

O-488-13

TRADE MARK ACT 1994

INTERNATIONAL REGISTRATIONS 102396, 1088560 & 1091075

IN THE NAME OF CLINIQUE LA PRAIRIE FRANCHISING SA

AND

DESIGNATION OF THE UK FOR PROTECTION OF THE

INTERNATIONAL REGISTRATIONS

AND

OPPOSITIONS 72170, 72390 & 72389

BY

CLINIQUE LABORATORIES LLC

Background and pleadings

1. Clinique La Prairie Franchising S.A. (“the IR holder”) holds three international trade marks as follows.

International registration 1088560 (“the 560 mark”):



International registrations 1091075 (“the 075 mark”) and 1025395 (“the 395 mark”) both for:

CLINIQUE LA PRAIRIE

2. The 395 mark was registered on 30 November 2009 and on the same date designated the UK for protection under the provisions of the Madrid Protocol.¹ It is registered (and the holder seeks protection in the UK) for food supplements and nutritional additives in classes 5 and drinks in class 32.²

3. The 560 and 075 marks were registered on 17 June 2011 and designated the UK for protection on the same date. These marks are registered for similar goods to those mentioned above in classes 5 and 32, and also for dietetic and other foodstuffs in classes 29 and 30, services in class 43 for providing food and drink, and medical and health services in class 44.³

4. Clinique Laboratories LLC opposes the granting of protection to these marks in the UK. The grounds of opposition to the 560 mark are based primarily on five of the opponent’s earlier trade marks. These are:

UK registration 1539591 - CLINIQUE – based on perfumes, cosmetics and similar goods in class 3.

UK registration 2000240 – CLINIQUE – based on a wide range of services in classes 35, 41, 42, 43 and 44, including the “*provision of beauty, perfumery,*

¹ Under article 3 of The Trade Marks (International Registration) Order 2008

² The full list is at annex A

³ The full list is at annex B

make-up and skin treatment services at counters, salons and advisory centres”.

CTM 54429 – CLINIQUE – based on perfumes, cosmetics and similar goods in class 3 and beauty consultation services in class 42.

CTM 54411



Based on the same goods and services as CTM 54429.

CTM 2293256



Based on the same services in class 42 as CTM 54429 above and also retail services for cosmetics, toiletries and the like in class 35.

5. The opposition to the 075 mark is primarily based on the first three earlier marks shown above.
6. The opposition to the 395 mark is primarily based on the first and third earlier marks shown above.
7. All of the opponent's marks predate the dates on which the IR holder designated the UK for protection of the international marks ("IRs"). The registration procedures for the earlier trade marks were completed more than 5 years prior to the dates on which the IRs were published for opposition purposes. Therefore, in accordance with the requirements of Rule 17(5)(d) of the Trade Mark Rules 2008, the opponent made statements of use of the IRs in relation to the goods/services relied upon for the purposes of these oppositions.
8. The opponent claims that the IRs are similar to all or some of the earlier marks and are to be registered for similar goods or services such that there exists a likelihood of confusion on the part of the public. In this connection, the opponent claims that the distinctiveness of the earlier marks has been enhanced through the extensive use made of the marks in the UK and elsewhere in relation to cosmetics,

beauty, skin care and anti-ageing preparations, and related retail, counselling and advisory services.

9. The opponent also draws attention to the fact that LA PRAIRIE is an established third party mark for cosmetics and claims that this exacerbates the likelihood of confusion because consumers are likely to assume that the IRs signify a joint venture between the opponent and the proprietor of the LA PRAIRIE mark.

10. Consequently, protecting the IRs in the UK would be contrary to s.5(2)(b) of the Act.

11. The opponent claims that the earlier marks have reputations in the UK for the goods and services mentioned at the end of paragraph 8 above. The IRs would be linked with these reputations enabling the IRs to unfairly benefit from the power of attraction and prestige of the earlier marks by transferring their image onto the opposed marks. Further, if the goods or services offered to the public under the IRs are of lower quality than the opponent's goods and services, the use of the IRs will tarnish the reputation of the opponent's marks. Further still, the use of the IRs will blur the distinctiveness of the opponent's marks causing the relevant public to be less likely to immediately recognise and rely on those marks thereby reducing their effectiveness in marketing the products and services sold under them.

12. Consequently, protection of the IRs in the UK would be contrary to s.5(3) of the Act.

13. The opponent further claims that, having regard to its UK reputation and goodwill under the registered earlier marks, use of the IRs in the UK would be contrary to the law of passing off. Protecting the IRs would therefore be contrary to s.5(4)(a) of the Act.

14. The IR holder filed counterstatements in which it:

- i) Put the opponent to proof of the claimed reputations of the earlier marks.
- ii) Denied that any of the goods or services covered by the IRs are similar to those covered by the opponent's earlier marks.
- iii) Denied that the respective marks are similar, pointing out that 'clinique' is a common French word meaning 'clinic' and is therefore descriptive and of "*marginal distinctive character*" for any goods/services with a clinical application or provided by clinics.

- iv) Claimed to have due cause to use the opposed marks because the IR holder has traded under the marks for 80 years from a clinic in (French speaking) Switzerland.

15. The standard form (TM8) used to file counterstatements includes the question “Do you want the opponent to provide proof of use?” The IR holder answered this question “Yes (in respect of claims made under s.5(3) and s.5(4) TMA)”. This means that the IR holder has not challenged the opponent’s statements of use of its marks for the purposes of the opponent’s s.5(2) grounds.

16. Both sides ask for an award of costs.

17. The opposition proceedings were consolidated. This decision therefore covers all three oppositions.

The Hearing

18. The matter was heard on 27 September 2013. The opponent was represented by Ian Bartlett of Beck Greener. The applicant was represented by Jon Welfoot of Stevens, Hewlett & Perkins.

The Facts

19. The opponent’s evidence comes in the form of a witness statement of Agnes Landau, the Senior Vice President, Global Marketing, Clinique Laboratories LLC, and two witness statements of Janet Saunders, the General Manager of Clinique UK and Ireland.

20. The evidence, including 97 exhibits, occupies seven ring binders. Some of it is duplicative or irrelevant. I will therefore distil the most relevant facts from the evidence and set them out along with my findings, issue by issue.

Extent of the Clinique marks’ reputation

21. According to Ms Landau, the CLINIQUE brand was founded in 1968 in collaboration with a well known physician and dermatologist called Dr Orentreich. Ms Saunders says that the mark was first used in the UK in 1969. Goods are sold under the brand through over 500 shops and stores across the UK including large retailers such as John Lewis, House of Fraser, Debenhams, Selfridges and Boots.

22. The CLINIQUE range consists of skincare products for topical application, such as moisturisers, skin cleansers, skin tonics/serums, and sun screens, makeup, such as foundation liquids and powders, concealers, and lip makeup, and fragrances, including eau de toilette and perfume.

23. Ms Saunders provides reports by an international statistics company called NPD which show that CLINIQUE was the top selling premium cosmetics brand in the UK in each of the years 2010, 2011 and 2012 with around 10% market share. I note that La Prairie also features in the lists for the first two years, at 43rd and 46th place, respectively, with 0.4% of the market.

24. Ms Saunders provides sales and annual and advertising figures for the CLINIQUE mark for 2008 onwards. These are the subject of a confidentiality order. It is not necessary to go into this evidence in any more detail because, despite initially putting the opponent to proof of its reputation, the IR holder subsequently conceded that CLINIQUE is *“amongst the most well known and widely sold cosmetics brands in the world”*. It is therefore sufficient to record that the UK sales and advertising figures (particularly the former) amount to many millions of pounds per annum.

25. Ms Saunders’ evidence is that the opponent’s UK business also provides beauty, cosmetic and skin-care consultation services under the CLINIQUE mark. There are approximately 2000 authorised CLINIQUE ‘consultants’ working on the 500 counters in the UK where the products are sold. These ‘consultants’ wear white uniforms and are *“trained to advise on the importance of a healthy lifestyle to beauty and skin care”*. They are also trained to provide *“dermatological skin typing”* advice. For years the same advice could be obtained by answering a series of questions on the opponent’s UK website. It can also be obtained from answering questions on an ‘app’ for an iPad provided for customers’ use at counters where the opponent’s goods are sold. The opponent’s ‘consultants’ provide makeup and skin care treatments to customers using the opponent’s products. Such treatments are *“generally”* provided free of charge (although the customers probably pay for them indirectly by purchasing the products used).

