

O/937/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003562134

BY JOANNA SILVA

TO REGISTER:



AS A TRADE MARK IN CLASSES 3 & 35

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 424543 BY

HELAN COSMESI DI LABORATORIO S.R.L.

BACKGROUND AND PLEADINGS

1. On 30 November 2020, Joanna Silva (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods and services:

Class 3: Beauty care cosmetics; Beauty care preparations; Beauty serums; Body and facial butters; Body and facial oils; Body butters; Body care cosmetics; Body scrubs; Cleansing oil; Cosmetic oils; Cosmetic preparations; Cosmetic preparations for body care; Cosmetic preparations for skin care; Cosmetics; Skin care cosmetics; Skin care oils [cosmetic]; Skin care preparations; Skin cleansers.

Class 35: Advertising services relating to cosmetics; Providing consumer product advice relating to cosmetics; Providing consumer product information relating to cosmetics; Retail services in relation to toiletries; Online retail services relating to cosmetics.

2. The application was published for opposition purposes on 19 February 2021 and, on 19 May 2021, it was opposed by HELAN COSMESI DI LABORATORIO S.R.L. (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and relies on the following EUTMs:¹



EUTM: 17818221

Filing date 15 February 2018; registration date 16 June 2018

¹ Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application. Further, see paragraph 3 of Tribunal Practice Notice 2/2020

Relying on some goods, namely:

Class 3: Bath foam; Bath oil; Hand cleansers; Hand creams; Soaps in liquid form; Massage oils; Perfumed creams; Skin cleansers; Sun creams; Aromatherapy preparations; Body oils [for cosmetic use]; Cosmetic pads; Eye make up remover; Make-up; Scented sachets; Grease-removing preparations; Moist wipes for sanitary and cosmetic purposes; Scented body spray; Scented linen sprays; Room scenting sprays; Beauty tonics for application to the body; Beauty tonics for application to the face; Body creams (cosmetics); Body oil spray; Conditioning creams; Cosmetics for the use on the hair; Foaming bath gels; Foams for use in the shower; Perfumed tissues; Sponges impregnated with soaps; Sponges impregnated with toiletries; Toilet water; Eau de parfum; Fragrances; Perfume; Perfume water; Scented body lotions and creams; Cosmetic creams and lotions for the face and skin care; Cocoa butter for cosmetic purposes.

("the opponent's first mark");



EUTM: 17959773

Filing date 20 September 2018; registration date 9 January 2019

Relying on all goods, namely:

Class 3: Bath foam; Bath oil; Hand cleansers; Hand creams; Soaps in liquid form; Massage oils; Perfumed creams; Skin cleansers; Sun creams; Aromatherapy preparations; Body oils [for cosmetic use]; Cosmetic pads; Eye make up remover; Make-up; Scented sachets; Grease-removing preparations; Moist wipes for sanitary and cosmetic purposes; Scented body spray; Scented linen

sprays; Room scenting sprays; Beauty tonics for application to the body; Beauty tonics for application to the face; Body cream; Body oil spray; Conditioning creams; Cosmetics for the use on the hair; Foaming bath gels; Foams for use in the shower; Perfumed tissues; Sponges impregnated with soaps; Sponges impregnated with toiletries; Toilet water; Eau de parfum; Fragrances; Perfume; Fragrances; Perfume water; Scented body lotions and creams; Cosmetic creams and lotions for the face and skin care; Cocoa butter for cosmetic purposes; Cosmetics for children.

("the opponent's second mark"); and



EUTM: 6373179

Filing date 17 October 2007; registration date 25 September 2008

Relying on some goods, namely:

Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

("the opponent's third mark").

3. The opponent claims that due to the fact that the marks are similar and the goods and services are identical and/or similar, there exists a likelihood of confusion, which includes a likelihood of association, especially taking into account the enhanced distinctive character of the earlier marks and the fact that they are a family of marks. The applicant filed a counter statement denying the claims made and putting the opponent to proof of use for its third mark.
4. Both parties filed evidence in chief with the opponent also filing evidence in reply. A hearing took place before me on 20 September 2022, by video conference. The

opponent was represented by Mr Rowland Buehrlen of Beck Greener LLP, who have represented the opponent throughout this matter. The applicant was represented by Mr Aaron Wood of Brandsmiths LLP, who have represented the applicant since the filing of a Form TM33 on 14 July 2022. Prior to Brandsmiths LLP's appointment, the applicant represented herself during these proceedings. Both parties filed skeleton arguments in advance of the hearing.

5. 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 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.

EVIDENCE

6. The opponent's evidence in chief came in the form of the witness statement of Mr Christian Rowland Buehrlen dated 8 December 2021. Mr Buehrlen is a trade mark attorney at the opponent's representative firm and is, therefore, duly authorised to file evidence on the opponent's behalf. Mr Buehrlen's evidence in chief is accompanied by nine exhibits, being those labelled exhibits CRB1 to CRB9.
7. The applicants' evidence came in the form of the witness statement of Ms Joanna Silva dated 25 February 2022, being the applicant herself. Ms Silva's statement is accompanied by seventeen exhibits, being those labelled exhibits JS1 to JS17. Ms Silva's statement was also accompanied by written submissions.
8. As for the opponents' evidence in reply, this came in the form of the witness statement of Mr Michael Hill dated 20 May 2022. Mr Hill is the owner of Skin Care Creative Solutions UK Limited, being a supplier of natural and organic skincare products for the organic baby market. Mr Hill's statement is not accompanied by any exhibits. The opponent also filed evidence in reply in the form of the second witness statement of Mr Buehrlen, also dated 20 May 2022. Mr Buehrlen's second statement was accompanied by a further six exhibits, being those labelled exhibits

CRB13 to CRB18. I note that in his second statement, Mr Buehrlen refers to his first statement including the exhibits labelled CRB1 to CRB12, however, this was not the case. It was confirmed at the hearing that this was a typographical error and that exhibits CRB10 to CRB12 were not filed in these proceedings.

9. I do not intend to summarise the evidence or submissions of the parties in full here, however, I will refer to them below where necessary.

PRELIMINARY ISSUES

10. In the applicant's skeleton argument filed prior to the hearing, an issue was raised in respect of the evidence of Mr Buehrlen. I do not propose to summarise the entirety of the point raised but, in short, note that the applicant's position is that Mr Buehrlen, as the opponent's trade mark attorney, was not able to profess to the credibility of the evidence filed or that the evidence was from within the relevant period. As a result, the applicant's position is that the opponent's evidence is of very little probative value and is entirely unsatisfactory. Further, the applicant submits that there is no excuse for the lack of direct evidence from an employee of the opponent itself. In summary, the applicant set out that if I was to agree with this position, I should conclude that no evidence has been provided meaning that the opponent's third mark, being the one put to proof of use, cannot be relied upon.
11. The opponent responded to this point at the hearing and its primary position is that the evidence can be relied upon and that if the applicant wished to take issue with the evidence filed, it was for the applicant to make a request that the witness be cross-examined at a hearing. I agree that if the applicant wished to make a direct challenge to the evidence and the reliability of the witness, it was open for her to request a cross-examination or to raise the issues earlier in the proceedings in order to allow them to be addressed appropriately. As a result, I will not consider any comments by the applicant that directly challenge the admissibility of the evidence and reliability of the witness. Having said that, I am of the view that a number of the points raised by the applicant are not direct challenges to the admissibility of the evidence as such but are points that the applicant is entitled to make in its submissions. It is my view that the applicant is entitled to raise criticisms

of the evidence at this stage. For example, I note that one of the issues raised is that the evidence includes undated screenshots of websites and it is not clear that they were within the relevant period. This is something that the applicant is entitled to take issue with.

