

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK TRADE MARK APPLICATION NO. 2581565 BY  
THORNTON & ROSS LIMITED**

**AND IN THE MATTER OF OPPOSITION NO. 102474 THERETO BY STRELLSON  
AG**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MR OLIVER  
MORRIS FOR THE REGISTRAR DATED 27 DECEMBER 2012**

---

**DECISION**

---

**Introduction**

1. This is an appeal brought under section 76 of the Trade Marks Act 1994 (the “**Act**”) against a decision of Mr Oliver Morris, Hearing Officer for the Registrar, in relation to an opposition under section 5(2)(b) of the Act (the “**Opposition**”) to trade mark application no. 2581565 (the “**Application**”). The Opposition succeeded in part. Strellson AG (the “**Opponent**”) now seeks by this appeal to increase the scope of the goods to be knocked out of the specification of the Application. There is no cross-appeal.
2. Thornton & Ross Limited (the “**Applicant**”) is the proprietor of the Application, which was filed on 17 May 2011. The Application is a device mark in the form set out below, covering a range of goods in classes 3 and 5:



3. The Opposition was filed on 4 October 2011. It is based on section 5(2)(b) of the Act and relies on the Opponent’s earlier International registration no. 837400 which designated the EU for protection on 5 October 2004, with protection being conferred on 31 January 2008, for the following mark (the “**Earlier Mark**”):



4. The Earlier Mark is protected in respect of a range of goods in classes 3, 9, 14 and 28, with those relied on in the Opposition being:

**Class 3:** perfumes, cosmetics.

5. The Opponent opposed the entire Application, and the Applicant defended the Opposition in full. Both sides filed evidence. The Opposition was heard on 15 November 2012 at which the Applicant was represented by Ms Jane Lambert, of Counsel, instructed by L.J. Bray & Co, and the Opponent was represented by Mr Mark Foreman of Rouse & Co.
6. The Hearing Officer allowed the Opposition in respect of some but not all of the opposed goods, in a written decision dated 27 December 2012 (BL O/511/12 – the “**Decision**”). Both sides having achieved a measure of success, the Hearing Officer did not give an award of costs in favour of either party.
7. On 23 January 2013, the Opponent gave notice of appeal to the Appointed Person, seeking to vary the Decision to the extent that it rejected the Opposition in relation to the following goods: “hair lotions; shampoos; hair care preparations; ...; essential oils; soaps; cleaning preparations”. The appeal came on for a hearing before me on 17 December 2013, at which the Opponent (and Appellant) was represented by Mr Philip Harris, instructed as advocate by Rouse & Co, and the Applicant (and Respondent) was represented Mr Peter Colley, instructed as counsel by L.J. Bray & Co.

### **Legislative Basis**

8. Section 5(2)(b) of the Act provides 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.

9. This provision is derived from the predecessor to article 4(1)(b) of First Council Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks (codified version).

### **The Decision**

10. The Hearing Officer set out the background and the full list of opposed goods in the Decision and I do not propose to repeat the exercise here.

11. He then summarised the evidence which had been filed by the Applicant, and mentioned the critique given in evidence by the Opponent, but found that the evidence did not assist him in deciding the issues before him. There is no appeal against that finding. The Hearing Officer also set out the standard Registry summary of the principles to be applied when determining whether there is a likelihood of confusion under section 5(2)(b). Again, since there is no challenge to this aspect of the Decision, I shall not re-set it out here.
12. At paragraph 22 of the Decision, the Hearing Officer identified the average consumer of the goods in class 3, as follows:

The average consumer will be a member of the general public and, although the cost of the goods can vary, they are not, generally speaking, expensive items and will be selected with no more than an average level of care and consideration.

There is no appeal against this.