26. At one time the opponent collaborated with Weill Cornell Medical College and opened a CLINIQUE SKIN WELLNESS CENTER in New York. It was a research facility, but also offered some treatment rooms. There is no evidence that this was known to many consumers in the UK and the centre subsequently closed. It is therefore irrelevant to the reputation of the CLINIQUE marks in the UK.

Findings

27. I find that the CLINIQUE mark, with and without the C device element shown at paragraph 4 above, has a substantial reputation for cosmetics, beauty, skin care and anti-ageing preparations.

28. I find that the opponent has not established that the earlier marks have a separate reputation for counselling and advisory services. The advice provided appears to be fairly basic, essentially about identifying skin types and appropriate cosmetics. Although I accept that such services contribute to the quasi-medical

image of the goods sold under the marks, the services are essentially retailing CLINIQUE products. They are part and parcel of the mark's reputation for such products.

Image and values of the Clinique marks

29. Ms Landau's evidence is that the CLINIQUE mark was chosen *"to reflect the brand's dermatological image and to evoke, in the consumer's mind, the fact that CLINIQUE products are scientifically developed and clinically tested."* This is borne out by the use of *"allergy tested"* on the packaging of some of the opponent's products⁴ and by the use of the strapline *"Allergy tested. 100% fragrance free"* in the opponent's UK advertisements and in-store promotions.⁵ CLINIQUE products have won many awards for quality.⁶

30. In conjunction with Allergan Inc., the manufacturer of BOTOX, the opponent launched CLINIQUE MEDICAL 'cosmeceutical' skin care products in 2008 in the USA. Although there was some reporting of the launch in the UK⁷ the products were not marketed here. They were only available in the USA from doctors' offices, and such use appears to have subsequently ceased. I doubt this use had any effect on the perception of the CLINIQUE mark amongst average UK consumers of cosmetics.

Finding

31. I find that CLINIQUE is associated with pseudo-medical values encapsulated by the promotional phrase *"scientifically developed and clinically tested."* This image permits the products to be promoted as allergy tested and safe.

Uniqueness of Clinique in the UK market

32. Mr Mattli gives evidence for the applicant that 'Clinique' is a French word meaning 'clinical' (when used as an adjective) and 'private hospital' (when used as a noun). He says that the word is widely used in Switzerland to refer to a retreat in the nature of a private hospital. He exhibits various web pages (all in English, but from .com or .ch sites) showing six other Swiss clinics using 'Clinique' in their names.⁸ These are Clinique Matignon Suisse S.A., Centre Biotonus Clinique Bon Port, Health Center Clinique Lémana, Clinique Générale-Beaulieu, Clinique Paul Niehans and Clinique Cecil. Some of these are conventional hospitals whilst others, such as Clinique Matignon, Clinique Lémana and Clinique Paul Niehans, appear to focus on

⁴ See exhibit JS1

⁵ See the advertisements from Vogue magazine at exhibit JS6 and the pictures of in-store promotions at JS8.

⁶ See exhibit JS10.

⁷ See exhibit JS47

⁸ See exhibit GM3

rejuvenation treatments. I notice that some of them translate 'Clinique' to 'clinic' when describing their businesses in the English text on their websites.

33. Mr Mattli also provides a list of around half a dozen live UK registered companies which have names including 'Clinique'.⁹ However, there is nothing to suggest that these companies are trading under these names in the UK market, so this evidence is irrelevant.

34. Ms Saunders provides evidence of a UK website called Mumsnet, which includes various blogs.¹⁰ My attention was drawn to several contributors using CLINIQUE without further explanation to refer to the opponent's products. Ms Saunders says that the UK media also expect their readers to understand that CLINIQUE is a reference to the famous beauty brand without further explanation. She exhibits various press articles and promotions to illustrate the point.¹¹

Finding

35. Taking all of the above into account, I find that the applicant's evidence casts no doubt on the opponent's claim that CLINIQUE is unique as a trade mark on the UK market, although there is likely to be some limited awareness here that private hospitals use that word descriptively as part of their names in French speaking countries.

Use of sub-brands

36. Ms Landau says that CLINIQUE is often used with sub-brands, such as CLINIQUE TURNAROUND, CLINIQUE CX, CLINIQUE CHEMISTRY and CLINIQUE EVEN BETTER CLINICAL DARK SPOT CORRECTOR.

37. The sub-brands are mostly descriptive or allusive (unlike LA PRIARIE), but I note this point and will give it such weight as it deserves when it comes to assessing the likely effects of the applicant's use of CLINIQUE LA PRAIRIE.

Similarity of cosmetics, beauty, skin care and anti-ageing preparations to the goods and services covered by the application

38. The IRs cover nutritional additives and supplements. In this connection, I note that an advertisement in Vogue magazine in June 2009 promoted CLINIQUE EVEN BETTER makeup as containing a "boost" of vitamin C, which it was claimed would help repair damage to the skin.¹² There is evidence of third party skin care

⁹ See exhibit GM4

¹⁰ See exhibit JS11

¹¹ See exhibit JS12

¹² See exhibit JS6, page 8.

manufacturers making similar claims about their cosmetic products on UK websites.¹³ There is also evidence that a manufacturer of liquid vitamin and mineral supplement claims its products benefit the appearance of the skin.¹⁴

39. Ms Landau draws attention to the emergence of a range of ‘nutricosmetics’ and she cites four examples of nutritional supplements available in Europe and marketed as enhancing appearance and reducing the signs of ageing.¹⁵ Ms Saunders gives evidence that two of these products – PERFECTIL and IMEDEEN – were available for sale in the UK, at least in 2012.

40. Ms Landau cites a range of other similar supplements available internationally.¹⁶ I note that one of these – HELP clear skin – is reported to have been available at TESCO prior to April 2011.¹⁷

41. Ms Saunders draws attention to an article placed on Brandchannel website in 2003 entitled ‘Marketing beauty from the Inside out’, which covers the growth in ingestible beauty products¹⁸, including a joint venture between Olay, the well known cosmetics company, and Pharmavite, to market Olay Vitamins to address “*wellness and beauty needs.*”

42. Ms Saunders also gives evidence about the similarity of purpose between cosmetics and drinks and foodstuffs. She points out that:

- i) Evian mineral water is promoted as having a beneficial effect on the skin.¹⁹
- ii) A French company called Avene markets a skin care product called ‘Thermal Water Spray’, which uses mineral water as a skin treatment.²⁰
- iii) A Brazilian company called ‘Beauty’In’ sold a beauty drink and beauty confectionery under that name from Selfridges (there is nothing to show that this mark was used in the UK before 2013).²¹
- iv) Weleda market a birch juice drink which is marketed as improving the appearance of the skin (this appears to be a nutritional supplement).²²

¹³ See exhibit AI24, page 9 and AL25, pages 2, 6, and 12.

¹⁴ See exhibit AL25, pages 8-10.

¹⁵ Sold under the marks INNEOV, IMEDEEN, OENOBIOIOL and PERFECTIL.

¹⁶ See exhibit AL41.

¹⁷ See exhibit AL41, page 8.

¹⁸ See paragraph 26 and JS50.

¹⁹ See exhibit JS27.

²⁰ See exhibit JS40.

²¹ See exhibit JS43.

²² See exhibit JS44.

- v) A company called Rejuvenated appears to have marketed a product called 'Collagen shots' in the UK, which is a drink intended to improve the condition of the skin (the product appears to be in the nature of a nutritional/medical product).²³
- vi) A company called Fushi markets a similar product (a nutritional/herbal supplement).²⁴

43. Ms Landau says that the opponent offers a range of goods that “*might emulate the results of more invasive procedures.*” For example, the opponent sells CLINIQUE branded:

- i) Products which help to lighten dark spots (in lieu of hydroquinone treatments).
- ii) Lipstick colours that make a person's smile look brighter (in lieu of dental whitening procedures).
- iii) Pore solutions (in lieu of laser treatments).
- iv) Repairwear Laser Focus (in lieu of using laser treatments).
- v) Redness Solutions products for treating mild redness conditions (instead of prescription medicines).
- vi) Anti-blemish solutions (in lieu of dermatological procedures).