12. Having considered the position of both parties, I accept that the opponent's evidence consists of hearsay evidence, however, this does not mean that it cannot be of use in these proceedings. On this point, I note that it is common in proceedings before the Tribunal for attorneys to file evidence on behalf of parties. It is not unusual and certainly is not fatal to the relevance of said evidence. However, while I remind myself to be cautious as to the weight attributed to the content of the evidence, I note that the evidence is accompanied by a statement of truth and, while the applicant has taken issue with its content (points I will bear in mind when assessing the evidence below), there has been no direct challenge to the accuracy of the evidence via the applicant's own evidence or cross-examination. Therefore, I have no reason to disbelieve the contents of the witness statement and will proceed to assess it in accordance with the probative weight I deem appropriate. For the avoidance of doubt, I will proceed to consider the evidence of use in the ordinary way whilst bearing in mind the legislation and case law (all of which will be reproduced in full below).

13. I have set out above that the opponent's pleaded case relies on a family of marks argument. However, this point was not furthered by the opponent throughout the course of these proceedings. In any event, I refer to the case of *Il Ponte Finanziaria SpA v OHIM*² wherein the Court of Justice of the European Union ("CJEU") stated that in order for a family of marks argument to succeed, the trade marks that make up the 'family' must be present on the market. While evidence has been filed in respect of the use for the opponent's third mark, no evidence has been filed regarding the presence of the remaining marks on the market. Further, the opponent has failed to expand on the argument as to what element it relies on as pointing to a family, be that the full word 'HELAN' or the letters 'ELAN'. In any event, no evidence has been provided in order to establish that the public would expect

² Case C-234/06,

any mark with the word 'HELAN' or the letters 'ELAN' to be connected to the opponent. This line of argument must, therefore, fail and I will say no more on the matter.

DECISION

Proof of use

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

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(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.”

15. The relevant statutory provisions are as follows:

“Section 6A

“(1) This section applies where

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Section 100 of the Act is also relevant, which reads:

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

17. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. The opponent’s first and second marks did not complete their registration process over five years prior to the filing date of the applicant’s mark. As a result, they are not subject to the above proof of use provisions. The opponent may, therefore, rely on these marks in respect of all of the goods highlighted in its notice of opposition. However, the opponent’s third mark did complete its registration process over five years prior to the filing date of the applicant’s mark and, as set out above, the applicant requested that the opponent provide proof of use for this mark. As a result, the opponent’s third mark is subject to a proof of use assessment in respect of all of the goods relied upon.

18. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch)

Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods

come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use

of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the filing date of the applicant’s mark, being 30 November 2020. Therefore, the relevant period for this assessment is 1 December 2015 to 30 November 2020.

20. As the earlier mark is an EUTM, the opponent must show use in the EU. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

21. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”³ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

³ *Jumpman* BL O/222/16

Form of the Mark

22. The evidence provided shows repeated use of the opponent's third mark in a number of different colours. Given that the mark is registered in greyscale, I accept that it is also covered for use in different colours. This is clearly use upon which the opponent may rely. Having reviewed the evidence, I note that the mark is also displayed on a number of different products but is used in conjunction with various other marks. There are a wide range of products on which the opponent's third mark is displayed in this way. While I do not intend to show all uses, I provide the following examples for illustrative purposes:



23. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

24. While the above examples include other marks, I note the case law above which sets out that use of a mark encompasses both its independent use and its use in conjunction with another mark. The above uses of the opponent’s third mark on various products are, in my view, examples of this type of use. While the opponent’s third mark is placed at the bottom of the products and in conjunction with various other elements, I am of the view that it remains the primary indication of the origin of the goods. The average consumer, when viewing the product, would not overlook the presence of the opponent’s third mark at the bottom and would consider that it is indicative of the undertaking that is ultimately responsible for the goods. I note that such use is demonstrated many times across the evidence and is, in my view, valid use of the mark as registered.

25. I note the opponent’s skeleton argument wherein it set out that “there is clearly a wide range of use of the HELAN figurative logo in respect of soaps, perfumery, essential oils, cosmetics and hair lotions. Typical example of cosmetics are shown on pages 75 – 81 of Exhibit CRB2.” While this may be the case for a number of goods that are sold in similar packaging to the ones shown at paragraph 22 above, it is not the case for all goods, particularly the cosmetic goods referred to by the opponent. I note that the evidence shows a number of make-up products that are shown under the banner of the following mark (albeit in different colours):



26. Having reviewed the evidence, the products bearing this mark are not shown as also being packaged with the opponent's third mark as was the case with the examples displayed at paragraph 22 above. I appreciate the case of *Colloseum* (cited above) that sets out that use of a mark as part of a composite mark or in conjunction with another mark may be capable of being use of the mark as registered. However, this is not the case for the above example. Instead, I am required to consider whether it is an acceptable variant of the same. In *Lactalis McLelland Limited v Arla Foods AMBA*,⁴ Mr Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under section 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

⁴ BL O/265/22

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

27. While this test was made in respect of a decision under section 46(2) of the Act, it applies equally to oppositions brought under section 5(2)(b) wherein a mark is subject to proof of use.

28. It is my view that the word ‘HELAN’ is the element of the opponent’s third mark that has the greatest impact on the distinctiveness of the mark. While that may be the case, the mark itself contains a number of additional elements, none of which will be entirely overlooked. While they may have a lesser impact on the mark as a whole, I do not consider that any of them will be considered entirely non-distinct. While they may be allusive, for example the words ‘COSMESI DI LABORATORIO’ may allude to the words ‘cosmetics’ and ‘laboratory’, this does not make them entirely non-distinct, particularly given their presentation in a foreign language. This will, in my view, require some thought process on behalf of the consumer. Further, given that the mark is made up of several separate components all falling within a

shaped background, I am of the view that the get-up of the mark as a whole enjoys some degree of distinctiveness. As for the example shown above, I note that aside from the inclusion of the word 'HELAN', none of the elements present in the opponent's third mark are included. Further, the word 'HELAN' sits underneath the words 'I COLOR DI' which themselves sit below a large, coloured square. While 'I COLOR DI' is likely to bring the word 'colour' to mind (which may be allusive in nature on the basis that it is displayed on alternatively coloured lipsticks), it is not lacking in distinctiveness. On the contrary, I find that it, arguably, enjoys an equal impact on the example with the word 'HELAN' on the basis that it is displayed in a large typeface at the start of the verbal element of the mark (by nature of its being above). Even if it is not the case that it is on equal footing with the word 'HELAN', it no doubt contributes to the example's distinctive character.

29. It is my view that the alterations in the example shown above are not simply the alteration of non-distinct elements and/or the additional of descriptive elements (being examples of acceptable variants as set out in the case law above). Instead, I am of the view that the differences between the marks significantly alter the distinctive character of the opponent's third mark to the point that it is not an acceptable variant of the same. Even if I am wrong and the elements removed from the opponent's mark are non-distinct and the additional words in the opponent's third mark are suggestive or allusive, it does not alter the outcome that the example shown is not an acceptable variant of the opponent's third mark. This is on the basis that the alteration of the get-up of the opponent's third mark as a whole is significant and, in my view, sufficient to alter the distinctive character of the mark, regardless of the role of the elements altered. For the avoidance of doubt, the example shown above is not an acceptable variant of the opponent's third mark and the goods which are shown in the evidence as being those sold under the banner of this mark will not be of any assistance to the opponent.

