

O-560-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3137658 BY
CHUTRARAM NEMARAMJI GEHLOT
TO REGISTER:**

K-AVERI

AS A TRADE MARK IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406193 BY LAVERANA GMBH & CO. KG**

BACKGROUND & PLEADINGS

1. On 24 November 2015, Mr. Chutraram Nemaramji Gehlot (“the applicant”) applied to register the trade mark shown on the cover page of this decision for the following goods in class 3:

Henna powder; Henna cone; Henna based hair dye; Henna oil; Hair colouring preparations; hair conditioners; Black henna.

The application was published for opposition purposes on 4 December 2015.

2. The application is opposed by Laverana GmbH & Co. KG (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon the goods (shown below) in the following European Union Trade Mark (“EUTM”):

No. 4098679 for the trade mark: **Lavera** which was applied for on 29 October 2004 and entered in the register on 25 February 2008:

Class 3 - Cosmetics, decorative cosmetics; face creams and lotions; skin-cleansing lotions and creams, hand and body lotions and creams; tinted moisturising creams, make-up, foundation, face powder and rouge; lipstick, lip pencils, eyeliner pens and mascara, eyeshadow; body care products, shower gels, hair care products; shampoos and hair lotions, conditioning rinses (conditioners), combined shampoo and conditioner, hair sprays, gels, skin oils.

In its Notice of opposition, the opponent states:

“8. The respective marks share the letters –AVER-. The prefix letters of the respective marks, K and L are visually similar. The suffix letters of the respective marks (I and A) may have a similar pronunciation...The stylisation of the mark subject of the opposed application is insufficient to detract from the similarity.”

The opponent further argues that the competing goods are identical and/or similar.

3. The applicant filed a counterstatement in which the basis of the opposition is denied. He states:

“3. The applicant denies the opponent’s claim that the marks under comparison are similar. The marks differ both aurally and visually.

4. The marks begin with different letters and end with different letters...

5. Visually, there is no similarity between the letters “L” and “K” and the relevant consumers will easily notice the difference. The fact that the marks begin with such obviously different letters is significant as it is established case law that consumers generally tend to focus on the first part of a sign when confronted by a trade mark. This is because the public reads from left to right and the element on the left will catch the eye first. Therefore, the very different first letters will not go unnoticed. Visually, the letters “a” and “i” also look completely different. In addition, the applicant’s mark is presented in a distinctly stylised form. Visually the marks are different.

6. Aurally, the letters “L” and “K” also sound very different. The letter “L” at the beginning of a word is pronounced softly whereas the letter “K” has a harder pronunciation. The endings of the marks are also pronounced differently. The letter “i” at the end of Kaveri will be pronounced [i:] whereas the “a” at the end of Lavera is pronounced [a]. Therefore, aurally, the marks are different.

7. In the English language neither mark has a meaning so cannot be compared conceptually.”

The applicant denies the competing goods are identical and/or similar, reserving his position until the opponent’s evidence has been filed.

4. In these proceedings, the opponent is represented by Kilburn & Strode LLP and the applicant by Novagraaf UK. Although only the opponent filed evidence, the applicant filed written submissions during the course of the evidence rounds. Whilst no hearing was sought, the opponent filed submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, below.

The opponent's evidence

5. This consists of a witness statement (accompanied by thirty five exhibits) from Thomas Haase, the opponent's Managing Partner. Although I have read this evidence, for reasons which will shortly become clear, I do not need to summarise it here.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above which qualifies as an earlier trade mark under the above provisions. As this trade mark had been registered for more than five years at the date when the application was published, it is subject to proof of use, as per section 6A of the Act. In its Notice of opposition, the opponent indicated that its earlier trade mark had been used upon all the goods upon which it relies, and in its counterstatement, the applicant asked the opponent to make good this claim.

9. It is at this point in my decision that I would normally assess the opponent’s evidence to determine whether it had used its earlier trade mark and, if so, where and upon which goods. Submissions in relation to this issue were received from both parties. However, for reasons which will become clear later in this decision, I intend to proceed on the basis most favourable to the opponent i.e. that it has used its earlier trade mark upon all the goods upon which it relies.

Section 5(2)(b) – case law

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales*

Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. Once again, I intend to proceed on the basis most favourable to the opponent i.e. that the competing goods are identical.

The average consumer and the nature of the purchasing act

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer 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.”

13. The opponent submits that the average consumer of the goods at issue is a member of the general public; I agree. The opponent further submits that as such goods typically, will be self-selected from the shelves of a retail outlet on the high street (such as a pharmacy or supermarket) or from the pages of a website, the selection process “would be primarily visual”. Once again I agree, as I do with the opponent’s submissions to the effect that as such goods may also be the subject of, for example, word-of-mouth recommendations and enquiries to sales assistants, aural considerations must be kept in mind. Although the goods are unlikely to be terribly expensive, as they are for use on the person and, broadly speaking, for the average consumer’s beautification, once again I agree with the opponent that one would expect an average degree of attention to be paid during the selection process. However, as before, I intend to proceed on the basis most favourable to the opponent i.e. that the average consumer will pay only a low degree of attention, thus making them more prone to the effects of imperfect recollection.


Comparison of trade marks

14. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

The Court of Justice of the European Union (“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.”

15. It would be wrong, therefore, artificially to dissect the trade 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 they create. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
Lavera	

16. The opponent’s trade mark consists of a single word presented in normal typeface in title case. That is the overall impression it will convey and where its distinctiveness lies.

17. Although presented in a slightly stylised bold font in which the letters are presented in varying sizes and in which the letters “K” and “A” are attached to one another as are the letters “V”, “E”, “R” and “I” (the latter of which may, given the presence of a tittle, be construed as a lower case letter “i”), the overall impression conveyed by the applicant’s trade mark is still that of a single word; that is also where its distinctiveness lies.

