

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 996233
IN THE NAME OF
DR ROBERTO LEGOVIC AND IVANA LEGOVIC**

IN RESPECT OF THE TRADE MARK

**ESENSA
MEDITERANA**

IN CLASSES 3, 35 AND 44

AND

**THE OPPOSITION THERETO
UNDER NO 72052
BY
FRATELLI CARLI S.P.A.**

Trade Marks Act 1994

**In the matter of
international registration no. 996233
in the name of Dr Roberto Legovic
and Ivana Legovic**

in respect of the trade mark:

**ESENSA
MEDITERANA
in classes 3, 35 and 44
and the opposition thereto
under no. 72052
by Fratelli Carli S.P.A.**

Introduction

1. Dr Roberto Legovic and Ivana Legovic (“the Legovics”) are the holders of the above international registration (“the IR”). Protection in the United Kingdom was requested on 8 December 2008 and the request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 28 August 2009.

2. Fratelli Carli S.P.A. (“the opponent”) filed notice of opposition to the granting of protection in the United Kingdom in respect of the following goods of the IR:

Class 03¹: *Antiperspirants (toiletries), cosmetic preparations for baths; beauty masks; cosmetics; cosmetic creams; dental bleaching gels; deodorants for personal use; hair lotions, lotions for cosmetic purposes; make-up preparations; beauty masks, cleansing milk for toilet purposes; nail care preparations; perfumery; shampoos; cosmetic preparations for skin and hair care; toiletries.*

3. The opponent claims that protection for these goods would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Section 5(2)(b) of the Act states:

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

....

¹ Classified according to 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.

(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.”

The opponent relies upon some of the goods of its earlier Community Trade Mark (“CTM”) 3197101, the relevant details of which are as follows:



LINEA
MEDITERRANEA

Mark:

Class 03: *Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.*

Date of filing: 23 May 2003
Date of completion of registration procedure: 28 July 2004.

4. As the earlier mark had been registered for more than five years at the date on which the IR was published, it is subject to the proof of use regulations². The opponent has made a statement of use in its notice of opposition in respect of all the goods it relies upon.

5. The Legovics filed a counterstatement, putting the opponent to proof of use of the goods upon which it relies. They deny that there would be a likelihood of confusion because the marks are not similar, claiming that the earlier trade mark contains a dominant and distinctive device element, the word LINEA, which is not similar to any word in the IR, and that trade marks containing the word MEDITERRANEAN and foreign language variations thereof are very common in

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

class 3. The Legovics claim such words are non-distinctive for the goods at issue.

6. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. Both parties filed evidence and written submissions which I bear in mind in reaching my decision.

Proof of use dates

7. The five year period ending on the date of publication of the application runs from 29 August 2004 to 28 August 2009. As the opponent has been put to proof of use of its mark for all the goods upon which it relies, the onus is on the opponent, under section 100 of the Act³, to show genuine use of its mark during this period or, alternatively, that there are proper reasons for non-use of the mark during this period.

Evidence

8. The opponent's evidence comes from Benjamin Neilus Britter who is a trade mark attorney at Keltie, the opponent's professional representatives in these proceedings. Mr Britter states that the information contained in his witness statement has come from the opponent's Italian legal representatives, ipSO Intellectual Property. There are no facts contained within Mr Britter's witness statement; it is simply a vehicle for introducing eight exhibits (BNB1-8) into the proceedings. The exhibits each consist of a copy of promotional material dated July 2004, February 2005, January 2006, November 2007, November 2008, July/August 2009 and Autumn 2009. Each exhibit is said to show use of the opponent's LINEA MEDITERRANEA trade mark in the European Union. The exhibits are all in Italian. Keltie has had some of the contents translated into English (and has filed a witness statement from the translator which meets the requirements of rule 62(1)(b) of the Trade Mark Rules 2008). The photocopies of the product brochures which have been filed are of poor quality, and it is not always possible to see what mark is shown in relation to the products highlighted by the translator. In some instances, it is clear that the mark used is LINEA MEDITERRANEA without the device element. However, I have identified the mark as registered on the following goods, together with pricing in Euros:

