

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2519091

BY SANDRA AMALIA MARY ELLIOTT

TO REGISTER THE TRADE MARK “LUV”

AND THE OPPOSITION THERETO UNDER NO. 99720 BY LRC PRODUCTS LIMITED

AND IN THE MATTER OF APPLICATION NO. 2534564

BY LRC PRODUCTS LIMITED

TO REGISTER THE TRADE MARK “LOVE”

AND THE OPPOSITION THERETO UNDER NO. 100555

BY SANDRA AMALIA MARY ELLIOTT

DECISION

INTRODUCTION AND BACKGROUND

1. On 20 June 2009, Sandra Amalia Mary Elliott applied to register LUV as a trade mark in class 10 for the following goods:

Massage instruments and apparatus; manually operated massage devices; instruments and apparatus for vibromassage; sexual massage devices and apparatus; stimulators; vibrators; dildos; apparatus for the treatment of sexual dysfunction; erection aids; sex toys; sexual aids and appliances; parts and fittings for all the aforesaid goods.

2. The application was published in the Trade Marks Journal on 7 August 2009 and, on 6 November 2009, it was opposed by LRC Products Limited (“LRC”) on the grounds that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) because there would be a likelihood of confusion with its earlier marks. Those earlier marks are as follows:

Community Trade Mark (“CTM”) 3052768

LOVE

Class 5: Contraceptive preparations and substances, spermicidal gels, liquids and creams; hygienic lubricants and disinfectants.

Class 10: Condoms; contraceptive, hygienic or prophylactic devices.

2432028

WE MAKE LOVE

Class 3: Non-medicated wipes; toiletries; sanitary preparations; non-medicated preparations for the bath in the form of salts, oils and soaks; moisturising preparations; essential oils; massage oils; room sprays.

Class 5: Pharmaceutical preparations and substances; contraceptive preparations and substances; spermicidal gels, liquids and creams; hygienic lubricants; lubricants for personal use; disinfectants.

Class 10: Condoms; contraceptive, hygienic or prophylactic devices; massage apparatus, instruments and appliances; electric and electronic massage apparatus, instruments and appliances; body massagers; personal massagers; vibrators; vibrating rings; marital aids; sex aids; parts and fittings for all the aforesaid goods.

3. LRC claimed that there is a likelihood of confusion, contending that, in the case of its earlier mark LOVE, LUV and LOVE are phonetically and conceptually identical, the two spellings are interchangeable, and the goods in the application are complementary to those of its earlier mark, will be used together and sold through the same trade channels. In the case of its earlier mark, WE MAKE LOVE, LRC claimed that there is a likelihood of confusion because the spellings of LUV and LOVE are interchangeable and the addition of “WE MAKE” does not substantially alter the distinctive character of WE MAKE LOVE. It claimed that the goods are either identical (class 10) or similar, being complementary.

4. Ms Elliot filed a counterstatement on 7 January 2010, denying the grounds of opposition. Meanwhile, on 16 December 2009, LRC filed a trade mark application for the mark LOVE in class 10, the amended specification of which now reads:

Massage apparatus; personal massagers; vibrators; vibrating rings; parts and fittings for all the aforesaid goods.

5. This application was published on 26 February 2010 and was, in turn, opposed by Ms Elliott on 26 May 2010. She opposed that application under section 3(1)(c) and section 3(1)(d) of the Act. Ms Elliott also opposed it under section 5(2)(b) of the Act on the basis of her earlier trade mark application 2519091, which is itself opposed by LRC, as noted above. LRC filed a counterstatement on 2 August 2010 in which it denied all of Ms Elliott's grounds of opposition.

6. The proceedings were consolidated by the Trade Marks Registry. Both parties filed evidence and the matter came to a hearing. At the hearing, LRC withdrew its defence against Ms Elliott's section 5(2)(b) ground of opposition. The effect of this is that if LRC's opposition against Ms Elliott's application failed, its application would be refused because Ms Elliott would succeed on the undefended section 5(2)(b) ground, regardless of the success or failure of her section 3 grounds.

7. The Hearing Officer considered LRC's section 5(2)(b) ground against Ms Elliott's application for LUV first and rejected it with the result that Ms Elliott's mark was allowed to be registered. LRC's application was accordingly refused.