44. As support for this point, Ms Saunders provides evidence from on-line websites²⁵ where people report using CLINIQUE products to help alleviate the symptoms of medical skin conditions.²⁶

45. Ms Landau says that companies offering health and beauty treatments also offer complementary products. She mentions the Aveda Institute in London which opened in 2001 and offers beauty and spa treatments as well as a range of products. These include cosmetics, which appear to be marketed under the mark VITAL ELEMENTS.²⁷ Aveda also markets herbal tea under the AVEDA mark, but it is not claimed to improve the appearance of the drinker.²⁸ The Aveda Institute includes a cafe.²⁹

²³ See exhibit JS45.

²⁴ See exhibit JS46.

²⁵ Netdoctor and TalkHealth Partnership

²⁶ See exhibits JS48 & JS49.

²⁷ See exhibit AL27.

²⁸ See exhibit AL26.

²⁹ See exhibit AL30.

46. Ms Saunders says that the goods and services covered by the IRs are intended to protect the marks for spa, skin care and anti-ageing services and for products with health benefits which enhance beauty and appearance. She says that the products used by the health clinic and beauty spa business in the UK are similar to those sold by Clinique. In this connection Ms Saunders draws attention to the treatments offered in the UK by the Skin Health Spa, which include laser treatments for skin pigmentation issues, anti-ageing treatments, injectable skin treatments, waxing, and spray tanning. Ms Saunders notes that some of these treatments would involve the use of medical professionals, whilst other treatments would not. She also notes that this business uses JAN MARINI and DERMEQUEST (third party) cosmetic products, which she says are the same sort of products Clinique sells. Ms Saunders says that products like these, which are stated to be clinically researched, are commonly available from health clinics and spas in the UK. Ms Saunders draws attention to another example of this: a health clinic called Renew in Leamington Spa which provides a range of cosmetic and beauty treatments, some of which are medical and some of which are carried out by beauty therapists. This clinic uses the ATTACHE range of (third party) skin treatment products, which Ms Saunders says are also similar to those sold by Clinique.

Findings

47. I find that there is a significant degree of similarity of purpose between cosmetics/skin care/anti-ageing products and some nutritional products for medical purposes, such as PERFECTIL, WELEDA birch juice drink and COLLAGEN SHOTS. This overlap is recognised by the emergence of the term 'nutricosmetics'. These products may be competitive to a degree, but they are probably more often used in a complementary way.

48. I find that there is a high level of similarity between cosmetics/skin care/anti-ageing products and the services of a beautician. These goods and services may be competitive to a degree, but they are probably more often used in a complementary way.

49. I find that there is only a low degree of similarity between cosmetics/skin care/anti-ageing products and cosmetic medical treatments. This is because although there is some similarity of purpose, cosmetics generally cover up the symptoms of the problem whereas medical treatments change the condition of the body and address the underlying complaint. Where skin care or anti-ageing products improve the underlying issue (as the opponent claims for some of its skin care products, such as *Pore solutions*) the product is likely to take much longer to work than a medical procedure (such as laser treatment) and is unlikely to have as much effect. Anti-ageing products are more likely to slow the apparent rate of ageing than to produce an immediate reduction in apparent age, as a cosmetic medical procedure could do, if successful. Such products are not therefore comparable, in

terms of their specific purpose, to cosmetic medical treatments. This is why *lipsticks* are not in any real sense in competition with *dental whitening procedures*, and nor is the opponent's *Repairwear Laser Focus* really in competition with laser eye treatments.

50. I find that the opponent has not established that there is a competitive or complementary relationship between, on the one hand, cosmetics/skin care/anti-ageing products and, on the other hand, foodstuffs and drinks for non-medical purposes in classes 29, 30 and 32. I accept that some non-medical goods and drinks could be promoted as helping to improve the condition of the skin, but products such as BEAUTY'IN drinks and confectionery are not really in competition with cosmetics. This is because no one would buy sweets or soft drinks as an alternative to using a skin cream and they are unlikely to be used in a complementary way in the sense described in the case law.

51. Similarly, it is unlikely that average consumers of cosmetics would consider mineral water to be an alternative, or regard the one as important for use with the other such that the products may be thought to originate from the same (or a related) trade source. That finding is not undermined by the evidence that some cosmetics are made from mineral waters. It does not follow that consumers expect the same undertaking to sell cosmetics and mineral water for drinking purposes, and the evidence does not show that this is a common practice.

The applicant's business

52. Mr Mattli gives evidence that the 'private hospital' Clinique La Prairie was founded in Switzerland in 1931. He says that it is "*a medical, health, well-being and beauty retreat which specialises in anti-ageing treatments*". This is borne out by the IR holder's advertising brochure,³⁰ which I note includes both medical and spa treatments. The centre includes two operating theatres. It also has a restaurant serving "*the best of nutrition and gastronomic excellence*".

53. It is one of Switzerland's most famous retreats having won numerous awards including 'Runner-up World's Favourite Medical Spa', Conde Nast Traveller, 2010 and 2011, and 'World's Best Medical Spa', 2006, The Sunday Times.³¹

54. Mr Mattli says that the IR holder "*and its affiliates*" have used the IRs in Switzerland in relation to "*mineral food supplements and nutritional additives for medical purposes*". He provides examples of packaging for such goods bearing the marks and some sales figures.³²

³⁰ See exhibit GM11.

³¹ See exhibit GM11.

³² See exhibits GM7 & 8.

55. The private hospital also established the skincare brand LA PRAIRIE before selling it off to an American business in 1982. According to the evidence given by Ms Saunders on behalf of the opponent, the IR holder's own skincare products are now provided under the mark SWISS PERFECTION.

56. Mr Mattli says that the IR holder has provided health clinic services under the opposed marks within the last 5 years in the USA. However, goods and services are currently only provided under the CLINIQUE LA PRAIRIE marks in Switzerland. The marks are, however, advertised throughout Europe and elsewhere. Mr Mattli says that the IR holder is not aware of any confusion arising as a result of such use.

Finding

57. The IR holder provides medical spa services (and associated restaurant services) under the opposed marks at a retreat in Switzerland. There is no evidence of use of the IRs in relation to any goods sold in the UK. The IR holder's retreat appears to have attracted some attention from the UK media as a top-end medical spa retreat based in Switzerland.

The Section 5(2)(b) grounds

58. Section 5(2)(b) is as follows:

“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.”

Comparison of the goods and services

59. Although the opponent formally relies on the registration of the earlier marks for all the services for which they are registered, it accepts that the services covered by classes 35, 41 and 43 of the earlier 075 and 560 marks are secondary in importance to registration of the earlier marks for the goods and services shown in the following table. For ease of comparison, I have also included the goods and services covered by the IRs. As the IR holder has not put the opponent to proof of use of the earlier marks for the purposes of the s.5(2) grounds of opposition, the opponent is entitled to rely on the goods/services as registered and covered by its statement of use.

<p>IR 1025395 - CLINIQUE LA PRAIRIE</p> <p>Class 5: Mineral food supplements; nutritional additives for medical purposes.</p> <p>Class 32: Mineral and aerated waters or other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p>	<p>UK 1539591 – CLINIQUE</p> <p>Class 3: Perfumes; cosmetics; non-medicated toilet preparations; soaps; essential oils; creams and lotions, all for the care of the skin and the body; preparations for suntanning and/or for protection against the sun; pre-shave and aftershave preparations; shaving creams; deodorants; anti-perspirants; shampoos; preparations for the care of the hair; all included in Class 3.</p> <p>CTM 54429 - CLINIQUE</p> <p>Class 3: Toiletries and body care preparations, soaps, perfumery, essential oils, cosmetics, anti-perspirants, talcum powder, hair care products including lotions; dentifrices.</p> <p>Class 42: Beauty consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; advisory services relating to provision of beauty, perfumery, make-up and skin treatment services; design and interior decoration services relating to retail stores, perfumeries, beauty salons, beauty counters; research, development, laboratory and technical support services relating to perfumes, cosmetics and beauty and skin treatment products.</p>
<p>IR 1088560</p>  <p><i>Clinique La Prairie</i></p> <p>& IR 1091075 – CLINIQUE LA PRAIRIE</p> <p>Class 5: Vitamin preparations; nutritional additives and supplements for medical purposes; dietetic</p>	<p>UK 1539591 - CLINIQUE</p> <p>Class 3: Perfumes; cosmetics; non-medicated toilet preparations; soaps; essential oils; creams and lotions, all for the care of the skin and the body; preparations for suntanning and/or for protection against the sun; pre-shave and aftershave preparations; shaving creams; deodorants; anti-perspirants; shampoos; preparations for the care of the hair; all included in Class 3.</p>

beverages, foodstuffs and substances for medical purposes; herbal teas for medical purposes; medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes.

