applicant’s mark share the same conceptual meaning and are therefore, conceptually confusingly similar”. I think that is a bit strained. In fact, it does not matter greatly whether that is a further meaning; what is important is that there is a meaning which is entirely different to ‘expert’, the meaning conveyed by the application. Mr Lamont’s mark is conceptually ‘Lash Expert’; PG’s mark is conceptually the word PERT. There is conceptual dissonance because each trade mark has a meaning and those meanings have different conceptual associations.

LashXpert

Likelihood of confusion: PERT v

22. In considering the likelihood of confusion, I have to bear in mind the nature of the goods and services, the purchasing process and the relevant consumer, which have been dealt with above. I have to weigh the proximity of the goods and services against the relative distance between the marks - the interdependency principle – whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). I have already found that the goods and services are identical or very similar. I must consider what is the relative importance that the phonetic and visual similarities have in relation to the goods and services during the purchasing process; as stated above, in buying cosmetics, the visual similarity is of greater importance than the aural similarity.

23. I must also appraise the distinctive character of the earlier mark, because the more distinctive it is (either *per se* or by reputation), the greater will be the likelihood of confusion (*Sabel*). The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer’s perception of the mark. PG states that PERT means firm and that the applicant’s synthetic fibres “would need to be firm in nature otherwise they would not “bond” to the users [sic] natural eyelashes.” Although I think that argument is strained, it cuts both ways. If ‘pert’ means ‘firm’, as PG says it does, then its distinctiveness in relation to certain goods covered by its own mark PERT may be reduced; for example for lip firming cosmetics, or for skin preparations which firm up the skin. The evidence submitted by PG does not mention the mark PERT and I have no idea how it is used (if it is used), or whether it has a reputation.

24. PG also claims that its earlier trade mark PERT is reproduced in the application in its entirety and that it remains an independent and distinctive element within the application. It is therefore relevant to consider the *Medion* judgment. In that judgment the ECJ stated:

“29 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 *Matratzen Concord*, paragraph 32).

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.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.

37 Accordingly, the reply to the question posed must be that Article 5(1)(b) of the directive is to be interpreted as meaning that where the goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.”

The ECJ dealt with this matter again in *Shaker di L. Laudato* :

“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.”

The dominant element of the application, visually, is the enlarged, stylised, ‘X’. However, it is not a stand-alone component and must be seen in the context of the part it plays in the overall impression of the mark. It is a substitute for ‘ex’ and creates ‘expert’. ‘Xpert’ is qualified by ‘Lash’: an expert in lashes - a lash expert. PERT cannot be said to retain an independently distinctive role in the applicant’s mark; to view it that way would be to engage in dissection of the mark, which is something that the average, relevant consumer does not do. Further, I cannot consider PERT to be the dominant element since the other components of the application are not negligible.

25. There is little aural similarity between the marks. Although there is a measure of visual similarity, this is outweighed by the conceptual dissonance between the marks. One is a dictionary word meaning jaunty, impudent, or possibly firm; the other means (eye)lash (e)xpert. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case T-147/03, the CFI stated:

“It is true that, according to case-law, a conceptual difference between the marks at issue may be such as to counteract to a large extent the visual and aural similarities between those signs (*BASS*, cited in paragraph 60 above, paragraph 54). However, for there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.”

In this case, both marks have a separate meaning, but even if the average consumer were to be unaware of the precise (or any) meaning of PERT, the applicant’s mark sends a conceptual message of LASH EXPERT which the average consumer will be capable of grasping

immediately. I find that there is no likelihood of confusion between the application and CTM No 301176 PERT.

26. The MAX mark

The marks to be compared are:

PG's



Mr Lamont's



In the MAX mark, the X is the final letter of the male forename 'Max' and the mark consists of the words 'MAX FACTOR THE MAKE-UP OF MAKE-UP ARTISTS'. I have already given my conclusions about how I think the average relevant consumer would make sense of the enlarged stylised 'X' in the application. The application consists of the words 'Lash Xpert'. There is a single point which both the MAX mark and the application have in common: they both include an enlarged, differently stylised 'X'. All other content in the respective marks is different. PG submits that the 'X' is featured in a similar position in both marks, although I am unable to agree (in one mark it is the third out of nine letters and in the other it is the fifth out of nine letters). I agree with PG that the stylised letter 'X' in each mark is a key element of each mark and that the eye is drawn to it. I disagree with PG that "the stylised X in the Applicant's mark is highly similar to the stylised letter X used in the Opponent's trade mark as both marks contain two simple diagonal lines". It is difficult to conceive of an X which does not use two diagonal lines, but I assume PG means that the representation of the X in each mark is not greatly embellished or altered from its obviousness as an X. Mr Lamont's counterstatement says that "The Maxfactor X is clearly intended to represent some liquid makeup squeezed out in an X shape". I agree that it looks as though it is some kind of liquid. I note that PG's evidence reveals that the X is used this way when liquid foundation is the subject of the advertisement, but alters its appearance when something else, such as mascara, is being promoted. I think it reasonable to infer from the evidence that it represents liquid of some sort. The two lines of the applicant's 'X' are irregular in length and width and are completely linear, with none of the 'blobs' contained in PG's 'X'. Although it is plain that both marks contain an enlarged X which each have a high degree of visual impact, I consider there to be a good deal of visual distance between the two 'X's themselves. In addition to that, there is no other visual similarity, the remainder of the marks being composed of recognisable words. I conclude that there is little visual similarity between the marks when compared as a whole.

