

O/380/21

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION UK3225990

IN THE NAME OF

AYA DESIGN GROUP LIMITED

FOR THE TRADE MARK

Les Boys

IN CLASSES 3, 9, 18, & 35

AND

THE APPLICATION FOR DECLARATION OF INVALIDITY THERETO UNDER
NUMBER 503016

BY

CHANEL LIMITED

Background and Pleadings

1. AYA Design Group Limited (“the Proprietor”) stands as the registered proprietor of UK trade mark No. 3225990, as shown on the cover page of this decision, filed on the 20 April 2017 and registered on 25 August 2017, for the following goods and services:

Class 3: Perfumery, essential oils, non-medicated cosmetics; non-medicated soaps.

Class 9: Glasses, sunglasses, spectacles; parts, fittings and accessories for all of the aforesaid goods.

Class 18: Leather and imitations of leather; luggage and carrying bags; handbags; rucksacks; briefcases; purses; wallets; vanity cases; parts, fittings and accessories for all of the aforesaid goods.

Class 35: Retail services related to clothing, footwear, clothing and footwear accessories, eyewear, perfume and cosmetics; online retail store services related to clothing, footwear, clothing and footwear accessories, eyewear, perfume and cosmetics.

2. On 5 February 2020, Chanel Limited (“the Applicant”), initiated invalidation proceedings against the Proprietor’s registration, under section 47(2) of the Trade Marks Act 1994 (“the Act”). The ground for the application for invalidation is based on section 5(2)(b) of the Act. It is a partial invalidation action, directed against the following goods and services:

Class 3: Perfumery, essential oils, non-medicated cosmetics; non-medicated soaps.

Class 35: Retail services related to perfume and cosmetics; online retail store services related to perfume and cosmetics.

3. The Applicant relies on its earlier UK registered trade mark No. 3137592; which was filed on 24 November 2015 and completed its registration process on 26 February 2016. The goods relied upon are as follows:

BOY

Class 3: Preparations for application to or care of the skin, scalp, hair or nails; soaps; perfumes; essential oils; make-up; deodorants; cosmetics; non-medicated toilet preparations.

4. The Applicant relies on all its goods for which the earlier mark is registered, claiming that there is a likelihood of confusion because the respective trade marks are similar and are registered for goods and services identical to, or similar with those for which the earlier mark is registered.
5. The Proprietor filed a defence and counterstatement denying that its mark offends against section 5(2)(b) on the basis that the competing marks are dissimilar and/or that there is no likelihood of confusion.
6. In these proceedings, the Applicant is represented by Withers & Rogers LLP; Briffa represents the Proprietor. Both parties filed evidence and submissions. Neither party requested a hearing; however, both parties filed submissions in lieu of hearing. Whilst I do not propose to summarise the submissions here, I have taken them into consideration, and will refer to them below to the extent that I consider it necessary. This decision is therefore taken following careful consideration of the papers before me.

Evidence

Applicant's Evidence

7. In support of its case, the Applicant filed evidence consisting of two witness statements in the name of Mary Louise Broughton, the second of which was filed in response to the Applicant's evidence and submissions. Ms Broughton is a Trade Mark Attorney at Withers & Rogers LLP and agent of record for the Applicant. The evidence she provides is as follows:

Exhibit MLB1 consists of definitions of cosmetic(s) from the Cambridge, Collins and Merriam-Webster dictionaries. The definition given, in the Cambridge Dictionary for example, is "*substances that you put on your face or body that are intended to improve your appearance*".

Exhibit MLB2 reproduces web pages from cosmetics companies (including *MAC, Benefit, ELF, IT* and *Kiko Milano*) and *Google* search results printouts, displaying various cosmetics and skin care products.

Exhibit MLB3 shows definitions for soap and toiletry respectively, as: "a substance used for washing the body or other things"; and "an article or preparation (such as toothpaste, shaving cream, or cologne) used in cleaning or grooming oneself - usually used in plural".