Sufficient Use

30. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.⁵
31. As I have discussed at paragraphs 10 to 12 above, the applicant made criticisms as to the reliability of the evidence at issue on the basis that it was given by the opponent's legal representative and not the opponent itself. Following on from the same reasoning provided when discussing this point above, I am content to proceed to consider the evidence as filed.
32. Having reviewed the evidence, I note that the main evidence of use comes in the form of a number of invoices. At the hearing, the opponent's representative set out that these were sample invoices. A point which was disputed by the applicant's representative on the basis that the narrative evidence does not confirm this. I agree with the applicant in that there is nothing further within the evidence to suggest that they are sample invoices. While I cannot accept that they point to sales beyond what they specifically show themselves, I have no reason to disbelieve their accuracy or that they are reflective of sales during the relevant period. I am, therefore, content to conclude that the invoices are capable of pointing towards the existence of sales.
33. The first set of invoices focus on sales to one UK company⁶ whereas the second set focus on sales across a number of countries within the European Union.⁷ I will deal with these sets of invoices separately.
34. Firstly, I note that the UK invoices are all dated between 15 December 2015 and 15 October 2020 being within the relevant period. I do not intend to summarise the entirety of the invoice evidence but note that there are 51 invoices, all of which bear the opponent's third mark in the top left hand corner. I note that the invoices are not in the English language but do not consider this to be an issue as the

⁵ *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁶ Exhibit CRB1

⁷ Exhibits CRB3 to CRB7

content of the invoices are self-evident. I raise the same issue here as the applicant did at the hearing in that there is nothing further outside the provision of the invoices to suggest a total amount of sales or any confirmation (in evidence) that these are sample invoices of a larger base of sales. I note that the opponent has not provided a total of the sales obtained via these invoices, however, I note that, at the hearing, the opponent's representative did provide some broad calculations as to the total figures that the invoices show. In respect of the UK invoices, the opponent's representative calculated that the invoices added up to well over €100,000. When assessing the evidence prior to the hearing, I did make my own assessment and calculations of the invoices. While I did not undertake a detailed calculation, I note that the majority of the invoices range from around €1,000 to €3,000 with the lowest invoice being €230.40 in total with the highest being €7,387.84. While these points are all noted, I note that the invoice totals include shipping and palette costs.

35. When assessing the invoices, I was able to marry up a majority of the goods sold via the invoices to products that bear the opponent's third mark by way of cross-referencing the product codes with the price list provided in the evidence.⁸ I note that the opponent's representative sought to provide examples of products that show the opponent's third mark via his skeleton argument. While that may be the case for the majority of the goods sold, it does not apply to them all. For example, I note that the accompanying price list shows goods that are sold under ranges that I am unable to determine whether they include the opponent's third mark or not (OCCHIO AL PIDOCCHIO Specific Shampoo, for example) and neither are they goods that fall within the scope of the specification at issue (scented wipes, for example). On the point of the price list provided, the evidence sets out that this is from 2017 and the applicant takes issue with this in that there is nothing to confirm that the goods shown in the price list are in the same form that they were throughout the relevant period. While this point is noted, it is not necessary for parties required to prove use of their mark to file evidence of the packaging used throughout the entirety of the relevant period. In any event, I am of the view that such an issue should have been raised earlier in proceedings to allow for the opponent to respond by filing additional evidence in reply to confirm this point.

⁸ Exhibit CRB2

Lastly, I note that the invoices provided all bear the opponent's third mark and I have no reason to believe that the goods did not bear the same mark throughout the relevant period.

36. As above, not all goods sold under the invoices bear the opponent's third mark and neither are they all for goods upon which the opponent now relies. Therefore, I am unable to accept that the total of the invoices as being well in excess of €100,000. If accurate sales figures were provided then I would be able to determine the level of sales. However, as it stands, there is no exact figure provided and I do not consider it proportionate (and neither would it be fair to the applicant) for me to undertake a full calculation of those goods sold via the invoices that (1) bear the opponent's third mark and (2) are for the goods upon which the opposition relies. Further, I note the case law set out above, together with section 100 of the Act, which confirm that the burden to prove use is on the opponent.

37. While the UK invoices are noted, they are addressed to one company within the UK only. I note that the additional evidence of Mr Hill sets out that he is the owner of the company that is on the receiving end of these invoices. The evidence sets out that Mr Hill's company began importing the opponent's goods in 2015 and that, as at the date of the statement, his company had generated sales online but was looking to expand onto wholesale markets supplying the high street. Despite this, no further information has been provided to suggest the level of sales that Mr Hill's company has made in respect of the opponent's goods. Having said that, the repeat sales to Mr Hill's company for a sustained period of five years indicate that there was at least some ongoing sales to end consumers by Mr Hill's company online in the UK. While I agree with the applicant's issues with the evidence in that it could have benefited from further explanations as to the level of sales, I consider it reasonable to infer that, on balance, the invoices provided are indicative of a repeated level of sales in the UK. While I cannot speak to the geographical spread due to the fact that the invoices were addressed to one location, the fact that the consequent sales were online is likely to point towards some degree of geographical spread across the UK.

38. The invoices across the European Union are spread across five exhibits, with each set of invoices being broken down yearly, namely between 2016 and 2020. As with the UK based invoices, there is no total sales amount provided in relation to these invoices. At the hearing, the opponent's representative made submissions as to the fact that there were 33 pages of invoices from 2016, 30 from 2017, 28 from 2018 and 30 from 2019. In giving his submissions, the opponent's representative also took me to various invoices in each exhibit, namely an invoice that totalled €13,000 in 2016, invoices that totalled €107,000 and €9,000 in 2017, invoices that totalled €77,000 and €8,600 in 2018 and an invoice that totalled €55,000 in 2019. As above, I also conducted a similar assessment of the invoices prior to the hearing and note that, in addition to the above, there are 27 invoices from 2020. However, I note that some of the invoices span a number of pages meaning that the total page count does not reflect the total invoice count. The invoices cover a wide number of EU countries including the UK (which, at the time was a Member State), Germany, Austria, Italy, Portugal, The Netherlands and Spain, amongst others. While this evidence is noted, the same issues discussed in respect of the UK invoices also apply here in that they also cover marks not relevant to the present issue (namely that the mark shown at paragraph 22 above, upon which the opponent may not rely) and goods that are not subject to the current assessment.

39. No evidence of a market share has been provided but I note that, at the hearing, the opponent's representative set out that the relevant market would no doubt be in the billions of euros. While I have no evidence that supports such a position, it is one that I am inclined to agree with. Against such a large market, the total turnover figures provided for by the invoices are, even at their highest, low. However, this is not fatal to the opponent's position. As confirmed in the case law reproduced above, minimal use may qualify as genuine if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving a market share for the relevant goods. As I have discussed throughout this assessment, I have criticisms of the evidence in that includes sales of goods outside the specification at issue, use of marks not at issue and that it lacks in specific information or explanations that could have been of assistance to the opponent. Further, I bear in mind the nature of the goods at issue, being ones that are likely to be of low cost that are bought relatively frequently. Therefore, the

threshold for what is considered genuine use is, in my view, higher than it would be for goods that are bought less frequently. Even taking all of this into account whilst also noting the lack of evidence as to advertising or marketing expenditure, I am satisfied that the use of the opponent's third mark on goods sold via the invoices in the UK and EU is capable of pointing towards a consistent level of sales by the opponent throughout the entirety of the relevant period. While all of the goods sold via the UK and EU invoices are not clearly done so under the opponent's third mark, I note that the majority of them are. Further, I consider that the repeated nature of sales to one online retailer for a period of five years in the UK is indicative of repeat use that is capable of pointing to some degree of intensity of use. In my view, it is reasonable to infer the nature of the repeat sales is indicative of the fact that those goods were sold on to end consumers across the UK. Even in light of the issues with the evidence and the fact that the level of sales are not quantitatively significant, I am satisfied, on balance, that the opponent has made a genuine attempt to create or preserve an outlet for the goods that bear its mark. The use shown is more than token and, taking all of the above factors into account, I find that the opponent has provided genuine use of its third mark.

Fair Specification

40. I must now consider whether, or the extent to which, the evidence shows use of the opponent's third mark in relation to the goods relied upon.

41. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

42. I note that at the hearing, the opponent's representative set out that the opponent's position was that there had only been genuine use for the following goods and not the entirety of the goods initially relied upon in the notice of opposition:

"Soaps; perfumery, essential oils, cosmetics, hair lotions."

43. In light of this, I will now proceed to assess the evidence in order to determine whether there has been use of the above goods.

Soaps

44. I note that the invoices provided include various soap products, such as “liquid soap” and a number of products identified as “scented vegetable soap”. While this is evidence of just two types of soap, I am of the view that the average consumer would describe such use as “soaps” at large and that they would not seek to identify it using a sub-category of goods. I do not consider it appropriate to limit the opponent’s term as to do so would, in my view, strip the opponent of protection for goods that the average consumer would consider to belong to the same group or category of those for which the mark has been used. Therefore, I accept use of the term “soaps”.

