

O-240-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2460482  
BY THE CHI SPA DE BIENESTAR SL**

**TO REGISTER THE TRADE MARK:**



**IN CLASSES 3, 35 AND 44  
AND**

**THE OPPOSITION THERETO  
UNDER NO 95843  
BY HC INTERNATIONAL SA**

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### ***Background***

1) On 8 July 2002 The Chi Spa De Bienestar SL (Bienestar) applied to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) for registration of the above trade mark (the trade mark). Bienestar subsequently requested that the application be converted to national applications in Spain, Portugal and the United Kingdom as per article 108 of Council Regulation 40/94 of December 20, 1993. It was so converted in the United Kingdom as per section 52(2)(c) of the Trade Marks Act 1994 (the Act) and regulation 10 of the Community Trade Mark Regulations 2006. The application was published for opposition purposes on 5 October 2007 with the following specification:

*soaps, perfumery, essentials oils, cosmetics, hair lotions;*

*information and advice services in relation to the retail sales of perfumery and cosmetics; import-export services of perfumery and cosmetics;*

*hygienic and beauty care; beauty salons; manicuring; hairdressing salons; hair implantation.*

The above goods and services are in classes 3, 35 and 44 (respectively) of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 7 January 2008 HC International SA (International) filed a notice of opposition against the registration of the trade mark. International relies upon section 5(2)(b) of the Act which states that a trade mark shall not be registered if because:

“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.”

The earlier trade mark upon which International relies is Community trade mark registration no 2770410 for the trade mark:



It has an international priority date from the Benelux of 17 May 2002. The application was registered on 7 January 2004 for goods and services in classes 3, 5, 29, 30 and 44 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. International only relies upon the goods and services in classes 3, 5 and 44:

*soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;*

*pharmaceutical and sanitary preparations; dietetic substances adapted for medical use;*

*medical services; hygienic and beauty care for human beings.*

3) International states that the trade mark primarily consists of the letters CHI combined with the word spa and a flower logo. It states that the letters C and H are highly prominent within the trade mark. International states that its trade mark consists of the letters H and C in a stylised HC combination together with the name Henri Chenot and the descriptive phrase Sources de santé, which means sources of health. It claims that the letters H and C are highly prominent in the trade mark. International states that the respective trade marks are highly similar; in particular they are visually similar to one another as the logo containing the letters C, H and I is visually similar to the HC logo. It states that the flower element in the trade mark is less prominent within it and that spa is largely descriptive. International claims that the letters HC in its trade mark bring to mind the letters CHI in the trade mark. It states that there is a similar degree of stylisation used in both designs which feature similar curved devices, making the trade marks highly similar visually. International states that the respective goods and services are identical or highly similar.

4) Bienestar filed a counterstatement. It states that the trade mark consists of a flower device, the word CHI in a stylised form and the word spa in lower case. Bienestar gives definitions from the *Collins English Dictionary & Thesaurus* (third edition 2004) for the words chi and spa. Chi is defined as meaning, in Oriental medicine, martial arts etc, vital energy believed to be circulated round the body in currents. Spa is defined as being a mineral spring or a place or resort where such a spring is found. Bienestar states that spa can be loosely understood to mean any place or treatment that is connected with physical, mental or spiritual health. It states that its trade mark slants downwards from left to right with the visual impact being shared roughly equally between the three constituent elements, the device of a flower and the words CHI and spa. Bienestar states that the trade mark would be pronounced as "chee spar". Bienestar claims that the phrase CHI SPA would be understood to mean a place or treatment which uses vital energy to improve physical, mental or spiritual health. It states that International's trade mark comprises a circular logo in the centre of which are the "conflated" letters H and C, the name HENRI CHENOT and the strap line Sources de santé. International states that the "conflated" letters H and C would be seen by the public as the initials of the name HENRI CHENOT. Bienestar refers to the Intellectual Property Office's practice in relation to the registrability of abbreviations (sic):

"...M.G.S. MISSILE GUIDANCE SYSTEM" has no distinctive character for electronic guidance systems. If it is not a known abbreviation, it may be the public would not penetrate the meaning of M.G.S. alone, but once combined with words describing the goods in question, the letters become no more than an abbreviation for the type of technical goods at issue.

Bienestar states that similarly the distinctiveness of the circular logo in International's trade mark is reduced by the virtue of the fact that it would be seen as no more than a stylised representation of the initials of the name HENRI CHENOT. Bienestar claims that the primary distinctive element of International's trade mark is the name HENRI CHENOT. It states that the majority of United Kingdom consumers would not know of the meaning of Sources de santé or would assume that it means source of health (sic). Bienestar states that the pronunciation of the word elements of International's trade mark would vary according to the consumer's knowledge of French. In any event, Bienestar's trade mark would be pronounced differently to that of International. Bienestar states that International's trade mark is organised vertically, when it is traced it takes a form similar to that of an arched window. Consequently, Bienestar claims that the respective trade marks are visually, phonetically and conceptually different.