13. The Hearing Officer then set out the guidance given by the Court of Justice of the EU in Case C-39/97 *Canon Kabushiki v Metro-Goldwyn-Mayer* [1999] RPC 117 to the effect that all relevant factors relating to the goods in issue should be taken into account when determining their level of similarity, including their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary. He also discussed other related guidance from the English and European courts. None of this has been challenged.
14. There followed a lengthy section (paragraphs 27 to 51) in which the Hearing Officer compared and contrasted the various goods in the specification for the Application with “perfumes” and/or “cosmetics” of the Earlier Mark. I reproduce below those extracts that are relevant to this appeal (with the underlining and bold emphasis being as per the original):

Hair lotions; shampoos; hair care preparations

34) Mr Foreman [for the Opponent] appeared to accept that such goods were not cosmetics per se but he argued they were nevertheless highly similar. I agree they are not cosmetics and, thus are not identical. In terms of similarity, the nature may be similar (to, for example, skin care lotions which are a form of cosmetic), but there (sic.) intended purposes have only a loose degree of similarity in terms of being part of a person’s personal care regime. The methods of use are different. The channels of trade have only a low level similarity, the goods are unlikely to be found in particularly close proximity. The goods are not competitive nor are they complementary in the sense described by the case-law. **I consider the goods to be similar but only to a moderate degree.**

....

Essential oils

37) According to the Collins English Dictionary, essential oils are products used for perfuming (as well as for flavouring); Strellson’s closest goods will, therefore, be perfumes. Essential oils consist of a concentrated extract of a particular plant. There is, however, nothing in the evidence to inform me as to how and for what purpose they are

sold to the general public as opposed to being sold to perfumery manufacturers. It may be possible that they can be purchased and then added to substances in the home to take advantage of their perfuming characteristics. For example, as aromatherapy products used to create massage oils, to add to bath water or to perfume the air. It seems unlikely, however, that an essential oil will be applied to the skin directly in the same way that a perfume may. There may be a similarity in nature in terms that they are perfumed liquids, however, the methods of use, primary purpose (although both may perfume) are not particularly similar. I doubt that the channels of trade are particularly similar, there is no evidence to offset my doubt. It does not strike me that the respective goods will be competitive in the sense that one would choose an essential oil as an alternative to perfume (or vice versa). Nor do I see that they are complementary in the sense described by the case-law. Overall, any aspects of similarity are not highly significant, however, as both perform, to some extent, a perfuming function, I would not go so far as to say that there is no similarity. **I consider the goods to be similar but only to a moderate degree.**

Soaps; cleaning preparations

38) Soaps and cleaning preparations can be considered together. They both have a primary purpose of cleaning/washing the face/body. This is more of a rudimentary human routine than a true cosmetic purpose to beautify oneself. The nature of soap and other cleaning preparations will often be in bar form or it could be in liquid form (such as liquid soap). Some cosmetics (such as lotions) are also liquid in nature so there is some similarity. The methods of use are similar in that they are applied to the body/face, but the exact methods of use differ due, for example, to the use of soap with water. The goods would not ordinarily compete and I do not regard the goods to be complementary in the sense described by the case-law. **I consider the goods to be similar but only to a moderate degree.**

15. Moving on to the marks themselves, the Hearing Officer first stated that, because there was no evidence of use of the Earlier Mark, he merely had to consider its inherent characteristics. Then, having taken on board each side's attempt to talk up (for the Opponent) or down (for the Applicant) the distinctive character of the Earlier Mark, the Hearing Officer described it as "a simple geometric shape of unremarkable characteristics" and concluded (at paragraph 51) that it had "at best a moderate degree of distinctiveness".
16. Before comparing the marks in issue, the Hearing Officer correctly stated that the average consumer perceives a mark as a whole and does not proceed to analyse its various details; and that 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. I do not need to set out the step by step approach of the Hearing Officer when comparing the two marks, since it is not under attack in this appeal, but suffice to say that he focused particularly on the presence of a cross in a circle in both marks and adopted a careful approach, concluding (at paragraph 56) that, "this all equates to marks that are reasonably similar to each other".
17. The Hearing Officer started his section of the Decision headed "Likelihood of confusion" with the following summary of the approach to be taken:

57) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, 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.

18. He then assessed each of the opposed goods in turn, applying his earlier conclusions on similarity of goods and marks, to consider whether or not there existed a likelihood of confusion. As stated at the outset, he found that this existed for some of the goods in issue, but not for others. In relation to the goods at the heart of this appeal, he said the following:

Conclusion in relation to: Class 3 - Hair lotions; shampoos; hair care preparations; essential oils; soaps; cleaning preparations (class 3).

63) I found these goods to possess only a moderate degree of similarity to cosmetics. Making the necessary multi-factorial assessment, **I come to the view that there is no likelihood of confusion. The opposition fails in relation to these goods.**

19. In view of the partial success and partial failure of the Opposition, the Hearing Officer decided not to award any costs in either direction.