- July 2004 brochure (just before the relevant date) – face creams, after shave creams and gels
- February 2005 – eye cosmetics

³ "If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

- January 2006 – body oils, nail varnish, eye shadow, soap, shampoo and conditioner, wipes, body creams, hand lotions, bath/shower foam
- November 2007 – body creams and face mask
- November 2008 – hand cream, face cream
- July/August 2009 – bath/shower foam, shampoo, massage oil, soaps, deodorant
- Autumn 2009 (just after the relevant date) products as above.

9. The Legovics' evidence is in the form of a witness statement from Huw David Duncan Evans who is a trade mark attorney at Chapman Molony, the Legovics' professional representatives in these proceedings. Mr Evans states that his information is based on information available to him as a trade mark attorney (it is not clear what this means) and from correspondence with the Legovics.

10. Mr Evans exhibits a translation of ESENS(S)A MEDITERANA which are Croatian words meaning ESSENCE OF THE MEDITERRANEAN (the Legovics' address is in Croatia). Another translation is exhibited to show that LINEA MEDITERRANEA are Italian words meaning MEDITERRANEAN LINE (the opponent's address is in Italy). Mr Evans has also filed details of trade marks filed prior to the opponent's mark which contain words identical or similar to the English word MEDITERRANEAN. Finally, Mr Evans states that the opponent also opposed the Legovics' French and Spanish designations of the IR the subject of these proceedings and that the French and Spanish national trade mark offices have rejected the oppositions. Mr Evans states that the oppositions failed because ESENSA and LINEA are the only distinctive words and they have their own meaning, and because the only common elements were non-distinctive adjectives meaning of the Mediterranean (sea or region).

Decision

Proof of use

11. Section 6(A) of the Act states:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or
 - (b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12. Ms Anna Carboni, sitting as the appointed person in, *PASTICCERIA E CONFETTERIA SANT AMBROEUS S.R.L. v G&D RESTAURANT*

ASSOCIATES LIMITED, case BL O-371-09, summarised a set of principles from the following leading CJEU genuine use cases: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85; *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38 (ECJ); and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client

which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

13. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-234/06 P, the CJEU stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).

74 By stating, at paragraph 35 of the judgment under appeal, that the evidence is very limited with regard to 1994 and non-existent for the period from 1996 to 1999, the Court of First Instance did not in any way require the appellant to establish continuous use of the trade mark THE BRIDGE (No 642952) throughout the whole of the period in question. In accordance with the Court's case-law cited in paragraphs 72 and 73 of the present judgment, the Court of First Instance examined whether that trade mark had been put to genuine use during that period. To that end, the Court of First Instance assessed, at paragraphs 32 to 36 of the judgment under appeal, whether the scale and frequency of use of that mark were capable of demonstrating that it was present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign.”

The opponent's evidence suffers from several defects, notably that there is a failure to provide any indication of turnover, orders, invoices or other evidence of actual sales. However, there is no hard and fast rule as to what evidence must be filed: it is a matter of taking all relevant facts and circumstances into account. Of importance is the fact that the opponent has filed product catalogues (I consider the exhibits to be in the nature of catalogues rather than what Mr Britter refers to as promotional material) from the six consecutive years which span the relevant period for proof of use. If there had been no sales, it is highly unlikely that the opponent would have released catalogues each year. The catalogues are consistent in terms of yearly issue, product range and pricing. The catalogues and their contents demonstrate that the mark was present on the market in a manner that was effective, consistent over time and stable in terms of the configuration of the sign.