Exhibit MLB4 reproduces webpages from UK retailers (*Superdrug, Boots* and *Sainsbury's*) showing: "Baby Toiletries", "Kids Toiletries", "baby & child toiletries".

Exhibit MLB5 are printouts of websites of UK retailers showing makeup products for children.

Exhibit MLB6 reproduces website extracts and articles relating to "Franglais" and/or "Frenghish": "a French blend which referred first to the overuse of

English words by French-speakers, and later to diglossia or the macaronic mixture of French (français) and English (anglais)”.

Exhibit MLB7 presents internet printouts evidencing purported “Franglais brands”, including *Agent Provocateur*.

Exhibit MLB8 reproduces a *Vogue* magazine article featuring Serena Rees, MBE, in which she is identified as the founder of lingerie brand, *Agent Provocateur*, as well as the street-to-bed label, *Les Girls Les Boys*.

Exhibit MLB9 consists of printouts of webpages for French-name brands, with commercial presence in the UK, incorporating forms of French definite articles for “the” in their names, namely: *Le Coq Sportif*, *La Redoute*, *L’Occitane* and *Le Creuset*.

Exhibit MLB10 presents a screen capture from the Applicant’s website promoting its fragrance, BOY CHANEL.

Exhibit MLB11 shows a *Google* search of *Les Boys*, displaying results for *Les Girls Les Boys*; with 4 of the 14 results showing *Les Boys* only (3 of which are videos and a *Wikipedia* reference). The latter results relate to film or TV shows; whilst the former results are associated with clothing, possibly of the Proprietor’s brand.

Proprietor’s Evidence

8. The Proprietor’s evidence consists of a witness statement by Serena Rees, MBE; with 7 exhibits marked as SR1 to SR7 and submissions. Ms Rees, MBE is the sole director and shareholder of the Proprietor, who adduces the following evidence:

Exhibit SR1 shows the Cambridge English Dictionary definition of *boy*: “a male child or, more generally, a male of any age”.

Exhibit SR2 consists of the following articles from UK publications: (1) “*Boy Beauty YouTuber Lewys Ball Stars in Rimmel London Campaign*”, dated 27 January 2017; under the Makeup category in *Teen Vogue*; (2) The Guardian article titled “*CoverGirl names makeup artist James Charles its first cover boy*”; dated 12 October 2016; (3) a *Seventeen* magazine feature dated 6 January 2017 and titled: “*One of Your Favorite Beauty Boys Is Now the Face of Maybelline*”; (4) “*13 best teenage skincare products that tackle blemishes, acne and redness*”, an Independent piece dated 27 August 2020, covering “teen-specific” products, some of which are “specifically created for boys’ skin problems”; and (5) *Men’s Health* magazine’s “*Yes, Guys Can Wear Makeup — and Here Are 5 Products to Get You Started*”, dated 4 December 2018.

Exhibit SR3 reproduces webpages from the Applicant’s website’s make-up selection for men, showing a number of items offered under the brand “BOY DE CHANEL”.

Exhibit SR4 provides Urban Dictionary definitions of “Les Boys” and “Lesboy”, relating to, for example, “a male who often seems gay/girly, but is highly attracted to lesbians and bisexual females with no attraction to other men”; or a male homosexual.

Exhibit SR5 is the Dire Straits song lyrics for Les Boys, which was released in 1980.

Exhibit SR6 shows the Proprietor’s *Les Girls Les Boys* story from its internet site, explaining inter alia, that: “We are a shareable label. We believe only you should choose what, who or how you are. It doesn’t matter to us, and it shouldn’t matter to anyone else either. Les girls one day, les boys the next. Les boys up top, les girls down below.”

Exhibit SR7 are excerpts from the Proprietor’s Brand Book, which include the statement: “Resolutely democratic and self-assured les girls les boys celebrates the fluidity of love and friendship, cross cultural mind-sets and diverse identities”. The exhibit also includes press coverage for the brand in

the form of articles in (British and Italia) *Vogue*; *Vogue Daily*; *W Magazine*; *Nylon*; *Forbes*; *whattowear.com*; and others, including social media posts.

