

O-430-16

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1020177

IN THE NAME OF L'OREAL

AND APPLICATION TO EXTEND PROTECTION IN THE UK

TO THE TRADE MARK:

INOA

IN CLASS 3

AND

OPPOSITION THERETO UNDER NO. 72221

BY COSMETICA CABINAS S.L.

BACKGROUND

1. On 27 August 2010, L'OREAL (the applicant), requested protection in the United Kingdom of the International Registration (IR) No. 1020177 for the mark **INOA** in respect of the following goods:

Class 3

Shampoos; cosmetic hair products namely gels, mousses, balms, creams, waxes, serums, lotions; hair care and hair styling products in the form of aerosols; hair sprays; hair dyes and bleaching products; hair waving and curling products; essential oils.

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection and particulars of the IR were published for opposition purposes on 12 November 2010.

3. On 7 January 2011 the designation of the IR was opposed by Cosmetica Cabinas S.L. (the opponent). The opposition, which is based upon section 5(2)(b) of Trade Marks Act 1994 (the Act), is directed against all of the goods in the IR. The opponent argues that the respective goods are identical or highly similar and that the marks are similar. The opponent relies upon its European Union Trade Mark (EUTM) registration no. 2720811 for the mark AINHOA, which has a filing date of 3 June 2002 and for which the registration procedure was completed on 9 September 2003. The opponent relies upon *Cosmetic products* in class 3.

4. The applicant filed a counterstatement denying that there is any similarity between the respective marks or the respective goods. It also requested that the opponent provides proof of use of its mark for the goods relied upon.

5. Both parties filed evidence during the evidence rounds. I have read all the papers carefully but I will only summarise the evidence to the extent that I consider necessary. Neither party asked to be heard, but they both filed written submissions

in lieu of attendance at a hearing. I will bear both parties' comments in mind and refer to them as necessary below.

Applicant's evidence

6. This consists of a witness statement from Rachel Wilkinson-Duffy of Baker & McKenzie LLP who represents the applicant in these proceedings, with three exhibits (RWD1-RWD3). RDW1 consists of print-outs from Wikipedia and www.sheknows.com indicating that Ainhoa is a Basque female name. RDW2 consists of a print-out from www.euskoguide.com which confirms that Ainhoa is a village in the French Basque Country. RDW3 shows the results of a trade mark search from the European Union Intellectual Property Office's (EUIPO) website for marks ending with the suffix '-OA' and registered (or applied for) in class 3.

DECISION

7. Section 5(2)(b) of the Act reads:

"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."

8. An earlier trade mark is defined in Section 6(1) of the Act, which states:

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

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

9. Of potential relevance are the “proof of use” requirements, also set out in Section 6A of the Act:

“Raising of relative grounds in opposition proceedings in case of non-use

6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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.

.....

(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.”

10. In these proceedings, the opponent is relying upon the mark shown in paragraph 3, which qualifies as an earlier mark in accordance with Section 6 of the Act. As this mark completed its registration process more than five years before the publication date of the IR in suit, it is subject to the proof of use provisions, but for procedural economy, it is sufficient that I continue based upon the assumption that the opponent has shown use in respect of the goods it relies upon. I will return to this point further below.

Section 5(2)(b) - case-law

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:

- (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 greater 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. For reasons of procedural economy, I will not undertake a full comparison of the goods listed above. Some of the contested goods, i.e. *cosmetic hair products namely gels, mousses, balms, creams, waxes, serums, lotions* are identical to the goods on which the opposition is based but I will proceed on the basis that all of the contested goods are identical to those covered by the earlier trade mark. If the opposition fails, even where the goods are identical, it follows that the opposition will also fail where the goods are only similar.

The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The

words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

14. The parties’ goods are, broadly speaking, hair care products (cosmetic or otherwise), essential oils and cosmetic products. The goods are used as part of a person’s personal care regime, e.g. shampoo, or for the purpose of improving a person’s appearance¹, e.g. cosmetics, or because of their scent², e.g. essential oils. In its counterstatement, the applicant states that its goods are “only used and sold in professional hair salons” whereas the opponent’s goods are mainly sold in beauty centres. However, neither the applicant’s nor the opponent’s specification limits the methods by which the respective goods are likely to be marketed and both sets of goods are available in either beauty and hair salons or specialist body care chains, chemists and supermarkets. In any event, even if the applicant does not sell directly to the public, notional and fair use of the respective marks would include use aimed at both the general public and professionals of the sector concerned, such as hairdressers or beauticians. Accordingly, the average consumer of the respective goods is likely to be the general public and/or a professional, but the end users would include members of the general public. In this connection, I note that the perception of the consumers and end users normally play a decisive role³. As to the level of attention paid during the selection process, in *CareAbout GmbH v OHIM*, case T-356/14⁴ the General Court (GC) stated:

“21. As regards the goods in Class 3, it must be held that they are everyday consumer goods aimed at the general public, but also at professionals in the sector, namely, hairdressers, in particular. [...]