14. The market itself seems to have been solely Italian. To qualify as genuine use, use of a CTM must have taken place in the European Community (section 6A(5) of the Act refers). I note that the Fourth Board of Appeal of the Office for

Harmonization in the Internal Market (OHIM) stated in *ILG Ltd v Crunch Fitness International Inc* [2008] ETMR 17:

“11 The relevant period is October 1998 to October 2003. Use in one country of the Community, such as Italy, is sufficient (Joint Statements by the Council and the Commission entered in the Minutes of the Council meeting at which the CTMR was adopted, No.B.10, OH OHIM 1996, 607, 613), provided that is it [sic.] genuine...”

Although not in relation to genuine use, in *Pago International GmbH v Tirolmilch registrierte Genossenschaft mbH* C-301/07, the CJEU considered the issue of the territorial scope of a CTM in relation to reputation where reputation of a CTM solely in Austria was held to be sufficient for the purposes of Article 5(2)⁴. The CJEU did not define what was necessary, territorially, for a reputation to exist; it said that the mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community. Italy is a major member state of the European Union which would qualify as a substantial part of the territory of the European Union.

15. I have listed above (paragraph 8) the particular products which are in evidence: all the goods to which the opponent was put to proof of use (*soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices*) are present in that list, during the relevant five year period, except for *dentifrices*. The opponent does not have a wider term which would encompass dentifrices. The average consumer⁵ would class dentifrices as a discrete category of goods, separate from soaps, perfumery, essential oils, cosmetics and hair lotions. The use shown would not be described as dentifrices so the term cannot remain. Taking into account the average consumer's perception of the goods, a fair specification based on the use shown is *soaps, perfumery, essential oils, cosmetics, hair lotions*. The opponent can rely upon these for the opposition, but not upon dentifrices.

Section 5(2)(b)

16. The leading authorities which guide me in this ground are from the CJEU: *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*

⁴ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008.

⁵ As per *Melis Trade Mark* (Mr Hobbs as the Appointed Person, O-345-10): “In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

Klijzen 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). 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 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) 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*

f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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.*

Comparison of goods

17. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* where the CJEU stated at paragraph 23 of its judgment:

“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.”

A further factor to bear in mind is that if goods fall within the ambit of terms within the competing specification, they are considered to be identical, as stated in *Gérard Meric v OHIM*, case T-133/05, where the General Court (“GC”) stated, at paragraph 29:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

18. The respective goods of the parties to be compared are as follows:

Opponent's goods	The Legovics' goods
<i>Soaps, perfumery, essential oils, cosmetics, hair lotions.</i>	<i>Antiperspirants (toiletries), cosmetic preparations for baths; beauty masks; cosmetics; cosmetic creams; dental bleaching gels; deodorants for personal use; hair lotions, lotions for cosmetic purposes; make-up preparations; beauty masks, cleansing milk for toilet purposes; nail care preparations; perfumery; shampoos; cosmetic preparations for skin and hair care; toiletries.</i>

19. Both parties have cover for perfumery so these goods are identical. The opponent has cover for cosmetics, which are identical to the Legovics' *cosmetic preparations for baths; cosmetics; cosmetic creams; lotions for cosmetic purposes; make-up preparations; nail care preparations; cosmetic preparations for skin and hair care*. The opponent has cover for hair lotions, which are identical to the Legovics' *hair lotions* and near-identical, if not identical, to the Legovics' *shampoos*. The opponent's goods all fall within the ambit of the Legovics' term *toiletries*, so this term is also identical to the opponent's goods. The Legovics' *beauty masks* and *cleansing milk for toilet purposes* ('beauty masks' appears twice within the specification) are in the nature of skin cleansing goods. They share this nature with the opponent's *soap*, along with sharing the same purpose, users and channels of trade. The goods may be used with each other or instead of each other. Beauty masks and cleansing milk for toilet purposes are highly similar to soaps. Deodorants for personal use are a type of perfumery product, often sold as part of a range of perfumery and so the Legovics' *deodorants for personal use* are highly similar to the opponent's *perfumery*. Antiperspirants (toiletries) are also for personal use. Their principal function is to prevent body odour caused by perspiration, rather than simply masking body odour, which is the function of a deodorant without an antiperspirant element. However, the two often combine in a single product: antiperspirant deodorants are often perfumed. Antiperspirants (toiletries) share some similar characteristics to perfumery: they are frequently perfumed, they are used to perfume the underarms of the body as well as to prevent body odour and they may form part of a range of perfumed toiletries, such as after shave and soap, and so may be sold side by side with perfumery. There is a reasonable degree of similarity between the opponent's perfumery and the Legovics' *antiperspirants (toiletries)*.

