

O-167-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3169994
BY THE CHAPEL HAIR & SPA LIMITED FOR THE TRADE MARK**

OPARUS

IN CLASSES 3, 4 & 21

AND

**THE OPPOSITION THERETO UNDER NUMBER 407565
BY
PENHALIGON'S LIMITED**

Background

1. On 16 June 2016, the Chapel Hair & Spa Limited (“the applicant”) filed trade mark application number 3169994, for the mark OPARUS, for goods in classes 3, 4 and 21.

2. The application was accepted and published in the *Trade Marks Journal* for opposition purposes on 8 July 2016. Penhaligon’s Limited (“the opponent”) opposes the application in respect of some of the class 3 goods under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the following earlier EU trade mark registration:

9964396

OPUS

Class 3: *Perfumery*.

Date of filing: 12 May 2011; completion of registration procedure: 7 October 2015.

3. The opponent claims that the marks and the opposed goods are similar, and that there is, therefore, a likelihood of confusion under section 5(2)(b).

4. The applicant filed a defence and counterstatement, denying the ground of opposition.

5. The opponent is represented by Ashfords LLP and the applicant by Trade Mark Consultants Co. Neither requested a hearing. The applicant filed evidence and written submissions in lieu of a hearing. In making this decision, I take into account the parties’ pleadings, evidence and written submissions.

Evidence

6. The applicant's evidence comes from Toby Dicker, the applicant's Managing Director, in the form of a witness statement dated 18 September 2017. Mr Dicker exhibits, at Annex 1, copies of a dictionary definition for 'opus':

"Noun. 1. *Music. A separate composition or set of compositions.*
2. *An artistic work, especially one on a large scale.*"

The definition comes from an online dictionary: en.oxforddictionaries.com.

7. Mr Dicker explains that the opponent's website refers to the meaning of its mark as "deed, labour, work and it is usually used in the context of magnum opus, great work."

8. Annex 3 consists of prints from the trade mark register, showing trade mark registrations which incorporate OPUS, for class 3 goods. This evidence is without relevance. Apart from the fact that some of the marks are registered for the sort of goods which the opponent has chosen not to oppose in the applicant's specification, there is no way of knowing whether the marks are in use in the UK. It is well-established that mere state of the register evidence does not assist a defence against a claim that there is a likelihood of confusion (see, for example, *Zero Industry Srl v OHIM*, Case T-400/06).

9. Annexes 4 and 5 consist of prints from the websites of 15 third parties which Mr Dicker states are trading using OPUS in relation to perfumes and goods which are similar to perfumery. Only two of these appear to emanate from the UK. Others appear to be details from the English language versions of overseas companies, and others clearly show the pricing in dollars. This, again, does nothing to suggest that the UK public is used to distinguishing between different entities using OPUS for similar goods.

Decision

10. 5(2)(b) of the Act states:

“(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.”

11. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

12. The opponent's earlier mark had been registered for less than five years on the date on which the contested application was published. It is not, therefore, subject to the proof of use provisions under section 6A of the Act. The consequence of this is that the opponent may rely upon the goods covered by the registration ("perfumery") without having to prove that it has made genuine use of them.

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

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

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

"82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...".

15. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited ("Treat")* [1996] R.P.C. 281 for assessing similarity between goods and

services also include an assessment of the channels of trade of the respective goods or services.

16. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

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

17. The goods to be compared are shown in the table below.

Earlier mark	Applicant's goods and services
Class 3: <i>Perfumery</i>	Class 3: <i>Perfumery; <u>toilet waters; eau de cologne; perfumes and fragrances; tissues and non-woven fabrics impregnated with toilet preparations and/or perfumes for personal use and/or cleaning preparations and/or with cosmetics; fumigating preparations (perfumes); ionone; musk; synthetic perfumery; perfumed tissues; perfumed sachets; perfumed soaps; perfumed creams; perfumed powders; aromatics for perfumes; perfumed toilet waters;</u></i>