Applicant's Reply Evidence

9. In response to the Proprietor's evidence, the Applicant filed a brief witness statement by the same Ms Broughton mentioned above. In this second witness statement Ms Broughton is critical of Ms Rees' reliance on the Urban Dictionary to define "Lesboy" and "Les Boys". She adduced evidence marked as **Exhibit MLB12**, consisting of printouts from the Urban Dictionary website. One of which shows, amongst other things, that: "All the definitions on Urban Dictionary were written by people just like you. Now's your chance to add your own!"; and a page titled, "Urban Dictionary Content Guidelines", which states "We are not a traditional dictionary", for example. The exhibit also includes an article titled: "How Urban Dictionary Became a Cesspool for Racists and Misogynists".

10. Ms Broughton further cites a *Wikipedia* entry, as **Exhibit MLB13**, highlighting that the Dire Straits song "Les Boys" (referred to in the Proprietor's evidence), "was released only as an album track".

Preliminary Issue

11. Before I deal with the substantive issues in these proceedings, there is one preliminary point I must address. The parties have made submissions and/or filed evidence in relation to use of the respective marks on the market, claiming amongst other things, that the competing marks are used in conjunction with other marks and/or in variant form. The Applicant submits for example, *Google* search results for the terms 'les boys' and 'lesboys', to show use of the mark in relation to the Proprietor's fashion brand "les girls les boys"; and that the Proprietor uses the trade mark LES BOYS on its website at *lesgirlslesboys.com* to denote "the boys". The Applicant further submits, citing evidence derived from the Proprietor's website "that the mark LES BOYS is used to indicate clothing intended for people who identify or want to shop on the masculine spectrum (and likewise, LES GIRLS to indicate clothing intended for people who identify or want to shop on the feminine spectrum)".

12. The Proprietor similarly submits that: “[a]s can be seen in SR3, the Cancellation Applicant itself advertises make-up and skincare products to males. It is noted that the said products are advertised under and by reference to the sign BOY DE CHANEL”.

13. It is therefore necessary for me to explain that, as a matter of law, such submissions will have no bearing on my decision. It is settled law that I must compare the marks as they have been registered, not as they are used. In *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd L.J. considered the CJEU’s judgment in *Specsavers*, Case C-252/12, which was submitted as establishing that matter used with, but extraneous to, the earlier mark should be taken into account in assessing the likelihood of confusion with a later mark. The judge stated:

“46. Mr Silverleaf submitted that, in the light of this guidance, the proposition stated by Jacob LJ in *L’Oreal* can no longer be regarded as representing the law. He starts by recognising that acquired distinctiveness of a trade mark has long been required to be taken into account when considering the likelihood of confusion. He goes on to submit that *Specsavers* in the CJEU has made it clear that the acquired distinctiveness to which regard may properly be had included not only matter appearing on the register, but also matter which could only be discerned by use. The colour, on which reliance could be placed in *Specsavers*, was matter extraneous to the mark as it appeared on the register. It followed that if something appears routinely and uniformly in immediate association with the mark when used by the proprietor, it should be taken into account as part of the relevant context.

47. I am unable to accept these submissions. The CJEU’s ruling does not go far enough for Mr Silverleaf’s purposes. The matter not discernible from the register in *Specsavers* was the colour in which a mark registered in black and white was used. It is true that in one sense the colour in which a mark is used can be described as “extraneous matter”, given that the mark is registered in black and white. But at [37] of its judgment the court speaks of colour as affecting “*how the average consumer of the goods at issue*

perceives that trade mark and in [38] of "*the use which has been made of it [i.e. the trade mark] in that colour or combination of colours*". By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used "*in association with the mark*". Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely are not matters which affect the average consumer's perception of the mark itself."