8. LRC appeals against that decision.

GROUND OF APPEAL

9. By the time of the hearing before me, LRC's case in summary was that the Hearing Officer had erred in the following respects:

- (a) in her approach to evaluation of similarity of the respective goods and, in particular, in the approach to application of the principles relating to complementarity;
- (b) in her approach to evaluation of how the marks would be considered and, in particular, the emphasis given to the visual appreciation of the marks;

- (c) in her approach to assessing the distinctive character of the earlier mark and, in particular, that the evaluation amounted to attributing no distinctive character to that mark.

10. LRC submitted that these errors all fed into the overall evaluation conducted by the Hearing Officer and that if any material error was identified in the approach to assessment of one or more of these factors, that would require this tribunal to reconsider the matter afresh. The argument rightly focused on the case based on the “LOVE” mark.

APPROACH TO THE APPEAL

11. Neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court (*Reef Trade Mark* [2003] RPC 5 and *BUD Trade Mark* [2003] RPC 25). Before that is warranted, it is necessary for this tribunal to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. As Robert Walker LJ (as he then was) said:

“...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle” (*Reef* at [28])

12. That approach was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation.

LRC’S MAIN CRITICISMS OF THE DECISION

13. Each of LRC’s criticisms of the Hearing Officer’s decision involves some analysis both of the law and of the facts and it is convenient to take the points in turn.

(a) Similarity of goods

Law

14. The Hearing Officer set out the law relating to similarity of goods as follows:

Comparison of goods

26. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (“*Canon*”) where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06 (“*Boston*”):

“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...”

27. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services included an assessment of the channels of trade of the respective goods or services. Jacob J also said, in *Treat*:

“When it comes to 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. After all a trade mark specification is concerned with use in trade”.

28. Finally, if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical.

15. A formulation of the law by the same Hearing Officer in very similar terms was accepted without criticism by either party or by Floyd J (as he then was) *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) and the Hearing Officer’s statement of the law cannot be faulted.

16. However, because of the particular grounds of appeal in this case, which did not arise in the *Youview* case, it is necessary to make three observations about that summary as it applies to the present case.

17. First, the starting point for the analysis of similarity is the wording of the Act and the Directive. These require the tribunal to determine whether or not the respective goods are “identical or similar” but they do not specify the criteria by reference to which similarity is to be assessed. In the well-established guidance from the Court of Justice on this issue originating in *Canon*, to which the Hearing Officer referred, the Court has not suggested that every case requires assessment of whether the respective goods or services are complementary. To the contrary, the Court has regularly made it clear that all relevant factors relating to the goods or services themselves should be taken into account, of which complementarity is but one (see e.g. in *Boston*).

18. Second, the concept of complementarity is itself not without difficulty. In a number of cases, reference to it does not make the assessment of similarity easier. If tribunals take the explanation of the concept in *Boston* as akin to a statutory definition, it can lead to unprofitable excursions into matters such as the frequency with which certain goods are used with other goods and whether it is possible for one to be used without the other. That analysis is sometimes of limited value because the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.

19. Third, the Hearing Officer said at [32]:

As stated above, the legal definition of ‘complementary’, as per *Boston*, is that the goods must be “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”. It is not sufficient that the goods “can” be used together; nor is it sufficient that they are sold together.

20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the

importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.

21. Moreover, it is necessary to view the quotation from *Boston* in the context of the facts of that case where the dispute over similarity turned in part on whether the goods were used together for a rather specific medical procedure. The Court of First Instance said at [77]-[87]:

Similarity between the products

77 According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM*, paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM - Gómez Frías (euroMASTER)*, paragraph 31).

78 As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fiber oxygenators with detachable hard-shell reservoir, on the other hand, have a different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81 In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

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).

83 It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fiber oxygenators with detachable hard-shell reservoir.

84 However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85 It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.

86 Finally, the products at issue can in fact be found in the same distribution channels, such a criterion being relevant for the purposes of the assessment of the similarity of the goods (*PiraÑAM diseño original Juan Bolaños*, paragraph 82 above, paragraph 37; see also, to that effect, *SISSI ROSSI*, paragraph 82 above, paragraph 65; and *PAM PLUVIAL*, paragraph 82 above, paragraph 95).

87 Accordingly, given the close link between the products in question as regards their end users, the fact that they are to some extent complementary and the fact that they may be distributed via the same distribution channels, the Board of

Appeal was right to find that the applicant's goods and those of the intervener were similar (see, to that effect, Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 56).