	<u>perfumed talcum powder; flower perfumes; natural oils for perfumes; scents; room perfumes in spray form; perfumed body lotions.</u>
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18. Mr Dicker, for the applicant, concedes in his witness statement that the parties' goods are similar. In its written submissions in lieu of a hearing, the applicant qualifies his concession by underlining the goods which it considers to be similar only to a low degree. I have replicated this in the table above. It is still necessary to decide to what degree the goods are similar because a lesser degree of similarity between goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

19. I cannot agree that toilet waters and eau de cologne are similar to a low degree to perfumery. Toilet waters and eau de cologne are perfumes, and therefore fall within the ambit of perfumery (the applicant has not underlined perfumes, presumably because it considers that they are similar to perfumery to more than a low degree).

20. Collins (online) English Dictionary gives the following definitions for perfumery:

- “1. a place where perfumes are sold
- 2. a factory where perfumes are made
- 3. the process of making perfumes
- 4. perfumes in general.”

21. In the context of goods in a trade mark specification, the fourth definition is the most pertinent. Some of the applicant's goods are identical to the opponent's goods:

Perfumery; toilet waters; eau de cologne; perfumes and fragrances; fumigating preparations (perfumes); synthetic perfumery; perfumed toilet waters; flower perfumes; scents; room perfumes in spray form.

22. *Ionone; musk; aromatics for perfumes and natural oils for perfumes* are all components of perfumes, used to create perfumery in perfumeries (see the other definitions of perfumery). If not identical, these goods must be at least reasonably similar to perfumery, being complementary and sharing a similar nature and purpose. The remaining goods can all be perfumed and, again, if not strictly identical to perfumes, they are highly similar to perfumery ('perfumes in general'), as they share purpose (to make the user smell nice), method of use (applied to the skin), channels of trade (same outlets, often as part of a set) and can be an alternative to conventional liquid perfume (a body lotion, or impregnated tissue wipe to freshen up). The parties' goods are either identical or highly similar.

The average consumer and the purchasing process

23. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

24. The applicant submits that the opponent's goods are luxury goods. I do not accept this submission. If the applicant means that the opponent's goods are expensive, this is entirely irrelevant to the assessment of a likelihood of confusion, which must be assessed on a notional basis, not on the current marketing strategy or price point of the goods¹. Notionally, perfumes range from the inexpensive, including everyday body sprays, to the highly expensive. Inexpensive perfumes are not luxury items, and may be purchased relatively frequently. There is potential for a range of attention levels, from average to a good level of attention, depending on the price of the goods. The purchasing process is primarily visual, particularly if, during purchase, the consumer wishes to try the goods to see what they smell like. In these circumstances, the consumer will see the packaging. I do not ignore the potential for an aural aspect to the purchase, for example in department stores where staff may approach customers speculatively and offer them a sample of the goods.

¹ *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06 P, CJEU and *Bang & Olufsen A/S v OHIM*, Case T-460/05, General Court.

Comparison of marks

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

Earlier mark	Applicant's mark
OPUS	OPARUS

27. Both marks consist of a single word element, which forms their overall impression. OPUS comprises four letters, whilst OPARUS comprises six letters. The marks have in common the letters OP and US, which, in both marks, appear at the beginning and ends of the marks. The 'AR' element, which is absent from the

earlier mark, is therefore sandwiched between OP and US. The marks have a medium level of visual similarity.

28. OPUS has two syllables, whilst OPARUS has three. There are a number of ways in which OPARUS may be pronounced. The stress may fall upon the first syllable which may be a long or short O, as in the words 'opera' or 'opal', or it may fall upon the middle syllable ("AR"). OPUS may be pronounced with a short O (as in 'opera'), or a long O (as in 'opal'). The US syllable will sound the same in both marks. The AR syllable is soft and does not have great aural impact in the comparison, especially if both marks are articulated similarly, such as with a long O. Depending on pronunciation, there is either a medium degree or a low degree of aural similarity.