DECISION

14. Section 47(2) of the Act sets out the provisions upon which section 5(2)(b) apply namely:

47. - (2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

15. The invalidation action is based on section 5(2)(b) of the Act which provides that:

"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".

16. An earlier trade mark is defined under section 6 of the Act, the relevant parts of which state:

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

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,

(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.”

17. The Applicant’s mark (which was filed on 24 November 2015) qualifies as an earlier right in accordance with the above provisions. As this earlier trade mark had not completed its registration procedure more than five years before the date of the application for invalidation (or the date on which the contested mark was filed), the Applicant’s trade mark is not subject to the proof of use provisions contained in sections 47(2A) – (2E) of the Act. The Applicant is, as a consequence, entitled to rely upon its mark in relation to all of the goods indicated without having to prove that genuine use has been made of it. Therefore, I must make the assessment based upon the full width of the goods relied upon by the Applicant, regardless of whether or not the mark has actually been used in relation to those goods. This is because the Applicant is entitled to protection across the breadth of what it has registered on a ‘notional’ use basis.

Relevant Law

18. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks

Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

19. 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 to mind the earlier mark, 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 the goods and services

20. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, 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”.

21. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a. The respective users of the respective goods or services;
- b. The physical nature of the goods or acts of services;
- c. The respective trade channels through which the goods or services reach the market;
- d. In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e. The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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 trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

23. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the*

Internal Market (Trade Marks and Designs) (OHIM), Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

24. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

25. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

Similarity of goods and services – Nice Classification

26. Section 60A of the Act provides:

27. “(1) For the purpose of this Act goods and services-

are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

The Proprietor's Class 3 Goods

Perfumery, essential oils, non-medicated cosmetics; non-medicated soaps

28. The Proprietor concedes that its class 3 goods are identical to the goods covered by the Applicant's earlier mark. The term *essential oils* appears in both specifications; therefore, they are self-evidently identical. *Perfumery, non-medicated cosmetics; non-medicated soaps*, though expressed in different terms, are identical to, or fall within the ambit of the Applicant's respective goods: *perfumes, cosmetics, and soaps*. Therefore they are identical under the principle outlined in *Meric*.

The Proprietor's Class 35 Services

Retail services related to perfume and cosmetics; online retail store services related to perfume and cosmetics

29. The Proprietor accepts that the class 35 services at issue are similar to the Applicant's class 3 goods to a low degree. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to an average degree.

30. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

31. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and

¹ Case C-411/13P.

² Case T-105/05.

³ Case C-398/07P.

then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

32. The nature, purpose and method of use of retail/online retail store services in relation to perfume and cosmetics are not the same as the earlier specification "perfumes" and "cosmetics". Nevertheless, I consider, in line with reasoning in the *Oakley* case, that they are complementary; the retail services at issue are those which would normally be associated with the goods relied upon by the Applicant. These services are specifically provided for the ultimate purpose of selling perfumery and cosmetics; and would make no sense without those goods. Furthermore, the services are generally offered in the same places where the goods are offered for sale; and likewise target the same public. I therefore find that the Proprietor's retail services in relation to perfumes and cosmetics are similar to the earlier specification (perfumes and cosmetics) to an average degree.

Average consumer

33. As indicated by the caselaw cited above, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide 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”.

30. For the purpose of assessing the likelihood of confusion, it must also 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.

31. The Applicant submits that: “The goods covered by the Proprietor’s Mark and the goods covered by the Applicant's Mark are everyday consumer items. It follows that the relevant public, by reference to which the likelihood of confusion must be assessed, is composed of members of the general public. The contested goods are available at a spectrum of prices, but consist of more or less “everyday” goods. The attention level in selecting and buying them will therefore vary from low to average. The goods will be brought in shops or via the internet, where a consumer will browse the shelves, website or promotional publications to select the goods. The consumer will see the marks used on labels on the goods themselves, and/or in advertising. As such the purchasing process will primarily be a visual one. However, aural considerations are also relevant as the marks will be articulated in certain circumstances such as during word of mouth recommendations, beauty vlogs, television, radio or social media advertising”.

