

O-477-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2626016
BY JOHNSON & JOHNSON
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 3 & 5:**

LUMESSE

AND

OPPOSITION THERETO (NO 103983) BY LUMENE OY

The background and the pleadings

1) Johnson & Johnson (“Johnson”) applied for the trade mark **LUMESSE** on 26 June 2012. It was published in the Trade Marks Journal on 20 July 2012. Registration is sought for the following goods:

Class 3: Non-medicated hair care products.

Class 5: Medicated hair regrowth products.

2) Lumene Oy (“Oy”) opposes the registration of the above mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). It relies on a number of trade marks which, it considers, give rise to a likelihood of confusion; the marks relied upon are:

- i) Community trade mark (“CTM”) registration 300905 for the mark **LUMENE** which was filed on 1 April 1996 and which completed its registration process on 18 May 1999. It is relied upon by Johnson in so far as it is registered for:

Class 3: Cleaning preparations; soaps, essential oils, cosmetics, personal hygiene products, deodorants, hair care products, hair styling products, hair lotions, perm lotions, hair colours; skin care products; shaving preparations.

- ii) CTM registration 6524029 for the mark **LUMENE NATURAL CODE** which was filed on 18 December 2007 and which completed its registration process on 4 September 2008. It is registered for the following goods:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.

- iii) CTM registration 7045008 for the mark **LUMENE EXCELLENT FUTURE** which was filed on 8 July 2008 and which completed its registration process on 11 December 2008. It is registered for the following goods:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 44: Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

- iv) CTM registration 8559718 for the mark **LUMENE NATURAL LASH-EXTENDERS** which was filed on 18 September 2009 and which completed its registration process on 28 January 2010. It is registered for the following goods:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Class 21: Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

- v) CTM registration 10054955 for the mark **LUMENE WILD ROSE** which was filed on 17 June 2011 and which completed its registration process on 4 October 2011. It is registered for the following goods:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides

- vi) CTM registration 10688471 for the mark **LUMENE AGE PREVENTING** which was filed on 1 March 2012 and which completed its registration process on 29 June 2012. It is registered for the following goods:

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

Class 5: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

It is not clear why the goods in class 5 mirror those in class 3. This is clearly a mistake of some form which appears not only on the IPO website but also the website of OHIM. I will comment further on this if this earlier mark needs to be assessed in detail.

- vii) CTM registration 10688513 for the mark **LUMENE AGE CORRECTING** which was filed on 1 March 2012 and which completed its registration process on 14 June 2012. It is registered for the following goods:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

- viii) CTM registration 010688521 for the mark **LUMENE AGE CARING** which was filed on 1 March 2012 and which completed its registration process on 14 June 2012. It is registered for the following goods:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

All of the above marks constitute earlier marks in accordance with section 6 of the Act. Only one of the marks (no. 300905 for the mark **LUMENE**) had completed its registration procedure before the start of the five year period ending on the date of publication of Johnson's mark. In view of this, the proof of use provisions set out in section 6A of the Act apply. Johnson made a statement of use matching the goods upon which it relies. In terms of the other earlier marks, they may be relied upon in these proceedings for their specifications as registered, the use conditions not applying to them. In relation to all of the marks relied upon, Johnson highlights the visual and phonetic similarity between the LUMENE element of the earlier marks and the applied for mark LUMESSE (the first four letters being the same, as is the last letter). In relation to marks ii)-viii), Johnson states that the goods are identical with the goods applied for because, on account of the practice adopted by OHIM, the registered specifications cover all the goods in their respective classes (I will comment upon this claim later); however, it is added that even if this were not the case, the goods are nevertheless identical or similar.

3) Johnson filed a counterstatement denying the claims. It considers the marks to be visually and phonetically distinguishable and that there is no concept to link the two marks together. It states that the prefix LUM- is commonplace and that Oy does not have exclusive rights to such marks. Johnson puts Oy to proof of use in respect of its **LUMENE** mark, but in response to the question posed on the Form TM8 (Notice of defence and counterstatement): "If you answered "Yes" to question five, please state for which goods and services you require proof", Johnson answered:

"Hair care products, hair styling products, hair lotions, perm lotions, hair colours".

I will return to the consequence of this answer later.

4) Both sides filed evidence accompanied by written submissions. Neither side requested a hearing. Johnson filed written submissions in lieu of a hearing, Oy did not.