29. The applicant has given evidence about the meaning of OPUS. It also relies, for this purpose, upon content found on the opponent's website which says that OPUS is more usually found as part of the phrase 'magnum opus', meaning 'great work'.

30. In my experience, OPUS is not a common word used in everyday speech. Furthermore, the fact that a word is found in a dictionary (even an authoritative one such as Collins) does not mean that the average consumer is aware of the definition or is even aware that it is a word (as opposed to an invented word). The applicant has filed evidence from the opponent's website which says that 'opus' is usually found as part of 'magnum opus'. If this is the case, then without the context of 'magnum', it may not be recognised as a dictionary word at all.

31. OPARUS is an invented word. OPUS may be seen as an invented word; if it is, then the conceptual similarity between the marks is neutral as neither will be given a meaning by the average consumer. If the average consumer knows what OPUS means, there is no conceptual similarity, the one mark having a meaning and the other no meaning.

32. I will bring forward all these points when I make the global assessment as to whether there is a likelihood of confusion.

Distinctive character of the earlier marks

33. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*² the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

34. The opponent has not filed any use of its mark, so I have only the inherent distinctiveness position to consider. I have given above my conceptual analysis of the earlier mark. If seen as an invented word, the mark has a high degree of distinctive character. If the mark is not interpreted this way, but is recognised as the word ‘opus’, meaning a classical musical work, or part of the phrase ‘magnum opus’ (a great work), the distinctive character of the earlier mark is still above average as it

² Case C-342/97

not a common word and does not describe or allude to any characteristics of the goods.

Likelihood of confusion

35. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. I have already set out the ‘interdependency principle’ (*Canon*). The parties’ goods are identical or similar to a reasonable or high degree.

36. In the applicant’s favour is the possible low degree of aural similarity, depending on the pronunciation of the marks. However, pulling against this is my finding that the visual level of similarity is medium, and the purchasing process is primarily visual. This means that the level of visual similarity is, in what is generally a self-service product, more important than the aural similarity in the purchasing process³. Also in the applicant’s favour is the potential conceptual dissimilarity, if the meaning of OPUS is understood by the average consumer. There will be some average consumers who will not know what OPUS means, or even recognise it as a dictionary word (without knowing its meaning). For these consumers, the marks are both invented, and of medium visual similarity, for identical and similar goods for which there is an average degree of care taken in the, mainly visual, purchase. Without either mark having a recognisable concept, there is no conceptual hook upon which to hang their recollection of the marks. When the other factors are added into the mix, including the identical beginnings and ends of the marks, there is a greater potential for imperfect recollection. For these average consumers, there is a likelihood of confusion.

37. This is enough for the opposition to succeed⁴. However, it is my view that there is also a likelihood of confusion in relation to the average consumers who know what OPUS means. OPUS does not allude to or describe the opponent’s goods and has an above average degree of distinctive character for goods which are identical and

³ *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, General Court.

⁴ *SoulCycle Inc v. Matalan Ltd* [2017] EWHC 496 (Ch).

similar to the applicant's goods. In combination with the other factors which I have identified throughout this decision, I remain of the view that there is a likelihood of confusion brought about by imperfect recollection, albeit not as strong a likelihood as in relation to the group of consumers who see both marks as invented words. If I am wrong about that, the opposition succeeds, in any case, because, as I have explained, there is a likelihood of confusion amongst average consumers who do not know what OPUS means.

Outcome

38. The opposition succeeds. The application is refused for the opposed goods and may proceed to registration for all the goods which are unopposed.

Costs

39. The opponent has been successful and is entitled to a contribution towards its costs, based on the published scale (Tribunal Practice Notice 2/2016). I award the following costs to the opponent:

Filing the opposition and considering the counterstatement	£300
Opposition fee	£100
Considering the applicant's evidence	£500
Total	£900

40. I order The Chapel Hair & Spa Limited to pay Penhaligon's Limited the sum of £900 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period.

Dated this 15th day of March 2018

Judi Pike

For the Registrar,

the Comptroller-General