Class 29: Dietetic food supplements or foodstuffs, for non-medical purposes, made with albumen, lipids, fatty acids, with added vitamins, minerals, trace elements, either individually or in combinations, included in this class; albumen for food; pollen prepared as foodstuff; meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; compotes; eggs, milk and/or milk products; edible oils and fats; weed extracts for food; fat-containing mixtures for bread slices; yogurt; kefir (milk beverage); soups; nuts (prepared); fruits (cooked, preserved and/or frozen); protein for human consumption.

Class 30: Dietetic foodstuffs or food supplements, for non-medical purposes, made with carbohydrates, dietary fiber, with added vitamins, minerals, trace elements, either individually or in combinations, included in this class; coffee and/or artificial coffee; tea; cocoa; sugar; rice; tapioca; sago; flour and/or cereal preparations; bread; pastries and/or confectionery; edible ice; honey, golden syrup; yeast, bicarbonate of soda; salt; mustard; vinegar, sauces [condiments]; spices; candy bars; corn flakes; essences for foodstuffs, except etheric essences and essential oils; cake paste; tea-based beverages; cereal preparations; yeast in pill form, not for medical use; chewing gum, not for medical purposes; malt extract for food; flour-milling products; muesli; natural sweeteners; infusions, not medicinal; glucose for food; rusks.

Class 32: Mineral and aerated waters or other non-alcoholic beverages; fruit drinks and fruit juices; syrups and other

CTM 54429 - CLINIQUE

Class 3: Toiletries and body care preparations, soaps, perfumery, essential oils, cosmetics, anti-perspirants, talcum powder, hair care products including lotions; dentifrices.

Class 42: Beauty consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; advisory services relating to provision of beauty, perfumery, make-up and skin treatment services; design and interior decoration services relating to retail stores, perfumeries, beauty salons, beauty counters; research, development, laboratory and technical support services relating to perfumes, cosmetics and beauty and skin treatment products.

UK 2000240 - CLINIQUE

Class 44: Provision of beauty, perfumery, make-up and skin treatment services, all provided at counters, salons and advisory centres; advisory services relating to all the aforesaid; beauticians' services.

CTMs 54411 & 2293256, both:



covering:

Class 44: Beauty consultation services regarding the selection and use of personal care products, cosmetics, make-up, toiletries, perfumery, bath and body products, skin care products, hair care products and beauty treatments,

<p>preparations for making beverages.</p> <p>Class 43: Services for providing food and drink; cafeterias; bar services; information and advice concerning all the aforesaid services; all the aforesaid services being offered in the context of health clinics and/or medical clinics.</p> <p>Class 44: Medical and surgical services; dentistry; hospitals; medical clinics; medical assistance; massage, this service being offered only in the context of health clinics; physiotherapy; Turkish baths, this service being offered only in the context of health clinics; health care, particularly draining and lymphatic draining offered only in the context of health clinics; hydrotherapy, this service being offered only in the context of health clinics; balneotherapy, this service being offered only in the context of health clinics; thalassotherapy, this service being offered only in the context of health clinics; aromatherapy and chiropractic offered only in the context of health clinics; nutritional advice offered only in the context of health clinics; services of a psychologist; telemedicine services; advice and information with respect to all the aforesaid services, offered in the context of health clinics and/or medical clinics.</p>	<p>color analysis and personal appearance, aromatherapy and reflexology products; beauty salon services, beauty treatment services, make-up services, massage services, hair care services, manicure services, pedicure services, cosmetic treatment services.</p> <p>- are relied on against IR 1088560 <u>only</u>.</p>
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60. In comparing the respective goods and services, I take account of the judgment of the CJEU in *Canon* where the court stated at paragraph 23 of its judgment that:

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

61. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*,³³ the General Court stated that “complementary” means:

“... 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”.

62. I am aware of comments made by Mr Daniel Alexander Q.C. as The Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*³⁴ to the effect that the complementary relationship between goods and services is but one aspect of the assessment of similarity which should not be given undue weight or be applied too rigidly.

63. I am also aware that in *Sanco SA v OHIM*³⁵ the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree, in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken and transport services for chickens. I remind myself that the purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking. As Mr Alexander noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:

“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.”

Whilst on the other hand:

“.....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.

64. The reason that the General Court accepted that chickens and chicken transport services are complementary appears to be because professional businesses that purchase chickens may expect the same provider to provide specialist transportation services for chickens.

65. Taking first the goods covered by class 5 of the 395 mark, I have already found that there is a certain similarity of purpose between some nutritional supplements and cosmetics, and that the goods are complementary to some degree. I consider

³³ Case T- 325/06

³⁴ See BL-0-255-13

³⁵ T-249/11

this may be enough for relevant consumers to believe that the respective goods are provided by the same undertaking (or related undertakings). Indeed there is some evidence of at least one company marketing both products under the same mark – OLAY. The goods are different in nature and method of use and only competitive to a low degree. I therefore find that there is a moderate degree of similarity between all the goods covered by class 5 of the 395 mark and cosmetics covered by class 3 of the opponent's earlier marks.

66. Class 5 of the 560 and 075 marks also cover nutritional supplements under the descriptions '*vitamin preparations; nutritional additives and supplements for medical purposes; dietetic beverages [in class 5, therefore for medical purposes], foodstuffs and substances for medical purposes*'. It follows from my previous findings that cosmetics are also similar to these goods to a moderate degree.

67. I do not see any similarity of nature, purpose or method of use between cosmetics, beauty products etc. in class 3 and "*herbal teas for medical purposes; medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes*" in class 5 of the 560 and 075 marks. The products are not complementary. They are not similar products.³⁶ Nor can I see any similarity between these products and the various beauty services covered by the earlier marks. Most of those beauty services are linked to cosmetics and skin treatments. I have considered whether '*cosmetic treatment services*' covered by CTM 2293256 (and relied upon only against the 560 mark) covers cosmetic weight reduction surgery, which might have some similarity of purpose to *medical preparations for slimming purposes*. I have concluded that cosmetic surgery of this kind is a medical service which does not naturally fall under the description '*cosmetic treatment services*'. Rather, these words naturally describe treatments involving cosmetics. This is consistent with OHIM's acceptance of the mark CLINIQUE (the French word for clinic) for these services. It seems unlikely that OHIM would have knowingly registered the French word for 'clinic' as a Community trade mark for a kind of medical service.

68. I therefore find that none of the services on which the opponent relies are similar to

"herbal teas for medical purposes; medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes" in class 5 of IRs 560 and 075.

³⁶ These findings appear to be consistent with those of Arnold J. in *Aveda Corporation v Dabur India Limited*³⁶, to which Mr Bartlett drew my attention.

69. Turning to the services in class 44 covered by the 560 mark, I note that the list includes 'massage services', which are also listed in class 44 of the opponent's CTM 2293256. Those services are clearly identical. The opponent's CTM 2293256 also covers '*Beauty consultation services regarding the selection and use of aromatherapy products*'. The IR holder's 560 mark covers '*aromatherapy services*'. Those services are self evidently similar in nature, are similar in purpose to a significant degree, and are complementary in the sense described in the case law. They are highly similar services.

70. The opponent's CTM 54429 covers '*Beauty consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; advisory services relating to provision of beauty, perfumery, make-up and skin treatment services*'. These are beauticians' services. The opponent's UK 2000240 covers '*Provision of beauty, perfumery, make-up and skin treatment services, all provided at counters, salons and advisory centres; advisory services relating to all the aforesaid; beauticians' services*'. These are also beauticians' services. The opponent's CTMs 54411 & 2293256 also cover beauticians services of various kinds.