Oy's evidence and submissions

Witness statement of Jarmo Korhonen dated 8 May 2013

5) Mr Korhonen is Oy's chief financial officer. He explains that Oy was founded in 1970 and has around 530 employees, 330 of whom work in Finland. Half of Oy's net sales of LUMENE branded goods are generated in Finland. The remaining sales occur in "other EU countries, as well as some outside Europe". Oy is said to foster a "holistic approach to beauty" and manufactures "high quality natural skin care and hair care products". Exhibit JK1 contains prints from Oy's website (they were printed after the relevant date). The bulk of the products depicted in the prints are skin care products, most of the prints carry, in some way, either the trade mark LUMENE or LUMENE LAB. Sometimes sub-brands are also used. There is one print relating to a 2 in 1 body and hair wash product for men. It is branded LUMENE FOR MEN; there are other products in this range, including skin care products and antiperspirants. There is also a shampoo branded Angry Birds by LUMENE, together with other products (body lotion, shower gel and hand cream) in this range.

6) Mr Korhonen states that the men's body and hair wash product has been sold for a number of years. Archive prints (obtained using the Way Back Machine) from its website demonstrate that the product was on its website on 7 May 2007. There is also a press release from July 2011 which depicts the product.

7) Mr Korhonen states that LUMENE hair care products are also produced by an affiliate company called Cutrin Oy. The products are said to include hair spray, fixing spray, styling mousse, wax, dry shampoo and styling glue. Two sets of marketing material are provided from 2008-2010 and 2011-2012 respectively. Much of it includes reference to CUTRIN by LUMENE. The products depicted are for various hair styling products; I could not find the dry shampoo. The brochures are a mixture of Finnish and English. Advertising is also claimed to have taken place in magazines. The example provided is in Exhibit JK4 which relates to the Angry Birds by Lumene product; however, this comes from September 2012 which is after the relevant date/period and, so, does not assist.

8) "Our" sales figures for LUMENE branded goods sold in the EU have ranged between £58 million and £61 million per annum between 2008 and 2012 with marketing expenditure ranging between £9.9 million and £14.5 million. The use of the word "our" is not company specific. I will take it as a reference to Oy's sales (as Mr Korhonen is an officer of Oy) and, as such, does not include sales by the affiliate company referred to. Mr Korhonen states that as a result of the use of the mark for the last 40 years, it is highly distinctive through use and has a valuable reputation in relation to cosmetics, skin care and hair care products and related goods in the EU. He believes that if a consumer saw LUMESSE they would think that it originated from Oy or an economically linked company.

Witness statement of Caitriona Desmond dated 8 May 2013

9) Ms Desmond is an associate of Squire Sanders (UK) Ltd, Oy's trade mark attorneys. Ms Desmond's evidence concerns Johnson's claim in its

counterstatement that the prefix LUM- is commonplace. Ms Desmond states that this is incorrect adding that the word has no meaning other than as an acronym. She provides some Internet search material showing various but non-relevant (to the goods in issue) meanings for LUM.

Submissions on behalf of Oy (filed with its evidence)

10) I will fully bear the submissions in mind, but the main points of argument to note are:

- LUMENE and LUMESSE are highly similar visually as both are one word marks beginning with the prefix LUME- and ending in E. That more focus will be given to the beginnings of the marks. That the point of visual difference is near the end of the marks and is a minor difference that may go unnoticed. Phonetically, they are highly similar and although N and SS sound somewhat different, this may be lost in speech. Neither mark has semantic content.
- With regard to the LUMENE marks which are presented with additional words, LUMENE is the dominant and distinctive element and, so, the marks are still similar overall. LUMENE is the first part of the marks, the additional parts of which contain descriptive words and which will receive minimal attention.
- That there are overlapping goods with regard to all of the marks.
- That bearing in mind the interdependency principle and imperfect recollection, there is a likelihood of confusion.

Johnson's evidence and submissions

Witness statement of Gemma Hennessey dated 5 July 2013

11) Ms Hennessey is a paralegal working for D Young & Co LLP, Johnson's trade mark attorneys. She has conducted some research into LUM- prefixed trade marks for hair care products available for purchase in the UK or EU and research into the use made by Oy of its LUMENE mark.