### **Approach to this Appeal**

20. The role of the Appointed Person is to review the Decision, not to re-hear the case. I should show “a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle”: as explained in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5, at [28]. A decision does not contain an error of principle merely because it could have been better expressed.

21. In *Galileo International Technology, LLC v European Union* [2011] EWHC 35 (Ch) Floyd J concluded at [14]

...unless I am satisfied that the Hearing Officer made an error of principle, I should be reluctant to interfere. I should interfere if I consider the decision is clearly wrong, for example if I consider that he has drawn inferences which cannot properly be drawn, or has otherwise reached an unreasonable conclusion. I should not interfere if his decision is one which he was properly entitled to reach on the material before him.

22. Secondly, as noted by Mr Harris in his skeleton argument, it was said in *English v Emery Reimbold & Strick Limited* (and two other appeals heard with it) [2002] EWCA Civ 605, and further quoted in *REEF* at [19]:

... the judgment must enable the appellate court to understand why the Judge reached his decision. This does not mean that every factor which weighed with the Judge in his appraisal of the evidence has to be identified and explained. But the issues the resolution of which were vital to the Judge’s conclusion should be identified and the manner in which he resolved them explained. It is not possible to provide a template for this

process. It need not involve a lengthy judgment. It does require the Judge to identify and record those matters which were critical to his decision. ...

23. Mr Harris also drew my attention to the observation of Daniel Alexander QC (sitting as a Deputy High Court Judge) in *Digipos Store Solutions Group Limited v Digi International Inc.* [2008] EWHC 3371 (Ch) at [6] that:

... In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.

24. In the slightly different but related context of an appeal against a finding of trade mark infringement, Lewison LJ in the Court of Appeal made the following comments (*Okotoks Limited v Fine & Country Ltd* [2013] EWCA Civ 672 at [50]), which are also applicable to the function of the Appointed Person in appeals from the Registrar:

The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect.

25. Lewison LJ then referred to statements from Lord Hoffman in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416, 2423, Lord Mance in *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 at [46], and Lord Steyn in *Smith New Court Securities Ltd v Citibank NA* [1997] AC 254, 274 in support of that general proposition that an appeal court must be especially cautious about interfering with a first instance judge's decisions on what are "essentially value judgments", and in particular in the nature of the "multi-factorial assessments" required in trade mark matters.

26. As Mr Harris mentioned in his skeleton argument, if the Hearing Officer is shown to have made a material error, the Appointed Person must decide whether in the circumstances the overriding objective is best achieved through remitting the matter to the Registry or determining the objection herself or himself: *O2 Holdings Device Mark Application* (O-127-07) at [20].

### **Grounds of Appeal**

27. There were effectively three grounds of appeal, one in relation to all of the goods in respect of which the Appellant says the Hearing Officer went wrong, and two additional grounds in relation to "essential oils", as follows:

- (1) In relation to “hair lotions; shampoos, hair care preparations, soaps, cleaning preparations and essential oils”, having found that –
- a. the contested marks were reasonably similar;
  - b. the contested goods were moderately similar; and
  - c. the public would select the goods with no more than an average level of care and consideration, –

then on a proper application of the multifactorial assessment the Hearing Officer should have found that the reasonable similarity of marks would have an enhanced role to the average consumer, and that the proximity of reasonable/moderate similarity between the goods was sufficient to give rise to a likelihood of confusion instead of finding as he did that there was no likelihood of confusion;

- (2) In relation to “essential oils”, on his own reasoning at paragraph 37 of the Decision, the Hearing Officer should have concluded that these were of greater than “moderate similarity” to perfumes; and
- (3) It is clear from paragraph 63 of the Decision that in relation to “essential oils” the Hearing Officer carried out the multifactorial assessment only in relation to “cosmetics” and not in relation to “perfumes”, the latter having a higher degree of similarity such that a likelihood of confusion should have been found.

28. Under the first ground, I am to assume (because they are not challenged) that the Hearing Officer was correct in his assessments of similarity of both marks and goods, and in his determination of the identity of the average consumer. I am also to assume, and in any event I can see for myself, that the Hearing Officer directed himself correctly in relation to the applicable principles of law and the guidance as to how to conduct the global assessment of the likelihood of confusion. But nevertheless, I am asked to find that the Hearing Officer made an obvious mistake in his weighing up of the various factors and concluding that there was no likelihood of confusion.

