

**O-463-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3229945 BY  
MAZIN ALWARITH  
TO REGISTER:**

**Stush**

**STUSH**

**stush**

**AS A SERIES OF THREE TRADE MARKS IN CLASSES 3 & 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 410037 BY  
HIC S.r.l.**

## Background and pleadings

1. Mazin Alwarith (the applicant) applied to register the trade mark series

Stush  
STUSH  
stush

in the UK on 9 May 2017. It was accepted and published in the Trade Marks Journal on 19 May 2017 in respect of the following goods:

*Class 3: Cosmetics*  
*Class 25: Clothing*

As nothing turns upon the fact that the application is for a series of marks, for convenience, I will, from this point refer to the series in the singular.

2. HIC S.r.l. (the opponent) partially opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent is opposing registration of the contested mark for “Cosmetics” (Class 3). This is on the basis of its earlier European Union (formerly Community) Trade Mark no. 6442586 which has an application date of 8 November 2007 and registration date of 9 October 2008. The earlier trade mark, SHATUSH, is registered for the following goods and services which are relied upon in this opposition:

*Class 3: Cosmetics, hair lotions.*  
*Class 44: Services provided by hairdressing and beauty salons.*

3. The opponent argues in its statement of grounds that:

... the Applicant’s mark “STUSH” shares the same beginning letter “S” and the same string of letters “TUSH” The presence of the letter “HA” in the Opponent’s earlier mark is insufficient for STUSH to be distinguishable from it, not least when the pronunciation of “SHATUSH” is very close to “STUSH”.

The Applicant's mark is therefore highly similar to the Opponent's earlier mark.

4. The applicant filed a counterstatement denying the claims made. It stated that its belief that the two trade marks were

individually unique and ... dissimilar. For example, there is no "SHA" in "STUSH" and there is no "STUSH" in "SHATUSH". Also both words are pronounced differently.

5. Neither party filed evidence or written submissions. No hearing was requested and so this decision is taken following a careful perusal of the papers.
6. In these proceedings the opponent is represented by Stevens Hewlett & Perkins. The applicant is self-represented.

## **Decision**

7. Section 5(2)(b) of the Act states that:

A trade mark shall not be registered if because –

...

(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.

8. An "earlier trade mark" is defined in section 6(1) of the Act as:

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.

9. The registration upon which the opponent relies qualifies as an earlier trade mark under the above provision. The earlier mark was registered more than five years before the date on which the applicant's mark was published, and is therefore subject to proof of use provisions. The applicant did not request that proof of use be provided, and so the earlier mark may be relied upon for all the goods and services identified in the statement of use (i.e. cosmetics, hair lotions, and services provided by hairdressing and beauty salons).

#### **Case law**

10. In coming to a decision, I have borne in mind the following principles, gleaned from the decisions of the EU courts 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 and services

11. The marks cover the goods and services listed in the table below.

	<b>Earlier Mark</b>	<b>Contested Mark</b>
Class 3	Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.	Cosmetics
Class 44	Services provided by hairdressing and beauty salons.	

12. The contested goods (i.e. cosmetics) are identical to cosmetics in the earlier mark.

### Average consumer and the purchasing act

13. 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 good or services in question: see *Lloyd Schuhfabrik Meyer*, Case C-342/97.

14. In *Hearst Holdings Inc & another v A.V.E.L.A. Inc & ors* [2014] EWHC 439 (Ch), paragraph 60, Birss J described the average consumer in these terms:

The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the

relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.

15. The average consumer will be a member of the general public who can be expected to be paying an average level of attention when choosing the goods. Cosmetics vary in price, but in general they are not highly expensive and are a fairly frequent purchase. The average consumer will buy them from general retailers, department stores and specialist outlets, either by selecting them from a shelf or, less commonly and in the case of the more expensive items, asking for them over a counter. They may also be purchased online. The average consumer will encounter the marks visually, through advertising or online stores. As I have found that some purchases are made over the counter, perhaps with advice from a sales consultant, aural considerations may also play a role, albeit a lesser one than that played by visual considerations.

### **Comparison of marks**

16. 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 Court of Justice of the European Union 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.

17. It would be wrong, therefore, artificially to dissect the trade marks, although, 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.

18. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
SHATUSH	Stush STUSH stush

19. The applicant's mark consists of the word "STUSH" (the series is presented in three formats). The word is in a standard font with no stylisation. Nothing turns on the format of the words, especially as one of the series is in capital letters.<sup>1</sup> The overall impression of the contested mark rests in just that word.