22. The Court of First Instance was not attributing decisive importance to the question of whether the goods in that case were complementary in determining the overall question of whether they were similar.

23. In the present case, because of the way in which the case was presented to the Hearing Officer, the issue of whether the goods were complementary assumed excessive importance which may have diverted the Hearing Officer's attention from other, no less important, considerations in the evaluation of similarity. That requires me on this appeal to scrutinize the approach taken by the Hearing Officer in considering the evidence by reference to the test of similarity more closely than would ordinarily be warranted by the *REEF* principles on an appeal of this kind.

Similarity and complementary use - facts

24. The Hearing Officer evaluated the evidence relating to similarity and complementary use as follows:

32....The evidence shows that it is unnecessary to use a condom with a vibrator and vice versa. The reasons why one might use a vibrator and a condom together are a) to prevent pregnancy and b) to prevent sexually transmitted disease. Neither of these would apply if the vibrator was for 'solo' use (i.e. without a partner being present); nor would a) apply if pregnancy was desired or unlikely for other reasons. It is plainly unnecessary to use a vibrator when using a condom. Condoms and Ms Elliott's goods, in either category, are not complementary.

33. Mr Tierney put a similar line of argument to me in relation to lubricants and Ms Elliott's goods. He conceded that vibrators and lubricants/gels can be used without each other but said that they are very often used together. Referring to a third party website in the evidence, which shows "Lubricant guide for sex toys", he said:

"The type of lubricant you can use with a vibrator depends on what the vibrator casing is made of. Again, it shows that vibrators and lubricants can be used together...sometimes vibrators must be used with a lubricant [for comfort]".

34. The key point here is that they can be used together, not that there is a dependency. This is not enough to demonstrate a complementary relationship in law. Mr Tierney also submitted that lubricants can be used for massage. I do not think that this is how the average consumer would view lubricants. Lubricants are to reduce friction to moving parts and although massage oils are to ease the friction of massage, to go back to the words in *Treat*:

“When it comes to 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. After all a trade mark specification is concerned with use in trade”.

LRC has cover for “hygienic lubricants” in class 5: this term cannot be stretched to include what the average consumer would naturally consider to be goods for massaging purposes.

25. This merits comment.

26. First, it appears to take the test for whether goods are complementary as requiring a finding that it is in fact necessary that the respective goods are used together (in this case condoms and lubricants together with vibrators). Although the Hearing Officer was doubtless correct that it is not necessary to use such products together, her evaluation did not take account of whether it may be important to use them together (which featured in the Court of First Instance’s formulation in *Boston*) or, indeed whether they were often used together.

27. Second, the evidence shows that vibrators are commonly purchased for use by couples who may well use condoms either placed on the vibrator or at least on the same occasions on which the vibrator is used. For example, there is some material in Durex’s enthusiastically worded guide to its “Pure Pleasure” vibrator that a significant proportion of those who use vibrating toys use them with their partner and condoms are often used in sex with partners. Ms Elliot, who has considerable experience in the broad area of selling aids for sexual pleasure has not suggested that this is wrong. Moreover, even for “solo” use, there are some documents in evidence which recommend use of a condom on a vibrator if easier clean up is desired. There are also some recommendations that users

place a condom onto certain kinds of sex toys if they wish to avoid damaging them by particular kinds of lubricant (see exhibits IG6 and IG7). The latter exhibit suggests that use of a condom on a vibrator is necessary or strongly recommended if the vibrator is inserted both vaginally and anally. It states:

“You should never put anything in your vagina after it’s been in your rear, so if you’re using your vibrator anally, cover it with a condom first, then remove the condom before you insert it in your vagina or touch it to your genitals”.

28. There is no reason to believe that this sensible advice is not regularly followed.

29. Third, the evidence shows that lubricants are also commonly used with vibrators, or at least on the same occasions. Exhibit IG6 contains several internet guides to lubricant use for sex toys of various kinds including, for example, detailed discussion of “what kind of lubes works best with a vibrator”. The SimplyPleasure website says: “There are many different types of lubricant on the market and it’s important to match up the right type of lubricant to the right type of sex toy”. These documents all reinforce the fact that there is an abundance of lubricants which are intended, inter alia, for use with sex toys. There are recommendations in this regard for beginners and for more experienced users. Some of the leading brands (including Durex Play Massage 2-in-1 Lubricant) are specifically said to be suitable for sex toys and massage. One of the websites, soFeminine.co.uk, says: “Lube is used to make sex less painful, to make using sex toys more comfortable or just for pleasure enhancement.” and that lubricant is “strongly recommended for use with sex toys and other such objects”.