29. The Opponent’s first ground of appeal effectively amounts to a submission that the following sum can be done for a case involving a consumer of average care and attention:

reasonable similarity (marks) + moderate similarity (goods) = likelihood of confusion.

30. Mr Harris rightly conceded in oral submission that one cannot have a precise formulaic approach to the assessment of likelihood of confusion. Indeed, to get over this problem, he had a go at persuading me that the Hearing Officer should have assessed the similarity between the Applicant’s goods in issue and “cosmetics” as being more than “moderate”, citing examples from previous cases in which particular pairings of goods had been found to have “reasonable” rather than “moderate” similarity. However, this strayed beyond the clear acceptance in the Form TM55 (Notice of Appeal) of the finding in relation to the

comparison of goods, and also amounted to speculation as to the different nuances of meaning intended by different tribunals when using words such as “moderate” and “reasonable” in relation to the level of similarity of goods under assessment. I am not prepared to go down that path in the absence of an obvious error, and none was brought to my attention.

31. Mr Colley submitted that this ground of appeal falls squarely within the observations of Daniel Alexander QC in *Digipos*. The suggestion that “the reasonable similarity of marks would have an enhanced role to the average consumer”, in the context of the level of similarity of goods and the nature of the average consumer that had been found, amounts to an argument that the Hearing Officer gave too much or too little weight to a factor in the multi-factorial global assessment, not an error of principle which warrants interference.

32. I agree.

33. Further, it simply is not the case that, under section 5(2)(b) of the Act, similarity of marks plus similarity of goods (or services), with an average consumer who is reasonably observant and circumspect, equals success of opposition. The law is that, where there exists a likelihood of confusion *because of* the similarities between the particular marks in issue and the particular goods (or services), then the mark shall not be registered. This requires an assessment which takes into account “all factors relevant to the circumstances of the case” (as explained in *Sabel v Puma C-251/95 [1998] R.P.C. 199* at [22] and subsequent cases). To follow a path of automatism would be contrary to established law.

34. Accordingly this ground of appeal is dismissed.

“essential oils”

35. There is more substance to the appeal in relation to “essential oils”.

36. By the second ground of appeal, the Opponent objects to the finding of “moderate similarity” between “essential oils” and “perfumes” at paragraph 37 of the Decision, which I have set out above. Here, Mr Harris argued that the Hearing Officer had made an obvious mistake, not simply in ‘grading’ the level of similarity, but in his understanding of the characteristics of the relevant pair of goods and their trade channels. The Opponent’s position was effectively that anyone who really understood what “perfumes” and “essential oils” are, and how they are sold in trade, would have found a higher than “moderate” level of similarity between them, particularly when set against the ‘similarity grading’ used for other pairings of goods in the rest of the Decision.

37. Mr Harris first pointed out that, before conducting his comparison, the Hearing Officer had said the following:



27) As a starting point, it is worth considering what goods are covered by the earlier mark. In terms of perfume, such a term is self-explanatory. In terms of cosmetics, the question arises as to the breadth of such an expression. “Cosmetics” is defined in the Collins English Dictionary as:

“Any preparation applied to the body, esp. the face, with the intention of beautifying it.”

38. The Hearing Officer expanded further on his understanding of what a cosmetic is, but said no more about perfumes before embarking on the comparison of the goods in the specification for the Application.

39. In Mr Harris’s submission, in the absence of an explanation by the Hearing Officer as to the “self-explanatory” characteristics of perfumes, it is appropriate to refer to the sorts of materials that Registry examiners and hearing officers refer to on a day to day basis, including in particular, dictionary definitions and Registry classification practice and procedure, in order to decide what he had – or should have had – in mind. In the absence of specific evidence, he submitted, one is also entitled to take judicial notice of matters that are notorious.

40. Mr Harris suggested that, given the Hearing Officer’s use of the Collins Dictionary for understanding other terms referred to in the Decision, it would be appropriate to refer to that dictionary for a definition of “perfume” along the lines of what the Hearing Officer had, or should have had, in mind. He set out the Collins English Dictionary online definition in his skeleton argument, as follows:

“1. noun: a mixture of alcohol and fragrant essential oils extracted from flowers, spices, etc, or made synthetically, used esp to impart a pleasant long-lasting scent to the body, stationery, etc *See also* cologne, toilet water; 2. a scent or odour, esp a fragrant one”

41. Mr Harris also directed me to the “TMclass” database operated by the Community trade mark office (OHIM), which is being rolled out across the EU member states, and which the UK Registry now adopts for classification purposes. When one searches for the term “perfume” in Class 3, one gets a list of over 40 ‘sub-categories’ to choose from, including (as highlighted by Mr Harris):

- Perfume oils
- Fumigation preparations [perfumes]
- Perfumes for ceramics
- Peppermint oil [perfumery]
- Room perfumes in spray form

Mr Harris pointed out in particular that, as for the dictionary definition, this list extends beyond perfumes for personal (body) use.