22. As regards the level of attention of the relevant public, the Board of Appeal found, without being challenged on this point, that it would be average.

¹ Oxford English Dictionary defines “cosmetics” as “a preparation applied to the body, especially the face, to improve its appearance”.

² Oxford English Dictionary defines “essential oil” as “a natural oil typically obtained by distillation and having the characteristic odour of the plant or other source from which it is extracted”.

³ *Björnekulla Fruktindustrier AB v Procordia Food AB*, case C-371/02

⁴ See also *Giovanni Cosmetics, Inc. v OHIM*, case T-559/13, where the GC held that the relevant public’s level of attention when purchasing cosmetic preparations involved a degree of reflection relating to consumers’ personal preferences or skin type.

23. In that regard, it must be held that while it is true that the average consumer, as a general rule, pays less attention to everyday consumer goods, that level of attention would not however be less than average when faced with the goods that this case concerns, namely hair care and skin care goods, because certain aesthetic considerations or consumers' personal preferences, their sensitivities or their hair or skin type may play a role in the purchase of those goods. Therefore, the Board of Appeal was correct to hold that the level of attention of the relevant public would be average.

24. As regards professionals [...], who also form part of the relevant public, it must however be noted that their level of attention would as a general rule be higher than average.

25. It follows from the foregoing that the definition provided by Board of Appeal of the relevant public and its level of attention was imprecise. Nevertheless, it was open to the Board of Appeal to base its decision upon the Spanish general public with an average level of attention only, since, as regards the assessment of the likelihood of confusion, the part of the relevant public with the lowest level of attention must be taken into account unless that part of the public must be regarded as insignificant (see, to that effect, judgment of 15 February 2011 in *Yorma's v OHIM — Norma Lebensmittelfilialbetrieb (YORMA'S)*, T-213/09, EU:T:2011:37, paragraph 25), which is not so in the present case and has not been argued by the applicant.”

15. Accordingly, the level of attention of the general public when purchasing the parties' goods will be, at least, average and it will be sufficient to ensure that the correct product is selected, taking into account factors such as ingredients, scent, properties and appropriateness for the consumer's skin and hair type. To the extent that it is necessary to take account of the views of professionals, as both customers and retailers of the goods, they are likely to pay more attention than the general public to ensure that the purchase of the goods meets their business' needs.

16. In relation to the issue of how the goods will be selected, the opponent made no submissions. The applicant states in its counterstatement:

“7..For the goods in question (namely hair care products and cosmetic products), the consumer is accustomed to purchasing the Applicant’s hair care products in hair salons (where products will be on display) and cosmetic products are usually chosen by consumers off the shelf or on-line, such that the visual impact of the marks is more important to the public than the aural impression of the marks. [...]”.

17. In *Mülhens GmbH & Co. KG v OHIM*, case T-355/02, the GC rejected the applicant’s argument that for the goods at issue, which included cosmetics, essential oils and hair care products, aural considerations were relevant on the basis that goods sold through hair dressing and beauty salons were not visible to customers. The Court stated:

“53 [...] The applicant has entirely failed to demonstrate that its goods are usually sold in such a way that the public does not visually perceive the mark. The applicant merely submits that one traditional sales channel is through perfumeries and hairdressing and beauty salons, such that the consumer cannot select the product directly but only via a seller.

54. Even if perfumeries and hairdressing and beauty salons are important channels for the sale of the applicant’s goods, it is not in dispute that, even in those places, the goods are generally displayed on shelves in such a way that consumers are able to examine them visually. Therefore, even if it is not excluded that the goods in question may also be sold in response to an oral order, that method cannot be regarded as the usual method of sale of those goods.”

18. Accordingly, the general public’s purchase of the parties’ goods is overwhelmingly a visual purchase whether in hair salons, beauty salons or physical retail environments and the opponent has not submitted any argument to the contrary. Turning to the position where a business user is involved, professionals are

likely to encounter the mark in catalogues or to select the goods after discussion with the distributor and/or manufacturer's sales representatives; the selection of the goods may also involve demonstrations as to how products should be applied/used. Consequently, for this group of consumers, the selection process is likely to consist of a mixture of visual and aural considerations.

Distinctive character of earlier mark

19. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, the Court of Justice of the European Union (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).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

20. The opponent's earlier mark consists of the single word AINHOA. It appears to be an invented word with no meaning and, as such, is endowed with a high level of inherent distinctive character⁵.

Comparison of marks

21. 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 them, bearing in mind their distinctive and dominant components. The CJEU 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.”

