

**O-239-20**

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
TRADE MARK APPLICATION NO 3341163  
BY LUCABELLA SOURCING LTD  
TO REGISTER**

**Luci**

**AS A TRADE MARK  
IN CLASSES 11 & 20  
AND OPPOSITION THERETO (UNDER NO. 415682)  
BY  
LUCITE INTERNATIONAL, INC.**

## Background and pleadings

1. Lucabella Sourcing Ltd (“the applicant”) applied for the trade mark **Luci** on 26 September 2018. The mark was published in the Trade Mark Journal on 7 December 2018 in class 11 and 20 for the following goods.

*Class 11: Taps; showers; shower kits; mirrors; bathroom accessories; basin wastes; bath wastes; baths; bath panels.*

*Class 20: Bathroom furniture; bathroom cabinets; vanity units; bathroom mirrors; bathroom accessories.*

2. On 6 March 2019, Lucite International, Inc (“the opponent”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of its earlier EU TM No.3368669. The earlier mark is registered in 12 classes. For the purposes of opposition, the opponent relies on goods in classes 1, 11, 17 and 20. The EU TM details are set out below.

EU TM No. 3368669	Goods relied on
<p data-bbox="204 1211 454 1272"><b>LUCITE</b></p> <p data-bbox="204 1379 657 1413">Filing date: 25 September 2003</p> <p data-bbox="204 1435 742 1469">Registration date: 11 December 2007</p>	<p data-bbox="785 1211 1337 1895">Class 1: plastics in the form of suspensions or solutions for use in industrial processes, including such plastics containing acrylic compounds; dispersions of plastics; dispersions of plastics including polymer in monomer; dispersion of plastics including inorganic fillers; unprocessed resins; unprocessed synthetic resinous plastic materials; unprocessed acrylic resin, synthetic resins, acrylic plastics; polymers; monomers.</p>

	<p>Class 11: Baths, showers, shower cubicles, shower trays, sinks, hand wash bowls and hand wash basins; sauna baths, sitz baths, spa baths; bathroom furniture; vanity units; toilet seats; cooking and refrigerating appliances and installations and housings and components for cooking and refrigerating appliances and installations; shelving for cooking and refrigerating appliances and installations including illuminated shelving for cooking and refrigerating appliances and installations; parts and fittings for all the aforesaid goods in class 11.</p> <p>Class 17: Plastics in extruded form for use in manufacture; synthetic resins made in the form of sheets, semi-processed plastic substances; semi-finished artificial resins and acrylic resin products.</p> <p>Class 20: Sign boards of wood or plastic; transport identification signs and number plates in class 20.</p>
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3. The opponent's trade mark is an earlier mark, in accordance with Section 6 of the Act and as it completed its registration procedure more than 5 years prior to the filing date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

4. The applicant filed a counterstatement denying the ground of opposition. In answer to question 7 of Form TM8 which asks, “Do you want the opponent to provide “proof of use”?”, the applicant ticked the “No” box. Consequently, the opponent is entitled to rely on all of the goods for which its mark is registered.

5. In these proceedings the opponent is professionally represented by Appleyard Lees IP LLP and the applicant has represented itself.

6. The Opponent filed evidence and written submissions in lieu of a hearing. The applicant filed only the counterstatement. I make this decision from the material before me.

### **Preliminary issue**

7. The opponent was not required to file any evidence, as per paragraph 4 above. However, on 29 September 2019, Mr Anthony Brierley of Appleyard Lees, the opponent’s representative, filed a witness statement and annexed one exhibit confirming that the earlier mark was “live”. I record this for completeness of information but do not intend to refer to the witness statement further.

### **Section 5(2)(b)**

8. Section 5(2)(b) of the Act is as follows:

“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”.

9. The leading authorities which guide me are from the Court of Justice of the European Union (‘CJEU’): *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 will 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**

10. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23:

“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”.

11. 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.

12. The following case law is also considered relevant for the comparison of goods. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

13. In its written submissions, the opponent contends that its class 11 goods are identical and/or highly similar to the applicant’s goods. It further contends that the applicant’s goods are complementary to the goods in its other classes. In my view the opponent’s strongest case is for its class 11 goods as although the opponent has goods in class 20, these do not help its case. So, I propose to focus on class 11 returning to the remaining classes only if it proves necessary to do so.