32. The Proprietor agrees that the goods are everyday items, directed at the public at large; however, it contends that a high level of attention will be observed during the selection process (as consumers select products according to particular tastes and/or physical requirements).

33. I agree that the average consumer is a member of the general public and that the goods are everyday consumables. I also agree with the respective submissions as to the level of attention the average consumer will exhibit. Although I find that the level of attention paid by the average consumer will generally be moderate, I accept, following the Proprietor's submission, that a proportion of the relevant public may take a higher than average level of care and attention at the point of selection, due to the nature of the goods at issue, or where consumers are particular as to allergies, skin sensitivities, or other preferences.

34. I consider that the goods are most likely to be obtained by self-selection from the shelves of a retail outlet, from a website equivalent or perhaps from a specialist undertaking. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that orders may be placed over the telephone; and purchases may be made on word-of-mouth recommendations or on the advice of sales assistants or representatives.

35. The services at issue are offered in shops on the high street (or online equivalents). The purchase is predominantly visual, with the consumer selecting the retail service following visual inspection of the shop front or website, though I do not discount an aural component. The average consumer will wish to ensure, for example, that the desired product range is offered for sale, or that individual items are in stock. Overall, consumers will pay an average degree of attention when selecting an appropriate retail channel.

Comparison of trade marks

36. 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 Court of Justice of the European Union 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.”

37. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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.

38. The respective trade marks to be compared are shown below:

Proprietor's Mark	Applicant's Mark
Les Boys	BOY

39. I earlier explained why the respective parties' actual use of the marks is not relevant to my decision. In comparing the marks there is no difference between the variation in the casing; because a word trade mark registration protects the word itself, irrespective of the font capitalisation or otherwise. Therefore, a trade mark in capital letters covers notional use in lower case and vice versa.⁴

40. The Applicant's mark consists of the word BOY. There are no other elements to contribute to the overall impression, which lies in the word itself.

41. The Proprietor's mark consists of two (2) word elements, Les and Boys. In its submissions, the Proprietor postulates that its mark "uses both French and English words in combination, marking it as distinctive in the eyes of consumers". It argues further that the word "Boys" is not the distinctive and dominant element of its mark

⁴ *Bentley Motors Limited v Bentley 1962 Limited* BL O/159/17
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or that “Les” is a non-distinctive prefix (particularly to English speaking consumers). The average consumer will see the two components forming the Proprietor’s Mark as forming a unit”.

42. The Applicant contends that “LES is a non-distinctive prefix”; “a determiner which qualifies the plural noun BOYS. Accordingly, the construction of the Proprietor’s Mark emphasises the distinctiveness and dominance of the BOYS element. In light of the foregoing, the Applicant submits that the overall impression of the Proprietor’s Mark is dominated by the BOYS element”.

43. There seems to me to be no doubt that the Proprietor’s mark is formed of two words, Les and Boys; and that its overall impression is that it is a term – representing either “the boys” or a genus of boys (I will form a conclusion as to the likely perceived meaning later in this decision). However, I consider, irrespective of how the first word of the mark is perceived, “Boys” is marginally more dominant than “Les”; because it is the noun or object of the term, whereas “Les” (depending on how it is defined/perceived) merely introduces the noun/object (if it is perceived as the French definite article); or is an adjective describing the noun (if it is taken as the abbreviation for lesbian). I must make clear, however, that the average consumer will not spend time considering whether a word or words in the mark is an adjective, object or a noun, but will simply look at the mark as a whole and attach more significance to the word “Boys”; given that it is an ordinary dictionary word, with recognisable meaning. Furthermore, it is an English word (taking the argument of the Proprietor), within the construct of a composite whole consisting of French and English words.

