

O-124-18

3204242

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3204242 BY
UK MOSCANY CO., LTD**

TO REGISTER THE TRADE MARK:

MOSCANY

FOR GOODS IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION TO ITS REGISTRATION
UNDER NO. 409068
BY
TOSKANI, S.L.**

Background

1) On 28 December 2016 UK MOSCANY CO., LTD (“the Applicant”) applied to register the following trade mark:

MOSCANY

The application was published for opposition purposes on 20 January 2017. Registration is sought for the following goods:

Class 3: *Lipsticks; Cotton sticks for cosmetic purposes; Beauty masks; Nail polish; Eyelashes (Cosmetic preparations for –); Cotton wool for cosmetic purposes; Make-up removing preparations; Make-up; Skin care (Cosmetic preparations for –); Lotions (Tissues impregnated with cosmetic –).*

2) The application is opposed by TOSKANI, S.L. (“the Opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies on European Union trade mark no. 8753394 for the following mark (“the earlier mark”), for which the colours green, grey, black and white are claimed :



TOSKANI

3) The following goods of the earlier mark's specification are relied on for the purposes of this opposition:

Class 3: *cosmetics, hair lotions; cosmetic preparations for skin care.*

The earlier mark was filed on 14 December 2009 and registered on 27 May 2010. The significance of these dates is that (1) the Opponent's mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is subject to the proof of use conditions contained in section 6A of the Act, its registration process having been completed more than five years before the publication of the Applicant's mark. The period during which use must be proved ("the relevant period") is 21 January 2012 to 20 January 2017.

4) The Opponent is represented by Kilburn & Strode LLP. The Applicant is represented by The Trade Marks Bureau. The Opponent claims that the mark applied for is similar to the earlier mark, that their respective goods are identical or highly similar, and that there consequently exists a likelihood of confusion within the meaning of Section 5(2)(b) of the Act. The Applicant filed a notice of defence and counterstatement, contending that the phonetic and visual differences between the opposed mark and the earlier mark will allow the relevant consumer to make a clear distinction between the marks and to avoid any likelihood of confusion. Both parties filed evidence. Neither side requested a hearing and both filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

The Evidence

The Opponent's Evidence

5) The Opponent submitted evidence of use of the mark in the form of a witness statement of 27 August 2017 of Mr Joaquim Xalabarder Torrents, who states that he is the Opponent's CEO. Although in its Notice of Defence the Applicant had requested proof of use, it did not in its subsequent written submissions contest that use had been proved, but took the goods to be compared from the earlier mark's

specification as being those relied on by the Opponent. Although I do not consider that this constitutes an explicit concession with regard to proof of use, in the interests of procedural economy I shall proceed on the basis that genuine use of the earlier mark in the EU has been proved in respect of all the goods relied on by the Opponent. I would note only that, although Mr Torrents appends as Exhibit JXT4 a proforma invoice to a customer in the UK, the UK is not included in the list he gives of EU countries where goods sold under the earlier mark are distributed through distributors. Nor is it possible to gauge from the material he appends (advertising and promotional material, catalogues, and materials relating to trade fairs, exhibitions and seminars) the extent to which relevant goods have been sold and/or promoted under the mark to customers in the UK.

The Applicant's Evidence

6) The Applicant submitted evidence in the form of a witness statement of 29 September 2017 of Mr Matthew Gardner from the firm representing the Applicant. Mr Gardner states that the content of his statement originates from research conducted by him on the internet. Exhibit MG1 contains a printout from *Wikipedia*, stating that "*Toscano, Toscana, Toscani or Toscanelli may refer to: Adjective meaning of Tuscany*". Exhibit MG2 consists of print-outs of Google searches providing translations of the term "Tuscany" in the languages of the EU countries where, according to Mr Torrents' witness statement, goods sold under the earlier mark are distributed via distributors. Exhibit MG3 consists of a print-out from *Wictionary*, according to which the terms *toscano* (masculine singular), *toscani* (masculine plural), *toscana* (feminine singular) and *toscano* (feminine plural) refer in the Italian language to persons originating from Tuscany. Exhibit MG3 consists of a print-out from *Wikipedia*, according to which the chemical and pharmaceutical industries are of note in the economy of Tuscany.

Section 5(2)(b)

7) Section 5(2)(b) of the Act 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”.

8) The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public 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

9) The Applicant concedes that the goods in question are “identical and similar”. For the avoidance of doubt I find in any event that the goods are identical under the guidance in Case T- 133/05, *Gérard Meric v Office for Harmonisation in the Internal*

Market and that, even if *Merix* were arguably not technically applicable to some, these would in any case have at least a very high degree of similarity on the *Canon* criteria, in particular by reason of complementarity as explained in Case T- 325/06 *Boston Scientific Ltd v Office for Harmonization in the Internal Market*.

The average consumer and the purchasing process

10) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. 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.”

