

O-340-14

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NOS 3022208 & 3022222
IN THE NAME OF UNIVERSAL HANDICRAFT INC. DBA DEEP SEA COSMETIC
IN RESPECT OF TRADE MARKS:

Adore

&

Adore
Cosmetics

AND

OPPOSITIONS THERETO
UNDER NOS 600000047 & 600000048 BY BSB GLOBAL

BACKGROUND

1. On 16 September 2013, Universal Handicraft Inc. DBA Deep Sea Cosmetic (the applicant) applied to register the above trade marks in class 3 of the Nice Classification system.¹ The specifications are the same for both marks and stand as follows:

Body creams [cosmetics]; Facial cleansers [cosmetic]; Facial creams [cosmetic]; Facial lotions [cosmetic]; Nail cream; Nail gel; Soaps; Facial beauty masks.

2. The applications were published on 13 December 2013, following which, BSB Global (the opponent) filed notice of opposition against the applications under the fast track opposition procedure.

3. The oppositions were brought under sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act) against all of the goods in both applications. The opponent relies upon UK trade mark 3013484 insofar as it is registered for the goods as shown below:

Mark details and relevant dates	Goods relied on
Adore Tanning Filing date: 11 July 2013 Date of entry on the register: 27 December 2013	Artificial tanning preparations; Self tanning creams [cosmetic]; Self tanning lotions [cosmetic]; Tanning gels [cosmetics]; Tanning oils [cosmetics].

4. The opponent states:

“Q.13 [The applicant’s mark] closely resembles the earlier trade mark because ADORE is a significant and memorable element of the trade mark. Although the earlier trade mark contains the additional word TANNING, this difference is insufficient to prevent confusion in the marketplace. Consumers who are aware of the earlier trade mark and are then confronted with the new trade mark on similar goods and services are likely to think that the similar goods and services derive from the same trade source, or be otherwise confused. Furthermore, the Cosmetic goods claimed in class 3 are similar to the conflicting trade marks claim for Cosmetic goods, also in class 3.”

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

5. On 12 March 2014 the applicant filed counter statements in respect of both marks. In respect of 'Adore' solus, it states:

"We deny the opponent's allegation that Trademark number [3022208] may cause confusion to consumers".

6. In respect of its 'Adore Cosmetics' mark the applicant states:

"We deny the opponent's allegation that Trademark number [3022208] may cause confusion to consumers, and do believe that the word COSMETICS is able to differentiate it from the opponent's trademark".

7. In both counter statements the applicant states:

"The owner of registered trademark number EU011885951 is also applicant of [the applications subject to these proceedings]. 'Universal Handicraft Inc.' filed for registration in the UK as 'Universal Handicraft Inc. DBA Deep Sea Cosmetic'. DBA means 'Doing Business As'"

As stated at point 20 of the Tribunal Practice Notice (TPN 4/2000), 'the counter-statement should set out the reasons for denying a particular allegation and if necessary the facts on which they will rely in their defence. For example, if the party filing the counter-statement wishes to refer to prior registrations in support of their application then, as above, full details of those registrations should be provided'.

We therefore accompany details of the previously identical trademark of the applicant..."

8. TPN 4/2000 is a general notice which refers to all types of proceedings before the Registry. At paragraph 8 of the same TPN the following is stated:

"There are a wide variety of grounds of opposition, revocation and invalidity and clearly detailed guidance for each cannot be given. And it would be wrong for practitioners to imply that setting out the information suggested below would be enough in any particular case to satisfy the requirement for particularised pleadings. However, in general, the statement must be headed up so as to identify the proceedings and should set out clearly and concisely details of each of the grounds on which the action is based and the material facts on which the party seeks to rely."

9. TPN 4/2009 is titled *"Trade mark opposition and invalidation proceedings – defences"* and is the relevant TPN applicable to these proceedings. Under the heading *"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark"*, the following is stated:

"4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in Ion Associates Ltd v Philip Stainton and

Another, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark, are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

10. That is the case here. Consequently, I will say no more about the applicant's Community mark.

11. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

"(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

12. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions.

13. No leave was sought in respect of these proceedings.

14. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

15. A hearing was neither requested nor considered necessary. Neither party filed written submissions.

16. I give this decision following a review of all of the material before me.

DECISION

17. Section 5(2)(a) and 5(2)(b) of the Act read as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.”

18. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

19. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

The average consumer and the nature of the purchasing act

20. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

21. The average consumer will be a member of the general public. The purchasing act is likely to be primarily a visual one as the goods will be selected from a website, catalogue or directly from a shelf. However, I do not ignore aural considerations as it is not unusual to find more expensive cosmetic products kept in cases or behind counters in, for example, salons and department stores, with the consequence that consumers may have to request the goods from a sales assistant. The goods in both parties' specifications are likely to be available in a broad range of prices though, as a general rule, these are relatively low value, fairly frequent purchases and are unlikely to demand a particularly high level of attention to be paid in their selection further than that necessary to establish suitable shade/colour, skin type, particular ingredients, aroma and so on.