44. The visual point of similarity between the marks is the presence in both marks of “Boy”. The “Les” element and the “s” after “Boy” are the points of visual difference, at the beginning and ending of the Proprietor’s mark respectively (with no counterparts in the earlier mark). Consequently, there is a moderate degree of visual similarity between the marks.

45. From an aural perspective the Applicant’s mark comprises of one word “BOY”; whereas the Proprietor’s mark consists of two verbal elements, “Les” and “Boys”.

The “Les” element (present at the beginning of the contested mark with no counterpart in the earlier mark), may be pronounced as either “LAY” or “LEZ”. The pluralisation of the second element, “Boys”, will not create a significant difference in pronunciation with the earlier mark. As a result, I find that there is also a moderate degree of aural similarity between the marks.

30. In addressing the conceptual similarity between the marks, the Applicant states that its mark “will be understood as a reference to a male child. The Proprietor's Mark will be understood as a reference to more than one male child. Accordingly, the marks are conceptually similar to a high degree”. The Applicant argues that “[t]he use [of] ‘Franglais’ is also not uncommon when it comes to branding”; that there are “various French-language brands beginning with the French word for ‘the’ (i.e. ‘le’, ‘la’, ‘les’ or ‘l’)” which are sold in the UK. As a result, the average UK consumer will easily recognise the Proprietor’s mark as simply referring to “the boys”, and the mark is dominated by the word BOYS. While UK consumers will recognise that the mark contains a French word, the word is so basic that it will be readily understood. Thus, the difference between BOY and LES BOYS is negligible”.

31. In response, the Proprietor argues as follows:

“To state that ‘Les’ is a non-distinctive prefix which means ‘the’ in English and which is simply a determiner which qualifies the plural noun BOYS, ignores a) the important feature of the mark being that the noun is an English word and therefore arguably the aforesaid rules of grammar do not apply as the mark is a construct of English and French words such that as a composite whole, it is not recognised by either language, and/or b) the irregular capitalisation of the ‘B’ in ‘Boys’ (*fn: 31/03/2016, R 3290/2014-4: Damia*).

“Conceptually the meaning of the mark is different to that of the Applicant’s Mark in that it will either be a) neutral – as a consequence of a French and an English word being used in the same mark resulting in the mark having no particular meaning in either language, or b) influenced by uses of or

references to (whether previous or current) ‘Les Boys’ within society as term to describe an individual who identifies, whether sexually or otherwise, as a gender different to the that (sic) of the body which they were born with and/or who is sexually/gender intertwined or sexually/gender free i.e. neither male nor female”.

32. On the question as to whether the Proprietor’s mark would be perceived as “the boys” or gender-fluid boys, the Applicant contends that the Proprietor’s reliance upon the Urban Dictionary and the Dire Straits song “Les Boys” to argue for the latter concept is untenable. The Applicant provides “internet print outs relating to [the] Urban Dictionary, from which it can be seen that it is a crowdsourced online dictionary for slang words and phrases. Anyone may contribute a “definition” to the dictionary.... While the site provides basic content guidelines, the primary quality control is a group of “volunteer editors” (comprising other users of Urban Dictionary) who can choose to include or reject a definition, but cannot actually edit the definitions that are submitted”.

33. Evidence adduced by the Applicant shows that the Dire Straits song “Les Boys” was “released only as an album track”. On this point the Applicant argues that “the lyrics to the song do not define or demonstrate any specific meaning of “Les Boys”; [and] the song was released only as an album track over 40 years ago. It hardly proves that the term “Les Boys” is known and understood by UK consumers in the specific way suggested by the Proprietor. Thus the Proprietor’s submissions and evidence regarding the concept of the Proprietor’s Mark are not persuasive”.

34. In its submissions in lieu of hearing, the Proprietor maintains “that [the] Urban Dictionary has been cited in a number of cases before the English High Court and the United Kingdom and European Intellectual Property Offices”. In support of its reliance on the Dire Straits song, the Proprietor also suggests that the Applicant ignores the fact that the Dire Straits album at issue was “certified platinum in the United States and double-platinum in the United Kingdom”.

