

O/342/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3353139

BY NESSA SKINCARE LTD

TO REGISTER THE TRADE MARK

N E S S A

IN CLASSES 3 AND 35

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 415630

BY CHUTRARAM NEMARAMJI GEHLOT

BACKGROUND AND PLEADINGS

1. On 13 November 2018, NESSA SKINCARE LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 30 November 2018 and registration is sought for the following goods and services:

Class 3: Skincare cosmetics.

Class 35: Retail services connected with the sale of cosmetics and skincare products; Retail store services relating to perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, non-medicated dentifrices, toiletries, body deodorant, anti-perspirants, shower gel, body wash, facial cleanser, facial scrub, facial wash, hand wash, soaps, skincare preparations, cosmetics, cosmetic moisturisers, cosmetic oils, cosmetic eye gels, cosmetics for personal use, cosmetic hand creams; Retail store services relating to cosmetic nourishing creams, cosmetic preparations for body care, cosmetic soaps, beauty masks, beauty balm creams, beauty creams, beauty creams for body care, beauty lotions, beauty milks, beauty serums, beauty soap, make-up, make-up removing preparations, body moist spray, spot sticks, moisturisers, body lotion, body moisturiser, facial moisturiser, shaving gel, shaving oil, shaving cream, shaving foam; Retail store services relating to shaving spritz, shaving soap, shaving stones, after-shave, after-shave gel, after-shave balm, hair removal preparations and creams, depilatory preparations, depilatory wax, hair care preparations, shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray, perfumery, eau de toilette, essential oils, lip balm, moustache wax; Retail store services relating to cosmetic kits, sunscreen preparations, Candles, scented candles, fragranced candles, table candles, floating candles, candle assemblies, wicks for candles, beeswax and wax for making candles, candles and wicks for lighting, perfumed candles, Christmas tree candles; Retail store services relating to textiles and substitutes for textiles, household linen, curtains of textile or plastic; Retail store services relating to clothing, footwear, headgear; Retail store services relating to games, toys and playthings, video game apparatus, gymnastic and sporting articles, decorations

for Christmas trees; information, advisory and consultancy services relating to the aforesaid.

2. On 28 February 2019, Mr Chutraram Nemaramji Gehlot (“the opponent”) partially opposed the application based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3137653 for the trade mark shown below:

Nisha

This trade mark was applied for on 24 November 2015 and registered on 08 April 2016. The opponent relies upon all the goods for which the mark is registered, namely:

Class 3: Henna; black mehendi; hair colouring; hair dye.

The opposition is directed against the goods and services set out in paragraph 18 below.

3. The opponent claims that there is a likelihood of confusion because the parties’ respective marks are identical or similar, and the goods and services are identical or similar. The statement of grounds also provides details of a number of trade marks owned by the opponent which consist of (or include) the word NISHA.

4. The applicant filed a counterstatement denying the claims made.

5. Only the opponent filed evidence. It also filed written submissions dated 16 October 2019.

6. A hearing took place before me on 18 March 2020. The applicant was represented by Philip Harris of Counsel, instructed by Lane IP Limited. The opponent did not attend the hearing or make written submissions in lieu of attendance. In these proceedings, it is represented by Mathys & Squire LLP.

DECISION

7. Section 5(2) of the Act reads as follows:

“(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.”

8. The mark upon which the opponent relies qualifies as an earlier mark because it was applied for at an earlier date than the applicant’s mark pursuant to Section 6 of the Act. The mark completed its registration process less than 5 years before the date of the application in issue in these proceedings and it is not subject to proof of use.

THE EVIDENCE

9. The opponent’s evidence consists of a witness statement dated 16 October 2019, by Rebecca Tew. Ms Tew is a Chartered Trade Mark Attorney for Mathys & Squire LLP. She states that she conducted an independent search in the course of representing the opponent. Attached to her witness statement are the following:

- **Exhibit RLT01:** consists of web-prints showing that henna is used in hair colouring products, including those of the opponent. Ms Tew points out that one of the brands offering henna-based colouring products is L’Oréal, which also offers skin care and cosmetic products;
- **Exhibit RLT02:** consists of web-prints showing that henna is used to stain the skin in temporary body design (known as “henna tattoos”) and that a number of businesses in London offer henna tattoos;

- **Exhibit RLT03:** consists of web-prints from the website www.hennaherbals.co.uk showing henna-based make-up products, e.g. eye, brow and lipstick liners, available for sale;
- **Exhibit RLT04:** consists of web-prints showing that henna powder is used to make DIY hair masks;
- **Exhibit RLT05:** consists of web-prints from www.amazon.com and www.oriental-style.de showing henna perfume oil products available for sale;
- **Exhibit RLT06:** consists of a web-print showing that henna oil has long been used in India to promote hair growth and that it *“is great for many uses, including soaps, candles, air fresheners, skin and hair care”*;
- **Exhibit RLT07-8:** consists of web-prints showing that henna and henna-based hair colour products are sold in the UK in chain stores such as Lush, Holland & Barrett and Boots.