11) As I am proceeding on the basis that the respective goods are identical, the average consumer would also be the same. The parties' competing goods are cosmetics or similar items. The average consumer will be a member of the general public. The goods will often be self-selected from a shelf (or the online or catalogue equivalent) and the marks may be exposed visually in advertising and websites etc. However, it is not unusual to find sales assistants and advisors involved in the purchasing process, so aural considerations will play a part. Even in these cases, however, the customer will normally see the goods before completing a purchase. The Opponent submits that the goods may be ordered via the telephone; but such telephone orders will normally be placed on the basis of the customer having found

the goods in, for example a printed catalogue or its online equivalent. The purchasing act is therefore likely to be primarily a visual one, but aural considerations will not be ignored in my assessment.

12) I accept that where consumers seek specific characteristics in the goods – such as non-allergenic or therapeutic qualities – they may be prepared to pay a higher price for them. Cosmetics and similar goods generally, however, are likely to be available in a broad range of prices – though, as a general rule, they are relatively low value, fairly frequent purchases, and are unlikely to demand a higher level of attention to be paid in their selection than that necessary to establish suitable skin type, particular ingredients, perfume, and so on. The purchasing process will be a normal, reasonably considered one.

The distinctiveness of the earlier mark

13) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, either on the basis of inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee 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).”

14) As regards distinctiveness enhanced through use, it is the UK market which is significant, because it is here that confusion with a national mark will be measured. I have found (at paragraph 5 above) that it is not possible to gauge from the Opponent’s evidence the extent to which relevant goods have been sold and/or promoted under the mark to customers in the UK. It therefore cannot establish any material degree of distinctiveness enhanced through use in the UK.

15) This leaves the question of inherent distinctive character to consider. The Applicant submits that:

“... a substantial portion of European Union consumers will see the term TOSKANI as a reference to Tuscany and therefore assume that the opponents goods are either manufactured in Tuscany or that the ingredients used in the opponents goods originate from Tuscany This is even more likely bearing in mind that one of the main industries of Tuscany is chemicals and pharmaceuticals

9. Therefore, not only will a substantial portion of EU consumers see the term TOSKANI and assume a link with Tuscany but the relevant consumer in the United Kingdom that speaks or has an understanding of Lithuanian, Estonian, Latvian, Bulgarian, Finnish, German, Greek, Hungarian, Slovakia, Italian, Spanish, Polish, Portuguese, Romanian and French will also assume that TOSKANI refers to Tuscany.

Notwithstanding the above, the relevant consumer in the United Kingdom without any knowledge of the above languages will note that the phonetic reference to TOSKANI is phonetically identical or extremely similar to TUSCANY.

The applicant therefore contends that the term TOSKANI which is only one element of the earlier composite mark possesses, a low level of distinctive character. The distinctive character of the earlier mark resides in the mark as a whole which includes the dominant figurative element and the colours claimed in the earlier EUTM.”

16) Here again, it is the perception of the average consumer in the UK which is determinative, because it is here that confusion with a national mark will be measured. I note that of the 13 translations of the term “Tuscany” given in Mr Gardner’s witness statement, only one (that for Greece) is actually “Toskani”. Even if it were shown that speakers of the relevant languages formed a significant proportion of the relevant public in the UK, and that they understood TOSKANI as referring or alluding to Tuscany, there is no evidence that they would associate Tuscany with cosmetics. Similarly, there is no evidence that the word TOSKANI will put the average consumer in the UK in mind of the word “Tuscany”; and, even if it did so, the evidence falls very far short of showing that the average consumer in the UK associates Tuscany with cosmetics, or would perceive the word TOSKANI as geographically descriptive or allusive of the origin of the products, thus weakening its distinctive force.

17) I find that TOSKANI has no meaning in English, cannot therefore be descriptive of, and is not allusive of, any of the goods of the earlier mark. The distinctive weight of the earlier mark lies in its word element. The figurative and graphic elements, however, are not negligible, and also make some contribution to the distinctive character of the mark. Overall, I consider the mark to have a somewhat higher than average degree of inherent distinctive character.


Comparison of the marks

18) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

19) The marks to be compared are shown below:

The opposed mark	The earlier mark
<p>MOSCANY</p>	

20) The Applicant's mark consists of the word MOSCANY. The orthographical treatment does not play a role. The word itself, being the mark's sole element, forms its distinctive component. Although the figurative element of the earlier mark is not negligible, it is the word TOSKANI which has the greater relative distinctive weight in the overall impression created by the mark.

21) In making my comparison I bear in mind that notional and fair use of the opposed mark would cover its use in any plain font¹ and that, not being limited to colour, it is registered in respect of all colours². Visually, the opposed mark consists of the word MOSCANY in capitals and plain font. The earlier mark consists of a figurative element comprising two horizontally parallel rows of three squares. The top left-hand square is green, the other five are grey, all being separated from one another by narrow strips of the white background of the mark. Underneath this device element, aligned with its right-hand side and separated from it by the white background, is the word TOSKANI in capitals and plain font. The colours green, grey, black and white are claimed.

¹ See *Peek & Cloppenburg v OHIM* T-386/07 at paragraph 47 and *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/0 at paragraph 54.