30. I am therefore unable to endorse the view that the average consumer would regard lubricants as being unsuitable for massage. To the contrary, I consider that the evidence established that lubricants are likely to be regarded as particularly suitable for use with vibrators and similar products. As to use for massage, this may depend on how comprehensive a view one takes of that term. If “massage” encompasses sexual massage, it is on the evidence likely that the average consumer would consider that lubricants were particularly suitable for such activities. It is doubtless true that lubricants of the specific

kind identified in the LRC specification have friction reduction as their sole purpose. However, on the evidence, it is clear that they are regularly used and recommended, inter alia, for improving the performance of vibrators and for sexual massage (among others): for example, “intended for use with sex toys...as well as all over body massage”; “...can be used as an additional game during foreplay” (Exhibit IG6).

31. In my judgment, taking all of these points together, LRC contention that the Hearing Officer approached this aspect of the evaluation erroneously has merit.

Other aspects of the evaluation of similarity of goods

32. As to the channels of trade, the Hearing Officer said this:

35. LRC is on stronger ground with its argument that its condoms and lubricants and Ms Elliott’s goods share the same channels of trade. I note from the evidence that the supermarket and high street pharmacies display condoms, lubricants and a limited range of vibrators (rings, in fact) side by side. That said, the photographs also show these side by side with first aid plasters, pregnancy testing kits and razors. The proximity of the ‘Durex’ branded goods in product displays, in which lubricants, condoms and vibrating rings are shown together, may be due in part to the fact that like-branded goods are displayed together, rather than it being a common feature of high street retailing practice to display condoms, lubricants and vibrators together. However, I think it fair to say that goods which are related to sexual activity are sold together in supermarkets and pharmacies. In the case of ‘adult shops’, everything inside such shops is related to sexual activity. In relation to Ms Elliott’s category (ii) goods, there is some similarity in terms of channels of trade with LRC’s condoms and lubricants. The evidence of vibrating rings and condoms in a pack supports this type of similarity rather than Mr Tierney’s view that vibrating rings and condoms are complementary. The combined packs of condoms and vibrating rings say more about the convenient purchase of items, or free goods with purchased items, which are part of a sexual experience, i.e. a channel of trade point, than they do about them needing to be used together. This follows through to Ms Elliott’s category (i) goods, to the extent that they cover sexual massaging apparatus; however, [Check Quote]

33. In my judgment, while it is right to say that the evidence was not particularly compelling as to common channels of trade, partly because many kinds of goods are sold in (e.g.) Boots and condoms are shown in the exhibits in reasonable proximity to razors, there was a reasonable basis to conclude that goods relating specifically to sexual

activities (including condoms, lubricants and sex toys of various kinds) were commonly sold in close proximity and regarded as a common set of goods.

34. Finally, the Hearing Officer also took into account other relevant factors in the evaluation of similarity. She said:

36. Although Mr Tierney's submissions focussed upon the complementary and trade channel aspects of the similarity assessment, I will also look at the other elements of the *Canon* test. There is no shared nature between condoms and lubricants and any of Ms Elliott's goods. In terms of intended purpose, condoms are to prevent pregnancy and disease. There may be an ancillary sexual stimulation function to them, but this is not their primary intended purpose. The method of use of condoms and massaging apparatus and vibrators is not the same; the best that can be said is that there is some similarity in how vibrating rings and condoms are placed onto the male human body. Condoms and vibrators are not in competition with each other. In relation to lubricants, their intended purpose has nothing in common with vibrators and sex aids in general. Their method of use is entirely different and they are not in competition with one another.

35. Although this point was not at the forefront of LRC's submissions, in my judgment, at the relevant level of generality for the purpose of an evaluation of similarity, condoms, lubricants and vibrators do share an intended purpose.

36. To take an analogy from sport, it is true that, on one view, cricket bats, cricket pads and cricket nets have different purposes and are used and handled in very different ways but their common purpose is to enable people to play specifically cricket (rather than sport in general) and to do so safely. They are sensibly regarded as part of a broader class of "cricket equipment". In my judgment, the position is similar with respect to the goods in question here. Condoms are intended to enable sex to take place safely; lubricants to enable it to take place more comfortably and vibrators are designed to enable sex to take place more pleasurably or to compensate for the absence of someone else with whom to engage in the activity. They are all "sex equipment" of various kinds. In my judgment, the view taken by the Hearing Officer focused too narrowly on the very specific characteristics of the goods and how they would be used rather than the function which they were intended to perform and the activity in which they would be used. In

this case, they are all goods intended to be used on the occasion of a specific physical activity, albeit one of more widespread appeal than cricket.

