

O/109/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3251352
BY SURINDER PANESAR FOR THE TRADE MARK**

Proaura

IN CLASSES 1, 3 AND 44

AND

**THE OPPOSITION THERETO UNDER NUMBER 410735
BY CLARINS FRAGRANCE GROUP**

Background and pleadings

1. On 19 August 2017, Surinder Panesar (“the applicant”) filed trade mark application number 3251352 for the mark Proaura, for the following goods and services:

Class 1: *Antioxidants for use in the manufacture of cosmetics.*

Class 3: *Cosmetic creams and lotions; Cosmetic creams for firming skin around eyes; Cosmetic creams for skin care; Cosmetic creams for the skin; Cosmetic eye gels; Cosmetic facial lotions; Cosmetic facial masks; Cosmetic preparations for skin firming; Anti-aging moisturizers used as cosmetics; Anti-wrinkle creams [for cosmetic use].*

Class 44: *Cosmetic treatment; Application of cosmetic products to the face.*

2. The application was accepted and published for opposition purposes on 8 September 2017. Clarins Fragrance Group (“the opponent”) partially opposes the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying upon its earlier IR registration number 966547, the pertinent details of which are as follows:

Mark: AURA

Priority date: 27 November 2007

International registration date: 22 May 2008

Date protection granted in EU: 09 June 2009

Goods: Class 3: *Perfumes, eau de toilette, eau de parfum.*

3. The opposition concerns all goods in class 3 of the application. The opponent claims that the respective goods are similar and that the marks are similar. It claims that the applicant’s mark consists of the two elements, ‘Pro’ and ‘aura’, and that the prefix ‘Pro’ simply adds a non-distinctive element to the shared ‘aura/AURA’ component. As a result of these similarities, it claims that there is a likelihood of confusion.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier mark.

6. The opponent is represented by Williams Powell, the applicant by Pemberton Reid. Both parties filed evidence. A hearing took place on 12 December 2018 at which the opponent was represented by Mr Ian Tollett and the applicant was represented by Mr Sam Carter of Counsel, appointed by Pemberton Reid.

The opponent's evidence

7. At the hearing, both parties agreed that the opponent's evidence of use was sufficient to establish that the earlier mark had been genuinely used in the UK within the relevant period and in relation to all of the goods, namely *perfumes*, *eau de toilette* and *eau de parfum*. They also agreed that the earlier mark had not acquired an enhanced level of distinctive character through use. Consequently, there is no need for me to say more about this evidence (and, indeed, the fact that the opponent's mark is subject to proof of use).

The applicant's evidence

8. This consists of a witness statement by Surinder Panesar, the applicant. Mr Panesar says that the facts stated in his witness statement are based on his own knowledge. His evidence contains a mixture of facts and submissions. The main points relied upon by Mr Panesar are that:

- All of the applicant's products are sold only online and will never be sold in the same outlets that stocks the opponent's products;
- Perfumery products and the types of products listed in the applicant's class 3 specification, may all be sold in various retail outlets (including supermarkets, high-street pharmacies such as Boots and Superdrug, dedicated perfume shops and department stores) and online;
- Supermarkets tend not to sell premium perfumes or cosmetics. Mr Panesar would not expect to see the opponent's products being sold in a supermarket;
- Perfume shops would not normally sell skincare or make-up products;
- Perfumes are usually sold all together in the perfume section of a shop;