22. It would be wrong therefore artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features, (which are not negligible) and therefore contribute to the overall impressions created by them. The marks to be compared are as follows:

⁵ Whilst the opponent has provided evidence of use of its mark (which, as I will explain below, I do not need to assess for the purpose of determining whether the earlier mark has been put to genuine use), it has not pleaded that the mark has acquired an enhanced distinctive character. However, even if it had, I would have found that the use shown is all use outside the UK and therefore it cannot demonstrate that the mark has acquired an enhanced level of distinctive character through use in the UK.

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23. The opponent's mark consists of the word AINHOA presented in a plain upper-case font. No part is highlighted or emphasised in any way and the overall impression the mark creates stems from the word itself.

24. The applicant's mark consist of the word **INOA** presented in upper-case and in a bold typeface. The overall impression the mark will convey is that of a single word and its distinctiveness lies in its totality.

Visual similarity

25. In its statement of grounds, the opponent merely claims that the marks are "phonetically and visually similar". However, in its written submissions it does not refer to the marks being visually similar. It states:

"Again for reasons of economy, the Opponent sees no reason to provide further detailed arguments as to the similarity of the marks, save to say that the respective marks are phonetically identical and there is (please see below for further details) no conceptual difference between the marks for the average UK consumer to counteract that strong phonetic similarity."

26. The applicant states in its counterstatement:

"6. The Opponent claims that the marks are visually similar, but this is not substantiated by the Opponent. It is denied that the Applicant's mark is visually similar to the Opponent's Mark. Visually the marks are quite different. The Applicant's Mark consists of four letters. The Opponent's Mark consists of six letters and is therefore significantly longer than the Applicant's Mark, creating a different overall visual impression on the consumer when viewing the mark. Furthermore, the marks differ in their beginning: the Applicant's Mark starts with "I" and the Opponent's Mark starts with the letter "A", which is therefore likely to be the element of the mark which makes the biggest

impression on the relevant public, who will read the words from left to right. It is commonly recognised that more weight tends to be attributed by the public to the beginning of a sign (*T-418/03 La Mer Technology, Inc. v OHIM and T-109/07 L’Oreal v OHIM*). In addition, the presence of the “H” in the central position in the Opponent’s mark separates the “N” and from the “OA” ending, again giving the marks a different overall impression and further distinguishing the marks visually. Furthermore, the Applicant submits that the suffix “OA” is common. By way of example, there are a number of other marks registered as Community or UK trade marks which contain the suffix “OA” and which are registered for goods in class 3: MILOA, ALHOA, ARSOA and CHENOA. ”

27. As a preliminary point, the applicant’s submission and evidence intended to establish that the suffix ‘-OA’ is commonly used in relation to class 3 goods are not pertinent. In relation to what is often called ‘state of the register evidence’ it is a well-established principle that the real test is not what marks are on the UK or EUIPO registers but what marks are in use⁶. It is not immediately obvious that the relevant audience has been educated to accord the suffix ‘-OA’ less weight as a result of the frequency with which they encounter it in class 3 products. On that basis it must be given due weight within the totality of the respective marks.

28. Considered from a visual perspective, the competing marks are of different length; they consist of six and four characters respectively. The presence of the letter ‘A’ at the beginning and the letter ‘H’ in middle of the opponent’s mark have no counterpart in the applicant’s mark and make it look much longer. The first two letters of the respective marks are very different. The letter ‘A’ in the opponent’s mark is formed by two inclined straight lines cut by a small horizontal stroke and looks significantly bigger than the straight line of the letter ‘I’ in the applicant’s mark. Whilst the marks coincide in the terminating element ‘-OA’ and share the same string of letters ‘IN’, the latter does not appear in the same order or position and is followed by different letters. In the opponent’s mark ‘IN’ is embedded in the second and third letter position and it is followed by the letter ‘H’; in the applicant’s mark ‘IN’ occupies the first and second letter position and is followed by the letter ‘O’. Given

⁶ *Zero Industry Srl v OHIM*, case T-400/06

that the competing marks are relatively short, that the beginning of the marks are different⁷ (which I accept are both rules of thumbs, albeit operative ones in this case) and that the marks are of different lengths, in my view, these differences make a striking impression and the marks share only a very low degree of visual similarity overall.

Aural similarity

29. As far as the aural comparison of the mark is concerned, the opponent merely states that the competing marks are “almost phonetically identical” but make no submissions as to how the marks will be articulated. The applicant states in its submissions:

“The words “AINHOA” and “INOA” have very different phonetic impressions. The word “AINHOA” is pronounced “AYE-NO-A” with an emphasis on the “AYE” element. The word “INOA” is pronounced in the much more punchy and abrupt manner “IN-OH-A” with emphasis is placed on the “OH” element.”