Section 5(2) – case law

10. 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 impression 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 greater 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 to mind the earlier mark, 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 and services

11. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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 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.”

12. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

13. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“GC”) stated:

“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 für 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”.

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 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 *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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."

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations" ... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

18. The competing goods and services are as follows:

Contested goods and services	Earlier goods
<p><u>Class 3</u>: <i>Skincare cosmetics.</i></p> <p><u>Class 35</u>: <i>Retail services connected with the sale of cosmetics and skincare products; Retail store services relating to perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions, non-medicated dentifrices, toiletries,</i></p>	<p><u>Class 3</u>: <i>Henna; black mehendi; hair colouring; hair dye.</i></p>

body deodorant, anti-perspirants, shower gel, body wash, facial cleanser, facial scrub, facial wash, hand wash, soaps, skincare preparations, cosmetics, cosmetic moisturisers, cosmetic oils, cosmetic eye gels, cosmetics for personal use, cosmetic hand creams; Retail store services relating to cosmetic nourishing creams, cosmetic preparations for body care, cosmetic soaps, beauty masks, beauty balm creams, beauty creams, beauty creams for body care, beauty lotions, beauty milks, beauty serums, beauty soap, make-up, make-up removing preparations, body moist spray, spot sticks, moisturisers, body lotion, body moisturiser, facial moisturiser, shaving gel, shaving oil, shaving cream, shaving foam; Retail store services relating to shaving spritz, shaving soap, shaving stones, after-shave, after-shave gel, after-shave balm, hair removal preparations and creams, depilatory preparations, depilatory wax, hair care preparations, shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray, perfumery, eau de toilette, essential oils, lip balm, moustache wax; Retail store services relating to cosmetic kits, sunscreen preparations, Candles, scented candles, fragranced candles, table candles, floating candles, candle

<i>assemblies, wicks for candles, beeswax and wax for making candles, candles and wicks for lighting, perfumed candles, Christmas tree candles; information, advisory and consultancy services relating to the aforesaid.</i>	
---	--

Class 3

19. The opponent submits that the main use of henna is colouring the hair or skin and that other uses of henna are in perfumes and make-up products. It also refers to the meaning of “skincare” and “cosmetics” and contends that “*one meaning of “skincare cosmetics” will cover make-up products such as henna brow pencils and lip liners [...] as well as henna designs and tattoos*” and that “*the applicant’s goods in class 3 are identical to the opponent’s henna goods in the same class*”.

20. The applicant disagrees and states that the opponent’s goods are hair colorants and dissimilar to its own goods. In this connection, Mr Harris argued that the opponent’s evidence is inconclusive because whilst it shows that henna is used to stain the skin in henna tattoos, that is not use of henna as a skincare product. Likewise, the few examples of henna being used in eye, brow and lip liners do not demonstrate that henna is normally used in cosmetics and do not illustrate that the natural meaning attributed to the term “skincare cosmetics” is one of describing (henna-based) preparations for use in hair colouring, tattoos and/or make-up products.

21. I concur with the applicant that the opponent’s *Henna; black mehendi; hair colouring; hair dye* do not fall within the applicant’s term *Skincare cosmetics*. The opponent provides a definition of skincare from the Collins Dictionary: “*skin care involves keeping your skin clean, healthy-looking and attractive*”. The natural meaning attributed to the term *Skincare cosmetic* is therefore that of a cosmetic product used to keep the user’s skin clean, healthy and attractive, such as, for example, a cleaning lotion and a moisturizer. Even if I were to accept that *Henna; black mehendi; hair colouring; hair dye* are cosmetic products or can be used for cosmetic purposes, I do not accept that they represent (or would be regarded as exemplifying) types of

skincare products. The applicant's *skincare cosmetics* and the opponent's *Henna; black mehendi; hair colouring; hair dye* belong to two different sub-categories of cosmetics. The goods are not identical. That said, it remains necessary to consider whether they are similar.

22. Whilst the goods are different in nature and method of use, they target the same consumers, have the same general purpose, which is to enhance the appearance of the users, and are produced by the same undertakings. Further, the goods are sold in the same outlets, so they share the same distribution channels. In my view the goods are similar to a degree between low and medium.