20. The majority of the Legovics' goods are identical or highly similar to those of the opponent, with antiperspirants being reasonably similar to the opponent's goods. This leaves the Legovics' *dental bleaching gels*, which could serve a

cosmetic purpose in that the user wants to enhance the appearance of teeth by making them whiter. However, I think that this would be stretching too far the meaning of ‘cosmetics’ as understood by the average consumer. Cosmetics are such goods as eyeshadows, eyeliners, mascara, lipstick, foundation, blusher and nail polish. Dental bleaching gels appear to me to fall within the term dentifrices, which the opponent is unable to rely upon. As the nature, purpose and channels of trade, competitiveness and complementary nature of dental bleaching gels and cosmetics differ, there is no similarity between them.


Average consumer and the purchasing process

21. The average consumer for these goods is the general public. A reasonable level of 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. 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 also a reasonably high, but not the highest, level of attention. Those who wish to enhance their appearance are likely to make a reasonably 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, although I do not ignore the potential for oral purchase, such as over-the-counter cosmetic sales.

Comparison of trade marks

22. 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, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

23. The marks to be compared are:

Opponent’s mark	The Legovics’ mark
	<p style="text-align: center;">ESENSA MEDITERANA</p>

24. The first of the two words comprising the Legovics' mark, ESENSA, is not an English dictionary word. The second, MEDITERANA, is also not an English dictionary word, although it bears an obvious resemblance to the English word *Mediterranean*. The first word, ESENSA, appears invented (I say more about this below), and although the second word is longer, and is not actually an English dictionary word, it is strongly reminiscent of the English word *Mediterranean*. ESENSA is the more dominant and distinctive of the two elements as it appears at the top of the mark and is invented.

25. The opponent's mark is the more complex mark of the two parties' marks. Like the Legovics' mark, it contains a word strongly reminiscent of *Mediterranean*. This word is a large feature of the mark. The other word, LINEA is not an English dictionary word; it is a distinctive element but it is proportionately quite small compared to the other elements of the mark, although not so small as to be negligible. The device element takes up a sizeable proportion of the mark as a whole. It is an invented, distinctive device, appearing as a 'stick' person, with branches growing from the arms. The device is both a dominant and distinctive element of the opponent's mark. Although MEDITERANEA is a large feature of the mark, it is less distinctive than the device because of its connection to the dictionary word *Mediterranean*, as in the Legovics' mark. The dominant and distinctive element of the opponent's mark is the device.

26. There is only one element of each of the parties' marks which shares a likeness visually and aurally: MEDITERANEA and MEDITERANA. The difference between the spelling (the double R and the penultimate E in the opponent's mark) makes little difference visually or aurally in words of this length, particularly because of the strong resemblance to the English word *Mediterranean*, which the English-speaking average consumer will regard as reminiscent of the words in the marks. The device is striking and is entirely absent from the Legovics' mark. The remaining two words, LINEA and ESENSA, are not at all alike. Weighing the differences between the marks against the similar and large word elements MEDITERANEA/MEDITERANA there is a low degree of visual similarity between them. Aurally, the device does not come into play; however, there is a reasonable degree of aural similarity since half of each mark is very similar when heard.