14. The goods to be compared are:

Opponent's goods	Applicant's goods
<p>Class 11: Baths, showers, shower cubicles, shower trays, sinks, hand wash bowls and hand wash basins; sauna baths, sitz baths, spa baths; bathroom furniture; vanity units; toilet seats; cooking and refrigerating appliances and installations and housings and components for cooking and refrigerating appliances and installations; shelving for cooking and refrigerating appliances and installations including illuminated shelving for cooking and refrigerating appliances and installations; parts and fittings for all the aforesaid goods in class 11.</p>	<p>Class 11: Taps; showers; shower kits; mirrors; bathroom accessories; basin wastes; bath wastes; baths; bath panels.</p> <p>Class 20: Bathroom furniture; bathroom cabinets; vanity units; bathroom mirrors; bathroom accessories.</p>

15. To facilitate the comparison of the goods, I intend to group terms together where appropriate, as permitted by the guidance given in *Separode Trade Mark* BL O-399-10.

16. I find that the terms *baths* and *showers* are identical in both parties' class 11 specifications.

17. The term *shower kits* in the applicant's class 11 specification is considered to be identical to *shower cubicles; shower trays; parts and fitting for all the aforesaid goods* in the opponent's class 11 specification on the *Meric* principle. I make this finding as a shower kit can be considered to be a collection of all the component parts necessary to create a finished shower.

18. I find the terms *taps; basin wastes; bath wastes; bath panels* in the applicant's class 11 specification to be identical to the terms *Baths, sinks, hand wash bowls and*



*hand wash basins; parts and fittings for all the aforesaid goods* in the opponent's class 11 specification on the *Meric* principle.

19. The terms *mirrors; bathroom accessories* in the applicant's class 11 specification would be covered by the broader term *bathroom furniture* in the opponent's specification on the *Meric* principle.

20. With regard to class 20, I consider that the applicant's terms *Bathroom furniture; bathroom cabinets; vanity units; bathroom mirrors; bathroom accessories* are highly similar to the opponent's class 11 terms namely *bathroom furniture; vanity units*. The difference generally between these classes is that the goods in 11 are usually part of a fitted arrangement and are purchased as matching or component parts, whereas goods in class 20 are stand alone items that can be sold separately, i.e. not part of a fitted bathroom arrangement. However, the goods themselves will share the same nature and purpose as well as the same users and channels of trade. They are also complementary in the sense that the fitted bathroom is not possible without some of the component goods in the earlier specification and the consumer, being a professional fitter or a member of the public, may expect the goods to originate from the same undertaking.

### **Average consumer and the purchasing process**

21. I next consider who the average consumers are for the goods and how they are purchased.

22. 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.”

23. The average consumers in this case are the general public, businesses and tradespeople such as plumbers, bathroom fitters etc. 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 in question (*Lloyd Schuhfabrik Meyer, Case C-342/97 refers*). Clearly the contested goods will vary in price, but such goods are a considered purchase when fitting out a bathroom even for items such as taps and mirrors when looking for a matching or coordinated finish and, in my view, average consumers will be paying a higher than normal degree of attention during the purchasing process as these are not goods which are purchased frequently and consumers would need to consider a number of factors such as specifications and functionality as well as style. Consumers will be browsing goods in physical premises such as DIY retail stores or in specialist bathroom showrooms or using primarily visual means such as catalogues, brochures or their online equivalents. However I do not discount an aural factor such as a word of mouth recommendation or if consumers are seeking advice from a salesperson or bathroom fitter.

### **Comparison of marks**

24. 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.”

25. It would be wrong, therefore, to artificially 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.

26. The marks to be compared are

Opponent's trade mark	Applicant's trade mark
LUCITE	Luci

27. The parties both have single word marks and the overall impression rests solely in those words. The title case presentation in the applicant's mark is not a consideration as the mark could be used in any case structure.

28. Taking first the visual comparison, the marks share the letters L-U-C-I and these are in the same order in both marks. These letters comprise the entirety of the applicant's mark and are the first four letters of the earlier mark. The opponent's mark is two letters longer and in its written submissions it contends that,

“these letters, being at the end of the mark, are of less significance than the four letters at the beginning of the mark being LUCI”.