35. Even if I accept the Urban Dictionary entries for “Les Boys”, it does not overcome the argument (in the absence of evidence in support) that “the mere existence of a

word or phrase in [the] Urban Dictionary does not in any way prove that the particular word or phrase is in fact known to the public or understood as denoting the “definition” given on the website, and far less that it is known and understood by the UK public”.

36. I therefore consider that the Urban Dictionary entries, the provenance of which is not known, bear very little, if any, weight, without further evidence to show that the concept is known in the UK or that the average consumer of the goods and services would be aware of it. Furthermore, I consider that the word “Les” will be recognised by a significant proportion of the general UK public as the French plural definite article for “the”; given the linguistic/cultural influences of France in the UK. This is reinforced by its use with an ordinary dictionary word, in the plural form, “Boys”. In the alternative, I consider that the average consumer will attach meaning to the word “boys”, whether or not it is taken to mean a gender-expansive boy, the underlying concept relates to “a male of any age” whether or not they identify as the gender to which they were assigned at birth. In other words, a boy who identifies as lesbian could not be classed as “Les Boy”, unless he was in fact a biological boy. Therefore, even if the mark is perceived to convey the meaning of a lesbian-identified male, it retains a conceptual connection to boy, given the antecedent to which it (Les Boys) refers.

37. In *Usinor SA v OHIM*, Case T-189/05, the General Court found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T 356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II 3445, paragraph 51, and Case T 256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II 0000, paragraph 57).

63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, 'galva', which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.

64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes 'llia' and 'lloy' were meaningless.

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word 'alloy', corresponding to 'alliage' in French, even if the first letter of that word ('a') has merged with the last letter of the prefix 'galva', according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix 'allia' is combined with the prefix 'galva' in the same way. The evocative force of the suffix 'allia' will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word 'alliage'. That process of identification is facilitated still further by the association of the idea of 'alliage' (alloy) with that of galvanisation, the suffix 'allia' being attached to the prefix 'galva'.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark".

38. In the context of these considerations, I conclude that the relevant public will most likely perceive the “Les Boys” mark as something to do with boys, whether or not they are familiar with the Proprietor’s suggested meaning. Therefore, for all of the above reasons, I find that the marks are conceptually similar to a high degree.

Distinctive character of the earlier trade mark

39. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion.⁵ 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.

40. “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.

41. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the Applicant has not pleaded that its mark has acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

⁵ *Sabel BV v Puma AG*, Case C-251/95 [para. 24].

42. The Applicant asserts that its mark “enjoys an above average level of inherent distinctiveness in respect of “perfumes; essential oils; make-up; cosmetics” which are not products that are marketed to boys or children generally. With regard to the remaining goods covered by the Applicant’s Mark, we submit that the Applicant’s Mark enjoys an average level of distinctiveness. In this respect, we note that skincare preparations, soaps etc. are marketed to babies or children and not specifically to children based on gender. Accordingly, the Applicant’s Mark is unusual and fanciful in respect of these goods.

43. The Proprietor on the other hand, contends that “the word ‘Boy’ is descriptive of the Relevant Goods in the sense that the average consumer will perceive it to be a reference to the public, for which the corresponding goods are meant or intended” and as a consequence, the earlier mark “enjoys only a very low level of distinctiveness”.

44. I agree with the Proprietor’s line of reasoning. I consider that the Applicant’s mark comprises a common, recognisable dictionary word and that it does possess some allusive quality. I find that the mark’s level of inherent distinctive character is low.

Conclusions on Likelihood of Confusion

45. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 (*Lloyd Schuhfabrik* at [26]).

46. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other; and indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The

distinction between these was explained by 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. He said:

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:

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).

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.).

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).”