² See *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2014] EWCA Civ 1294 at paragraph 5 and *Starbucks v EUIPO* T-398/16 at paragraphs 53-54.

22) The device element does make some contribution to the overall impression of the mark. It is not negligible but, despite its size relative to the word element, it is unremarkable. Though smaller than the device, the word TOSKANI, on which the distinctive weight of the mark rests, is perfectly prominent, and will attract the average consumer's attention. Visually, the words MOSCANY and TOSKANI are of the same length, each consisting of seven letters, four of which are shared and appear in the same sequence in both marks. However, the initial, middle and end letters of the two marks – i.e. the pairs M and T, C and K, and Y and I respectively – are quite different visually. Overall, there is a low degree of visual similarity between the marks.

23) Figurative elements of a mark are not normally expressed orally. The average consumer in the UK will regard both MOSCANY and TOSKANI as either invented or unfamiliar words, probably of foreign origin. This being so, people may well hesitate over their pronunciation. Though both sides made submissions on the putative pronunciation of MOSCANY and TOSKANI by the average consumer in the UK, neither filed any evidence on the point, so I must make my own assessment.

24) Both marks consist of three syllables. It is possible that some may pronounce the SC in the opposed mark like an S, as in the word “ascend”. I consider that most UK consumers, however, will pronounce the initial MOSC in the opposed mark like the word “mosque”, and that they will pronounce the initial TOSK in the earlier mark to rhyme with “mosque”. It is possible that some may pronounce the rather foreign-looking final ANI in the earlier mark like the final ANI in “Hindustani”. I consider that most UK consumers, however, will pronounce the final two syllables of both marks – both ANY and ANI – like the corresponding endings of words like “company” or “botany”. There is thus a considerable element of aural similarity between the marks. On the other hand, the initial soft M sound of the opposed mark, formed with the lips, is quite different from the initial hard palatal T sound of the earlier mark. Particularly having regard to their position at the beginning of these words, they contribute a considerable element of difference. Overall, there is a medium degree of aural similarity between the marks.

25) The average consumer will not attribute any semantic content to the device element of the earlier mark. Both MOSCANY and TOSKANI will strike the average UK consumer as unfamiliar foreign or invented words; he or she will not attribute a meaning to either of them. This being so, there can be neither conceptual similarity nor conceptual difference between the marks.

Likelihood of Confusion

26) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). There is no scientific formula to apply, however. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

27) My assessment will proceed on the basis that the contested goods and services are identical to goods and services covered by the earlier mark. I have found the earlier mark to have a somewhat higher than average degree of inherent distinctive character. I have found a low degree of visual similarity, a medium degree of aural similarity, and neither conceptual similarity nor conceptual difference between the competing marks. I have found that the purchasing act is likely to be primarily a visual one and that the purchasing process will be a normal, reasonably considered one. Given my findings on the average consumer, and bearing in mind the principle of imperfect recollection, I do not consider that the average consumer would mistake the opposed mark for the earlier mark (i.e. directly confuse them), even when considered in relation to identical goods or services. The clear differences in the initial, middle and end letters of the two marks would be noticed by the average consumer.

28) That leaves the possibility of indirect confusion to be considered, and this connection the Opponent draws my attention to the observations of Mr Iain Purvis

QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (“L.A. Sugar”), where he noted that:

“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).”.

29) In order to find indirect confusion in the present case it would be necessary to conclude that the average consumer would find MOSCANY and TOSKANI respectively to contain an element in common such as would lead to the conclusion that they are both brands of the same or associated owners. The Opponent submits:

“In the event that the average consumer noticed that any difference exists between the respective marks, the shared letters and highly similar pronunciation may to [*sic*] be sufficient to lead the average consumer to make connection between the Applicant and the Opponent which could result in a mistaken belief that the goods/services are being provided by economically linked undertakings”.

30) It is true that, given my findings on aural similarity, the words MOSCANY and TOSKANI closely rhyme. I cannot see that this could be sufficient to lead the average consumer to make a connection between the marks such as could result in a mistaken belief that the respective goods are provided by economically linked undertakings. Moreover, I have in any case found that the purchasing process will be a primarily visual one. I have pointed out that, although the marks share four letters which appear in sequence, the initial, middle and end letters of the two marks – i.e. the pairs M and T, C and K, and Y and I respectively – are quite different visually. I struggle to see that the average consumer would see these differences as constituting, as Mr Purvis put it, “a change of one element [which] appears entirely logical and consistent with a brand extension”. Accordingly, I find that there is no likelihood of either direct or indirect confusion, even in the case of identical goods.

Outcome

31) The opposition fails in its entirety.

Costs

32) The Applicant has been successful and is entitled to a contribution towards its costs. In making my calculation I have borne in mind that the Applicant's written submissions were brief and straightforward, and that I did not find the Applicant's evidence of material assistance. I hereby order TOSKANI, S.L. to pay UK MOSCANY CO., LTD the sum of £950. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£250
Preparing evidence and considering the other side's evidence	£400
Preparing written submissions	£300

The above sum should 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 23rd day of February 2018

**Martin Boyle
For the Registrar,
The Comptroller-General**