12) In relation to Oy's use of LUMENE, she provides a print from its website (Exhibit GAH1) which she has reviewed and which she notes contains only the Angry Birds by Lumene Shampoo and the Lumene for Men 2 in 1 body and hair wash.

13) Ms Hennessey provides Internet prints of various products which have the prefix LUM- in them as follows:

- L’Oreal Professional Lumion Contrast Taming Gloss Serum (plus a further similarly named product).
- Kerastase Cristaliste Serum Lumiere (plus a further similarly named product).
- Alterna Bamboo Luminous Shine conditioner (plus two further similarly named products).
- Moroccanoil Styling and Finish Luminous Hairspray.
- L’Oreal Professional Infinium Lumiere Extreme Hold (plus a further similarly named product).
- Wella SP Luminous Shine Care Booster.
- Kerastase Bela Chroma Riche Luminous Softening Shampoo.
- White Hot Luminous Conditioner.
- Leonor Greyl Leit Luminescence Bi-Phrama Detangling Milk styling spray.
- Ultimate Organic Luminous Conditioning Sheen Spray.
- Planter’s Hydrating Luminosity Hair Mask.
- Luminous Oil Glow
- Two images that cannot be ascertained.
- Various other products which are available in the US or Australia but which are said to be available on eBay. This evidence is less pertinent so I will not detail it further, other than to say that the products include references to the words: Luminous, Luminosity, Luminescent, Lumin, Luminance.

14) Exhibit GAH3 contains a list of LUM- prefixed marks in class 3 that are said to co-exist on the UK, EU or International registers. Ms Hennessey highlights, in particular: LUMINCARE, LUMINELLE, LUMIERE, LUMINA, LUMIA, LUMIAN and LUMINESS.

15) Exhibit GAH4 contains a copy of a French trade mark decision based on the marks LUMENE and LUMEALE, in which it was held that there was no likelihood of confusion given the differences between the marks. I note in the decision the reference to the juxtaposition of the letters E and A being unusual in the French language which contributed to the finding.

Submissions on behalf of Johnson (filed with its evidence)

16) I will fully bear the submissions in mind, but the main points of argument to note are:

- The majority of materials (from Oy) are undated or come from after the relevant period and some do not even show the LUMENE mark.
- The use is primarily in relation to skin care products.
- The use on hair care products is not sufficient to constitute genuine use, particularly given that the turnover figures etc are not broken down.

- That the differences between LUMESSE and LUMENE will be noticed immediately and are clearly distinguishable. The shortness of the marks also assists and that smaller differences in this context are sufficient to avoid confusion.
- Given the commonness of LUM- prefixed marks, the scope of protection of the earlier mark(s) is limited.
- That the phonetic differences are very clear.
- That the earlier mark(s) do not possess an enhanced distinctive character.
- That weighing all these factors, there is no likelihood of confusion.

Submissions on behalf of Johnson filed in lieu of a hearing

17) The main points (beyond that already set out above) of argument to note are:

- That having regard to the judgment of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV*, genuine use of the mark in the EU has not been established for anything or, alternatively, at best for skin care products. I will say more about this judgment and the relevant arguments shortly.
- That there is only a low level of similarity between all the various marks, and that the differences outweigh the similarities.
- That even though some of the earlier marks have closer goods (e.g. the earlier marks with additional words), these marks are even less similar to LUMESSE.

Proof of use assessment

The legal background

18) As stated earlier, the proof of use provisions apply to the **LUMENE** earlier mark. The use conditions are set out in Section 6A of the Act as follows:

“(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered [.....]”

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered [.....]

(5) “In relation to a Community trade mark [.....], any reference in subsection (3) [.....] to the United Kingdom shall be construed as a reference to the European Community”.

19) Section 100 is also relevant; it reads:

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

20) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied, namely: the judgments of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks* C-259/02 (“*La Mer*”). In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the CJEU in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

21) The earlier mark is a CTM which means that genuine use must be in the EC. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV* C-49/11 (“*ONEL*”) the CJEU said:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those

goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

22) Regarding the territorial scope of the use, the CJEU went on to say:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the

characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

What needs to be established and in what period?

23) In its statement of use Oy claims that it has made genuine use of its **LUMENE** mark in respect of:

Cleaning preparations; soaps, essential oils, cosmetics, personal hygiene products, deodorants, hair care products, hair styling products, hair lotions, perm lotions, hair colours; skin care products; shaving preparations

24) Although Johnson put Oy to proof of use in respect of the earlier mark, it specified the following goods upon which proof was required:

Hair care products, hair styling products, hair lotions, perm lotions, hair colours.