47. These categories are not exhaustive, but illustrative;⁶ and provide a helpful focus for my analysis on the likelihood of confusion. I have found that the Proprietor’s mark comprises a term formed of two words, “Les Boys”, the latter of which is marginally more dominant than the former. I concluded that the marks share a moderate degree of visual and aural similarity; and that they are conceptually similar to a high degree.

48. I determined that the average consumer is predominantly ordinary members of the public, who will pay an average (and in limited instances, a higher) degree of attention in the purchasing process; and that the selection process, without discounting the aural component, is likely to be visual. I found the respective goods and services are either identical or similar to an average degree. I also concluded that the Applicant’s mark, which has not been enhanced through use, is of low inherent distinctive character.

49. Although I have found that the earlier mark has only a low degree of distinctive character, that does not, of itself, preclude a finding of likelihood of confusion. In *L’Oréal SA v OHIM*, Case C-235/05 P, the CJEU found that:

“45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive

⁶ See *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14; § 29.

character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders”.

50. From a global perspective, I consider that there is a strong coincidence between the marks with a decisive impact. The word/s Boy/s will convey a conceptual message with significant overlap, which is qualified, but not critically altered, by the presence of “Les” at the beginning of the Proprietor’s mark. I find that, notwithstanding the presence of the word “Les” in the later mark, the word “Boy/s” is likely to fix itself in the average consumer’s mind and act as an important hook in prompting their recall of the competing trade marks. An appreciable proportion of the relevant public will perceive the later mark as constituting the plural form of the earlier mark, “BOY”. However, I consider that the “Les” element in the Proprietor’s mark will be sufficient to enable the average consumer to differentiate between the marks; they will not be misremembered or mistakenly recalled as each other. I am satisfied that the average consumer will not simply mistake one mark for another. Therefore, I do not find that there is a likelihood of direct confusion.

51. Although I consider that the average consumer will notice that there is a difference between the marks and is unlikely to directly confuse one for another, confusion works both ways; and I must also consider the possibility of indirect confusion. In my view, the similarities pointed out above (particularly the high degree of conceptual similarity), are likely to lead the relevant public to perceive the Proprietor’s mark as a sub-brand or extension of the earlier mark; or that the competing goods and services, that are identical or similar to an average degree, come from the same undertaking or economically linked undertakings; despite the possible higher level of attention some of the relevant public may exhibit for those goods and services. Accordingly, there is a likelihood of indirect confusion.

Conclusion

52. The application for invalidation therefore succeeds for all of the goods in class 3 (*Perfumery, essential oils, non-medicated cosmetics; non-medicated soaps*) and the class 35 retail services specifically contested in these proceedings, namely: *Retail services related to perfume and cosmetics; online retail store services related to perfume and cosmetics*. Therefore, subject to any successful appeal, the Proprietor's trade mark will be declared invalid and, under the provisions of section 47(6) of the Act, deemed never to have been made in relation to the specified class 3 goods and class 35 services. The Proprietor's trade mark remains validly registered for the following goods and services, there being no objection raised for these goods and services:

Class 9: Glasses, sunglasses, spectacles; parts, fittings and accessories for all of the aforesaid goods.

Class 18: Leather and imitations of leather; luggage and carrying bags; handbags; rucksacks; briefcases; purses; wallets; vanity cases; parts, fittings and accessories for all of the aforesaid goods.

Class 35: Retail services related to clothing, footwear, clothing and footwear accessories, eyewear; online retail store services related to clothing, footwear, clothing and footwear accessories, eyewear.

Costs

53. As the applicant has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying this TPN as a guide, I award costs to the applicant on the following basis:

Official Fee	£200
Filing the application and reviewing the counterstatement	£400
Filing evidence	£600

Written submissions £400

Total £1600

54. I order Aya Design Group Limited to pay Chanel Limited the sum of £1600 as a contribution towards its costs. This sum is to be paid within twenty-one (21) days of the expiry of the appeal period or within twenty-one (21) days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 21st day of May 2021

**Denzil Johnson
For the Registrar**