5) Bienestar accepts that the class 3 goods of its application are identical to the class 3 goods of the earlier trade mark. It states that *hygienic and beauty care*, *beauty salons* and *manicuring* in its application are similar or identical to *hygienic and beauty care for human beings* of the earlier trade mark. Bienestar states

that *hairdressing salons* and *hair implantation* are dissimilar to the goods and services of the earlier trade mark, it states that one would not normally go to a beauty salon for hairdressing services, for example. Bienestar states that *hair lotions* of the earlier trade mark are dissimilar to hair dressing services, it notes that on the Intellectual Property Office cross search list there is no link between classes 3 and 44. Bienestar states that the class 35 services of the application are similar to the class 3 goods of the earlier trade mark.

6) Bienestar denies that there is a likelihood of confusion.

7) Bienestar filed evidence in support of its application. Neither side requested a hearing. International furnished written submissions.

### ***Evidence of Bienestar***

8) This consists of a witness statement made by Mr David Tate. Mr Tate is a trade mark attorney representing Bienestar. The witness statement consists of the counterstatement with paragraphs topping and tailing it in order to put it into the format of a witness statement. Consequently, the statement consists mostly of submission rather than evidence of fact and has been covered by my summary of the counterstatement.

### ***Average consumer and nature of purchasing decision***

9) The class 3 goods are purchased by the public at large. They can be goods of low cost. They are not goods whose nature of itself will normally lead to a careful and educated purchasing decision; the nature of the purchasing decision will be more likely to depend on the costs of the goods rather than of the nature of the goods. The nature of the purchasing decision means that the potential effects of imperfect recollection are increased. However, it is to be born in mind that the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant<sup>1</sup>. *Information and advice services in relation to the retail sales of perfumery and cosmetics* I find ambiguous<sup>2</sup>; is the advice being given to retailers or those purchasing from retailers? As the specification can be read in both ways I need to consider it from both perspectives. In the former case the nature of the purchaser of the services means that a good deal of care will be used in making use of the services. In the latter case the relevant public

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<sup>1</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>2</sup> In considering the service specifications I take into account the judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

is the public at large, the goods to which the services relate being bought by the public at large who are likely to suffer more from the effects of imperfect recollection. *Import-export services of perfumery and cosmetics* are services that will be provided to a commercial undertaking, they are services that will be purchased as the result of a careful, educated commercial decision. Owing to the nature of the purchasing decision, the potential effects of imperfect recollection will be diminished. All of the class 44 services, of both the application and the earlier registration, are services that are purchased by the public at large. *Hygienic and beauty care; beauty salons* appear to me to be services that will normally be purchased with a good deal of care; the purchaser not wanting to suffer debeatification rather than beautification, caution is likely to be the watchword. Within the breadth of the terms there will be varying degrees of care taken eg the purchaser of botulinum toxin injections is likely to be more wary than the purchaser of a facial. However, in both cases there is likely to be a good deal of care taken, they are unlikely to be services that are purchased on impulse. Consequently, in relation to these services the effects of imperfect recollection are likely to be limited. There is nothing in the nature of a *manicuring* service that suggests that use of the service is the result of a particularly careful and educated decision. Consequently, the effects of imperfect recollection are likely to be increased. *Hairdressing salons* are services that may be purchased with a good deal of care and prudence, however, they can also be purchased very casually, eg dropping into part of a salon which is a barbers. Consequently, the nature of the service itself does not dictate the care that will be taken in the purchase. Consequently, taking the term in all its possible manifestations, the effects of imperfect recollection are increased. *Hair implantation* is a service that will be expensive and has potentially serious effects if not effected in a proper fashion. It is a service that will be purchased as a result of a careful and educated decision. Consequently, the effects of imperfect recollection will be diminished.

### ***Comparison of goods and services***

10) Bienestar accepts that all of the respective goods and services are identical or similar with the exception of *hairdressing salons* and *hair implantation*. Taking into account the nature of the respective goods and services I consider that those services which Bienestar considers similar are highly similar to the goods and services of the earlier registration.

11) Bienestar submits that, as examples, that *hairdressing salons* are not similar to beauty salons as one would not generally go to the latter for hairdressing services and that *hairdressing salons* are not similar to *hair lotions* on the basis that there is no link between class 3 and class 44 on the cross search list.

12) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of

trade<sup>3</sup>". Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>4</sup>. Consideration should be given as to how the average consumer would view the goods or services<sup>5</sup>. The class of the goods and services in which they are placed is relevant in determining the nature of the goods<sup>6</sup>. In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary<sup>7</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>8</sup>. In considering the services the judgment of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 must be taken into account (see above).

13) The class 44 specification of the earlier registration is not for beauty salons but for *beauty care*. In its submissions International submits that *beauty care*

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<sup>3</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>4</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>5</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

"In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use"

<sup>6</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>7</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>8</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- (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."

should include hairdressing or similar services. This seems to be the sort of argument that was dealt with in *Avnet*, interpreting the term beyond the core of the possible meaning attributable to the rather general term. I view beauty care, in the absence of evidence, as relating to such services as furnishing facials, manicuring and depilatory services; although the last services relate to the removal of hair I am not aware of them being available in a hairdressing salon and I certainly do not consider that they would be described as a hairdressing service. I do not consider that either the average consumer or the trade would view *beauty care* as encompassing *hairdressing salons*, hairdressing is a long established trade and I, certainly, have never heard it described as beauty care; even if the intention of hairdressing may be to improve the appearance. International also submits that it believes that it is common knowledge that hair salons provide ancillary services such as nail treatments, tanning services, massages, hair depilatory treatments and facial treatments. By common knowledge I assume that International considers that this is a notorious fact that should be taken on judicial notice. I am not aware that this is the case, even if it maybe; perhaps if I was female I might be aware of this, if it is the case. Consequently, I cannot take the claim by International on judicial notice. It is a matter that it needs to establish by evidence and it has furnished no evidence. It is to be remembered that in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 the European Court of Justice (ECJ) stated:

“22. It is, however, important to stress that, for the purposes of applying Article 4(1)(b), even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 4(4)(a), which expressly refers to the situation in which the goods or services are not similar, Article 4(1)(b) provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar.”

The court required evidence of similarity to be adduced. This finding has been reiterated by the ECJ and the Court of First Instance (CFI) eg in *Commercy AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-316/07:

“43 Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

The above part of the *Canon* judgment has been more recognised in the breach than in the observance in this jurisdiction. It may not always be practical to adduce evidence of similarity; it may be that the nature of the goods or services



is so well-known that it would be a waste of effort and resources to do so. In relation to the comparison of *beauty care* with *hairdressing salons* I can still consider the matter within the parameters set out by the case law, as there are some matters which do not require evidence. Both sets of services are to improve the appearance of the individual, so they have the same general purpose and the same general user, although this is on a very general level. I cannot see that the respective services are fungible and so they are not in competition. The concept of the complementary nature of goods and/or services has been dealt with by the Court of First Instance (CFI) on a number of occasions. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

I cannot see that the respective services are indispensable or important to each other; they are not mutually dependent and there is no symbiotic relationship between them. The respective services are not complementary. Consequently, any similarity between *beauty care* and *hairdressing salons* is very limited. International has not submitted that *hairdressings salons* are similar to any other goods or services of the application.

14) International submits that *hair implantation* has the aim of improving a person's appearance and, therefore, must fall within the ambit of *beauty care*. Again this is interpreting the term beyond the core of the possible meaning attributable to the rather general term. As far as I am aware, there is no evidence in relation to this, *hair implantation* is a discrete service that is supplied by specialist clinics. It is not fungible with *beauty care* and not complementary, as per *Boston Scientific*. The only point of intersection is at the most general of levels, that of being to improve the appearance of a person; a level so general that I do not consider that it is such as to make the service similar to *beauty care*, which is the basis of the submissions of International. It requires a *reductio ad absurdum* approach to find the respective services similar. (On the argument proffered the supply of prostheses would be covered by *beauty care* as they can also improve the appearance.)

## Comparison of trade marks

15) The trade marks to be compared are:

### Application



### Earlier registration



16) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>9</sup>. 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<sup>10</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>11</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>12</sup>.

17) In its statement of grounds International states that the trade mark of Bienestar includes the letter C,H and I. In its submissions it states:

“Whilst we, as the Opponent’s attorneys, know that this element is intended to be word CHI, this is only because we have been told that this is the case.....In the absence of being educated as to the significance of that element in the mark, the impression is that of an H within brackets.”

International appears to resile from its initial position. I have to consider how the average consumer for the various goods and services will view the respective trade marks, a matter that I can only effect through my own impression.