37. Finally, on this issue, the Hearing Officer did not refer to one factor which, at least in some of the cases, has been regarded as of considerable significance, namely that the respective kinds of goods were, in fact, produced by the same manufacturers. My attention was drawn to the following examples in the evidence: (i) Durex branded condoms, lubricants, single-use “cock rings”, finger-mounted vibrators, as well as larger “pure fantasy” vibrators and, in some instances, the cock rings and condoms are sold together in a single “pleasure box”; (ii) Trojan branded condoms and fingertip vibrators also sold together in a single pack; (iii) Mates branded condoms and “pleasure vibes” rings.

38. This supports a conclusion that an average consumer is likely to consider that goods of those kinds come from the same trade source since, in fact, for a number of prominent brands, they do.

Conclusion on similarity

39. For these reasons, in my judgment the Hearing Officer took too narrow an approach to the evaluation of the similarity of the respective goods. Having regard to the points made above, there was, in my view, a reasonable degree (albeit not the highest degree) of similarity between at least some of the goods in the respective specifications.

(b) Comparison of marks

40. The Hearing Officer addressed the issue of comparison of marks as follows:

Comparison of marks

38. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the

average consumer normally perceives a mark as a whole and does not analyse its details.

39. The respective marks are:

LRC's mark	Ms Elliott's mark
LOVE	LUV

40. As each mark consists entirely of a single component, these are self-evidently the dominant and distinctive components of each mark.

41. LRC's mark consists of four letters and Ms Elliott's consists of three; of these, only two letters are similar, L and V. The vowels are different. The first letter of each mark is L, but the last letters are different. The marks are short and these differences have, proportionately, a large effect: there is a low level of visual similarity between the marks. Aurally, however, the marks are identical. This is because the O in LOVE is pronounced more as a U and the final E of LOVE is silent.

42. The meanings of LOVE are well-known to anyone with a command of English and were set out in Ms Elliott's evidence. As both parties accepted, and as I take on judicial notice, LOVE and LUV are alternate spellings: love is the formal spelling and luv the informal version of it, the latter much seen on car stickers and in text messages and online blogs. LOVE and LUV both mean, depending on context, a feeling of deep affection; a deep romantic or sexual attachment to someone; a great interest and pleasure in something; person that one loves, or an informal mode of address ("alright love/luv?"). The marks are conceptually identical.

43. In summary, the marks are identical aurally and conceptually but similar on a visual level to only a very low degree. I will bring forward these points when I come to the global comparison.

Distinctive character of the earlier mark

44. It is necessary to consider the distinctive character of LRC's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁷. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public.

41. The Hearing Officer's evaluation has much to commend it. There is, however, one point which merits comment.

42. She held that the marks were conceptually identical. In one sense, this is correct, but it is important to bear in mind that the concept of one of the marks taken as a whole is the normal word “LOVE” whereas the concept of the other mark taken as a whole is a slang version “LUV”. Although they may denote the same thing, it does not follow that, for trade mark purposes, their conceptual content is wholly identical since they do not do so in the same way.

The average consumer and the purchasing process

43. The Hearing Officer addressed the issue of the average consumer as follows:

Average consumer and the purchasing process

25. The average consumer for the goods of both parties is the adult (or over the age of consent) general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but his/her level of attention is likely to vary according to the category of goods. I think it unlikely that a particularly close level of attention will be paid to the purchase of many of the goods, although the evidence shows that some of the sex aids/devices/appliances can be more specialist in nature and so these may be subject to a closer degree of analysis before being bought. The purchasing process is overwhelmingly visual: this is borne out by the evidence of both parties which shows the goods on supermarket shelves and websites. Indeed, the nature of the goods of most interest to the parties is such that consumers may be attracted to the online mode of purchase as this preserves a degree of anonymity for the purchaser. As Dr Banford submitted, gone are the days when condoms were asked for in a whisper in a chemist’s shop. They are now displayed on shelves in supermarkets, in high street pharmacies and on websites, as shown in the parties’ evidence. They are also sold in public toilets from coin-operated dispensing machines. The aural aspect to the purchasing process is considerably reduced in proportion to the visual aspect.