71. The IR holder's 560 and 075 marks cover some services which are plainly medical services, such as '*Medical and surgical services; dentistry; hospitals; medical clinics; medical assistance; health care, particularly draining and lymphatic draining offered only in the context of health clinics; nutritional advice offered only in the context of health clinics; telemedicine services*'. These services are different in nature to beauticians' services, although there is some similarity of purpose between some beauticians' services and some anti-ageing medical treatments and advisory services. Generally, the services are not competitive, but beauticians' services may be complementary to some anti-ageing medical treatments. Further, the evidence indicates that they may all be provided at a medical spa. Overall, I consider there to be a low level of similarity between the services listed above and the beauticians' services covered by the opponent's marks. For the reasons given in paragraph 49 above, I have already found that there is a low degree of similarity between cosmetics/skin care/anti-ageing products and cosmetic medical treatments.

72. The IR holder's 560 and 075 marks also cover '*Turkish baths, this service being offered only in the context of health clinics; hydrotherapy, this service being offered only in the context of health clinics; balneotherapy, this service being offered only in the context of health clinics; thalassotherapy, this service being offered only in the context of health clinics; chiropractic and aromatherapy and offered only in the context of health clinics; 'massage services.*' These are the kinds of services that one might find in a health clinic or in a health spa, which might also offer beauticians services. They are similar in nature to beauticians' services (personal pampering) and also slightly similar in purpose in that they are partly intended to make one look healthier. I therefore find that there is a reasonable degree of similarity between the

services listed above and the sorts of beauticians' services covered by classes 42 and 44 of the opponent's earlier marks.

73. The other services covered in class 44 of IRs 560 and 075: '*Physiotherapy; services of a psychologist*' do not appear to be similar in any way to beauticians' services and cosmetics.

74. In line with my findings of fact above, I do not consider that the cosmetics/skin care/anti-ageing products covered by class 3 of the earlier marks are competitive or complementary to foodstuffs and drinks for non-medical purposes in classes 29, 30 and 32. Although this may include some goods, such as the BEAUTY'IN products identified in the opponent's evidence, which have some similarity of purpose with anti-ageing skin care products, they are very different in nature, method of use, and they are not in competition or complementary goods in the sense described in the case law. Taking all the various factors into account, I find that they are dissimilar goods.

75. Class 43 of the 075 and 560 marks cover services for providing food and drink. On the face of it these services are dissimilar to cosmetics etc. in class 3 and beauticians' services in class 44. It is submitted on behalf of the opponent that the limitation applied to the list of services in class 43 "*...all the aforesaid services being offered in the context of health clinics and/or medical clinics*", makes the services similar. I do not understand how this can be so. If the services without this restriction are dissimilar, it is difficult to see how adding such a restriction makes them similar.

76. The thrust of the opponent's argument is that all the goods/services covered by the IRs should be equated to '*the goods and services of a health spa specialising in anti-ageing treatments*' and therefore regarded as similar to some degree or another to cosmetics and anti-ageing products. However, it is not appropriate to adopt this broad brush approach. All of the goods and services covered by the IRs must be assessed on the basis of the descriptions of those goods/services included in the IRs. In the case of food and drink related services, this includes the provision of those services in a health clinic. However, that does not mean that (say) cafeteria services should be treated in the same way as anti-ageing medical services. In my view, the services covered by class 43 of the 075 and 560 marks are different in every respect to those covered by classes 3 and 44 of the earlier marks, except that some of the parties' goods and services might be provided at a health spa. That alone is not sufficient to make cafeteria services and the like similar to cosmetics or beauticians' services.

77. Given the opponent's acceptance that the goods/services shown in the above table represent its best case, there is no need to conduct any further assessment of the similarity between the respective goods/services.

Distinctive character of the earlier marks

78. The IR holder argues that CLINIQUE is “*descriptive and of marginal distinctive character*” for any goods/services with a clinical application or provided by clinics.

79. The average UK consumer of personal products of the kind covered by class 3 of the earlier marks is not fluent in French, but is capable of recognising the meaning of French words that look similar to well known English words.

80. I am not persuaded that the relevant average UK consumer encountering CLINIQUE in relation to cosmetics, beauty, skin care and anti-ageing products would equate that word to ‘clinical’. I accept that such a consumer is more likely to approximate the word to ‘clinic’, but I do not think that CLINIQUE will be taken as meaning precisely ‘clinic’ either. This is partly because the average consumer does not have a good grasp of French, partly because (even in English) ‘clinic’ does not have an obvious descriptive meaning for these goods (particularly if encountered in a retail environment), and partly because the consumer has no reason to stop and think about exactly what the mark means. Such a consumer is, however, likely to perceive the mark as conveying general medical overtones associated with properties of the goods. Indeed, the opponent’s marketing strategy appears to depend on such a link being made. The mark therefore alludes to characteristics of the goods. I find that CLINIQUE has a normal or average level of inherent distinctiveness for cosmetics, skin care, anti-ageing and the other products for which it is registered in class 3.

81. I have found that the mark has a substantial reputation for cosmetics, beauty, skin care and anti-ageing preparations. As a result of such use I find that it is highly distinctive of such products.

82. I found that the earlier marks do not have a separate reputation for beauty counselling and advisory services. The marks must therefore rely on their inherent distinctiveness for the services for which they registered in classes 42 and 44.

83. UK 2000240 is registered for:

‘Provision of beauty, perfumery, make-up and skin treatment services, all provided at counters, salons and advisory centres; advisory services relating to all the aforesaid; beauticians’ services’

84. CTM 54429 covers, in particular:

'Beauty consultation services in the selection and use of cosmetics, toiletries, perfumery and beauty treatment; advisory services relating to provision of beauty, perfumery, make-up and skin treatment services'.

85. These services are not closely associated with clinics, and also taking into account that the mark is CLINIQUE rather than CLINIC, if encountered outside the context of a clinic, the CLINIQUE mark would have at least a normal or average degree of inherent distinctiveness for such services.

86. CTMs 54411 & 2293256 cover similar services and also:

'Massage services, manicure services, pedicure services'.

87. These services are more likely to be immediately associated with clinics. In that context the average consumer is more likely to recognise CLINIQUE as having the same meaning as the English word it resembles: clinic. The mark therefore has some descriptive significance in relation to the above services. The CLINIQUE element of these earlier composite marks therefore has a below average level of inherent distinctive for such services.

88. The same would be true of the beauty related services covered by the other earlier marks, if they were encountered in the context of a clinic.

Comparison of the marks

89. The IRs are plainly not identical to CLINIQUE, but they includes that word. This introduces a degree of visual and aural similarity between the marks. The additional words at the end of the IRs – LA PRIARIE - mean that the marks also have significant visual and aural differences. Further, the 560 mark includes a device based on the letters CLP which introduces a further point of visual distinction from the word-only earlier marks. Earlier CTMs 54411 & 2293256 also include a device element including the letter C, but that device looks quite different to me to the CLP device in the 560 mark and, notwithstanding the similar positioning of the devices above the words, further distances the marks to the eye.

90. Conceptually, the earlier marks convey the ideas of French and medical, except in relation to services provided at clinics where the more precise 'clinic' concept would be more obvious.

91. When considered as wholes, the IRs do not have a recognisable concept in relation to the goods covered by the IRs. However, the words are obviously French and the CLINIQUE element of the IRs is likely to convey a similar general medical

connotation to that conveyed by the opponent's word marks when used in relation to nutritional and medical products in class 5.

92. When used in relation to services provided at health clinics and/or medical clinics, the IRs (or the word element in the case of the 560 mark) are likely to convey the more precise idea of 'clinic'. When used in that context, the words in the IRs give the impression that CLINIQUE LA PRAIRIE are French words designating a clinic called LA PRAIRIE.

93. Overall there is a low to medium degree of similarity between the marks, low where the (different) device elements reduce the level of visual similarity between them.