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<sup>9</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>10</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>11</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>12</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

Consumers do not analyse trade marks, they do not seek meaning within them or seek to identify specific elements; although some elements are likely to be distinctive and dominant.

18) There is no dispute that Bienestar's trade mark includes the stylised device of a flower, an element which is most certainly not lost in the trade mark as a whole. It is a distinctive element of the trade mark. In my experience the word spa is commonly used in relation to both beauty services and beauty products, having expanded from its use in relation to health spas. In relation to some of the goods and services of the application it has no distinctiveness, and in relation to others very limited distinctiveness. My first impression of the other parts of the trade mark was that it was simply a device, I did not see those parts as being letters, or a letter between two brackets. Scrutinising it more deeply, which the average consumer is unlikely to do, the middle element appeared to me to be more like the musical notation for a sharp with one of the cross members missing. Owing to the length and position of the two uprights and the cross member, I find it difficult to see a letter H; even after considering the submissions and claims of the parties. I cannot imagine anyone, without being told, seeing the word CHI. Owing to the common style in which they appear and the clearly identifiable nature of the flower and word elements, the "other parts" of the trade mark do appear to form a whole. So there are three elements: the flower, "the other parts" and spa. Owing to its size the second element is both a distinctive element and the dominant element. However, it does not subsume the flower device in any way.

19) International's trade mark includes the words HENRI CHENOT and Sources de santé. HENRI CHENOT is likely to be seen as a full name and so "hangs together". In my experience the knowledge of the average United Kingdom consumer of other languages is exceptionally limited. Sources is an English word and so should be understood by the average consumer, however, I do not think that the average consumer will know what de santé means. As a whole Sources de santé for the average consumer will not have a meaning and will not be lacking in distinctiveness, as it would to Francophones. The device element of International's trade mark is placed in a prominent position and takes up as much space as the word elements. International, in its submissions, claims that the central part of the device element will be seen as a stylised H. In its statement of grounds International states:

"The Opponent's mark consists of the letters "H" and "C" in a stylised "HC" combination..... The letters "H" and "C" are highly prominent within the mark."

International appears to be resiling from its initial position. My first impression of the device element was to see it simply as a device element. On further scrutiny of the device element the central part might be seen as a letter H but I am not convinced by this. I certainly cannot see the central part of the trade mark as

being the letters H and C coalesced. All three elements of International's trade mark are distinctive. Owing to their size and position I consider that the words HENRI CHENOT and the device are more dominant than Sources de santé. However, I do not consider that either of the first two elements can be considered to be more dominant than the other.

20) The flower device and spa of the application are completely alien to the earlier trade mark. The words of the earlier trade mark are, in turn, completely alien to the application. The device element of the earlier trade mark includes two curved lines on a horizontal plane. The middle part of the application has two curved lines on a vertical plane. The central parts of both the device element of the earlier trade mark and the middle part of the application consist of two vertical lines and one horizontal line. In the earlier trade mark the vertical lines are at the same level, in the later trade mark they are at different levels. In the earlier trade mark the horizontal line passes through only one vertical line, in the later trade mark it passes through both verticals lines. However, a description of the structure of the device elements does not greatly assist in considering the overall effect, one is left with a reductionist approach that says nothing about the perception of the trade marks. In considering the respective trade marks I must compare them in their entirety, take into account their overall impressions. In the case of the application the stylised flower is very much part and parcel of that overall impression. **I find that the respective trade marks are not similar.**

### **Conclusion**

21) Having found that the respective trade marks are not similar there can be no likelihood of confusion, similarity of trade marks is part of the cumulative process that can lead to a finding of likelihood of confusion. In coming to this conclusion I have taken into account that the word element of the application is either without distinctiveness or, for some goods and services, of very limited distinctiveness. So it is the device elements of the application that the average consumer will keep in the memory and so if the respective device elements were similar the word elements of the later trade mark would not obviate confusion necessarily; the device elements acting as a common thread that could indicate that the goods and services come from the same or an economically linked undertaking. I have kept in mind the judgments of the ECJ in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* Case C-120/04 and *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P and the order of the ECJ in *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-3/03 P and in particular that although the comparison must be made by examining each of the marks in question as a whole, this does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components.

## **Costs**

22) Bienestar having been successful is entitled to a contribution towards its costs. As the evidence it furnished was, to all intents and purposes, the same as its counterstatement I will make no award in relation to the evidence. I make an award of £600 in relation to the counterstatement and the consideration of International's statement of grounds. I order HC International SA to pay The Chi Spa De Bienestar SL the sum of £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

**Dated this 13<sup>th</sup> day of August 2009**

**David Landau  
For the Registrar  
the Comptroller-General**