20. The opponent's mark consists of the word "SHATUSH", in a standard font with no stylisation. As with the applicant's mark, nothing turns on the format of the words. The overall impression of this earlier mark rests in just that word.

### Visual comparison

21. The marks share the same initial letter and the last four letters. The earlier mark is longer, at 7 letters compared to the 5 letters of the contested mark. In my view, there is a medium degree of visual similarity between the marks.

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<sup>1</sup> Registration of a mark in capital letters covers use in lower case, as stated by Professor Ruth Annand, sitting as the Appointed Person, in *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.



## **Aural comparison**

22. The applicant's marks consist of one syllable and begin with a sibilant "S". The vowel may be short ("U") or long ("OO"). The earlier mark consists of two syllables and begins with a different phoneme: "SH". The word may be articulated as "SHA-TUSH" or "SHA-TOOSH". In my view, there is a low degree of aural similarity between the marks.

## **Conceptual comparison**

23. Both "SHATUSH" and "STUSH" are unusual words. The parties have provided no evidence on what the average consumer would understand by them. Consequently, it seems to me that I must find that the average consumer would think that both these words had been invented. There is therefore no conceptual similarity between the two marks and they are conceptually neutral.

## **Distinctive character of the earlier trade mark**

24. Having compared the marks, it is necessary to determine the distinctive character of the earlier mark, in order to make an assessment of the likelihood of confusion. In *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, 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).

25. The opponent was not required to submit any evidence to show that it has used its mark, so I must consider only the question of inherent distinctiveness. I found that the average consumer would perceive SHATUSH to be an invented word, and so it does not allude to the goods in question (cosmetics). Consequently, I find its distinctiveness is higher than average.

### **Likelihood of confusion**

26. Having considered the relevant factors, I now come to an assessment of the likelihood of confusion. As the CJEU stated in paragraph 17 of its judgment in *Canon Kabushiki Kaisha v Metro-Goldwyn Mayer* (C-39/97), the likelihood of confusion must be appreciated globally and an assessment

implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods and services. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.

27. Making such an assessment is not simply a case of applying a scientific formula. In that regard, I bear in mind the comments of Mr Geoffrey Hobbs QC, acting as Appointed Person, in *Intersnack Knabber-Geback GmbH & Co KG v Chiquo Ltd* (O-095-14), paragraph 12:

Both as between marks and as between goods and services, the evaluation of “similarity” is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is “similarity” of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) would have attached to them at the relevant point in time.

28. I found that the goods in question are identical. As stated in paragraph 12, I have confined my consideration to cosmetics, as, if the opposition fails in this respect, it would not succeed on any of the other goods or services that the opponent has relied upon.
29. The marks, in my view, possess a medium degree of similarity on a visual comparison, with a low degree of similarity in aural factors. The marks have no concepts. Taken as a whole, I find a low to medium degree of similarity between the marks.
30. I have also considered the circumstances in which the average consumer would be encountering the marks. In *Lloyd Schuhfabrik*, the CJEU said at paragraph 35 that:

For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also 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.

31. I must make an assessment of the likelihood that the average consumer will mistake the contested mark for the earlier mark, or assume that the goods are from the same or related undertakings, on the basis of a misremembered word. I have therefore considered the case law on the impact of words in this context.
32. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginnings of word tend to have more visual and aural impact than the ends. The court stated:

81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

33. If I were to follow the approach of giving greater weight to the start of the word, I would find no likelihood of confusion. "SHA" and "STU" are different and this feature, combined with the lack of similarity in the length of the words, would outweigh the identity between the goods in question. However, it is not a rule that the beginning of a word is always more important than its end.

34. With no conceptual hooks to suggest concrete meanings, in my view, it is the beginning of the words and their different lengths that will distinguish the marks in the memory of the average consumer.

35. I find that there is no likelihood of confusion and the opposition fails.

## **Conclusion**

36. The opposition has failed. Subject to any appeal, the application can proceed to registration in respect of:

*Class 3: Cosmetics*

*Class 25: Clothing.*

## **Costs**

37. The applicant has been successful. As they are self-represented, the Tribunal invited them to complete and return a proforma indicating the time spent on various activities associated with the proceedings. As the applicant has not provided such information, I make no award as a contribution towards the cost of the proceedings.

**Dated this 26th day of July 2018**

**Clare Boucher  
For the Registrar,  
The Comptroller-General**