27. According to Mr Evans' evidence, the Legovics' mark mean Essence of the Mediterranean in Croatian, whilst the opponent's mark means Mediterranean Line. The average consumer in the UK is unlikely to be aware that ESENSA MEDITERANA are Croatian words and unlikely to understand the translated meaning of the opponent's mark⁶. However, it is more than likely that the

⁶ As per the comments of Ms Amanda Michaels, sitting as the Appointed Person, in *Toppy Trademarks Limited v Cofra Holding AG*, BL O/092/11: "25. What the Hearing Officer had to consider was how the mark would be perceived by the average UK consumer. Whilst of course there are many persons whose mother tongue is not English who live and work in the UK, such

MEDITERRANEA/MEDITERANA elements will be understood as a variant or foreign spelling of the English word *Mediterranean*. The other words will be regarded as invented or unknown foreign words. As far as conceptual similarity between the marks is concerned, both marks share the concept of a reference to the Mediterranean (either as a sea or a European region), without the other words contributing a meaning, particularly in the opponent's case as the word LINEA is so small compared to MEDITERRANEA. The device of a person/tree does not have any impact on the meaning (or lack of meaning) of any of the words. The level of conceptual similarity between the marks is of a reasonable degree, and the overall level of similarity is low to reasonable.

Distinctiveness of the opponent's mark

28. It is necessary to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁷. The distinctive character of a trade mark must be assessed by reference to the goods in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁸. Although the opponent's use was sufficient for it to satisfy the proof of use burden, it falls far short of showing that it is entitled to claim an enhanced degree of distinctive character. I have, therefore, only its inherent distinctive character to consider. In relation to the goods, the device and LINEA element have no meaning. These are distinctive elements. MEDITERRANEA is strongly evocative of the word *Mediterranean*. For personal care products, cosmetics and toiletries, there is a suggestion of a characteristic of the goods in that they are Mediterranean in some respect, be it in terms of ingredients or sourcing. It is fair to say that it comprises the least distinctive element of each mark, LINEA, ESENSA and the device being the more distinctive elements. Viewing the earlier mark as a whole, it has a good degree of distinctive character.

Likelihood of confusion

29. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The majority of the goods of the parties are identical or highly similar; antiperspirants in the IR are reasonably similar to the opponent's goods. I keep in mind the comparison of the marks as wholes. I have found the marks to be similar to a low to reasonable degree, the opponent's mark to be

persons are not the average UK consumer for the purposes of considering the pronunciation or meaning of a word."

⁷ *Sabel BV v Puma AG* [1998] RPC 199.

⁸ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

distinctive to a good degree (the distinctiveness stemming from the device) and the purchasing process to be predominantly visual and reasonably attentive. The only similarity between the marks comes from the MEDITERRANEA/MEDITERANA elements. These elements are suggestive of the Mediterranean and play the least distinctive role of the marks, both of which are complex marks. I bear in mind that 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,⁹ but that the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. The parties' marks are not dominated by the common element. I bear in mind that, even if the similar elements between two marks are relatively low in distinctive character, this does not rule out a likelihood of confusion¹⁰, but that the assessment is a global one, based on several factors. In this case, there is a large visual difference between the marks and the visual comparison is the primary one based upon the purchasing act, which is reasonably considered.

30. Balancing all these factors together, I have come to the conclusion that the overall difference between the marks will not lead to a likelihood of confusion. The other words in the mark will both appear as invented words, both positioned above the similar, 'Mediterranean-like', element. The differences between the marks will outweigh the part which the Mediterranean element plays in the perception of the marks, even in relation to identical goods. The opposition fails.

Costs

31. The Legovics have been successful and are entitled to an award of costs¹¹. I have not made an award in relation to the submissions filed with their evidence because they repeat the contents of the counterstatement and are extremely brief.

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the other side's evidence	£500
Total:	£700

32. I order Fratelli Carli S.P.A. to pay to Dr Roberto Legovic and Ivana Legovic the sum of £700. 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.

⁹ *Shaker di Laudato*

¹⁰ *Air Products and Chemicals v OHIM*, Joined Cases T – 305/06 to T 307/06.

¹¹ As per the scale in Tribunal Practice Notice 4/2007.

Dated this 4th day of October 2011

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