Perfumery

45. I note that the opponent’s invoices show sales of different ranges of “eau de toilette” (both alcohol and alcohol-free), “eau de parfum”, “scented deodorant” and “refreshing deodorant”. These are all types of perfumed goods that are for use on the human body. It is my view that the term “perfumery” at large is not limited to goods that are used on the human body and may also include perfumed goods that are used on items such as textiles or used to scent spaces. While the opponent has not demonstrated use of all variations under the term “perfumery”, I am reminded that this is not a requirement. Instead, I must look at what term the average consumer would use to describe the goods used. I do not consider that the average consumer would consider the use shown as covering all types of perfumery. This is on the basis that the average consumer would be aware of the other uses described above. Instead of describing the use shown as being “perfumery” at large, I consider that the average consumer would describe it using the sub-category of “perfumery for use on the human body”. I do not consider that this strips the proprietor of protection for goods which the average consumer would consider to belong to the same group or category as those for which the mark has

been used. Taking all of this into account, I consider that, for the purpose of a fair specification, the opponent's term should be limited to "perfumery for use on the human body".

Essential oils

46. It is my understanding that essential oils are natural oils that have been distilled or concentrated and are used to give off an aroma. I also understand that essential oils are commonly used as ingredients in perfumes and other cosmetic related goods. The opponent's position is that the good listed as "Olio spray" is an essential oil. While this is noted, I have nothing in evidence to suggest that 'olio spray' is an essential oil and, without anything further, I do not consider it appropriate to infer that it is. I note that the evidence of the price list consists of a wide range of goods that contain essential oils but these are simply ingredients of other goods and not the essential oil product itself. As a result, I do not consider that the opponent has shown any use of "essential oils".

Cosmetics

47. The term "cosmetics" is a very broad term that covers goods that relate to the beautification of the human body, namely the skin, hair or nails. In my view, this covers goods such as make-up, skin care products and goods that are applied to improve the appearance of the hair or nails. I do not consider that cosmetic extends to goods such as shampoo or soaps. While, technically speaking, those goods may be used to improve the appearance of the skin or hair, their main purpose is to clean the skin or hair. To be granted protection for such a broad term as "cosmetics", I am of the view that the opponent is required to provide evidence of use of a fairly sizable range of cosmetics that, when confronted by the use shown, the average consumer would fairly describe the use as covering "cosmetics" as a whole.

48. Having reviewed the evidence, I note that there are sales of slimming cream, softening cream, softening protective oil, moisturising cream, revitalising lotion, lip balm and purifying cleansing mousse. These are all types of goods that I accept

as being used for the purpose of improving the condition of the skin. I appreciate that these cover a wide range of a certain sub-category of cosmetics, however, they do not cover the entirety of cosmetic goods as a whole. I note that no use has been made of the opponent's third mark in respect of any make-up goods which, in my view, is an important category to consider when assessing use of "cosmetics" as a whole. While there are some make-up goods in the invoices, these are all under a mark that I have not deemed to be an acceptable variant and, therefore, are of no assistance.

49. While I accept that the opponent has shown use of a range of goods that fall within the category of "cosmetics", I do not consider it appropriate to grant protection for the term as a whole. This is on the basis that it would provide protection for make-up goods, of which there is no use whatsoever. While I am conscious not to strip the opponent of an appropriate level of protection for the use shown, I consider it reasonable to limit the term "cosmetics" to a sub-category of the term, being "skin care products" on the basis that all of those goods listed above are types of products that are applied to the skin to improve its appearance. I make this finding on the basis that this offers a sufficient level of protection to the opponent and is a sub-category of the term that I consider will be used by the average consumer to describe the use shown.

Hair Lotions

50. At the hearing, submissions were made as to whether shampoo was a hair lotion or not. In my view, shampoo is not a lotion but it is, instead, a type of gel used for cleaning hair. While I do not doubt there are similarities between the two, use of one is not the same as use of the other. Therefore, I do not consider that the opponent has demonstrated any use for "hair lotions".

51. To summarise, I consider that a fair specification of the opponent's goods is as follows:

Class 3: Soaps; perfumery for use on the human body; skin care products.

Section 5(2)(b): legislation and case law

52. Section 5(2) of the Act reads as follows:

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

(a) [...]

(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 or association with the earlier trade mark.”

53. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

54. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

55. The applicants' goods and services are listed at **paragraph one** above. The goods in the opponent's first and second marks' specifications can be found at **paragraph two** above. Further to my findings in respect of genuine use, the goods in the opponent's third mark's specification can be found at **paragraph 51** above.

56. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

57. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;

- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

58. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“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”.

59. In its skeleton argument, the applicant set out as follows:

“Insofar as there is a comparison between class 3 of the application and these earlier trade marks, the Applicant has admitted identity/similarity in the Counterstatement. By reason of the overlap in general and specific terms identity is admitted in relation to the comparison.

Insofar as the opponent asserts similarity in class 35, the grounds as express are such that we invite you to reject similarity.”

60. This point was made in respect of the opponent’s first and second marks only. Given the concession of identity between the goods, I will proceed on the basis

that the goods in the opponent's first and second marks are identical to the goods in the applicant's specification. As for the class 35 services, I will proceed to assess these in detail below. However, before doing so, I consider it necessary to consider the goods in the opponent's third mark's specification. I note that the applicant's primary position is that use has not been proven and a comparison is, therefore, not necessary. However, as I have found above, genuine use has been proven, albeit for a limited specification. I note that the applicant offered a fall-back position that use applies only to "soaps" and "women's perfumery". As per my findings under my fair specification assessment above, I disagree with this fallback position.

Class 3

61. I have set out above that "cosmetics" is a broad term that covers goods such as make-up and other types of skincare products, all used for the improvement of the appearance of the skin. Therefore, I consider that the opponent's "skin care products" falls within the applicant's broader category of goods meaning that they are identical under the principle outlined in *Meric*.

62. I am of the view that the applicant's specific type of cosmetic goods, namely "beauty care cosmetics", "beauty care preparations", "beauty serums", "cosmetic preparations" and "cosmetic oils" are not identical to "skin care products" in the opponent's third mark's specification. While both can be said to be separate types of cosmetic goods, I am of the view that they are not the same in that the applicant's goods are types of make-up related goods whereas the opponent's focus on skin care. However, the goods are similar in that there is some overlap in nature and method of use in that they are all products that are applied to the skin, be that the skin of the body or the face. As for purpose, there is some overlap in that both parties' goods aim to improve the appearance of the skin, however, I appreciate that the opponent's goods improve the appearance of the skin by caring for it (by way of moisturisers, for example) whereas the applicant's goods improve the appearance by covering it in different substances (such as those that cover up blemishes, for example). Further, they overlap in user as someone looking to use make-up, is also likely to be a user of skin care products and vice versa. As for the trade channels of these goods, I consider that they overlap on the basis that it is

common in the trade for a producer of the specific type of cosmetics covered by the applicant's terms to also produce skin care products such as products that assist in the recovery of the skin after wearing make-up, for example. Further, all of these goods are likely to be sold via the same retail outlets with the goods placed within close proximity with each other in physical stores or in the same sections of online stores. I do not consider them to be complementary or competitive. Overall, I consider these goods to be similar to a high degree.

63. "Body care cosmetics", "cosmetic preparations for body care", "cosmetic preparations for skin care", "skin care oils [cosmetic]" and "skin care cosmetics" in the applicant's specification are, in my view, all types of products that fall within the broader category of cosmetics, at large, but are those specifically used to take care of the user's skin, be that the skin of the body or the face. As a result, I consider that these goods all fall within the broader term "skin care products" in the opponent's third mark's specification. They are, therefore, identical under the principle outlined in *Meric*. If I am wrong to make a finding of identity on the basis that the applicant's goods do not fall within the opponent's term, they are highly similar on the basis that these goods share the same overlaps as those discussed at paragraph 62 above

64. "Body and facial butters", "body butters", "body and facial oils", "cleansing oil", "body scrubs", "skin cleansers" and "skin care preparations" in the applicant's specification are all types of skin care products and are, therefore, identical with "skin care products" in the opponent's specification under the principle outlined in *Meric*.