25) The consequence of the above is that the goods in the statement of use which are not "hair care products, hair styling products, hair lotions, perm lotions, hair colours" may be considered in these proceedings as their use has not been put into question by Johnson. Therefore, irrespective of what I will come on to say, the earlier mark may be relied upon, at the very least, in respect of:

Cleaning preparations; soaps, essential oils, cosmetics, personal hygiene products, deodorants, ~~hair care products, hair styling products, hair lotions, perm lotions, hair colours~~; skin care products; shaving preparations; **but not including hair care products, hair styling products, hair lotions, perm lotions, hair colours**

26) Whilst it is clear from Johnson's submissions that it does not see the matter this way (it considers that there has been no genuine use at all) it cannot extend

its pleaded case. In view of this, the question that arises in the proof of use assessment is whether genuine use has been made in respect of “hair care products, hair styling products, hair lotions, perm lotions, hair colours”. The period in which genuine use must be established is the five year period ending with the date of publication of Johnson’s mark, namely: **21 July 2007 to 20 July 2012.**

Has genuine use been made?

27) Although not part of the pleaded dispute, the evidence provided by Oy easily demonstrates that genuine use has been made in relation to skin care products. It is abundantly clear that such goods are the predominant part of the product range it sells. The criticisms made by Johnson of the evidence (whilst some of its individual points may have merit) fail to take into account the overall picture and the commentary of the witness. The sales figures are high and such sales have been made not only in Finland but in other (albeit not specified) EC Member States. Examples of the mark in use have been provided. Having regard to the combination of the *Ansul* and *ONEL* cases, the tests have easily been met in relation to skin care products.

28) The reason I refer to the sales in relation to skin care products is that it gives context to the use in relation to other goods. As I have said, the goods appear to be predominantly skin care products not hair care products. In relation to Oy’s use in relation to hair care, all it has really put forward are the Angry Birds by Lumene shampoo and the Lumene for Men 2 in 1 Body/Hair wash. However, the former of these products is not pertinent because the only evidence of actual use comes from after the relevant period and there is nothing in the commentary of the witness to suggest that the product was sold during the relevant period. Even if it was, the lack of specificity and objectiveness of the evidence is telling and does not stand Oy in good stead. In relation to the Lumene for Men product, there is at least evidence that the product was on Oy’s website in May 2007, however, this is before the relevant period. There is, though, the press release from 2011 which is within the relevant period. Johnson criticizes the fact that the turnover figures etc have not been broken down. This, I agree, is a flaw in the evidence. In circumstances where one type of product (skin care products) represents the predominant part of a business, providing total turnover figures is not helpful, particularly when, as in this case, there is little other evidence that can be objectively measured. Therefore, I do not know the level of sales made. Beyond the one press release, there is no evidence of any promotion. The evidence relating to the geographical scope of Oy’s business cannot necessarily be read across into other products. In view of all these difficulties, the evidence presented by Oy (other than in relation to skin care products) does not establish genuine use in the EC.

29) I must also consider the evidence relating to the use by Cutrin Oy on a range of, essentially, hair styling products. Such use by an affiliate can be considered

as use with the consent of Oy given the relationship between the two. Marketing material from within the relevant period is provided. This was criticized by Johnson as not showing the mark. However, in the material before me, and although it is not the clearest, use of LUMENE has been made in the context of CUTRIN by LUMENE. This counts as use of the mark being jointly affixed¹ so I do not need to consider whether such use is an acceptable variant under section 6A(4)(A). However, again, I have no idea as to the turnover figures. I have no idea of the geographical spread of any sales. In view of these difficulties, the evidence presented does not establish genuine use in the EC by the affiliate company.

30) The consequence of my finding is that the earlier **LUMENE** mark can only be relied upon in relation to:

Cleaning preparations; soaps, essential oils, cosmetics, personal hygiene products, deodorants, ~~hair care products, hair styling products, hair lotions, perm lotions, hair colours;~~ skin care products; shaving preparations; **but not including hair care products, hair styling products, hair lotions, perm lotions, hair colours**

Section 5(2)(b)

The legislation and the leading case-law

31) Section 5(2)(b) of the Act reads:

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

(a)

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

32) The CJEU has issued a number of judgments² which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street*

¹ See, by analogy, the decision of the Appointed Person in *Orient Express* (BL O/299/08) and the decision of the GC in Case T-29/04 *Castellblanch SA v OHIM* [2005] ECR II-5309.