- Some higher-end brands, including the opponent, sell skincare products, make-up and perfumes. However, these brands would usually have their own dedicated counters in department stores where they sell all their products. For brands not falling into this category, retail outlets have dedicated sections sorted by products, i.e. perfume section, make-up section, skincare section. Even within the general skincare and make-up sections of a store the products are grouped together by brand. Photographs of departments stores are provided in support at exhibit SP1;
- Even if some perfume manufacturers produce fragranced bath and body products with the same perfume, they will not produce perfumed skincare products;
- Customers of perfumes and cosmetic products are likely to be repeat customers. Exhibited at SP1 is an extract from a 2017 brand loyalty survey (UK) showing that 22% of respondents say they always use the same brand of skincare and only 4% always try different brands;
- If the 'Proaura' products were sold in retail outlets they would be stocked in a different area from that of the opponent's products;
- A consumer seeing a 'Proaura' product in the skincare section would not think that the product originates from the opponent as it would not be in the Clarins' section;
- 'Proaura' products are promoted on Twitter and in magazines. Since the applicant's products have been launched it has received over 4,000 requests for free samples. None of the recipients have complained that they were expecting a perfume or a product connected with the opponent.

The opponent's evidence in reply

9. The opponent's evidence in reply comes from Nicola Harrison, a trade mark attorney at William Powell, the opponent's professional representatives. The purpose of her witness statement is to address the applicant's argument that the respective products are insufficiently similar for confusion to arise. Ms Harrison states that she conducted internet searches for products the same as or similar to the parties' products marketed under the same mark by the same business. She filed internet evidence (Exhibits NH1-

8) to show that eight brands, namely AVON, THE BODY SHOP, CLINIQUE, LANCOME, ESTEE LAUDER, ELIZABETH ARDEN, DIOR, L'OCCITANE, LIZ EARLE, sell both perfumes and cosmetics, including various face and anti-aging creams, serums and lotions, eye creams and facial masks.

Section 5(2)(b)

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

“5(2) 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”.

Section 5(2)(b) case law

11. The following principles are 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:

(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. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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 respectively 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. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

15. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that the responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“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.”

16. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

17. The goods to be compared are:

Applied for goods	Opponent's goods
Class 3: <i>Cosmetic creams and lotions; Cosmetic creams for firming skin around eyes; Cosmetic creams for skin care; Cosmetic creams for the skin; Cosmetic eye gels; Cosmetic facial lotions; Cosmetic facial masks; Cosmetic preparations for skin firming; Anti-aging moisturizers used as cosmetics; Anti-wrinkle creams [for cosmetic use].</i>	Class 3: <i>Perfumes, eau de toilette, eau de parfum</i>

The correct approach

18. One of the issues which attracted much argument in this case was whether the respective distribution channels are similar. Mr Carter relied heavily upon the applicant's evidence and how that evidence should, in his view, feed into the comparison. There are three particular points which Mr Carter submitted I should take into account. In the first place, he said that the opponent's perfumes will be sold either in dedicated perfume shops (which do not stock the applicant's cosmetic creams), or in dedicated perfume sections (in shops or on internet websites), separately from the cosmetic sections where the applicant's skincare products will be displayed. Thus, the competing products will be sold either in different shops, or in different sections of the same shop(s). Secondly, he said that supermarkets tend not to sell perfumes and would not sell the opponent's perfumes; in this connection, it seemed implicit in his submission that he was somehow considering the fact that the opponent appears to be trading at the higher end of the market. Finally, he submitted that the evidence relating to (well-known) brands offering their perfumes and skincare products in dedicated counters of department stores or Boots type stores, means that the applicant's goods and the opponent's goods will not, effectively, be stocked and sold in the same counter.

19. Mr Carter's arguments must be dismissed. As I pointed out at the hearing, the similarity of the goods must be assessed in the context of the opponent's earlier AURA

mark being used independently, not as a part of the opponent's Clarins brand. To take into account in comparing the goods, other marks actually used by the opponent, would introduce matters that are extraneous to the relevant comparison. Likewise, the opponent's earlier mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for the goods on which the opponent relies for the purposes of this opposition. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*¹ like this:

"22.It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

20. Accordingly, I must consider notional and fair use of the opponent's mark across all segments of the market for the goods for which it is registered (i.e. fine fragrances and cheap perfume products), and the particular segment of the market in which the opponent has so far chosen to trade is therefore irrelevant.

