

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2354835
BY BARE ESCENTUALS, INC
TO REGISTER A TRADE MARK
IN CLASS 3**

BACKGROUND

1. On 31st January 2004 Bare Escensuals, Inc. of 425 Bush Street, 3rd Floor, San Francisco, California 94018, United States of America applied under the Trade Marks Act 1994 for registration of the following trade mark in Class 3:


i.d.

2. The goods for which registration are sought are :

Class 3

Cosmetics, foundation, blush, eye shadow, lipstick and mascara; cosmetic skin creams, lotions and gels, perfumes, essential oils used as cosmetics, body lotions, creams and gels, bath lotions, hair shampoos and hair conditioners, colognes and toilet waters, and cosmetic powders for the skin and eyes.

3. Objection was taken under Section 5(2) of the Act in respect of three earlier trade marks all of which are now registered trade marks. Details of these earlier trade marks are as follows:

Number	Mark	Specification	Proprietor
E2283539	ID HAIR	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices	Cutrin Danmark A/S Filing date: 05.08.1997
E3082931		Cosmetic and make-up preparations	Lancome Parfums et Beaute & Cie Filing date: 24.12.2002
E3401601	COLOR ID	Cosmetic and make-up preparations	Lancome Parfums et Beaute & Cie Filing date: 20.10.2003

4. A hearing was held on 31st August 2005 at which the applicant was represented by Mr Parker of Jeffrey Parker and Company, their trade mark attorney. Following the hearing the objections Under Section 5(2) of the Act were maintained and Notice of Refusal was subsequently issued.

5. I am now asked under Section 76 of the Act and Rule 62(2) of the Trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it.

6. No evidence has been put before me, therefore no claim under Section 7 of the Act has been made.

The case for registration

7. No submissions were made by the applicant or their trade mark attorneys prior to the hearing. At the hearing Mr Parker referred me to seven earlier trade marks, all of which have proceeded to registration. Details of these registered trade marks are at Annex A. Mr Parker sought to persuade me that this, by itself, is sufficient reason for me to conclude that the objections under Section 5(2) of the Act should be waived. Having considered these submissions and taken full account of the earlier registered trade marks referred to I advised Mr Parker that the objections are maintained.

The Law

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

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

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

9. An earlier trade mark is defined in Section 6(1) which states:

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

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

10. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

11. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG*;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*.

Distinctive character of the earlier trade marks

12. The earlier trade marks are registered trade marks and are therefore deemed to be valid (Section 72 of the Act refers). The earlier trade marks do not consist solely of invented words so they cannot be accorded the very highest level of distinctive character.

13. Citation E2283539 consists of the letters and word “ID HAIR”. The word HAIR is a well known dictionary word and requires no further explanation. In respect of “cleaning preparations; soaps; essential oils, cosmetics, hair lotions” I consider the word “HAIR” to be very low in distinctive character although its level of distinctiveness is higher in relation to the remaining goods. The letters ID, in some circumstances, may be identified as an abbreviation for the word IDENTIFICATION although in relation to the goods for which this citation is registered I consider this to be unlikely. The letters ID will be perceived as two letters with no particular relevance for the goods in question. In respect of all of the goods the letters “ID” are meaningless and although it consists of only two letters it possesses an average level of distinctive character. I therefore conclude that this registered trade mark has an average level of distinctive character and that the letters “ID” are its dominant and distinctive component.

14. Citation E 3082931 consists of the word and letters “Color ID” within a fairly nondescript background device. The word “Color” is the American spelling of the well known dictionary word “Colour”. In respect of all goods for which it is registered the word “Color” possesses very little if any distinctive character. By comparison the letters ID, in respect of the goods for which the citation is registered, will be perceived as two letters with no particular relevance or meaning and in my view it possesses an average level of distinctive character. The background device which encloses the words is not particularly distinctive. Although it has a protrusion at the top right hand corner which has the effect of converting it into a possible representation of a label with a hole in the centre of it, this is almost de-minimis within the mark. These elements of the mark are also enclosed with a square device which brings very little distinctive character to the mark. I therefore conclude that this registered trade mark has an average level of distinctive character and that the letters “ID” are its dominant and distinctive component.

15. Citation E3401601 consists of the word letters “COLOR ID”. This mark consists of the same word and letters as citation E3082931 but does not possess the background device. For the same reasons set out in respect of citation E3082931, having taken account that this mark does not possess a background device, this mark also possesses an average degree of distinctive character in relation to all goods for which it is registered and that the letters “ID” are its dominant and distinctive feature.

Similarity of the goods

16. Citation E2283539 is registered in respect of a wide range of goods in Class 3. The applicant has applied for a narrower range of goods but all are identical with the following goods which are contained within the citation’s specification:

“Cleaning preparations; soaps; perfumery, essential oils, cosmetics, hair lotions.”

17. Citations E3082931 and E3401601 are both registered in respect of the following goods in Class 3:

“Cosmetic and make-up preparations.”

These goods are identical with the following goods for which registration is sought:

“Cosmetics, foundation, blush, eye shadow, lipstick and mascara; cosmetic skin creams, lotions and gels, essential oils used as cosmetics, body lotions, creams and gels, bath lotions, cosmetic powders for the skin and eyes.”