² The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

Clothing Ltd (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

33) My proof of use findings have resulted in the specification of the **LUMENE** earlier mark being restricted, removing identical goods from the equation. For this reason, I will begin my assessment with one of the earlier marks that are not subject to the proof of use provisions. I will focus on:

LUMENE AGE CARING

Which is registered for:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

Comparison of goods

34) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

35) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

36) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“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).”

37) In relation to complementarity, I also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“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*.”

38) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “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 the trade”³ and that I must also bear in mind that words should be given their natural meaning within the context in which they are

³ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

used; they cannot be given an unnaturally narrow meaning⁴. I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

The applied for goods are:

Class 3: Non-medicated hair care products.

Class 5: Medicated hair regrowth products

The goods of the earlier mark are:

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

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

39) A claim was made in the counterstatement that the goods of the earlier mark extend to all goods in the respective classes because they contain class headings which OHIM have, in the past, regarded as covering everything in a class. However, this practice has largely been overtaken by the judgment of the CJEU in *IP Translator* and it seems to me that the argument has now been overtaken and is no longer tenable. I will say no more about it. Irrespective of

⁴ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

this, and as highlighted by Oy, it nevertheless has other goods which may conflict. The earlier mark covers “hair lotions” which would include those for, or at least assisting, with hair re-growth and, as such, is highly similar to a medicated hair growth product in class 5 as the nature and method of use is extremely similar, the purpose is the same, as are the users. There can often be a very fine line between medicated and non-medicated products. **Thus, hair lotion in class 3 is highly similar to the applied for goods in class 5.** In terms of the applied for goods in class 3 (non-medicated hair care products) then there is identity on the basis that the earlier mark includes hair lotions and, also, cleaning preparations (which could potentially be for the hair). There may, of course, be goods within the ambit of hair care products that are not hair care lotions or are not specifically for cleaning, however, such products will still be highly similar on account of their purpose, trade channels, users, methods of use etc. **Thus, the goods in class 3 are identical, and even if fall back specifications were put in, would still be highly similar.**

40) I should add that the goods in class 5 of the earlier mark also include pharmaceutical preparations, which, upon an ordinary reading, would potentially also cover “medicated hair regrowth products” in class 5. **There is identity on this basis also.**

The average consumer

41) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

42) In class 3 the conflict centres on hair care products. Such goods are purchased by the general public. The goods are purchased reasonably frequently and are not, generally speaking, particularly expensive. The goods will be selected with an average level of care and consideration, but no higher than that. The goods will most often be self-selected from a shelf (or an online equivalent), but I will not ignore oral uses of the mark from the equation.

43) In so far as medicated products are concerned, such goods are unlikely to be purchased as frequently and may, thus, have a higher degree of care and attention utilised when they are selected. As they are medicated, health care professionals will constitute one form of average consumer, but members of the general public are another on account of them being end-users and, also, potential purchasers. This suggests a more careful selection process, although not of the highest degree. There is likely to be a more equal balance between visual and oral use.

The significance of the LUM- prefix

44) Johnson has presented evidence concerning the prefix LUM-. It has provided state of the register(s) evidence, together with what I will call state of the market evidence. The latter assists, the former does not. The primary problem with state of the register evidence is that it does not always reflect what is going on in the marketplace and, thus, what impact it is having on the average consumer. This is illustrated well by the fact that Johnson's state of the market evidence is more limited in terms of LUM- prefixed words than its state of the register evidence. The actual uses found by Ms Hennessey primarily relate to known words: Lumiere, Luminous, Luminescence and Luminosity. Beyond this there is only one use of a LUM- prefixed mark: LUMION. The consequence of this is that whilst I am prepared to accept that the average consumer will have encountered in the hair care field uses (predominantly descriptive uses) of known words which have a similar root, there is no common use of LUM- prefixed marks or words beyond this. I do not consider that the average consumer will necessarily see either the word LUMESSE or the word LUMENE as falling into a pattern of LUM-prefixed marks or words, nor am I persuaded that the average consumer will see the marks as sharing a similar (descriptive/suggestive) root. **The marks will be seen, effectively, as invented words.** The fact that LUM-prefixed marks may co-exist on registers makes no difference.