Are the respective goods similar?

21. In relation to the distribution channels, Mr Tollett accepted that cosmetic creams and perfumes are usually displayed on different shelves, however, he argued that they

¹ See also *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

are still likely to be found in the same area of department stores and/or shops, citing frying pans an example of goods that are dissimilar and are unlikely to be found in close proximity. Further, he relied on Ms Harrison's evidence in support of his submission that it is not unusual for companies which sell perfumes to also sell cosmetic creams and that consumers would expect these products to come from the same undertaking. In terms of users, both parties agreed at the hearing that the typical user of the respective goods will be a woman over the age of 30.

22. As regards the other features of the relationship between the competing goods, according to Mr Tollett, the opponent's perfumes and the applicant's cosmetic creams share similar natures, intended purposes and methods of use, because they are both liquid substances designed to be applied to the human body for the purpose of enhancing the physical appearance. Further, the parties' goods are complementary since they are used together to enhance different aspects of a person's appearance. Finally, Mr Tollett relied on the finding of the fellow Hearing Officer in BL-O-342-16², where he found that there was a medium degree of similarity between, inter alia, "herbal products for the skin" and "perfumes". The Hearing Officer stated his reasons as follows:

"Both parties' products are used by consumers upon their bodies and come under the overall description of cosmetics. They would be sold to the same consumer group, the physical nature can be the same as perfumes can come in a cream or powder form as well as a liquid. The trade channels are likely to be the same as they will be found in the same area of retail outlets. I note that it is common for producers to sell ranges of products which would include perfume and hair and skin care goods. [...] **To my mind the goods of the two parties are similar to at least a medium if not high degree.**"

23. Mr Carter's answer to this was that the Hearing Officer in that case did not have the benefit of the evidence from the applicant and since he was not a typical user of the goods concerned I should attach very little weight to his finding. Mr Carter also argued that the applicant's cosmetic creams do not have the same nature and

² The case relates to an opposition brought by the opponent against a different mark

consistency as the liquid of a perfume; that the method of use is different, the applicant's cosmetic creams being applied on the face, the opponent's perfumes on the wrist; and, ultimately, that the purpose is different because the applicant's products are purchased to improve a person's physical appearance rather than for their smell. According to Mr Carter, the goods are not even complementary because, he said, perfumes would be used before going out - citing the example of a women getting ready for a party - whilst cosmetic creams are part of a daily routine, and would be used first thing in the morning or before bed. Further, in Mr Carter's submissions, if one were to consider cosmetic creams to be complementary to perfumes on the basis that they are both goods used to improve the overall appearance of a person, by the same token, it could be said that clothing and fast cars are complementary because they could be used to "show-off". Bearing in mind the case-law in *Boston Scientific Ltd*, I do not regard the analogy with clothing and cars as a pertinent one.

24. Having considered both parties' lengthy submissions, I find that consumers are unlikely to compartmentalise the market to the extent that Mr Carter's submissions invite me to accept. Rather, they will, in my view, regard the respective goods as part of a category of products for personal grooming and beautification purposes (and so they will consider the goods complementary to a certain extent). The general purpose of these goods is the same or closely related. There is no evidence as to how the products are used and, contrary to what is alleged by Mr Carter, I do not see why perfumes should not be used for daily body care. Moreover, as the applicant itself confirms, perfumes and cosmetic creams are sold in the same area of large department stores; although they might be sold in separate perfumes and cosmetics sections, they will still be placed in close proximity. Furthermore, the applied for term *cosmetic creams and lotions* would cover body creams and body lotions, which are sold together with perfumes and might have the same fragrance. Finally, the respective goods could be produced by the same manufacturers and are sold to the same public.