44. In my view, this is sensible evaluation.

45. The Hearing Officer was criticized by LRC for placing undue emphasis on the visual aspect of the purchasing process but I think she was right to do so. The goods in question are likely to be selected at least predominantly by eye and there is no convincing evidence that word of mouth plays a significant role in purchasing decisions. In my judgment, the difference in spelling of LUV and LOVE is highly likely to come to the consumers’ attention.

46. I am unpersuaded by LRC's argument that the Hearing Officer committed an error of approach in placing too much emphasis on the visual comparison or that she applied a principle of "visual counteraction" contrary to the case law of the Court of Justice. I think that reads too much into the decision which amounts to no more than saying that the average consumer is highly likely to notice the difference between the marks.

47. I therefore reject this criticism of the decision.

(c) Distinctive character to the earlier mark

48. The Hearing Officer's approach to comparing the marks was criticized by LRC on the basis that it involved treating the earlier mark as having no or very little distinctive character, effectively amount to saying that it was unregistrable. She said (referring to *Sabel BV v Puma AG* [1998] RPC 199 and *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91):

Distinctive character of the earlier mark

44. It is necessary to consider the distinctive character of LRC's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public.

45. LRC has not filed evidence of use of its mark, so there is no question of whether it is entitled to an enhanced degree of distinctive character gained through use. The assessment to be made is the degree of inherent distinctive character. Ms Elliott has filed evidence about this in order to support her claim that LRC's mark offends sections 3(1)(c) and (d) of the Act. Some of her evidence shows that at the date the evidence was printed, which falls after the date of her application, LOVE appeared to be a term used in relation to various sex aids, such as love dolls, love eggs, love ropes and love rings. However, there is no evidence before the relevant date to which I can point and say that LOVE was used as a descriptive term.

46. As Mr Tierney pointed out, I must bear in mind that LRC's CTM is to be considered validly registered, as per Article 99(1) of the Community Trade Mark Regulations⁹. That does not, however, mean that the mark necessarily possesses

even an average level of distinctive character. In the context of the parties' goods, LOVE is a politer or more romantic expression for sexual intercourse, as in "making love". The relevant consumer, being reasonably well informed, would be aware of this meaning. It is a word likely to be used in the marketing of sex aids and contraceptives because it is less direct and more commercially appealing than using the word sex, particularly when the goods may be sold in more mainstream retail outlets. The average consumer would be likely to view its use in such a promotional context. Consequently, the mark LOVE for sex aids and contraceptives is inherently distinctive to a very low degree.

49. LRC contends that, in effect, this amounts to treating its earlier mark as having no distinctive character which is impermissible since an earlier mark is presumed to be validly registered and therefore that it has some ability to distinguish (see *Formula One Licensing BV v. OHIM* Case C-196/11 P (24 May 2012) at [38]-[47]).

50. LRC is right to refer to this principle. However, in *Formula One* the Court of Justice did not suggest that it was inappropriate for a tribunal to consider "if necessary the degree of distinctiveness" of the earlier sign. In my judgment, the Hearing Officer was doing no more than this. She did not hold that the earlier marks were completely non-distinctive or call their registration into question. She merely drew attention to the fact that "LOVE" for the particular goods in question was only very weakly distinctive.

51. Her conclusion in this respect was unimpeachable. The Hearing Officer was not obliged in the context of an opposition to treat a mark which plainly had weak distinctive character (even if sufficient to be registrable) as having "average" distinctiveness contrary to common sense. That is particular so since the threshold of distinctiveness required for registration is not particularly high (ruling out marks which are "devoid" of distinctive character, not requiring marks to have "average" distinctiveness). I am equally unpersuaded that it was erroneous to consider the issue of distinctiveness of the earlier signs at the stage that she did in her reasoning.

52. I therefore reject this criticism of the decision.

EVALUATION

53. I have held above that the Hearing Officer's approach to similarity of goods, although not clearly wrong, would have benefited from a less rigid approach to assessment and that LRC's contentions in this respect have merit. Although this is a case perhaps on the borderline of reviewability in the light of the *REEF* principles, in my view, there was a sufficient error of approach to the evaluation of similarity of goods to give rise to a need to undertake the evaluation of the overall question of likelihood of confusion afresh. I do so, however, having regard to the Hearing Officer's overall decision on the issue and her specific reasons for taking the view she did on the global assessment of a likelihood of confusion.