Likelihood of confusion

94. The matter must be judged at the dates when the IRs were designated for protection in the UK. This means 30 November 2009 in the case of the 395 mark, and 17 June 2011 in the case of the 560 and 075 marks.

95. In considering the likelihood of confusion I take account of the principles established by the Court of Justice of the European Union (CJEU) in cases *Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05P.

The principles

(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 in that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

96. As I have found that the goods and services covered by classes 29, 30, 32 and 43 of the IRs are dissimilar to any of the goods and services covered by the earlier marks, it follows that the ground of opposition under s.5(2) must be rejected insofar as it is directed at those goods and services.³⁷

97. The same must apply to '*herbal teas for medical purposes; medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes*' covered by class 5 of the 560 and 075 marks, and '*Physiotherapy; services of a psychologist*' covered by class 44 of these marks, which I have also found to be dissimilar to the goods/services covered by the opponent's marks.

³⁷ See *Waterford Wedgewood v OHIM* Case C-398/07

98. I have found that the goods covered by class 5 of the 395 mark and the nutritional supplements covered by class 5 of the 560 and 075 marks under the descriptions '*vitamin preparations; nutritional additives and supplements for medical purposes; dietetic beverages [in class 5, therefore for medical purposes], foodstuffs and substances for medical purposes*' are moderately similar to the goods covered by class 3 of the earlier marks, particularly cosmetics, beauty, skin care and anti-ageing products.

99. I also found that the earlier marks are highly distinctive of such goods and that there is a low to medium degree of similarity between the respective marks (low where the (different) devices are included in the visual comparison).

100. Importantly, I also found that the IRs would not convey any precise descriptive message to an average UK consumer when used in relation to the goods in class 5 which I have found to be similar to the goods covered by the opponent's marks in class 3.

101. Taking all these factors into account I have concluded that the similarities between the marks and goods are sufficient, when combined with the high level of acquired distinctiveness of the earlier CLINIQUE marks, to make it likely that an average UK consumer of nutritional supplements, which includes so-called 'nutricosmetics', will believe that CLINIQUE LA PRAIRIE (with or without the CLP device) is used by the same undertaking, or an economically linked undertaking, to that which uses the CLINIQUE mark in relation to cosmetics, beauty, skin care and anti-ageing products.

102. In coming to this finding, I have not found it necessary to take into account the existence of a third party mark for cosmetics called LA PRAIRIE. Although it is necessary to take account of all relevant factors when assessing the likelihood of confusion (and I can see that this may have been a relevant factor if the IRs covered cosmetics), I do not regard it as relevant to the facts here. This is because it does not seem particularly likely that two parties which compete in the cosmetics market would collaborate together in order to produce and co-brand related nutritional supplements.

103. Nor do I consider the existence of the third party LA PRAIRIE mark as being relevant to the likelihood of confusion between the earlier CLINIQUE marks and the services for which the IR holder seeks protection for the 075 and 560 marks in class 44. This is because:

- i) This class covers health and medical services, not cosmetics products.
- ii) Although the IR holder developed the LA PRAIRIE mark for cosmetics, the mark was sold to a third party around 30 years ago and no longer

(if it ever did in the UK) creates a link between the IR holder's marks and cosmetics sold as products.

- iii) There is no reason for the public to believe that two competitors in the cosmetics market would collaborate to provide (and co-brand) health or medical spa services.

104. I earlier found that there is some similarity between the services covered by class 44 of IRs 075 and 560 and the beauticians' services, advisory services and cosmetics etc. covered by the earlier marks. This ranges from identical (in the case of *'massage services'*), to reasonable (in the case of typical health spa services, such as *'turkish baths'*, to low in the case of ostensibly medical services, such as *'medical and surgical services'*.

105. As I have already noted, the earlier CLINIQUE marks are highly distinctive for cosmetics, beauty, skin care and anti-ageing products. However, the opponent's marks have no reputation for services and are therefore less distinctive for the services I have found to be similar than they are for cosmetics. In the one instance where the services are identical (*'massage services'* relied upon only against the 560 mark) the similarity between the respective marks is less than with the word only marks because the marks include different looking device elements.

106. Importantly, I also found that when encountered in the context of services provided at a health or medical clinic, as all the services offered under the IRs are bound to be,³⁸ the words CLINIQUE LA PRAIRIE are likely to be taken as a name. More specifically they are likely to be understood by an average UK consumer of such services as French words designating a clinic called LA PRAIRIE. This will strongly point away from any connection to the well known cosmetics mark CLINIQUE.

107. Taking all these factors into account, I find that there is no likelihood of direct or indirect confusion in relation to the contested services covered by class 44 of IRs 075 and 560.

Outcome of the s.5(2) ground of opposition

108. The s.5(2) ground of opposition to the 395 mark succeeds in class 5, and also succeeds against the goods covered by class 5 of the 075 and 560 marks, (except for *'herbal teas for medical purposes; medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes'*). The s.5(2) ground fails against the goods and services in other classes of the IRs.

³⁸ Because of the wording of the IRs services in class 44.

Assessment of the Section 5(3) ground of opposition

109. Section 5(3) is as follows:

5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

110. As I have already decided that the s.5(2) ground of opposition to the IRs succeeds in relation to the goods in class 5 described in paragraph 108 above, there is no need for me to decide whether the s.5(3) ground also succeeds so far as those goods are concerned. Instead I will consider this ground against the goods and services which have survived the opposition based on s.5(2).

111. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and *Marks and Spencer v Interflora*.³⁹ The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks, the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

³⁹ Case C-323/09

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

The reputation of the earlier marks

112. Earlier I found that the extensive use made of the CLINIQUE mark, with and without the C device element shown at paragraph 4 above, has given the earlier marks a substantial reputation for cosmetics, beauty, skin care and anti-ageing preparations. It follows that, for these goods, the earlier marks satisfy the use conditions in s.6A of the Act. There is no question that the earlier marks have the necessary reputation to qualify for protection under s.5(3).

Link

113. The relevant public for the goods and services covered by the IRs is the general public. The general public are also the relevant consumers of cosmetics, beauty, skin care and anti-ageing preparations.

114. Taking account of:

- i) the high level of reputation of the earlier marks,
- ii) the fact that they appear to be the only CLINIQUE marks in use for goods on the UK market,
- iii) the common consumer base,

- I consider that, despite the low to moderate level of overall similarity between the respective marks, the presence of the word CLINIQUE in the IRs will cause the relevant public to call to mind the earlier CLINIQUE marks (and therefore create the necessary link) if the IRs are used in relation to goods connected with improving the appearance of the skin.

115. I must consider "*all the circumstances in which the [IRs] applied for might be used if [they] were to be registered*".⁴⁰ There is evidence that mineral waters, drinks and confectionery are currently marketed as improving the appearance of the skin. The latter, in particular, shows that it is possible to add vitamins and/or collagen to many foodstuffs and drinks and market them as improving appearance. Further, certain natural products, such as honey, are well known for their benefits to the skin. On that basis I find that use of the IRs in relation to the goods in classes 5, 29, 30 and 32 will cause the public to link the IRs to the earlier CLINIQUE marks, except where the nature of the goods means that there is no serious likelihood that they could be perceived as being connected with improving the appearance of the skin.

116. This excludes the following from the scope of the s.5(3) objection:

Class 5: Medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes.

Class 29: Meat, fish, poultry and game; meat extracts; jellies; jams; compotes; eggs.

Class 30: Coffee and/or artificial coffee; cocoa; sugar; rice; tapioca; sago; bread; pastries: edible ice; golden syrup; bicarbonate of soda; salt; mustard; vinegar, sauces [condiments]; spices; cake paste; chewing gum, not for medical purposes; natural sweeteners; glucose for food.

Class 32: Syrups and other preparations for making beverages.

⁴⁰ See, by analogy, Case C-533/06, *O2 Holdings v Hutchison 3G UK* at paragraph 66

117. I also reject the s.5(3) ground in relation to the services in classes 43 and 44 covered by the 075 and 560 marks. This is because I consider that the public will see CLINIQUE LA PRAIRIE as the name of a clinic called LA PRAIRIE when used in relation to the services of a health or medical clinic. In that case use of the IRs would not cause the public to bring to mind the earlier CLINIQUE marks for cosmetics etc., even when used in relation to services connected with anti-ageing treatments.