Class 35

65. I do not consider that "advertising services relating to cosmetics" in the applicant's specification is similar to any of the goods in the opponent's marks' specifications. The goods and services share no overlap in nature, method of use or purpose. Further, the applicant's term is a service that I consider is one that is offered to producers of cosmetic products, not members of the general public who would be considered users for the opponent's goods. As for trade channels, the applicant's

service is one that will be offered to its customers by advertising agencies whereas the opponents' goods will be offered by retailers (be that online or in physical stores). There is clearly no overlap here. I do not consider that the goods and services are competitive. Lastly, the parties' goods and services may be complementary to a degree, in that the opponent's range of cosmetic goods in its first and second marks' specifications are likely to be important to the advertising of cosmetic goods thereby leading the average consumer of the opponent's goods (albeit incorrectly) to believe they are provided same undertaking.⁹ However, even though I acknowledge that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,¹⁰ I do not consider this to be the case here. Therefore, given the lack of overlap in all remaining factors, I consider that these goods and services are dissimilar.

66. I am of the view that "providing consumer product advice relating to cosmetics" and "providing consumer product information relating to cosmetics" in the applicant's specification share some degree of similarity with the specific cosmetic goods in the opponent's first and second marks' specifications, namely "body oils [for cosmetic use]", "cosmetic pads", "make-up", "cosmetic purposes", "body creams (cosmetics)", "cosmetics for the use on the hair", "cosmetic creams and lotions for the face and skin care" and "cocoa butter for cosmetic purposes". I also consider that there is also the same level of similarity with the applicant's services and "skin care products" in the opponent's third mark's specification on the basis that skin care products are a sub-category of cosmetic. While the nature, method of use and purpose of the goods are different, the user looking to obtain the product advice and information is likely to be the same as the user for the opponent's goods. Further, the services are likely to be provided by the same undertaking that produces the goods themselves. The goods and services are not in competition but they are likely to be complementary. This is on the basis that the cosmetic goods themselves are important and/or indispensable to the service and the average consumer is likely to believe that the advice and information in relation to

⁹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

¹⁰ *Kurt Hesse v OHIM*, Case C-50/15 P

the goods is provided by the producer of the cosmetic goods themselves. Overall, I consider these goods and services to be similar to a medium degree.

67. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC 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 a degree. I consider that this is the case for both “online retail services relating to cosmetics” and “retail services in relation to toiletries” in the applicant’s specification and the cosmetic goods in the opponent’s first and second marks’ specification such as “make-up” and “skin care products” (on the basis that this covers a range of toiletry goods – being goods that are used to take care of the body) in the opponent’s third mark’s specification, respectively. I am of the view that these respective goods and services are likely to overlap in users as they will be used by members of the general public looking to buy toiletries or cosmetics. As for trade channels, I consider it common in the trade for retailers of cosmetics and toiletry goods to also produce their own range of those goods, or vice versa. As for complementarity, I consider that the goods are likely to be important and/or indispensable to the retail of the same and given how common it is for undertakings to retail their own produced goods, the average consumer is likely to believe that they are provided by the same undertakings. As a result, I consider the goods and services to be similar to a medium degree.

68. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those services I have found to be dissimilar will fail.¹¹ For ease of reference, the opposition fails against the following service in the applicant’s specification that I have found to be dissimilar to the opponent’s goods:

Class 35: Advertising services relating to cosmetics.

¹¹ See *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA and *Waterford Wedgwood PLC v OHIM* - C-398/07 P

The average consumer and the nature of the purchasing act

69. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Insc 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.”

70. In my view, the average consumer for the goods and services at issue will be members of the general public at large. The goods at issue will be available via retailers or their online equivalents, be that specialist or general, where they will be displayed on shelves and self-selected by the consumer. For online retailers, the goods will be displayed on webpages and will be selected by the consumer after having viewed an image of the products. In my view, the visual aspect will dominate the selection process, however, I do not discount the aural component playing a role by way of word of mouth recommendations or after discussions with sales persons or beauticians. Even where this occurs, the consumer will still review the products visually.

71. As for the services at issue, I consider that these will be sought either from salespersons, beauticians or be selected after viewing signage on the high street or online. As for the advisory/information services, these will include an aural component and I consider that this will play an equal role with the visual component on the basis that the selection process will depend on the way in which the

consumer seeks the services (be that online or in person). As for the retail services (be that online or not), the visual component will dominate but, as was the case with the goods at issue, an aural component may also play a part for the same reasons discussed above.

72. It is my understanding that the goods at issue are, for the most part, relatively low cost goods that are purchased relatively frequently. Turning to the level of attention, while some goods may be of low cost, they are all goods that are applied to the human body and, therefore, I am of the view that the goods will attract a medium degree of attention. I consider that the average consumer will consider various factors such as the ingredients of the goods, the compatibility with the user's skin, the cosmetic and/or skin care benefits, whether they were tested on animals and cost. As for the services at issue, these will also be selected relatively frequently as they will be sought when the user is looking to buy goods such as those at issue. The services will be selected after considering factors such as stock, price of goods offered in comparison to other retailers and expertise/knowledge of staff. It is my view that the services will also attract a medium degree of attention during the selection process.

Comparison of the marks

73. It is clear from *Sabel 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.

74. 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.”

75. It would be wrong, therefore, to artificially dissect the trade marks, 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.

76. The respective trade marks are shown below:

The opponent's marks	The applicant's mark
 <p data-bbox="311 1104 708 1137">("the opponent's first mark")</p>	
 <p data-bbox="285 1491 735 1525">("the opponent's second mark")</p>	
 <p data-bbox="304 1816 716 1850">("the opponent's third mark")</p>	

Overall Impression

The applicant's mark

77. The applicant's mark consists of device and word elements. The first word element is the word 'elan' which is presented in a fairly standard black typeface. This sits atop the second word element, being 'SKINCARE', which is presented in a standard black typeface. The word 'elan' is somewhat larger than the word 'SKINCARE'. Both words are surrounded by a black and white circular border presented in what I would describe as a hand-drawn effect. The overall impression of the mark is dominated by the word 'elan' with 'SKINCARE' playing a lesser role due to its descriptive nature (a point that I note was accepted by both parties in their pleadings). As for the border element, I consider that this plays a minimal role.

The opponent's marks

78. The opponent's first mark consists of device and word elements. The central word element is the word 'Veg' which is displayed in a white, conjoined typeface on a black circular background. Surrounding this element is a black and white circular border device. Within that device sits the words 'HELAN' and 'VEGAN' in a standard black typeface. I note that the opponent pleaded that the 'Veg' and 'VEGAN' elements were descriptive because they merely denote goods that are suitable for vegetarians or comprise of ingredients that have not been tested on animals. While I agree with the opponent on the point of the word 'VEGAN', I do not fully agree insofar as it relates to 'Veg'. I am not convinced that 'Veg' will be understood as short for 'Vegan' and, instead, will be understood as short for 'Vegetables'. I agree that this may be understood as a reference to the fact that the products at issue are plant-based in that they are made from vegetables, however, the use of the short-hand 'Veg' is somewhat unusual in my view. Having said that, I am of the view that it will still be viewed as allusive to the ingredients used. Further, it is the largest element of the mark and is placed at its centre. It is my view that the eye of the average consumer will naturally be drawn to this word over the other elements. Having said that, its allusive nature does result in it being attributed less trade mark significance. Balancing these two points out, I am of the

view that 'Veg' will play an equally dominant role in the overall impression of the mark with the word 'HELAN'. As for 'VEGAN', this plays a lesser role and the border/background element plays a minimal role.

79. The opponent's second mark is also one that consists of device and word elements. The words are the word 'zanz' in a standard grey typeface that sits above the word 'HELAN', also displayed in standard grey typeface. Sitting behind these words is the device element, which is a light grey scrawl. The words 'zanz HELAN' dominate the overall impression of the mark with the scrawl playing a lesser role.