42. While I accept that dictionary definitions may be of assistance in understanding what is meant by words used in a trade mark specification, and may remind one of alternative meanings which do not immediately spring to mind, I am more cautious about reliance on the TMclass database, particularly in this case where that database was not (at least not openly) in use by the UK IPO at the filing date of the Application. However, like the dictionary definition, the above list does serve as a reminder that “perfumes” are not limited to bottles of perfume/scent that one would apply to one’s body.
43. Turning to the matters of which Mr Harris invited me to take judicial notice, as notorious facts, he did get dangerously close to giving evidence in his oral submissions, but those matters which it seems to me are widely known include the following:
- (1) the reason why people purchase perfumes is for their scent or odour; the same is true of many essential oils (albeit some are purchased more for their flavour than odour);
  - (2) as stated above, perfumes are not limited to perfumes for application to the body; they cover substances used to perfume products or the air around;
  - (3) perfumes generally contain essential oils as their perfuming ingredient;
  - (4) essential oils can be purchased and used in “raw” form, for example, in oil burners or heaters to perfume a room: they do not have to be used in admixture to create a perfume;
  - (5) a perfumed massage oil containing an essential oil performs the same perfuming function as a body perfume;
  - (6) perfumes, aromatherapy goods and room perfuming goods are sold in close proximity through the same channels, such as in specialist body care chains and in supermarkets
44. Bearing these matters in mind, it does seem to me that, where he carried out the comparison at paragraph 37, the Hearing Officer placed too much emphasis on the lack of evidence of (a) the purpose for which essential oils are sold to the public, and (b) the channels of trade through which they are sold. Further, having cited the example of essential oils being used to create massage oils, it is odd that he found it “unlikely” that an essential oil would be applied directly to the skin in the same way that a perfume would. Similarly, having stated earlier in the paragraph that essential oils can be used to perfume the air, it was strange that he concluded that perfume and essential oils would not be competitive in the sense that one would choose an essential oil as an alternative to perfume (or vice versa). If both products can perform that same function of perfuming the air, then surely they are competitive alternatives that a consumer can choose between. The same can be said of essential oils and perfumes designed for perfuming things such as stationery items. And, in relation to perfumes for application to the body, in addition to

the example of massage oil mentioned above, there are essential oils that in pure form are known to serve as personal perfumes – such as rose or lavender essential oil.

45. Mr Colley submitted that there was no error of principle here: the Hearing Officer relied on common sense and experience and did the right job. In his oral submissions he accepted that there was a degree of overlap between essential oils and perfumes, but he emphasised that they can be very different, citing turpentine as an example of an essential oil which would not be used for perfuming.
46. I have concluded that this is a case where intervention is warranted. Looking at the *Canon* criteria of the nature of the goods, their purpose, their methods of use and their degree of competitiveness, it seems to me that the Hearing Officer operated on some incorrect assumptions about the goods and channels of trade which do not accord with the normal meanings or ordinary trade usages of the goods. Insofar as complementarity is concerned, 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 Case T-169/03 *Sergio Rossi v OHIM (SISSI ROSSI)* [2005] ECR II-685 and other cases cited in the Decision at paragraph 25). This is somewhat circular guidance, but it is certainly the case that essential oils are indispensable as an ingredient of perfumes, and there are undoubtedly some well-recognised traders who sell perfumes alongside essential oils.
47. Accordingly, I conclude that the Hearing Officer was wrong to find only a “moderate degree” of similarity between “essential oils” and “perfumes” and that they in fact have reasonably high degree of similarity for the purpose of the test under section 5(2)(b).
48. Before considering whether this changes the outcome of the case on “essential oils”, I shall briefly deal with the third ground of appeal. Here, the Opponent’s point is that, having performed the comparison of goods between “essential oils” and “perfumes”, when setting out his conclusions on the likelihood of confusion in paragraph 63 of the Decision, the Hearing Officer then ‘lumped in’ “essential oils” with “hair lotions; shampoos; hair care preparations; soaps; cleaning preparations”, which had each been found to be moderately similar to “cosmetics”. Thus, apparently, on the face of the Decision, the Hearing Officer had forgotten that he was meant to be looking at the likelihood of confusion between the Mark on “essential oils” and the Earlier Mark on “perfumes”, but was instead assessing it in relation to the Earlier Mark being used on “cosmetics”.
49. It seems to me that the Hearing Officer made an unfortunate slip here in the way that he expressed his decision. He had many other pairings of goods to deal with in his assessment, which are not in issue in this appeal, and he was trying to set out his