Advantage

118. Turning to the remaining goods in classes 5, 29, 30 and 32, I accept that use of the IRs in relation to goods which might be connected with improving the appearance of the skin would lead to the 'safe' and 'clinically tested' image of the earlier CLINIQUE marks being transferred to the IRs. This would also make it easier to market such goods under the IRs. It would also save the IR holder the usual advertising costs associated with familiarising the UK public with a new mark for such products. The IRs would therefore gain an advantage from the link with the opponent's earlier marks.

Due cause

119. The opponent's representative drew my attention to the well known passage from the judgment of the Benelux court in *Lucas Bols*⁴¹ to the effect that:

" What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damage the owner of the mark would suffer from such use or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark."

120. My attention was also drawn to paragraph 93 of the judgment of the CJEU in *Marks and Spencer v Interflora*⁴² to the effect that:

"...where....advertisement puts forward.... without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without 'due cause'."

121. The CJEU appears to accept that where, as a result of fair competition, a defendant gains an advantage from the use of a sign corresponding to an earlier reputed mark, such use is 'with due cause'. This might cover some uses that would

⁴¹ [1976] LLC 425

⁴² Case C-323/09

not qualify for the defence on the strict ‘compulsion’ basis described in the *Lucas Bols* case.

122. In *BskyB v Microsoft*⁴³ Asplin J. appears to have thought that the description of the ‘due cause’ defence expressed in *Marks and Spencer v Interflora* may be of limited application to internet keyword cases. So far as I am aware, the *Marks and Spencer* case is the first time that the CJEU has expressed a view as to the scope of the ‘due cause’ defence.⁴⁴ The last time the court was called upon to decide the meaning of a provision of EU trade mark law based on earlier Benelux law, it decided that the EU provision had a different meaning to that which the Benelux courts had given to the original national provision.⁴⁵ The CJEU’s statement as to the scope of the ‘due cause’ defence in *Marks and Spencer* may therefore be a more accurate indicator of the scope of the defence than the passage set out above from *Lucas Bols* case. However, it is not necessary for me to decide the exact scope of the ‘due cause’ defence in order to decide this case. In my view, the IR holder does not have due cause to use the IRs in the UK for any of the goods set out in paragraphs 129 and 130 below (“the goods at issue”).

123. This is because:

- i) The IR holder has not used the IRs in the UK for any goods.
- ii) The IR holder does not even appear to use the IRs in relation to the goods at issue in Switzerland.

124. In these circumstances, the longstanding use of the IRs in relation to health and medical spa services in Switzerland, and any associated use of the marks in Switzerland in relation to nutritional supplements and additives, cannot provide the IR holder with ‘due cause’ to use the IRs in the UK in relation to the goods at issue.

Unfair advantage

125. There is some debate as to whether the judgment of the CJEU in *L’Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L’Oreal v Bellure* when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood*.⁴⁶

⁴³ [2013] EWHC 1826 (Ch) at page 193

⁴⁴ Advocate General Kokott relied upon the judgment of the CJEU in *Marks and Spencer v Interflora* in opining that use of a later mark, which started before the filing date of an earlier filed mark of repute, might provide ‘due cause’ for the use of the later filed mark: See Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*.

⁴⁵ See *Sabel BV v Puma AG* [1998] RPC 199

⁴⁶ Reported at [2010] RPC 2: see paragraph 136

And thirdly and most recently, in *Specsavvers v Asda Stores Limited*.⁴⁷ On each occasion the court appears to have interpreted *L'Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause.

126. The opponent's representative drew my attention to paragraph 89 of the judgment of the CJEU in *Marks and Spencer v Interflora* as support for the submission that use without due cause which exploits the public's familiarity with the mark CLINIQUE thereby takes unfair advantage of the earlier marks. The relevant paragraph of the CJEU's judgment is set out below (and in context).

“Unfair advantage taken of the distinctive character or the repute of the trade mark (free-riding)

84 As the Court has already held, an advertiser which has selected in an internet referencing service a keyword corresponding to another person's trade mark intends that internet users who enter that word as a search term should click not only on the links displayed which come from the proprietor of the trade mark, but also on the advertising link of the advertiser (*Google France and Google*, paragraph 67).

85 It is also apparent that the fact that a trade mark enjoys a reputation makes it likely that a large number of internet users will use the name of that mark as a keyword when carrying out an internet search to find information or offers relating to the goods or services covered by that trade mark.

86 In those circumstances, as the Advocate General observes at paragraph 96 of his Opinion, it cannot be denied that, where a competitor of the proprietor of a trade mark with a reputation selects that trade mark as a keyword in an internet referencing service, the purpose of that use is to take advantage of the distinctive character and repute of the trade mark. In fact, that selection is liable to create a situation in which the probably large number of consumers using that keyword to carry out an internet search for goods or services covered by the trade mark with a reputation will see that competitor's advertisement displayed on their screens.

87 Nor can it be denied that, when internet users, having studied the competitor's advertisement, purchase the product or service offered by the competitor instead of that of the proprietor of the trade mark to which their search originally related, that competitor derives a real advantage from the distinctive character and repute of the trade mark.

⁴⁷ [2012] EWCA Civ 24: see paragraph 127.

88 Furthermore, it is not disputed that, in the context of a referencing service, an advertiser which selects signs identical with or similar to the trade marks of other persons does not, as a general rule, pay the proprietors of the trade marks any compensation in respect of that use.

89 It is clear from those particular aspects of the selection as internet keywords of signs corresponding to trade marks with a reputation which belong to other persons that such a selection can, in the absence of any 'due cause' as referred to in Article 5(2) of Directive 89/104 and Article 9(1)(c) of Regulation No 40/94, be construed as a use whereby the advertiser rides on the coat-tails of a trade mark with a reputation in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of its own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark. If that is the case, the advantage thus obtained by the third party must be considered to be unfair (Case C-487/07 *L'Oréal and Others*, paragraph 49)."

127. It is important to note that the case concerned the selection of keywords that corresponded to the claimant's trade mark. The defendant had clearly intended to cause the public to make a link between its use and the claimant's mark (in the sense that it wanted to use the keyword in order to identify itself as a competitor of the trade mark owner). I do not therefore consider that the CJEU's judgment in *Marks and Spencer v Interflora* resolves the debate as to whether an advantage gained without due cause is necessarily unfair. However, the absence of due cause appears to be closely linked to the existence of unfair advantage.⁴⁸

128. Where the user of the later mark has offered no plausible evidence explaining why it chose to use the mark in relation to the contested goods or services, UK courts and tribunals have been prepared to accept that the use of the later mark would be unfair.⁴⁹ In this case it is obvious why the IR holder chose to protect the IRs in the UK for services. However, it has offered no justification for applying to protect the IRs in the UK for the goods at issue in circumstances where the IRs do not appear to be in use in relation to those goods, even in Switzerland. Accordingly, if some additional factor is required, I find it is present here. I find that the advantage gained by the IRs, if they were used in relation to digestible products connected with improving the appearance of the skin, would take unfair advantage of the earlier CLINIQUE marks.⁵⁰

⁴⁸ See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*.

⁴⁹ See *Lonsdale Sport v Erol* [2013] EWHC 2956 (Pat) and *Socks World International Ltd v Beko* BL O-310 -10

⁵⁰ Excluding goods with the characteristics which make the IRs objectionable under s.5(3) would not be possible for the reasons set out in *Postkantoor* CJEU, Case C-363/99. See, in particular, paragraph 115 of the judgment.

129. The s.5(3) therefore succeeds against the 395 mark for:

Class 32: Mineral and aerated waters or other non-alcoholic beverages; fruit drinks and fruit juices.

130. The s.5(3) ground succeeds against the 075 and 560 marks for:

Class 5: Herbal teas for medical purposes

Class 29: Dietetic food supplements or foodstuffs, for non-medical purposes, made with albumen, lipids, fatty acids, with added vitamins, minerals, trace elements, either individually or in combinations, included in this class; albumen for food; pollen prepared as foodstuff; preserved, dried and cooked fruits and vegetables; milk and/or milk products; edible oils and fats; weed extracts for food; fat-containing mixtures for bread slices; yeast in pill form, not for medical use; yeast; yogurt; kefir (milk beverage); soups; fruits (cooked, preserved and/or frozen); nuts (prepared); protein for human consumption.