80. Lastly, the opponent's third mark consists of the word 'HELAN' that sits on a dark grey curved-top rectangle. To the left of the word 'HELAN' is a small white device that, in my view, will be seen as a receptacle. Above these elements are the words 'cosmesi di laboratorio' and below them sits the word 'GENOVA' with white pointed lines sitting either side of it. All of the word elements are displayed in a white standard typeface. I am of the view that the word 'HELAN' plays the greater role in the overall impression of the marks with the remaining elements all playing a lesser role, save for the background which, as a banal background device, is likely to only contribute to a minimal degree.

Visual Comparison

The opponent's first mark and the applicant's mark

81. Visually, these are both marks that are circular in shape. They are also similar to the extent that they contain word elements that share the letters 'E-L-A-N'. In respect of this point of similarity, I note that the letters are presented in different (albeit both fairly standard) typefaces. Further, these letters in the opponent's mark are preceded by the letter 'H'. This point of difference is at the beginning of that word element and, therefore, will be of particular focus to the average consumer on the basis that they tend to focus on the beginnings of words.¹² The marks differ further in the placement of the elements within the circular shape and the presence of the

¹² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

word 'Veg', which sits as the central element of the opponent's first mark and is an element that I have found to play an equally dominant role in the overall impression of that mark. As for the remaining elements, being the words 'SKINCARE' in the applicant's mark and 'VEGAN' in the opponent's mark, I am of the view that while they play lesser roles in their respective marks, they are points of visual difference. Taking all of the above into account, I am of the view that these marks are visually similar to a low degree.

The opponent's second mark and the applicant's mark

82. Visually, these marks share the same similarities as those discussed at paragraph 81 above, namely that they both consist of a word element that has the letters 'E-L-A-N' in them. Having said that, the same point of difference between these elements also exists here, namely the presence of the letter 'H' at the beginning of the word in the opponent's mark. These words differ in the typeface used and while this similar element is placed prominently at the centre of both marks, I note that the word 'HELAN' is accompanied by the equally dominant element of 'zanz' which, in my view, is a considerable point of difference. The marks differ further in the presence of the word 'SKINCARE' in the applicant's mark. Finally, the marks differ in the presence of the scrawl in the opponent's mark and the circular device in the applicant's mark. While these further differences all play lesser roles in their respective marks, they still contribute as points of visual difference. Taking all of the above into account, I am of the view that these marks are visually similar to a low degree.

The opponent's third mark and the applicant's mark

83. Like those marks discussed above, the same points of similarity in the word elements also exists between these marks. Again, those word elements differ for the same reasons set out above. In these marks, I note that the similar element, being the words 'elan' and 'HELAN' are both placed prominently in their respective marks. The marks differ in the presence of the words 'SKINCARE' in the applicant's mark and the words 'cosmesi di laboratorio' and 'GENOVA' in the opponent's mark. All of the remaining device elements across both marks differ. While these are all

elements that play lesser roles in their respective marks, they are still points of visual difference. Taking all of the above into account, I am of the view that these marks are visually similar to a low to medium degree.

Aural Comparison

84. Before proceeding with the aural comparison of the marks at issue, I am reminded of the case of *Purity Hemp Company Improving Life as Nature Intended*¹³ wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible. While I agree that a number of the word elements in the parties' marks play lesser roles due to their descriptive nature, I am of the view that they will all be pronounced by the average consumer.

85. All of the opponent's marks share the element 'HELAN' and I note that specific mention has been made of the pronunciation of this element throughout these proceedings. Firstly, I note that the opponent's submission in its pleadings was that the letter 'H' is often spoken silently in the English language. I also note that the opponent's evidence in the form of the witness statement of Mr Hill sets out that the mark is normally pronounced with a soft 'H' and that some English speakers pronounced it the same as 'Helen' or as 'Elen'.¹⁴ While this is noted, I do not consider the evidence on this point to be particularly compelling as it is based on the understanding of one individual whereas the assessment I must make is on the average consumer base as a whole. On the point of the pronunciation of the letter 'H', I refer to the case of *ZOHARA*, Case BL O/040/20, wherein Mr Daniel Alexander K.C., sitting as the Appoint Person stated that:

"33. As to this point, it can be important for a tribunal to take account of variations in pronunciation regional and otherwise, especially for consumer goods which are likely to be sold nationwide and where the class of likely customers includes people around the country. However, it is also important to bear in mind the nature of these variations. In some cases, this is as a result of

¹³ Case BL O/115/22

¹⁴ Paragraph 3 of the Witness Statement of Michael Hill

terms being correctly pronounced in a range of ways in that all parts of the mark in question are articulated but with phonetic difference. In other cases, the reason for difference in pronunciation is because (for example) an “H” is dropped or there is elision of syllables – and therefore the whole of the mark is not reproduced. While it would be wrong to approach a case on the basis of hierarchy of accents, or to assume that the average consumer must be a user of received pronunciation, it is appropriate to address a question of similarity of marks on the basis that the average consumer would be expected to pronounce the whole of the mark in aural use and to do so in the most natural way, even if in some real cases, that might not happen. It would unbalance the legal test of similarity if it were approached on the footing that the typical consumer was not expected to use the mark as a whole or was expected to use it in a manner contrary to its normal use.

34. Moreover, it would lead to a situation in which the real source of any likelihood of confusion was not similarity of the marks but failure on the part of some consumers to use the mark fully or properly. There are questions of degree in different cases but just as the tribunal must compare marks as a whole, from the perspective of the average consumer, so should it expect marks to be expressed and heard as a whole in the typical case.”

86. It is my view that, in the present case, it would not be typical for the average consumer to drop the pronunciation of the letter ‘H’. For the reasons set out by Mr Alexander K.C. above, it is my view that the word ‘HELAN’ will be pronounced in full, namely that it will consist of two syllables that will be articulated as ‘HELL-ANN’ or ‘HEEL-ANN’.

87. While I will make the comparisons separately, the pronunciation of the applicant’s mark will be the same throughout. In my view, the applicant’s mark consists of four syllables that will be pronounced as either ‘EEL-ANN-SKIN-CARE’ or ‘ELL-ANN-SKIN-CARE’. This finding will apply to all of the following.

The opponent's first mark and the applicant's mark

88. Clearly, there is some degree of aural similarity between these marks on the basis that the pronunciation of 'HELAN' and 'elan' across both marks are highly similar. However, I cannot discount the presence of the word 'SKINCARE' in the applicant's mark or the words 'Veg' and 'VEGAN' in the opponent's mark. This results in the opponent's mark being five syllables in length. Another point to consider is that it is not clear how the opponent's mark as a whole will be pronounced. Given that 'Veg' is the centre element, I am inclined to consider that it is this word that will be pronounced first with the words 'HELAN' and 'VEGAN' to follow, for example, 'Veg HELAN VEGAN'. The applicant's mark is four syllables in length whereas the opponent's is five. The only point of aural similarity is the pronunciation of 'elan', which sits at the start of the applicant's mark and 'HELAN' which sits in the middle of the opponent's mark. Taking all of this into account, I consider that the marks are aurally similar to a medium degree.

The opponent's second mark and the applicant's mark

89. The opponent's mark consists of three syllables that will either be pronounced as 'ZANZ-HEEL-ANN' or 'ZANZ-HELL-ANN'. As above, the 'HELAN' and 'elan' elements are aurally highly similar. However, I cannot discount the word 'SKINCARE' and note that the word 'zanz' is at the beginning of the mark, being where the average consumers tend to focus. Taking into account the similar nature of the 'HELAN' and 'elan' elements but also bearing in mind the points of difference, I am of the view that the marks are aurally similar to a medium degree.

The opponent's third mark and the applicant's mark

90. As was the case with the opponent's first mark, I consider that it is the central element of the opponent's mark here that will be pronounced first. As a result, I consider that the opponent's mark will be pronounced as 'Helan Cosmesi Di Laboratorio Genova' or as 'Helan Genova Cosmesi Di Laboratorio'. This results in the marks at issue being of considerably different lengths, with the opponent's being fifteen syllables in length with the applicant's mark only consisting of four.

While the first letter differs, the aural similarity sits at the beginning of both marks. I have set out above that this is where the average consumers tend to focus and while the marks are of considerably different lengths, they do share a level of similarity. Taking all of the above into account, I consider that the marks are aurally similar to between a low and medium degree.