Comparison of the marks

22. The competing marks are as follows:

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5 May 2004

The opponent's earlier mark	The applicant's marks
Adore Tanning	Adore
	Adore Cosmetics

23. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of them, because the average consumer normally perceives a mark as a whole and does not analyse its details.

24. The applicant's first mark consists of the word 'Adore' in title case. The type face is slightly stylised with gaps between the top of the bowl of the lower case letter 'd' and the stem and another gap in the letter 'e' between the crossbar and the stress. The stylization does not prevent the word being read as the word 'Adore' which is the dominant and distinctive element of this mark.

25. The applicant's second mark consists of the word 'Adore' presented as it is in the first of its marks. In addition, the word Cosmetics is presented, in title case, below the word 'Adore', beginning below the centre of the letter 'o' of the word 'Adore'. It is much smaller than the word 'Adore' and is subservient to it within the mark as a whole. The word 'Cosmetics' is non-distinctive for the goods at issue. Taking these factors into account, it is the word 'Adore' which is the dominant and distinctive element of this mark.

26. The opponent's earlier mark consists of the words 'Adore Tanning' in title case in a plain typeface, with no additional stylisation. The word 'Tanning' is the same size as the word 'Adore' but is non-distinctive for the goods at issue. Consequently, it is the word 'Adore' which is the distinctive element of the mark.

The opposition under Section 5(2)(a)

27. The opposition under section 5(2)(a) of the Act relied upon for the purposes of this opposition requires the competing marks to be identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the CJEU said, in relation to what constitutes an identical trade mark:

"51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

³ *Sabel v Puma AG, para.23*

52. However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] E.C.R. I-3819 at para.[26]).

53. Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54. In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

28. With regard to the opposition under section 5(2)(a) neither of the applicant's marks can be considered identical to the opponent's mark. Whilst the additional elements 'Tanning' and 'Cosmetics' are not distinctive in respect of the goods at issue, they are not “so insignificant that they may go unnoticed by an average consumer”.

29. The opposition under Section 5(2)(a) fails.

The opposition under Section 5(2)(b)

Section 5(2)(b) case law

30. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

The CJEU 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.*

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 of that mark;

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

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

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

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

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

Comparison of goods

31. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
Artificial tanning preparations; Self tanning creams [cosmetic]; Self tanning lotions [cosmetic]; Tanning gels [cosmetics]; Tanning oils [cosmetics].	Body creams [cosmetics]; Facial creams [cosmetic]; Facial cleansers [cosmetic]; Facial lotions [cosmetic]; Nail cream; Nail gel; Soaps; Facial beauty masks.

32. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

33. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (a) the respective *uses* of the respective goods or services;
- (b) the respective *users* of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, where in practice they are found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive, taking into account how goods/services are classified in trade.

34. Also relevant are the comments of the CJEU in *Canon* in which it stated, at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia,

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

35. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

36. I also bear in mind the comments of Daniel Alexander, sitting as the Appointed Person, in *LOVE*⁴, in which he said:

“18... the purpose of the test, taken as a whole, is to determine similarity of the respective goods in the specific context of trade mark law. It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

37. Where appropriate I will, for the purposes of comparison, group related goods together in accordance with the decision in *Separode Trade Mark*⁵:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

38. ‘Body creams’, ‘face creams’ and ‘facial lotions’ in the applicant’s specification are broad terms which may include the ‘tanning creams’ and ‘tanning lotions’ in the opponent’s earlier registration. In accordance with *Meric*, these are identical goods.

39. With regard to the remaining goods, they have a shared purpose in that they will all be used by someone seeking to beautify their body, to enhance their appearance. The goods are all creams, gels, oils and soap, which may be provided by the same undertakings within the cosmetics industry. They are sold in the same retail outlets such as pharmacies and department stores and will be sold in similar areas in stores or on websites or in catalogues. The goods are not complementary or in competition with each other. Taking all of these factors into account the remaining goods are similar to a high degree.

Visual and aural similarity

⁴ *BL O/255/13*

⁵ *BL O-399-10*

40. It is clear from cases such as *Sadas*⁶ and *Peek & Cloppenburg v OHIM*⁷ that normal and fair use of a word trade mark includes use in a range of fonts and cases. Accordingly, the fact that the earlier mark is registered in a plain black font does not prevent its use in a different font or case.