27. PG submits that "the letter X is unusual and has a very distinct sound when spoken, such that it is very noticeable even when used in the middle of a word." For this reason, PG says that the two marks are phonetically similar and will be confused. I have difficulty with this argument. Firstly, the letter X is not unusual in the English language (in the way that Z is, for instance). There are thousands of words in which it appears. In writing this decision thus far,

I have used, apart from ‘expert’, some seventeen words which incorporate an x. Some start with ‘ex’, such as example, exclusively, exhibits and exists. Others are words such as complex, text, proximity and context. I therefore reject the notion that X is unusual. Furthermore, PG’s proposition that X is very noticeable aurally even when used in the middle of a word does not bear up under scrutiny; how would one be able to distinguish aurally between an ‘x’ sound, a (sa)cks sound or a (ca)kes sound, or a ‘cs’ sound, as in ‘facsimile’ (of which the common contracted form is ‘fax’)? I find that there is no aural similarity between MAX FACTOR THE MAKE-UP OF MAKE-UP ARTISTS and LASHXPERT.

28. I have already mentioned, in relation to PERT and LASHXPERT the conceptual dissonance is created by two marks which each have a different meaning and different conceptual associations. The same is true of the MAX mark and the application; the one is a name (Max Factor) and the other denotes a Lash Expert. PG submits that its mark alludes to the products it offers (by the inclusion of the word make-up) and the application contains LASH, a clear reference to eyelashes: “There is a clear overlap between make-up and eyelashes such that the marks are conceptually very similar”. I do not find that persuasive, but there is a further point to consider in relation to conceptual similarity. Both marks have as their ‘concept’ an enlarged stylised ‘X’. However, I consider that the primary conceptual message of each mark, the one a name, the other an expert, is of such significance as to overwhelm the conceptual similarity of an enlarged X within a word in the mark. I find there is little conceptual similarity between the two.



Likelihood of confusion:

v

29. I have already found that the goods and services are identical or very similar and have found that the visual similarity is of greater importance than the aural similarity in the purchasing process. The distinctive character of a mark must be assessed by reference to the particular goods or services to which it is attached and by reference to the relevant consumer’s perception of the mark. PG’s mark as a whole is inherently distinctive and the ‘X’ has a reasonable degree of distinctive character. No evidence has been filed which persuades me that it is become more distinctive through reputation. PG’s claim that there exists a likelihood of confusion on the part of the public rests upon the X elements which are the dominant elements in each of the marks. I return to the ECJ’s judgment in *Shaker di L. Laudato*, cited above:

“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.”

In neither mark can the remainder of the components be said to be negligible. At the risk of sounding repetitive, I also return to the CFI’s judgment in *Devinlec*, where it was held that a conceptual difference may counteract visual or aural similarities provided at least one of the marks has a meaning which the public are capable of grasping immediately. The MAX mark is clearly a name, with a strap-line promoting professional-standard make-up. The application clearly conveys the conceptual message of an ‘expert in lashes’ - a eyelash expert

(bearing in mind the relevant goods are cosmetics). Seen in the context of ‘pert’, the ‘X’ in the applicant’s mark is a stand-in for the more mundane ‘ex’. I believe that there would be no likelihood of confusion on the part of the public and that the application would not even call to mind the mark of the opponent.

30. As I have found there to be no likelihood of confusion between the application and either of PG’s earlier marks upon which it founds its ground of objection under section 5(2)(b) of the Act, the opposition fails under this ground.

Passing-off: section 5(4)(a) of the Act

31. Section 5(4)(a) of the Act states:

“4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

32. The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short general proposition--no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

33. It is necessary to determine the material date in relation to the claim of passing-off. It is well established that this date is the date of the behaviour complained of. Section 5(4)(a) is derived from article 4(4)(b) of First Council Directive 89/104 of December 21, 1988 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark.”

In the absence of any indication to the contrary, the relevant date in these proceedings is 13 November 2006, the date the application was filed. PG must therefore establish that at that date it possessed goodwill in the UK, in soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for the cleaning, care and beautification of the skin, scalp and hair, agents for the body and beauty care, shampoos and other hair care products, bath preparations, dentifrices, and that a misrepresentation had taken place by the Mr Lamont which had damaged, or would be likely to damage, that goodwill.

34. The first hurdle is for PG to prove it has goodwill attached to the goods in the mind of the purchasing public by association with the 'X'. I do not consider that it has overcome that hurdle. There is no evidence of 'X' in use by itself, either in terms of turnover figures or exhibits, and where it appears within the MAX mark, the evidence is scant, or after the relevant date. I find that although there is a goodwill attached to PG's cosmetic business, as evidenced by its turnover figures, there is no evidence of a link between the sign upon which it relies under this ground and the business in which it has goodwill. The ground of objection under section 5(4)(a) of the Act fails.

Costs

35. The opposition having failed on both its sections 5(2)(b) and 5(4)(a) grounds, Mr Lamont is entitled to a contribution towards his costs. In *Adrenalin Trade Mark*, BL O/040/02, Simon Thorley QC, sitting as the appointed person, observed that:

"8 It is correct to point out that the Registrar's practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6."

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

"48.6—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative."

Consequently, the **maximum** that Mr Lamont can receive is two thirds of the scale costs. I award costs on the following basis, bearing in mind that nothing further was filed by Mr Lamont after receipt of his Form TM8 and counterstatement:

Considering the notice of opposition	£133
Statement of case in reply	£100
Total	£233

Accordingly, I order The Proctor and Gamble Company to pay to Iain Lamont the sum of £233. This sum is 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 this 5th day of August 2008

**Judi Pike
For the Registrar
the Comptroller-General**