25. Taking the matter in the round, the similarities outweigh the differences. In my view the applied for goods, which are in the main cosmetic creams and lotions are similar

to a medium degree to the opponent's perfumery products³. The same conclusions apply to cosmetic facial masks.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods will be selected in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. The average consumer of the parties' goods is the general public. The goods will most often be self-selected from a shelf or its online equivalents and the marks may be exposed visually in advertising and websites. I consider that the visual impact of the marks will take on more importance, although I will not ignore the aural impact completely, as sometimes sales advisors are involved in the process.

28. As to the degree of attention consumers are likely to deploy when selecting the goods, cosmetics and perfumery items can vary considerably in price. The level of care exercised by consumers in purchasing such goods will vary accordingly. In his oral submissions Mr Carter relied upon the applicant's survey evidence that only 4% of respondents always try different brands of skincare and that 22% of respondents say they always use the same brand of skincare; according to Mr Carter this evidence

³ See also the GC's decision in Case T-388/13, *SAMSARA*, § 26

demonstrates that the goods are selected with a higher than average degree of attentiveness. I do not believe that the applicant's survey evidence is material to any extent. Although certain types of perfumes and cosmetic creams are purchased with greater care because they can be expensive, there are also much cheaper versions of the same product. Accordingly, I consider the purchasing process to be a normal, reasonably considered one.

Comparison of marks

29. 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 them, 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.”

30. It would be wrong, therefore, to artificially dissect the marks, although, it is necessary to take into account their distinctive and dominant components 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:

Applied for mark	Opponent's mark
Proaura	AURA

31. The overall impression of the opponent's mark will be based upon its single component, the word AURA per se.

32. As regard the applied for 'Proaura' mark, Mr Tollett submitted that the word 'aura' constitutes the most distinctive and dominant element. He argued that the word 'Pro' is used in the cosmetic sector to indicate an enhanced version of a particular product (or a product recommended by a professional beautician) and thus, has a low degree of inherent distinctive character. According to Mr Tollett, the average consumer will understand 'Pro' as indicating a professional range of products and associate 'aura' with the main brand. Mr Carter disagreed and claimed that 'Proaura' will not be regarded as a composite mark consisting of two elements, but as a whole; in his view, 'Proaura' will be seen by the average consumer as a fanciful, made up word. Alternatively, he claimed that even if it were the case that the average consumer would perceive 'Proaura' as a composite mark, "the prefix 'Pro' is susceptible of a number of meanings [...] and it is far from clear that it would be perceived as an abbreviation of 'professional'"; however, no evidence was filed in this connection. He also referred to the following paragraph of Mr Panesar's witness statement in which he stated:

"28. I note from the Statement of grounds that the Opponent says that "Proaura" will suggest to consumers that Proaura products must be AURA products for professional use. Given that the Opponent's AURA products are perfumes and that there is no concept of "professional" perfumes then I do not see that this will ever be the case."

33. Mr Panesar's argument seems to have missed the point. What I must consider is how the element 'Pro' will be perceived in the context of the applied for cosmetic creams, so the fact that, as he says, "there is no concept of "professional" perfumes" is irrelevant.

34. In terms of overall impression, whilst I accept that 'Proaura' is presented as one word, there is a natural break in its pronunciation and I agree with Mr Tollett that the

average consumer is likely to appreciate that it is composed of the words 'Pro' and 'aura', albeit conjoined⁴.

35. From a visual perspective, the applied for mark is longer than the opponent's mark as it has the additional letters 'Pro' at the beginning. However, the marks do share the letters aura/AURA which creates an inevitable degree of similarity. I should add that the difference in casing between the marks is not a factor in my assessment because the respective marks could notionally be used in upper-case and/or upper and lower-case lettering. I therefore find that the marks are visually similar to a medium to high degree. The same assessment follows through to the aural comparison. Conceptually, the Collins online dictionary contains the following definitions of 'pro':

Pro

1. countable noun

A pro is a professional.

2. adjective

A pro player is a professional sportsman or woman.

3. preposition

If you are pro a particular course of action or belief, you agree with it or support it.