30. There is no evidence that the UK average consumer is likely to be familiar with the mark AINHOA, thus, the word will be pronounced according to rules of the English language. In my view, the opponent’s mark is likely to be pronounced as ‘EYN (like in the word ‘rain’)-H-OA’, or alternatively, as ‘EYN-OA’ (with the ‘H’ silent). The applicant’s mark INOA is most likely to be pronounced as ‘IN (like in the preposition ‘in’) –OA’. The aural differences between the marks are therefore less striking than the visual differences and there is in my view a medium degree of aural similarity.

Conceptual similarity

31. As regards the conceptual comparison, the applicant highlighted that the word ‘AINHOA’ is a female first name commonly used in the Basque Country and is also the name of a small town in the Basque country in France. It also submitted that the word ‘INOA’ is devoid of any meaning although (apparently) it stands for Innovation

⁷ *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, joined cases T-183/02 and T-184/02

No Ammonia, an acronym used to describe a key features of its products, i.e. they contain no ammonium. The fact that the word 'AINHOA' corresponds to a female name or to a geographical location of the Basque region cannot, as noted by the opponent, lead to the conclusion that the UK average consumer would be aware of these meanings and there is no evidence to prove otherwise. Consequently, the UK average consumer will perceive the word 'AINHOA' as an invented word. As to the meaning of the word 'INOA', the applicant's argument presupposes that the relevant public recognises that abbreviation. However, I note that the letters 'INOA' in the mark are not explained, for example, by listing the words for which they are meant to be an acronym. As the mark is simply **INOA** the UK average consumer (whether the general public or a professional) will not be in a position to decrypt its meaning as an abbreviation and will perceive it as an invented word. As both marks will be perceived as invented words with no meaning the conceptual position is neutral.

Likelihood of confusion

32. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

33. Earlier in my decision I proceeded on the assumption that the respective goods are identical. I have made observations on the average consumers, namely that it is likely to include both members of the general public and professionals in the concerned sectors. I have found that for the general public, the level of attention will be, at least, average and the selection of the parties' goods is overwhelmingly a visual selection (although aural considerations cannot be completely ignored they are of less importance as the usual method of purchase is visual). For the professional customer aural considerations must also be taken into account, but the level of attention will be higher than average. Finally, I have found that the

opponent's mark is endowed with a high degree of distinctive character and that the competing marks are visually similar to a very low degree and aurally similar to a medium degree while the conceptual position is neutral.

34. The crux of the matter rests, in my view, on the marks themselves which must be considered in totality, without artificial dismemberment. The similarity between the competing marks stems from the presence in the applicant's mark of the strings of letters 'IN' and 'OA' which are common to the opponent's mark. I have already stated that in word signs, the first part is generally the one that primarily catches the consumer's attention and that in short words, such as these, the removal of two sizeable letters, one at the beginning and one in the middle of the mark will not go unnoticed. The effect of this is, in my view, that the average consumer is unlikely to see the word/mark 'AINHOA' when encountering the applicant's mark **INOA**. To find otherwise would be to suggest an artificial process of analysis and dismemberment which average consumers will not likely adopt.

35. Even proceeding on the assumption that goods are identical and making due allowances for the highly distinctive character of the opponent's mark and for the average consumer's imperfect recollection, my conclusion is that, when at least an average degree of attention is deployed, the visual differences between the marks are as such that there is no likelihood of direct confusion (one mark being mistaken for the other). It is true that from an aural perspective the degree of similarity is more significant but, as I have found, the goods are usually sold in such a way that the consumers are able to examine them visually so aural considerations are less important. Whilst, for professional users, aural considerations must also be taken into account, this is counterbalanced by the fact that they are likely to pay more attention than the general public and are therefore, if anything, less likely to be confused by use of the applicant's mark.

36. As to whether there is nevertheless a likelihood of indirect confusion, on this matter, it is helpful to consider the comments of Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, case BL-O/375/10 where he stated:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

37. The circumstances of the case before me do not fall within any of the three categories identified by Mr Purvis. Whilst I bear in mind that these categories are illustrative rather than exhaustive, I also cannot see, nor have I been directed to, any other manner in which the marks are likely to be indirectly confused.

38. As the opponent's 'best case' on the basis of the closest goods fails, I extend this finding to all of the other goods. The opposition fails in its entirety.

39. As the outcome is no likelihood of confusion, there is no need to consider the question of whether or not the earlier trade mark has been used (paragraph 10 refers) as it is irrelevant to the outcome as is the need to conduct a full comparison of the respective goods.

CONCLUSION

40. The opposition has failed.

COSTS

41. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 4 of 2007. I award costs to the applicant on the following basis:

Preparing a statement and considering the other side's statement:	£ 200
Preparing evidence and consider other side' evidence:	£ 400
Preparing submissions:	£ 200
Total:	£ 800

42. I order Cosmetica Cabinas S.L. to pay L'OREAL the sum of £ 800 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 9th day of September 2016

Teresa Perks

**For the Registrar
The Comptroller – General**