54. The Hearing Officer said this:

Likelihood of confusion

47. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency. In this regard, I found that the goods of the parties ranged from a low degree of similarity to no similarity. Where there is no similarity of goods there can be no likelihood of confusion (*Canon*).

48. I also found that the marks are phonetically and conceptually identical and that the level of visual similarity between them was of a low degree. The relevance of this point is that sometimes the characteristics of the purchasing process for some goods and services are more aural than visual. However, in the instant case, the average consumer's selection and contact with the parties' marks will be overwhelmingly visual via shop shelves and websites. Mr Tierney drew my attention to telephone numbers at the top of some of the website pages. Even so, I think it much more likely that a website visitor will make an online transaction. I disagree with Mr Tierney that the phonetic and visual perceptions should be given equal weight. In my view, the most relevant perception of the marks will be visual, and the level of visual similarity is very low. Against this is the identical meaning of the parties' marks; however, this, in turn, has to be balanced against the finding that LOVE has only a very low level of inherent distinctive character for the goods.

55. The Hearing Officer placed considerable weight on the fact that the marks were different and that "LOVE" had a low level of distinctive character. She was right to do

so. In my judgment, even if one re-evaluates the issue of likelihood of confusion to take account of the greater similarity of goods than the Hearing Officer was prepared to acknowledge and feed that into the interdependency analysis, the outcome of the assessment is the same.

56. Having regard to the differences in the marks including the weakly descriptive nature of both of them, the nature of the average consumer and the circumstances of sale, in my judgment there is no real risk of confusion.

57. This is a case in which the well known *Office Cleaning* approach (from the law of passing off) to the effect that, where an earlier mark is descriptive, small differences are enough to distinguish, is of some importance. That approach is not taken for any doctrinal reason but simply because, in practice, consumers are less likely to think that two descriptive marks denote businesses that are connected with one another, because a credible and dominant alternative explanation exists for the similarity in marks which has nothing to do with their denotation of a common trade source, namely that their similarity is attributable to their descriptiveness.

58. Situations in which factors of this kind are of greater or lesser importance depend heavily on their facts. To take two examples from the cases cited before me, in *Sergio Rossi SpA v. OHIM* Case T-169/02 (1 March 2005) at [83], the Court of First Instance took into account, in holding that there was no likelihood of confusion, the fact that the common element of the marks was a common name “Rossi” and that consumers would therefore not believe that there was an economic link between all the proprietors of different marks containing that name. Conversely, in *L’Oreal v. OHIM* Case C-232/05, (27 April 2006), the Court of Justice upheld a decision of the Court of First Instance to the effect that the partial descriptiveness of the earlier mark FLEX did not remove the likelihood of confusion with FLEXI AIR. This, perhaps, illustrates the futility of searching for general principles in this area. It suffices to say that, on the facts of the present case, in relation to goods concerned (broadly) with making love, there is no reason to believe that the average consumer will assume that there is an economic link

between undertakings using the quite different spellings of the word “LOVE” and “LUV” even if the kinds of sex equipment are similar.

59. For these reasons, notwithstanding the difference of approach to the issue of comparison of goods that I have identified, in my judgment, the Hearing Officer’s overall evaluation of the case was correct. Ultimately, this case boils down to a simply point: the respective marks are, having regard to the nature of the goods in question, their descriptiveness and the relevant circumstances in which they are likely to be perceived, sufficiently different to avoid confusion.

60. LRC did not suggest that its case based on “WE MAKE LOVE” was better overall on this key issue than its case on “LOVE” alone and there is therefore no need to consider it separately.

61. For these reasons, this appeal will be dismissed.

COSTS

62. The Hearing Officer awarded Ms Elliott £2300 in costs, including £600 in preparing for and attending the substantive hearing. I did not receive any specific submissions on costs of the appeal. The hearing took approximately half a day and involved counsel on both sides who had each prepared helpful skeletons. Having regard to the scale of costs, in my judgment LRC should pay Ms Elliott the costs awarded by the Hearing Officer and a further £700, making a total of £3000.

DANIEL ALEXANDER QC

Appointed Person

2nd May 2013

Representation

Simon Malynicz instructed by Reckitt Benckiser Corporate Services Limited for the appellant, LRC

Alastair Wilson QC instructed by Franks & Co for the respondent, Ms Elliott