conclusions in a convenient manner, and paragraph 63 was intended to deal with those pairings of goods where he had found “moderate similarity” between the goods covered by the Mark and either “perfumes” or “cosmetics” of the Opponent’s Earlier Mark. If this were the Opponent’s only complaint, I would have found it difficult to decide whether it was enough to justify a fresh look at the question of likelihood of confusion, though I am inclined to think that it would, as there is at the very least a ‘missing link’ in the reasoning as expressed. To assume that the Hearing Officer really meant to refer to “perfumes” insofar as his conclusion related to “essential oils” would be to write words in that are not there, in a way that might be unfair to the Opponent. However, given my conclusion in relation to the actual level of similarity between “essential oils” and “perfumes”, I do not need to consider this any further, as the question of likelihood of confusion must be looked at again in any event.

50. Mr Colley for the Applicant raised the question of whether I should re-apply the test myself, or instead refer the case back to the Registry for re-assessment there, if I were to conclude that the assessment of likelihood of confusion had been based on an incorrect finding of similarity between goods. Given that the conclusions of the Hearing Officer were reached without the benefit of witness evidence, I am in as good a position as the Registry would be in determining this point. I do not believe that it would be in accordance with the overriding objective to send the case back down for further submissions and further consideration, and possibly a further appeal, when the issues are self-contained and both parties have had the opportunity to argue the matter for a second time before me. I shall therefore consider the matter myself.

51. Applying the “global appreciation” test, as laid down in the case law and summarised in paragraph 16 of the Decision, and taking particular account of:

- (1) the nature of the average consumer as found by the Hearing Officer;
- (2) the Hearing Officer’s assessment of the similarity of the respective marks, with which I agree;
- (3) my finding that “essential oils” and “perfumes” have a reasonably high degree of similarity; and
- (4) the principle of interdependency, namely that a greater degree of similarity of goods may offset lesser similarities between the marks concerned (*Canon* at [17]), –

I consider that there is a likelihood of confusion between the marks in relation to these goods.

52. I note that the Hearing Officer himself concluded that there would be a likelihood of confusion when he considered the position in relation to pairs of goods that he found to be “highly similar” or “similar to a reasonably high degree”, or even only to have “a

reasonable level” of similarity. (On the ‘scale’ of similarity of goods that he used within the Decision, “moderate” came below “reasonable”.) Therefore, I believe that my conclusion is consistent with what he would have concluded had he not erred in his comparison of “essential oils” and “perfumes”.

### **Conclusion**

53. I therefore uphold the Opponent’s appeal in respect of “essential oils” and find that the Opposition is successful in relation to those goods, in addition to those for which the Hearing Officer found the Opposition successful below.
54. The Opponent’s appeal in relation to “hair lotions, shampoos, hair care preparations, soaps, cleaning preparations” is dismissed.
55. The Mark should therefore be allowed to proceed to registration in respect of the goods listed at paragraph 67 of the Decision, with the exception of “essential oils”
56. The Opponent’s appeal succeeded in part and failed in part, the Applicant having defended the appeal in full. Once again, the parties have each achieved a measure of success. While the Opponent has been successful in relation to only one of the six categories of goods under appeal, the lion’s share of the grounds, the argument and the effort on both sides related to that part of the case. Therefore, I shall not make an award of costs in either party’s favour, and nor shall I disturb the Hearing Officer’s decision as to costs below.

**ANNA CARBONI**

16 April 2014

The Appellant (Opponent) was represented by Philip Harris, instructed by Rouse & Co.

The Respondent (Applicant) was represented by Peter Colley, instructed by L.J. Bray & Co.