91. At paragraph 84 above, I have discussed the *Purity* case and the finding of the Appointed Person. While that is my primary finding, I consider it necessary to discuss this in more detail with regard to the opponent's third mark on the basis that the additional elements after 'HELAN' are of a foreign language and, as a result, I consider it possible that the average consumer in the UK may not attempt to pronounce those words, particularly when taking into account their length. This would leave the aural pronunciation of the mark as simply 'HELAN'. In this scenario, I still consider that 'SKINCARE' will be pronounced but consider that the marks are aurally similar to a high degree on the basis of the aural similarity between 'HELAN' and 'elan'.

Conceptual Comparison

92. Both parties have made submissions and provided evidence as to the meaning of the words within their marks, namely 'elan' and 'HELAN'. I note that the applicant submits that 'elan' is a dictionary word and has provided a screenshot from Harper Collins in her submissions to confirm the same. While this was not filed under the appropriate cover of evidence of fact, it has no impact on my decision on the basis that the existence of a dictionary entry does not necessary mean that it is a word that will be readily understood by a significant proportion of average consumers in the UK. On the contrary, I consider that the average consumer in the UK will either perceive 'elan' as a made-up or foreign language word with no obvious meaning. As for 'HELAN', I note that the opponent's evidence includes a description of the origin of the word, being a portmanteau of HELIOS and ANIMUS.¹⁵ I do not consider that the average consumer would be aware of this meaning that this has no bearing on the perception of 'HELAN'.

¹⁵ Page 2 of Exhibit CRB2

93. I am of the view that neither 'HELAN' or 'elan' would carry any particular concept that is immediately graspable by the UK average consumer. As a result, the conceptual position regarding 'elan' and 'HELAN' is neutral. While I do not consider that either 'elan' or 'HELAN' will be viewed as female forenames, I have, for the avoidance of doubt, given consideration to such a position. On this point, I refer to the case of *Luciano Sandrone v EUIPO*¹⁶ wherein the GC stated that:

“85. [...] a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM— McKenzie (McKENZIE)*, T502/07, not published, EU: T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM— Cortefiel (PEDRO)*, T38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI, T707/16*, not published, EU:T:2018:424, paragraph 65).”

94. Following the findings of the GC, I do not consider it possible to make a conceptual comparison in respect of the words 'HELAN' or 'elan' (insofar as they are understood as forenames) on the basis that they are not names that are particularly

¹⁶ Case T-268/18

well known as the names of famous persons. While I have set out above that 'elan' and 'HELAN' are conceptually neutral, the marks at issue consist of additional matter that will impact their concepts. I will assess these below.

The opponent's first mark and the applicant's mark

95. In addition to the elements discussed above, the opponent's mark consists of the additional words 'Veg' and 'Vegan'. The remaining elements in that mark do not convey a conceptual message. In my view, the word 'VEGAN' will be descriptive of the fact that the products on which the mark is displayed are vegan products, being those derived from plant-based sources. As for 'Veg', the average consumer in the UK will view this as short for 'Vegetables'. I consider that while the inclusion of the word 'Veg' is somewhat unusual (albeit still allusive), it does, in the context of the mark as a whole, convey a similar message to that of 'Vegan' in that the products will be plant-based i.e. made of vegetables. Turning to the applicant's mark, the only additional element that conveys a conceptual message is the word 'SKINCARE'. Plainly, this will be understood as being descriptive of the products on which the mark is displayed, namely that they are skincare products. While some elements of the marks, being 'HELAN' and 'elan', are conceptually neutral, the additional elements (albeit some of those elements playing lesser roles) are points of conceptual difference between the marks. Overall, I consider the marks to be conceptually dissimilar.

The opponent's second mark and the applicant's mark

96. The addition of what the average consumer will consider to be a foreign or made-up word with no obvious meaning, 'ZANZ', prior to 'HELAN' in the opponent's mark will do nothing to alter the findings made above in respect of 'HELAN'. As a whole, the mark will carry no obvious meaning. The position in respect of the applicant's mark will be the same as above, in that 'elan' will be a forename or made-up/foreign word with no obvious meaning accompanied by a clearly descriptive word, being 'SKINCARE'. When comparing the marks conceptually, neither have any particularly distinct meaning outside of the reference to 'SKINCARE'. While this is

a point of slight difference on the basis that it plays a lesser role, it is still a point of conceptual difference. Overall, I consider the marks to be conceptually dissimilar.

The opponent's third mark and the applicant's mark

97. While the words 'cosmesi di laboratorio' in the opponent's mark are in a foreign language, I consider that the average consumer will understand them as alluding to cosmetics that originate from a laboratory. As for the word 'GENOVA', I consider that this will either be seen as an unidentifiable foreign word or be understood as a location, regardless of whether that is the case or not. Lastly, the device element will be identified as the type of receptacle that the goods at issue will be sold in. Comparing this concept with the one taken from the applicant's mark, the only point of conceptual similarity is the reference to cosmetics. This is on the basis that the skincare products referenced in the applicant's mark will be known as a type of cosmetic. Having said that, this is a very slight point of similarity. Given the descriptive nature of these words, I consider that this shared concept only gives rise to a conceptually similarity to a very low degree.

Distinctive character of the opponent's marks

98. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

99. Registered 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In the present case, the opponent expressly pleaded that its marks benefit from enhanced distinctive character as a result of their use. However, the only evidence filed related to the opponent’s third mark and, therefore, I only have the inherent position to consider for the opponent’s first and second marks. I will consider these first before moving to consider the opponent’s third mark.

100. The opponent’s first mark will be viewed as ‘Veg HELAN VEGAN’. Given what I have said regarding the words ‘Veg’ and ‘VEGAN’, it is clear that they will not contribute as significantly to the distinctive character of the opponent’s first mark as the word ‘HELAN’ does. I make this finding despite the placement and role of ‘Veg’ in the mark. I have already discussed the fact that ‘HELAN’ will be understood as either a made-up or foreign language word with no obvious meaning. As a result, I consider that ‘HELAN’ itself enjoys a high degree of distinctive character. While I accept that the elements other than the words ‘HELAN’ have varying impacts on the mark as a whole, I do not consider that they are impactful enough to further the position of inherent distinctiveness beyond the distinctiveness attributed to ‘HELAN’. Therefore, I consider that the mark, as a whole, enjoys a high degree of inherent distinctiveness.

101. Moving to the second mark, I find that, when viewed together, the phrase 'ZANZ HELAN' will either be seen as a made-up or foreign language phrase with no meaning to the UK consumer. It neither alludes to or describes the goods at issue and, in my view, enjoys a high degree of distinctive character. I do not consider that the flourish that sits behind these words will contribute to the distinctiveness of the mark to the point that it will result in a finding of anything higher than the distinctiveness of the words themselves. Therefore, I consider that the mark, as a whole, enjoys a high degree of inherent distinctiveness.

102. Turning to the opponent's third mark, I make a similar finding here to the findings above, namely that 'HELAN' enjoys a high degree of distinctive character. As I have already discussed at paragraph 28 above, the additional elements all contribute to the distinctiveness of the mark (even the get-up of the mark as a whole enjoys a degree of distinctiveness). However, I do not consider that the combination of all of the elements is enough to take the mark beyond the distinctiveness of its dominant element, being 'HELAN'. Therefore, I consider that the mark, as a whole, enjoys a high degree of inherent distinctiveness.

103. As for the claim that the distinctiveness of the opponent's third mark has been enhanced through use, I do not consider that the evidence provided is sufficient to demonstrate this. While I note the presence of a consistent level of sales (via invoices) over a five year period, there is nothing further to suggest the market share enjoyed by the opponent nor is there any evidence regarding advertising or marketing expenditure. Further, the nature of the goods at issue mean that the level of sales, while sufficient for proof of use, are not at a high enough level to the point where a proportion of the relevant section of the public would, because of the use of the mark, identify those goods as originating from the opponent. I make this finding particularly on the basis that the inherent position is high, meaning that any use to enhance this finding would need to be very high and, put simply, the evidence does not meet this threshold. Therefore, the distinctiveness enjoyed by the opponent's mark is in line with the inherent position discussed above.