Turning to the remaining goods applied for I consider the specifications for both citations to include goods which are similar to “perfumes, colognes and toilet waters”. I say this because of the similarity between the nature of these goods and their respective uses, the relevant consumer is the same and their proximity to each other at the point of sale. In respect of the goods covered by these specifications “hair shampoos and hair conditioners” the level of similarity is lower.

Similarity of the marks

18. Since the trade mark of this application is not identical to the earlier trade mark the matter falls to be decided under sub-section (b) of Section 5(2) of the Act. The question, therefore, is whether the mark of this application is so similar to the earlier trade mark that there exists a likelihood of confusion which includes the likelihood of association on the part of the public.

19. The similarity of the marks must be assessed by reference to the visual, aural and conceptual similarities of the trade marks. It is clear from the judgment of the ECJ in the case of *Sabel BV v Puma AG* that I must assess the overall impressions created by the marks bearing in mind their distinctive and dominant components.

20. The applicant’s trade mark consists of two letters, each followed by a full stop. The mark is “i.d.” Citation E2283539 is registered for the trade mark “ID HAIR” in plain upper case lettering. Citation E3082931 is registered for the words “Color ID” which are contained within a device which resembles a label. Citation E3401601 is registered for the words “COLOR ID”, again in plain upper case lettering.

21. Each of these earlier trade marks incorporate the letters ID within them. In each mark, and in the applicants mark, the letters “i.d.” appear to have no descriptive identity at all. They will be perceived as two letters with no descriptive meaning but possessing an average degree of distinctive character.

22. In relation to citation E2283539 I consider the word HAIR to be very low in distinctive character in respect of “cleaning preparations; soaps, essential oils, cosmetics, hair lotions”, all of which are goods which encompass goods which may be used in relation to lotions for the hair. The letters ID have a dominant and distinctive role within the mark.

23. In respect of citations E3082931 and E3401601 the word COLOR possesses little if any distinctive character in respect of any of the goods for which they are registered. Although it is an American spelling of the English word COLOUR this is a version of the word which the relevant consumer will recognise and will place no other interpretation upon it. In citation E3082931 the letters are placed within a

background which resembles a device of a label but the letters ID still play a dominant and distinctive role within both marks in respect of all of the goods in question.

Likelihood of confusion

24. I must, of course, bear in mind that a mere possibility of confusion is not sufficient. (See e.g. *React Trade Mark* [2000] RPC 285 at page 290) The Act requires that there must be a likelihood of confusion. Furthermore this likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. I have already found that the goods for which the earlier trade marks are registered contains goods which are either identical or similar to the goods applied for. It is clear that where there is a lesser degree of similarity between the trade marks this may be offset by a greater degree of similarity between the goods (and vice versa) - see *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*.

25. Furthermore, it is now well established that the matter must be determined by reference to the likely reaction of an average consumer of the goods in question, who is deemed to be reasonably well informed, reasonably observant and circumspect. In relation to these goods I consider the average consumer to be the general public. I accept that some of the goods in question may be purchased with a degree of care such as perfumes, colognes and perhaps, toilet waters. However, there are goods contained within the terms of the specifications in question where the consumer will not exercise the same degree of care such as cleaning preparations, soaps and hair lotions.

26. The average consumer generally relies upon the imperfect picture of the earlier trade marks that he or she has kept in his or her mind and must therefore rely upon the overall impression created by the trade marks in order to avoid confusion.

27. I must, of course, consider the likelihood of confusion by reference to the visual, aural and conceptual points of similarity. The similarities between the marks and the identical and similar goods which are in conflict are likely to lead to both visual and aural confusion. I have found that the conflicting marks possess an average degree of distinctive character for the goods in question and this is a factor that I have borne in mind in concluding that there are visual and aural similarities between the marks. The applicant has applied to register the mark “i.d.” and these two letters, although in upper case, are incorporated in each of the earlier trade marks. The combination of these two letters is distinctive and in each citation this combination is a distinctive element within the marks. Furthermore, the words “HAIR” and “COLOR” which appear within the earlier mark will not be perceived as indicators of trade origin but as descriptive matter. I must, of course, take full account of the device elements in citation E3082931 but as I have already indicated I do not consider that these are sufficient to remove the likelihood of confusion. I also take full account of the fact that the applicant’s mark is in lower case lettering whereas in each of the earlier trade marks the letters ID are in upper case. This a very slight difference in the presentation of these two letters and it is one which would not be noticed or recalled by the relevant consumer of the goods in question. In my view there appears to be two ways in which confusion could occur between these marks. Firstly, consumers could mis-recollect the earlier marks as “i.d.” marks because that is the dominant impression that they create. Secondly, consumers will notice the differences between the marks,

but because of the prominence of “i.d.” and “ID” in the earlier marks, and the identity and similarity of the respective goods, mistakenly believe that the applicant’s mark is indicative of an economic connection between the applicant and the proprietor of the earlier marks.

28. Mr Parker has referred me to seven registered mark which incorporate the letters ID and has suggested that these should influence the outcome of this application. I do not accept this.

29. I am unaware of the circumstances surrounding the acceptance of these marks and they are of little if any assistance in determining the outcome of this application. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

30. I have concluded that the identical and similar goods that I have identified, coupled with the average degree of distinctive character of the marks and the similarity between them, is sufficient to give rise to a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

CONCLUSION

31. In this decision I have considered all of the documents filed by the applicant and all of the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

Dated this 28th day of February 2007

A J PIKE
For the Registrar
The Comptroller-General