Class 30: Dietetic foodstuffs or food supplements, for non-medical purposes, made with carbohydrates, dietary fiber, with added vitamins, minerals, trace elements, either individually or in combinations, included in this class; tea; tea-based beverages; flour and/or cereal preparations; corn flakes; flour-milling products; muesli; malt extract for food; essences for foodstuffs, except etheric essences and essential oils; confectionery; honey; candy bars; infusions, not medicinal; rusks.

Class 32: Mineral and aerated waters or other non-alcoholic beverages; fruit drinks and fruit juices.

131. As I have upheld the 'unfair advantage' claim against all the goods for which the IR holder's marks are liable to be linked to the opponent's earlier marks, there is no need to separately examine whether the use of the IRs would be also be detrimental to the distinctive character or repute of the earlier marks.

The passing off right claim

132. Section 5(4)(a) of the Act states that a trade mark shall not be registered:

".....if, or to the extent that, its use in the United Kingdom is liable to be prevented

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade".

133. There is no need for me to decide whether the opposition brought under s.5(4)(a) succeeds against the goods I have already decided are caught by the s.5(2) or s.5(3) grounds of opposition. I will therefore limit myself to considering this ground against the remaining goods and services. These are:

Class 5: Medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes.

Class 29: Meat, fish, poultry and game; meat extracts; jellies; jams; compotes; eggs.

Class 30: Coffee and/or artificial coffee; cocoa; sugar; rice; tapioca; sago; bread; pastries; edible ice; golden syrup; bicarbonate of soda; salt; mustard; vinegar, sauces [condiments]; spices; cake paste; chewing gum, not for medical purposes; natural sweeteners; glucose for food.

Class 32: Syrups and other preparations for making beverages.

Class 43: Services for providing food and drink; cafeterias; bar services; information and advice concerning all the aforesaid services; all the aforesaid services being offered in the context of health clinics and/or medical clinics.

Class 44: Medical and surgical services; dentistry; hospitals; medical clinics; medical assistance; massage, this service being offered only in the context of health clinics; physiotherapy; Turkish baths, this service being offered only in the context of health clinics; health care, particularly draining and lymphatic draining offered only in the context of health clinics; hydrotherapy, this service being offered only in the context of health clinics; balneotherapy, this service being offered only in the context of health clinics; thalassotherapy, this service being offered only in the context of health clinics; aromatherapy and chiropractic offered only in the context of health clinics; nutritional advice offered only in the context of health clinics; services of a psychologist; telemedicine services; advice and information with respect to all the aforesaid services, offered in the context of health clinics and/or medical clinics.

134. The requirements to succeed in a passing-off action are well established and are summarised in *Halbury's Laws of England* 4th Ed. Vol. 48 (2007 reissue), paragraph 304, drawing on the guidance given by the House of Lords in *Jif Lemon*. Adapting the guidance to the facts in this case the opponent must establish that:

(1) the goods it provides have acquired a goodwill in the market and are known by reference to CLINIQUE;

(2) use of the contested marks in relation to the above goods and services would give rise to a misrepresentation (whether or not intentional) leading or likely to lead the public to believe that such goods or services are connected in the course of trade to the opponent; and

(3) it would be likely to suffer damage as a result of the erroneous belief engendered by that misrepresentation.

135. The opponent plainly has protectable goodwill under the CLINIQUE mark in relation to its business in cosmetics, beauty, skin care and anti-ageing preparations. Under the law of passing off it is not necessary for a claimant to be in the same field of activity as defendant, although it is more onerous to establish misrepresentation as a matter of fact where, as here, the parties are in different fields of activity.⁵¹

136. In my judgment, and save for one possible point, the case for saying that use of the IRs would amount to a misrepresentation to relevant consumers of the above goods/services is no stronger than the cases I have already considered for likelihood of confusion or unfair advantage under s.5(2) and 5(3).

137. The one possible difference between the position under trade mark law and the position under passing off law is that in the Court of Appeal in *Marks and Spencer PLC v Interflora*,⁵² Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law.⁵³ He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, as both tests are intended to be partly qualitative measures intended to exclude those who are unusually careful or careless, it is doubtful whether the difference between the legal tests will often result in different outcomes.

138. For the same reasons I found that the use of the 075 and 560 marks would not create a likelihood of confusion, or create a link to the earlier marks and the goods for which they have a reputation, I find that it is unlikely that a substantial number of persons will believe that use of the 075 and 560 marks in relation to the goods and services listed at paragraph 133 above, indicates a connection in the course of trade to the opponent’s CLINIQUE business.

139. The opposition under s.5(4)(a) cannot therefore succeed to any greater extent than the other grounds of opposition.

⁵¹ See, for example, *Harrods Limited v Harrodian School* [1996] RPC 697

⁵² See [2012] EWCA (Civ) 1501

⁵³ As per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40.

Outcome

140. I find that the opposition against the 395 mark succeeds for all the goods covered by the IR, except for:

Class 32: Syrups and other preparations for making beverages.

141. I find that the oppositions against the 075 and 560 marks succeed for:

Class 5: Vitamin preparations; nutritional additives and supplements for medical purposes; dietetic beverages, foodstuffs and substances for medical purposes; herbal teas for medical purposes.

Class 29: Dietetic food supplements or foodstuffs, for non-medical purposes, made with albumen, lipids, fatty acids, with added vitamins, minerals, trace elements, either individually or in combinations, included in this class; albumen for food; pollen prepared as foodstuff; preserved, dried and cooked fruits and vegetables; milk and/or milk products; edible oils and fats; weed extracts for food; fat-containing mixtures for bread slices; yeast in pill form, not for medical use; yeast; yogurt; kefir (milk beverage); soups; fruits (cooked, preserved and/or frozen); nuts (prepared) protein for human consumption.

Class 30: Dietetic foodstuffs or food supplements, for non-medical purposes, made with carbohydrates, dietary fiber, with added vitamins, minerals, trace elements, either individually or in combinations, included in this class; tea; tea-based beverages; flour and/or cereal preparations; corn flakes; flour-milling products; muesli; malt extract for food; essences for foodstuffs, except etheric essences and essential oils; confectionery; honey; candy bars; infusions, not medicinal; rusks.

Class 32: Mineral and aerated waters or other non-alcoholic beverages; fruit drinks and fruit juices.

142. The oppositions against the 075 and 560 marks fail for:

Class 5: Medical preparations for slimming purposes; diabetic bread; chewing gum for medical purposes.

Class 29: Meat, fish, poultry and game; meat extracts; jellies; jams; compotes; eggs.

Class 30: Coffee and/or artificial coffee; cocoa; sugar; rice; tapioca; sago; bread; pastries; edible ice; golden syrup; bicarbonate of soda; salt; mustard;

vinegar, sauces [condiments]; spices; cake paste; chewing gum, not for medical purposes; natural sweeteners; glucose for food.

Class 32: Syrups and other preparations for making beverages.

Class 43: Services for providing food and drink; cafeterias; bar services; information and advice concerning all the aforesaid services; all the aforesaid services being offered in the context of health clinics and/or medical clinics.

Class 44: Medical and surgical services; dentistry; hospitals; medical clinics; medical assistance; massage, this service being offered only in the context of health clinics; physiotherapy; Turkish baths, this service being offered only in the context of health clinics; health care, particularly draining and lymphatic draining offered only in the context of health clinics; hydrotherapy, this service being offered only in the context of health clinics; balneotherapy, this service being offered only in the context of health clinics; thalassotherapy, this service being offered only in the context of health clinics; aromatherapy and chiropractic offered only in the context of health clinics; nutritional advice offered only in the context of health clinics; services of a psychologist; telemedicine services; advice and information with respect to all the aforesaid services, offered in the context of health clinics and/or medical clinics.

Costs

143. The opposition against the 395 mark has been mostly successful.

144. The opposition against the 075 and 560 marks has partly succeeded and partly failed in the goods classes and failed in the service classes.

145. Overall, I find that each side should bear its own costs.

Dated this 5th day of December 2013

**Allan James
For the Registrar**