18. In its submissions, the opponent states, inter alia:

“18. The text element “-aver” of the earlier mark Lavera is fully contained within the opposed mark. The letter L and K, particularly in the stylised form of the opposed mark, share a visual similarity due to a similar structure between the respective letters. The prefix element KAVER- and Laver- are visually similar, particularly with the enlarged letter K in the opposed mark. The suffix letter I and A respectively do not contribute to a significant visual difference, with any visual differences created by the respective letters being lost as it features at the end of the mark...The visual impact is dominated by the shared letters, combined with the similar structure to the letters L and K respectively...It is submitted that the opponent’s mark and the opposed mark are visually very similar.

19. The respective marks have a similar rhythm and intonation due to the number of shared letters – AVER. The suffix letters I and A respectively have close phonetic pronunciation. Although the prefix letters K and L respectively do have distinction, the differences are insufficient to render the mark significantly phonetically distinguishable from the opponent’s earlier mark. The different prefix letters and any phonetic variation that results may be lost on a consumer due to the same pronunciation of the central letters of the mark – AVER, the highly similar pronounced I and A suffix letters, and the tendency by some consumers to tail off at the end of a word thereby reducing any negligible impact of the different suffix letters. It is submitted that the opponent’s mark and the opposed mark are aurally very similar.”

19. Both trade marks consist of six letters and share the letters “a-v-e-r-”/“A-V-E-R” in the second to fifth letter positions. The first letters i.e. “L” and “K” differ as do the sixth letters “A” and “I/i”. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court (“GC”) noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.”

20. Although the competing trade marks share the letters “a-v-e-r”/“A-V-E-R”, their positioning in the competing trade marks is, in my view, important. Appearing as they do in the second to fifth letter positions, the visual impact they will make on the average consumer will be significantly less than if they were the first five letters of the trade marks at issue. In addition, I agree with the applicant that the first letters of the competing trade marks i.e. “L” and “K” are visually quite different and will not go unnoticed by the average consumer. While I also agree with the applicant that the letters “A” and “I/” are visually quite different, this is of somewhat less significance

because as the opponent points out, these letters appear at the end of the competing trade marks. Finally, although the applicant's trade mark is only slightly stylised, it nonetheless creates a further point of visual difference. Considered overall, there is, in my view, a very low degree of visual similarity between the trade marks at issue.

21. When considered from an aural perspective, both trade marks consist of three syllables i.e. La-ve-ra and KA-VE-RI. While a number of pronunciations are possible, the most likely, in my view, are La (as in the Italian definite article) and vera (as in the girl's forename) and KAV (as in the surname Cavendish) and ERI (as in airy). Having noted that the opponent accepts that "the prefix letters K and L respectively do have distinction", I agree with the applicant that the differing initial letters "sound very different". This significant aural difference created by the differing initial letters combined with the aural difference in the final letters (albeit in relation to the latter I accept a less significant aural difference), results, in my view, in a low degree of aural similarity overall.

22. The parties submit that a conceptual comparison is not relevant; I agree.

Distinctive character of the earlier trade mark

23. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

24. As far as I am aware, the opponent's earlier trade mark consists of a coined word; it follows that it is possessed of a high degree of inherent distinctive character. However, as before, I intend to proceed on the basis most favourable to the opponent i.e. that the use it has made of its earlier trade mark in the United Kingdom since at least 2011 has improved its position still further, with the consequence that by the date of the application in November 2015, it was possessed of the highest degree of distinctive character.

Likelihood of confusion

25. 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. 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 trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. In its submissions, the opponent states:

“27...It is likely that direct confusion would apply here given the striking similarity between the marks and the identity/similarity between the respective goods. Indirect confusion is also possible. The shared letters and other similarities, in terms of mark length and general structure, would lead the average consumer to make a connection between the applicant and the opponent which would result in a belief that the goods are being provided by an economically linked undertaking.”

26. Earlier in this decision, I indicated that, where appropriate, I intended to proceed on the basis most favourable to the opponent i.e. (i) it had used its earlier trade upon all the

goods upon which it relies, (ii) the competing goods are identical, (iii) the average consumer is a member of the general public paying a low degree of attention to the selection of the goods at issue and (iv) its earlier trade mark is possessed of a high degree of inherent distinctive character which had been enhanced through use.

27. In reaching a conclusion, I begin by reminding myself that the conceptual position is neutral and so the average consumer has no conceptual hook to assist his recollection of the competing trade marks. Notwithstanding that point and keeping firmly in mind all the points I have notionally determined in the opponent's favour, I am satisfied that the significant visual differences between the competing trade marks mentioned above (which the opponent agrees is the primary method by which the goods will be selected), combined with the low degree of aural similarity, is more than sufficient to neutralise any superficial visual and aural similarities resulting from the competing trade marks sharing the letters "a-v-e-r"/"A-V-E-R" in the second to fifth letter positions. There is, in my view, no likelihood of either direct or indirect confusion and the opposition fails accordingly.

Conclusion

28. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

29. As the applicant has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Bearing the guidance in that TPN in mind, I award costs to the applicant on the following basis:

Considering the Notice of opposition and £300
filing a counterstatement;

Considering the opponent's evidence: £600

Written submissions (including commenting upon the opponent's evidence): £300

Total: £1200

30. I order Laverana GmbH & Co. KG to pay to Mr. Chutraram Nemaramji Gehlot the sum of **£1200**. 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 28th day of November 2016

C J BOWEN

For the Registrar

The Comptroller-General