29. There is case law<sup>1</sup> to support the view that the beginnings of words have more visual significance than the ends. Notwithstanding this, I must also be alert to the visual impact of the marks in full and their differences. The opponent's mark is noticeably longer, with the letters TE following the letters LUCI. This has no counterpoint in the application and creates a point of visual difference. Taking these factors into account I find there is a medium degree of visual similarity.

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<sup>1</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

30. When making an aural comparison, the most likely pronunciation, in my view, of the applicant's mark will be LOO-SEE, probably as a result of its resemblance to the female forename "Lucy". Whereas the most likely pronunciation of the opponent's mark would be LOO-SITE. I find that the first syllable in both marks is pronounced identically and that the letter C in both marks will be a soft rather than hard consonant. However, there is a noticeable difference to the ear when the marks are spoken, especially as the last syllable in the opponent's mark is a hard "t" sound which has an aural impact. Nevertheless, taking all factors into account I find there is a medium degree of aural similarity.

31. Finally looking at the conceptual comparison, the opponent submits that,

"As both marks are made up of invented words with no obvious and direct meaning, it must be found that the respective marks are conceptually similar to a high degree".

32. The opponent has not made clear why it regards the marks as conceptually highly similar if they are both invented words. It is possible that some consumers may bring the female forename "Lucy" to mind if they encountered the applicant's mark's **Luci**, especially given its phonetic equivalence. They may also perceive that the opponent's mark has a similar construction to a mineral name. Where the consumer perceives a different conceptual picture from the marks then the marks are likely to be conceptually dissimilar. If consumers simply regard both marks as invented words then they should be considered as conceptually neutral.

### **Distinctiveness of the earlier mark**

33. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. 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).”

34. No evidence has been filed in these proceedings, so I have only the inherent distinctiveness position to consider. The earlier mark is an invented word which does not describe or allude to the goods. I find the earlier mark to be inherently highly distinctive.

### **Likelihood of confusion**

35. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where 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 trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the opponent’s mark, the average consumer and the nature of the purchasing process for the contested goods. In doing so, I must be aware that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related.

37. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“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.”

38. Whereas in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., also sitting 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.

39. So far in this decision I have found that the respective goods are identical in class 11 and highly similar in class 20. I also found that consumers are likely to pay a higher than normal degree of attention during a primarily visual purchasing process, although I did not discount an aural aspect to any purchase. The earlier mark was found to be highly distinctive. In addition, I found that the marks are visually and

aurally similar to a medium degree and conceptually neutral if the marks are considered as invented words or conceptually dissimilar for the reasons I set out in paragraph 32.

40. In my view when there are visual and aural differences between a short mark and a longer mark such as is the case here, those differences will have a bigger proportional impact on the average consumer's perception. I also consider that the conceptual dissimilarity of the marks if consumers have any concept of the marks or the conceptual neutrality if they don't will play a part as the marks are not conceptually similar. Taking this into account, I do not think it is likely that the average consumer will directly mistake one mark for the other.

41. Having considered and found against direct confusion, I will go on to consider indirect confusion. The letters 'Luci' which make up the application are the first four letters of the earlier mark, but those first four letters are simply part of a longer mark. They do not appear in the mark in a way which would lead the average consumer to see the marks as originating from the 'same stable'. Taking account of Mr Purvis's summation in *L.A. Sugar* above, there is nothing about the applied for mark which leads me to find that it could be taken as a brand extension of the earlier mark nor do I find that an average consumer is likely to believe that the goods have come from the same undertakings given the higher degree of attention I have found consumers will pay during purchase. I find that the guidance given in *Duebros* is more appropriate in this case, namely that an average consumer may merely associate the common element in the marks but would not confuse the two. As such I do not find a likelihood of indirect confusion.

## **Conclusion**

42. The opposition fails under section 5(2)(b). The application can proceed to registration subject to any appeal.

## **Costs**

43. The applicant has been successful and is therefore, in principle, entitled to a contribution towards its costs. As the applicant is unrepresented, the tribunal invited it, in the official letter dated 27 January 2020, to indicate whether it wished to make a

request for an award of costs. The applicant was invited to complete a pro-forma including a breakdown of actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the defence of the opposition. The letter made clear to the applicant that if the pro-forma was not completed “costs may not be awarded”. The applicant did not respond to that invitation. Consequently, I make no order as to costs.

**Dated this 16<sup>th</sup> day of April 2020**

**June Ralph  
For the Registrar  
The Comptroller-General**