Class 35

23. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use from goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

24. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for

determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

25. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*¹, and *Assembled Investments (Proprietary) Ltd v. OHIM*², upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*³, Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;

iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

26. The applied for retail services cover a range of cosmetic and non-cosmetic goods. Where the services are homogeneous, I will group them together for the purpose of assessment.

¹ Case C-411/13P

² Case T-105/05, at paragraphs [30] to [35] of the judgment

³ Case C-398/07P

27. Retail store services relating to Candles, scented candles, fragranced candles, table candles, floating candles, candle assemblies, wicks for candles, beeswax and wax for making candles, candles and wicks for lighting, perfumed candles, Christmas tree candles. The opponent states that these services are similar to the earlier *Henna; black mehandi; hair colouring; hair dye* because candles can be prepared using henna perfumes. I disagree. Candles (or candles-related goods) are not goods which I would expect to be offered by retail services normally associated with the opponent's goods. The goods and services have different purpose, the trade channels are not particularly close and there is neither complementarity nor competitive relationship. These goods are dissimilar.

28. Retail services connected with the sale of cosmetics; Retail store services relating to non-medicated cosmetics, cosmetics, cosmetics for personal use, cosmetic preparations for body care, hair care preparations; information, advisory and consultancy services relating to the aforesaid. These services are broad enough to include retail services relating to the opponent's *Henna; black mehandi; hair colouring; hair dye*. These goods are similar to a low degree.

29. Retail services connected with the sale of non-medicated hair lotions, toiletries, cosmetic oils, shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; information, advisory and consultancy services relating to the aforesaid. Although *non-medicated hair lotions, toiletries, cosmetic oils, shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray*, are not identical to the opponent's *Henna; black mehandi; hair colouring; hair dye*, I consider that providers of retail services normally associated with the opponent's goods would also sell other cosmetic and toiletries preparations for personal use, including the goods, i.e. *non-medicated hair lotions, toiletries, cosmetic oils, shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray*, to which the contested retail services relate. These services are similar to a very low degree to the opponent's goods.

30. The same goes for the following retail services, all of which relate to the sale of toiletries and cosmetic preparation for personal use: Retail services connected with the sale of skincare products; Retail store services relating to perfumery, essential oils, non-medicated dentifrices, body deodorant, anti-perspirants, shower gel, body wash,

facial cleanser, facial scrub, facial wash, hand wash, soaps, skincare preparations, cosmetic moisturisers, cosmetic eye gels, cosmetic hand creams; Retail store services relating to cosmetic nourishing creams, cosmetic soaps, beauty masks, beauty balm creams, beauty creams, beauty creams for body care, beauty lotions, beauty milks, beauty serums, beauty soap, make-up, make-up removing preparations, body moist spray, spot sticks, moisturisers, body lotion, body moisturiser, facial moisturiser, shaving gel, shaving oil, shaving cream, shaving foam; Retail store services relating to shaving spritz, shaving soap, shaving stones, after-shave, after-shave gel, after-shave balm, hair removal preparations and creams, depilatory preparations, depilatory wax, perfumery, eau de toilette, essential oils, lip balm, moustache wax; Retail store services relating to cosmetic kits, sunscreen preparations,; information, advisory and consultancy services relating to the aforesaid. These services are similar to a very low degree to the opponent's goods.

Average consumer and the nature of the purchasing act

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the parties' respective goods or services. I must then determine the manner in which the goods or services are likely to be selected by the average consumer. 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.”

32. The average consumer of the goods in class 3 and retail services in class 35 is a member of the general public. The opponent submits that the average consumer will pay a low to medium degree of attention when selecting the goods. I disagree. Given

that the goods concerned will be used on the consumer's body, the purchase will not be made without some consideration and at least a medium degree of attention will be paid. The goods will be selected visually from shops, catalogues and websites, although word-of-mouth recommendations may also have a part to play so aural considerations cannot be overlooked.

33. Likewise, the average consumer will pay a medium degree of attention when selecting which retail services to use. The consumer will consider the range of items on sale, the price of goods, any special offers, the location of the shop, and the levels of customer service given. The services will be selected from promotional material and signage in the street so visual consideration will be more significant although I do not discount aural considerations in the form of word-of-mouth recommendations.

Comparison of the marks

34. 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-591/12 P, *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.”

35. 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. The respective trade marks are shown below:

Applied for mark	Earlier mark
N E S S A	Nísha

36. The applied for mark consists of the word NESSA written in upper case letters with the letter A minimally stylised. The stylisation makes a lesser contribution to the mark as a whole and therefore the overall impression of the mark is dominated by the word itself.