Pro (in British)

Adverb

1. in favour of a motion, issue, course of action, etc

Compare anti

Preposition

2. in favour of

Noun

Word forms: plural pros

3. (usually plural) an argument or vote in favour of a proposal or motion
4. (usually plural) a person who votes in favour of a proposal, motion, etc

⁴ According to the case-law, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a verbal sign, he will break it down into elements which, for him, suggest a concrete meaning or which resemble words known to him (see, for example, the decision of the GC in *Ecoblue v OHIM*, T- 281/07, paragraph 30).

Pro (in British)

Noun

Word forms: plural pros

1. informal short for professional

36. Whilst there is no single definition of ‘pro’ applicable in all circumstances, its meaning must be assessed in the specific context of the mark applied to the contested goods, which are, largely speaking, cosmetic creams and lotions. The prefix ‘Pro’ precedes the distinctive term ‘aura’. At the hearing there was a disagreement between Mr Tollett and Mr Carter as to whether ‘aura’ might actually refer to an emanation in the form of an odour or a light. Neither parties provided evidence on the point. Having consulted various English dictionaries, it seems to me that the term ‘aura’ might be used to refer to both⁵, but it can also be used to refer, more subtly, to “a quality or feeling that seems to surround a person or place or to come from them, i.e. *she had an aura of authority*.”⁶ In my view, when considering the combination of the two components ‘Pro’ and ‘aura’ as a whole, ‘Pro’ will be perceived as a prefix having some laudatory connotations. Whilst the extract meaning of ‘Proaura’ is not clear, the ‘Pro’ element will be seen as implying that the designated cosmetic products are ‘professional’ or, somehow, ‘favourable, positive or supportive’⁷ in the sense that, for example, they can help the user to metaphorically have an ‘aura’. Taking into account that the additional concept introduced by the component ‘Pro’ in the applied for mark is not particularly distinctive and that the meaning of ‘aura’ in both marks is the same, the marks are conceptually similar to a high degree.

⁵ Cambridge English Dictionary includes a reference to light, i.e. aura- “a type of light that some people say they can see around people and animals” whilst the Oxford English Dictionary includes a reference to odour, i.e. aura - any invisible emanation, especially an odour: *there was a faint aura of disinfectant*.

⁶ Collins English Dictionary

⁷ See in this connection the GC’s decision in T-145/12 - *Bayerische Motoren Werke v OHIM (ECO PRO)* in which the Court stated: “26. As regards the word element ‘pro’ it is sufficient to observe that, according to case-law, first, it may be laudatory for the sake of advertising, the purpose of this being to highlight the positive qualities of the goods or services for the presentation of which that element is used, and, secondly, it is commonly used in trade for the presentation of all kinds of goods and services (Joined Cases T- 79/01 and T- 86/01 *Bosch v OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II- 4881, paragraph 26). The European Union judicature has already held that that word element would be perceived by the English-speaking public as meaning ‘professional’ or ‘favourable, positive or supportive’ (judgment of 15 November 2011 in Case T- 434/10 *Hrbek v OHIM – Outdoor Group (ALPINE PRO SPORTSWEAR & EQUIPMENT)*, not published in the ECR, paragraph 64).”

Distinctive character of earlier mark

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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).”

38. The opponent’s mark consists of the term AURA. Whilst the opponent has used the mark, Mr Tollett conceded that the use shown is not sufficient to have enhanced the mark’s distinctive character.

39. Mr Carter submitted that the earlier AURA mark has a low or, at best, medium degree of distinctive character in relation to the opponent’s perfumery products because the word ‘AURA’ is allusive of an imperceptible presence much closer to a smell than visual aura. Whilst the term ‘aura’ might be used to signify an odour, it is not directly descriptive of the opponent’s perfumery goods and there is no evidence

that this is the meaning that will immediately spring to mind when the average consumer encounters the mark. In my view, the mark has an average degree of distinctive character.