Likelihood of confusion

104. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

105. I have found the applicant's goods to be either identical or similar to a high or medium degree with the opponent's goods. In respect of the applicant's services, I have found these to be similar to a medium degree. I have found the average consumer for the goods and services to be members of the general public at large who will select the goods and a majority of the services through primarily visual means, although I do not discount an aural component. However, for some services, these will be selected via both visual and aural means. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and services at issue. I have found that the opponent's marks are inherently distinctive to a high degree. In respect of the similarity of the marks, I have found these to be as follows:

- a. The applicant's mark is visually similar to a low degree, aurally similar to a medium degree and conceptually dissimilar with the opponent's first and second marks; and

- b. The applicant's mark is visually and aurally similar to between a low and medium degree (or aurally similar to a high degree in the event that only 'HELAN' is pronounced in the opponent's third mark) and conceptually similar to a very low degree with the opponent's third mark.

106. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that the differences between the parties' marks are sufficient to overcome a likelihood of direct confusion, even taking into account the high degree of distinctiveness of the opponent's marks. The low or low to medium degree of visual similarity between the marks will, in my view, enable the average consumer to accurately recall and/or remember which parties' marks are which. While the 'HELAN' and 'elan' elements of the marks at issue are similar to a degree, the additional elements in the parties' marks will not be overlooked or forgotten. I make this finding even taking into account the fact that 'HELAN' is either the dominant element in the opponent's mark or the element that shares dominance and also the fact that some of the differing elements play lesser roles in their respective marks. In support this finding, I remind myself of the case of *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03 which sets out that where the visual component dominates the selection process of the goods at issue, it will be given more weight. I appreciate that this case related to clothing goods, but I see no reason why it would not apply to the goods and services at issue that will be selected via primarily visual means. Even when the average consumer encounters the marks aurally, the aural differences between the marks are fairly significant and I see no reason why the consumer would misremember or inaccurately recall the marks aurally. Even where the other elements in the opponent's third mark are not pronounced, the 'H' in 'HELAN' will, contrary to the submissions of the opponent, be pronounced and, as it sits at the beginning of the word, it will not be mistaken or overlooked. On this point, I am of the view that the selection of the goods and services at issue will still take place after a visual inspection. Further, I note that outside of the reference to cosmetics in the opponent's third mark, there is no shared concept that would lead the consumer to mistakenly recall/misremember the marks. In any event, any conceptual similarity between them is, in my view, fairly non-distinct. Consequently, I find that there is no likelihood of direct confusion, even in circumstances where the marks at issue

are displayed on identical goods. I will now proceed to consider a likelihood of indirect confusion.

107. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained 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)".

108. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor K.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

109. As above, indirect confusion exists where the differences between the marks are noticed and those differences point to the existence of an economic relationship between the marks at issue (be that being owned by the same undertaking or an economically connected one). While this may be the case, it is still possible for indirect confusion to exist where some differences are overlooked but some are not. In the present case, I have found that the difference between 'HELAN' and 'elan' would not be overlooked and, therefore, do not consider that it is possible for the marks to be imperfectly recalled or misremembered for one another on the basis that there is no plausible rationale for the average consumer to think that 'elan' and 'HELAN' belong to the same or economically connected undertakings. Even if the other differences may be seen as those types of differences that fall within the categories set out by Mr Purvis K.C. in *L.A Sugar*, the elements that will be seen as the reference to the undertaking providing the goods and services at issue (being 'elan' and 'HELAN') will, in my view, indicate the existence of two separate and unconnected undertakings. While it may be the case that the use of 'elan' may call into mind 'HELAN', or vice versa, this is not sufficient and, as set out by Mr James Mellor K.C. in the case of *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, this is mere association not indirect confusion. Consequently, I do not consider that there is any likelihood of indirect confusion between the marks at issue, even on goods that are identical.

110. For the avoidance of doubt, I have also given consideration to the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), wherein Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent

distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

111. I accept that it is possible that the average consumer may consider that the parties’ marks are composite marks and perceive the ‘HELAN’ and ‘elan’ elements of the respective marks to have a distinctive significance which is independent of the significance of the marks as wholes. In such a scenario, it is possible to make a comparison of those elements only which may result in a likelihood of confusion between the marks. However, even in applying the principles set out in *Whyte and Mackay*, I do not consider that there is any likelihood of confusion between the most similar elements of the marks. I note that paragraph 21 of *Whyte and Mackay* (reproduced above) sets out that even where independent distinctive elements are similar or identical, it is not automatically the case that there is a likelihood of confusion. I find that to be the case here. In making a global assessment of these elements, I see no reason why the average consumer would overlook the differences between ‘HELAN’ and ‘elan’, particularly given that the point of difference sits at the beginning which, as I have set out above, is the part of a mark that the average consumer tends to focus on. In addition to this, I note that the ‘elan’/‘HELAN’ elements are relatively short. While I acknowledge that there is no special test which applies to the comparison of ‘short’ marks,¹⁷ I am of the view that in the present case, the average consumer is more likely to notice the differences between these elements. To conclude, I do not consider that the average consumer would confuse these words and, instead, would consider them both to be entirely different (albeit similar) words that point towards different and unconnected economic undertakings and, as a result, are unlikely to either directly or indirectly confuse them.

CONCLUSION

112. The opposition fails in its entirety. As a result, the application may proceed to registration for all goods and services applied for.

¹⁷ See paragraph 44 of *BOSCO*, BL O/301/20

COSTS

113. The applicant has been successful and is, therefore, entitled to her costs. The applicant was, for the entirety of these proceedings save for the hearing, unrepresented. I note that in the applicant's skeleton argument prior to the hearing, mention was made of a costs proforma, however, this was not present on the file so, at the hearing, I asked the applicant's representative to forward a copy of the same to the Tribunal and to the opponent. This was received on 5 October 2022. The applicant claims that she spent the following amount of time on these proceedings.

Notice of Defence:	10 hours
Considering forms filed by the other party:	8 hours
Examining opponent's evidence:	8 hours
Preparing evidence:	32 hours
Preparing written submissions:	2 hours
First and second case management calls:	10 hours
Total:	70 hours

114. There was no opportunity for the opponent to discuss the claimed time spent at the hearing as the costs proforma was not received by them either. However, I did not consider it necessary to seek comment from the opponent in respect of the costs outlined by the applicant on the basis that I can deal with the claims relatively swiftly.

115. I appreciate that the tasks outlined above would have required more of a time commitment by the applicant on the basis that she is a litigant in person. However,

I am of the view that the time spent on the above tasks are on the excessive side. For example, I note that her defence was relatively straight forward with the counter statement being two pages in length. Further, while the evidence filed by the applicant during these proceedings was of some significant length, it was ultimately of no real assistance to the applicant and, in any event, I consider 32 hours to be excessive. Lastly, I note that the applicant elected not to attend the first or second case management conference, although I do note that she did file written observations so I will make an allowance for that. In the alternative, I consider a costs award for the following number of hours to be reasonable:

Notice of Defence:	3 hours
Considering forms filed by the other party:	1 hour
Examining opponent's evidence:	3 hours
Preparing evidence:	5 hours
Preparing written submissions:	1 hour
First and second case management calls:	2 hours
Total:	15 hours

116. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the opponent the sum of £285.00 (15 hours at £19 per hour) in respect of her costs proforma.

117. The applicant also wishes to recover the costs associated with instructing legal representation for the hearing. In respect of these costs, I refer to Tribunal Practice Notice 2/2016 which sets out that costs for attending a hearing are up to £1,600

per day with a cap of £3,300 (unless one side has behaved unreasonably). While the hearing was scheduled for half a day, it lasted no longer than 2 hours and I do not consider that either party acted unreasonably. I will, therefore, make a contributory cost award of £400 in respect of the hearing. Together with the costs set out at paragraph 116 above, this brings to total costs award to **£685.00**.

118. I hereby order HELAN COSMESI DI LABORATORIO S.R.L. to pay Joanna Silva the sum of £685. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 27th day of October 2022

A COOPER
For the Registrar