37. The opponent's mark consists of the word Nisha written in title case in a slightly stylised font with what looks like a small stylised leaf replacing the dot of the letter 'i'. Again, neither the stylisation nor the small device detracts from the mark essentially comprising of the letters N-I-S-H-A, which are the dominant and distinctive elements of the mark.

Visual similarity

38. Visually the marks coincide in the letter structure N, S, A. The difference lies with the second and fourth letters, the applicant's mark comprising of the letters E and S as opposed to the letters I and H in the opponent's mark. Even though the marks are of equal length and coincide in their first, third and fifth letters, in short marks it has been noted that differences are more noticeable. Further, the two differences presented within the middle of the marks derive from the presence of letters which

have different visual and phonetic characteristics, i.e. E and S and I and H. I find that the marks are visually similar to a low degree.

Aural similarity

39. The opponent submits that the earlier mark will be articulated as “NEE-SHA”, while the applied for mark will be articulated as “NE-SSA” and that the first syllables are highly similar, while the second are virtually identical. In addition, it submits that the second syllables will be stressed in both marks. I disagree that the second syllable will be the stronger in the applied-for mark. Both parties accept that this mark will be pronounced as in “VA-**NESSA**”. The stress is not on the last syllable here. The average consumer will, to my mind, not be sure how to say the opponent’s mark and is more likely to stress the beginning of the word than the end. The marks are, however, identical in length, and begin and end with the same sound. Overall, I find that they have a medium degree of aural similarity.

Conceptual similarity

40. The opponent submits that both marks are female names, with “Nisha” being a name of Hindi origin meaning “night”. I agree with the applicant that there is no evidence to support the view that the average consumer – who is a member of the UK general public – would know this. It seems to me more likely that the opponent’s mark would be viewed as an invented word, with the applicant’s more likely understood as being a contraction of the name “Vanessa”. If I am wrong in this, it will also be perceived as an invented word. Either way, there is no conceptual similarity between the marks. name. Consequently, I find there is no conceptual similarity.

Distinctive character of the earlier trade marks

41. 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-2779, 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).”

42. Since the opponent did not plead that the distinctive character of its mark has been enhanced through use, I only have the inherent position to consider.

43. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of or allude to a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. I found that the average consumer would think that the earlier mark was an invented word, and since it has no apparent allusion to its goods, the inherent distinctiveness of that mark is high.

Likelihood of confusion

44. 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 services and vice versa. I must also keep in mind the average

consumer for the goods and services, 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.

45. Confusion can be direct or indirect. This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand

extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

It is, however, important to bear in mind that these are only examples.

46. Some similarity of goods and services is a pre-condition for the application of section 5(2)⁴. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

47. Given my finding that there is no similarity between the opponent’s goods and some of the applied-for services, the opposition fails in relation to the services which I found to be dissimilar (which will proceed to registration), namely: *Retail store services relating to Candles, scented candles, fragranced candles, table candles, floating candles, candle assemblies, wicks for candles, beeswax and wax for making candles, candles and wicks for lighting, perfumed candles, Christmas tree candles.*

48. I found that the remaining services were similar to the opponent’s goods to a low or very low degree, and the applied for goods were similar to a degree between low

⁴ *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

and medium. I also found that the marks were visually similar to a low degree and aurally similar to a medium degree.

49. Mr Harris drew my attention to the decision of the CJEU in *The Picasso Estate v OHIM*, Case C-361/04 P. The court said:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

50. I consider that this is the case here. The word “Nessa” would, in my view, have a clear and specific meaning. Both parties are agreed that it is a female name. However, even if I am wrong in this, and a first name does not have the such a clear and specific meaning, or in the case that neither mark has a clear concept in the perception of the average consumer, the marks are not sufficiently similar for the average consumer, who will be paying a medium degree of attention, to confuse them, given the low level of similarity between the goods and services. I find that there is no likelihood of direct confusion.

51. Neither do I find there to be a likelihood of indirect confusion. I cannot see how the average consumer, on recognising the differences between the marks, would assume that they denoted the same or connected undertakings.

52. The opposition fails.

CONCLUSION

53. The opposition has failed and the application by NESSA SKINCARE LTD may proceed to registration for all the goods and services.

COSTS

54. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2006. I award the applicant the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £200

Considering and commenting on the other side's evidence: £500

Preparing for and attending a hearing: £500

TOTAL: £1200

55. I therefore order Chutraram Nemaramji Gehlot to pay NESSA SKINCARE LTD the sum of £1200. The above sum should be paid within two months of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 8th day of July 2020

T Perks

For the Registrar,

the Comptroller-General