Likelihood of confusion

40. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

41. In *L.A. Sugar Limited v By Back Beat Inc*, case BL-O/375/10 where he stated:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

42. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he

pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

43. Earlier in my decision I found that the goods are similar to a medium degree and will be selected visually with an average degree of attention. The marks are visually and aurally similar to a medium to high degree and conceptually similar to a high degree. The earlier mark is distinctive to an average degree.

44. In his oral submissions, Mr Tollett took issue with Mr Carter's approach to the likelihood of confusion and referred in the following paragraph of his skeleton argument:

"57.2 A person seeking a PROAURA product in the skin care section of a shop would not think it was the Opponent's product because it would not be in the correct area of the shop - the opponent's products would be stocked either in the perfume section, or in a dedicated Clarins concession. [...] A PROAURA product would not be stocked in either of these sections, so consider the likelihood of confusion if it was to be is academic and fruitless."

45. He criticised Mr Carter's argument for "setting the bar far too high". I agree with Mr Tollett that the correct test is whether, on encountering a 'Proaura' product in the skincare section, the average consumer would believe that it comes from the same undertaking who produces 'AURA' perfumes.

46. Mr Carter's argument that "a person seeking a 'PROAURA' product in the skin care section of a shop would not think it was the Opponent's product because it would not be in the correct area of the shop", i.e. the perfume section, equates to no more than saying that there would be no mistaken purchase, i.e. direct confusion⁸. However, the fact that the goods are not identical (or highly similar) does not exclude indirect confusion. In my view, balancing all of the relevant factors, including the fact that the only difference between the marks is created by a laudatory element (i.e. the letter 'Pro' in the applied for mark), the applicant's mark is likely to be perceived as a brand

⁸ This concept was explained by Professor Phillip Johnson, sitting as the Appointed Person in *CALEDONIAN*, BL-O-382-16

extension of the opponent's mark. Consumers are likely to be confused into believing that the respective goods come from the same, or linked, economic undertakings on the basis that the applicant's cosmetic goods are merely an extension of the opponent's perfumery products. **There is a likelihood of indirect confusion.**

47. In reaching my conclusion, I have not overlooked Mr Carter's submissions that notwithstanding the applicant having used the mark, it is not aware of any instances of confusion. In this connection Mr Carter referred to the evidence given by Mr Panaser in his statement. That evidence consists only of a single paragraph in which Mr Panaser referred to the applicant's products being advertised on Twitter; he also produced (a) a screenshot which, he said, shows that one of the applicant's products, i.e. the day cream, had 13,000 views in April 2018 and (b) an undated copy of a printed advert. The same paragraph also contains the following statement:

“[...] Since the product have been launched, there have been over 4,000 requests for samples (a summary of the number of samples sent is at page 26). None of the recipients have complained that they were expecting a perfume or a product connected with the opponent”.

48. Page 26 is also an undated page from what it seems to be an email account for sale@proaura.co.uk showing 1,415 and 2,609 requests of samples. In this regard, it suffices to say that Mr Panaser 's evidence is wholly insufficient to establish that the marks at issue had peaceably coexisted before the date on which the application for registration of the contested mark was filed; and still less that the consumers of the respective goods did not confuse the marks. As such it has no impact on the assessment of the likelihood of confusion.

Conclusion

49. The opposition under Section 5(2)(b) succeeds and, subject to appeal, the applied for mark is partially refused registration in relation to the opposed goods in class 3.

Costs

50. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Tribunal Practice Notice (TPN) 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fees:	£100
Preparing a statement and considering the other side's statement:	£300
Filing evidence and considering the other side evidence:	£500
Attending a hearing:	£500
Total:	£1,400

51. I order Surinder Panesar to pay Clarins Fragrance Group the sum of £1,400 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated 22 February 2019

**Teresa Perks
For the Registrar
The Comptroller – General**