41. The colouring in the words does not have a bearing on the issue of similarity as neither party's mark is limited to any particular colour. The matter must be assessed on the similarity between the respective marks without regard to colour.⁸

The applicant's first mark, Adore

42. Both parties' marks contain the word 'Adore'. It is the first word of the opponent's mark and the totality of the applicant's mark. The earlier mark also includes the additional word 'Tanning', (which is non-distinctive for the goods). These words are common English words which will be well known by the average consumer. Taking all of these factors into account, I find these marks to be visually and aurally similar to a medium degree.

The applicant's second mark, Adore Cosmetics

43. Both parties' marks contain the first word 'Adore'. The applicant's mark is followed by the word 'Cosmetics', the opponent's by the word 'Tanning'. As before, these are common English words which will be well understood by the average consumer. I find these marks to be visually and aurally similar to a medium degree.

Conceptual similarity

44. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁹ The assessment must be made from the point of view of the average consumer.

45. All three marks contain the word 'Adore' which will be understood by the average consumer to mean, inter alia, 'love', 'cherish', 'care for'. The additional words 'Tanning' and 'Cosmetics' are descriptive of the goods at issue and are unlikely to be afforded any origin significance by the average consumer.

46. Accordingly, all three marks will evoke a sense of 'caring' resulting in the conceptual message being the same for all of them.

Distinctive character of the earlier mark

47. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods

⁶ *Sadas SA v OHIM*, T-346/04

⁷ T-386/07

⁸ *Specsavers International Healthcare Ltd v Asda Stores Ltd (No.2)* [2011] FSR 1, Mann, J.

⁹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

48. The opponent has not filed any evidence to show that it has used its mark, so I have only the inherent position to consider. The earlier mark consists of the words Adore Tanning. As I have already discussed, the word tanning is descriptive. The word Adore is not descriptive nor allusive of any of the goods relied upon. The mark in its totality is a normal trade mark, possessed of an average level of inherent distinctive character.

Likelihood of confusion

49. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁰ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

50. I have found the marks to be visually and aurally similar to a medium degree and have concluded that all three marks will convey the same conceptual message. I have found the earlier mark to have an average level of inherent distinctive character. I have found some of the parties' goods to be identical and some highly similar. I have identified the average consumer, namely any member of the general public, and have concluded that the level of attention paid will vary but will be at least reasonable to the extent that the purchaser will need to consider suitable shade/colour, skin type, particular ingredients, aroma. I have concluded that the purchase will be primarily visual, though I do not discount an aural element as enquiries may be made, or advice sought, prior to purchase.

51. I bear in mind the comments of the GC with regard to identical goods when considering the likelihood of confusion. In *Aldi GmbH & Co KG v Office for Harmonization in the Internal Market*¹¹ the GC stated:

“91 In addition, the Opposition Division considered that the goods at issue were identical, as was recalled in the contested decision, without the Board of Appeal's taking a final decision in that regard (see paragraph 40 et seq. above). That implies, in accordance with the case-law cited at paragraph 23 of the present judgment, that, if there is to be no likelihood of confusion, the degree of difference between the marks at issue must be high (see, to that effect, judgment of 29 January 2013 in Case T-283/11 *Fon Wireless v OHIM – nfon (nfon)*, not published in the ECR, paragraph 69).”

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

¹¹ (*Trade Marks and Designs*) (*OHIM*) Case T-505/11

52. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027,¹² that the first parts of words catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case the word 'Adore', which is the entirety of the applicant's first mark and the first word of the applicant's second mark and the opponent's mark, is the distinctive element of all of the marks at issue.

53. Taking all of these factors into account, particularly the concept of imperfect recollection, in my view, the similarity of the marks is such that in the context of identical and highly similar goods purchased, for the most part, visually, I find that there will be direct confusion (where one mark is mistaken for the other). At the very least there is indirect confusion where a consumer familiar with one party's mark(s) would, on encountering the other side's mark(s), believe them to be economically linked.

Conclusion

54. The opposition succeeds under section 5(2)(b) of the Act.

Costs

55. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Official fee:	£100
Total:	£400

56. I order Universal Handicraft Inc. DBA Deep Sea Cosmetic to pay BSB Global the sum of £400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of August 2014

**Ms A Skilton
for the Registrar,
The Comptroller General**

¹² *El Corte Ingles v OHIM - Gonzales Cabello and Iberia Lineas Aereas de Espana (MUNDICOR) [2004] ECR II – 965, paragraph 81*