Comparison of the marks

45) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

Oy's mark	Johnson's mark
LUMENE AGE CARING	LUMESSE

46) LUMESSE has only one element so is its dominant and distinctive element. In LUMENE AGE CARING, the mark breaks down into two components, LUMENE and AGE CARING (the two words hang together). LUMENE is clearly the dominant and distinctive element. It dominates the mark strongly, but not to the point that the other aspect is completely negligible. Having said that, the other aspect is extremely weak in distinctiveness and will be seen as either a descriptive or highly suggestive element pointing to some form of attribute of the LUMENE product (in that it helps care for the hair with age).

47) There are some points of visual similarity in that the marks begin with the same first four letters, and that the first/only element of the respective marks (which are of a similar length), end in the same letter (E). There are points of visual difference in that the N in LUMENE is replaced with a SS in LUMESSE

and, further, that the overall impression of Oy's mark is longer given its additional AGE CARING element. More focus will be placed on the LUMENE aspect of Oy's mark, although, I do not ignore AGE CARING completely. I consider there to be a reasonable, but not high, degree of visual similarity.

48) From a phonetic perspective, a similar analysis is applicable. I do not consider that the respective pronunciations create any greater or lesser degree of aural similarity than exists visual similarity.

49) From a conceptual perspective, that AGE CARING has a suggestive meaning does not greatly assist because this is not the alleged point of similarity and because this is not the aspect of the earlier mark that is its dominant and distinctive element. Thus, in my view, and given that LUMENE/LUMESSE has no meaning, the conceptual analysis is essentially neutral.

Distinctiveness of the earlier mark

50) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). There is no use of the earlier mark per se, neither is there any use in relation to the identical (or highly similar) goods that are in play. There is, thus, no distinctiveness gained through use. In terms of inherent qualities, I have already stated that LUMENE will be perceived as an invented word. The distinctiveness of the mark as a whole (with the words AGE CARING) is slightly less, but I still consider the earlier mark to be reasonably high in inherent distinctive character.

Likelihood of confusion

51) The factors assessed so far have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

52) In terms of the "non-medicated hair care products" the goods are either identical (or if fall back specifications were considered, still highly similar). The earlier mark is reasonably high in distinctive character. An average level of care and consideration will be used in the purchasing process. Imperfect recollection is an important point to bear in mind. This is particularly so in this case because neither the mark LUMESSE, nor the dominant and distinctive element (of the earlier mark) LUMENE, has a fixed concept for the average consumer to pack away to assist with recall. Bearing this in mind, I consider there to be great capacity when identical (or highly similar) goods are in play, for LUMENE to be confused with LUMESSE (or vice versa) due to imperfect recollection. Whilst I

have fully borne in mind the earlier mark in totality, the nature of the earlier mark means that the additional element does little, in this case, to avoid a likelihood of confusion. Even if the average consumer recalled that one of the marks contained the additional words AGE CARING but the other did not, this would not prevent imperfect recollection of the dominant element and there is still a likelihood of confusion on the basis of the goods being from the same stable. **There is a likelihood of confusion with the class 3 goods.**

53) In relation to the class 5 goods, I come to the same conclusion. Even though there is a somewhat higher degree of care and consideration in the purchasing process, for the reasons given, **I still consider there to be a likelihood of confusion.**

Outcome

54) **The opposition succeeds in its entirety.** In view of this, it is unnecessary to consider the other earlier marks as they put Oy in no stronger position. For example, in relation to the other earlier marks with additional elements, then my rationale would have been exactly the same and the outcome exactly the same. In relation to the **LUMENE** earlier mark, although this mark is arguably closer to the applied for mark, its goods are further away. Neither can the earlier mark be said to have enhanced distinctiveness with regard to the average consumer in the UK because no UK use has been provided; this mark does not improve Oy's position.

Costs

55) Oy having been successful, it is entitled to a contribution towards its costs. My assessment of costs is as follows:

Preparing a statement and considering the other side's statement:	£300
Filing evidence (and accompanying submissions)	£600
Opposition fee	£200

Johnson and Johnson is ordered to pay Lumene Oy the sum of £1100. 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 27th day of November 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**