

**O/970/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3688053  
BY SAS LA VÉRANDA  
TO REGISTER THE FOLLOWING TRADE MARK:**

**Scentiana**

**IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 428624  
BY AMELIA KNIGHT LIMITED**

## **Background and pleadings**

1. On 31 August 2021, SAS La Véranda (“the applicant”) applied to register the trade mark **Scentiana** in the UK, under number 3688053 (“the contested mark”). Details of the application were published for opposition purposes on 1 October 2021. Registration is sought for the following goods:

Class 3: Soaps; perfumery, essential oils, cosmetics, skin care preparations; skin creams, lotions and gels; hair care preparations; non-medicated toilet preparations; beauty care preparations; bath preparations.

2. On 30 November 2021, Amelia Knight Limited (“the opponent”) opposed the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opponent relies upon its comparable UK trade mark number 918101135,<sup>2</sup> **SCIENTIA** (“the earlier mark”). The earlier mark was filed on 29 July 2019 and became registered on 22 November 2019 in respect of the following goods, all of which are relied upon for the purposes of the opposition:

Class 3: Cosmetics and cosmetic preparations; colour cosmetics; cosmetic box sets; eye, eyebrow, hair and face cosmetics; decorative and colour cosmetics; beauty care cosmetics; make-up; make-up foundation, primers and removers; nailcare preparations; nail polish and varnish; nail tips; skincare preparations; face care preparations; soaps; hair care preparations; hair conditioners; bath preparations; body cleaning and beauty care preparations; body washes, lotions and shampoos.

3. Given the respective filing dates, the opponent’s mark is an earlier mark in accordance with section 6 of the Act. As the earlier mark had not completed its

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<sup>1</sup> I note that the opposition was originally based upon section 5(4)(a) of the Act in addition to section 5(2)(b). However, the opponent withdrew reliance on this particular ground in its email correspondence dated 30 May 2022.

<sup>2</sup> Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent’s EUTM number 18101135 being registered as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark is now recorded on the UK trade mark register, has the same legal status as if it had been applied for and registered under UK law, and retains its original EUTM filing date.

registration process more than five years before the filing date of the contested mark, it is not subject to the proof of use provisions specified in section 6A of the Act. Consequently, the opponent is entitled to rely upon all the goods of the earlier mark, without having to demonstrate genuine use.

4. The opponent essentially contends that the competing marks are similar and that the parties' goods are identical or similar, giving rise to a likelihood of confusion, including the likelihood of association.

5. The applicant filed a counterstatement, denying the ground of opposition. The applicant denies that the competing marks are similar and that the parties' goods are identical or similar. It also disputes the existence of a likelihood of confusion.

6. The opponent is professionally represented by HGF Limited and the applicant by RevoMark. Neither party filed evidence in these proceedings, nor did they request a hearing. Only the opponent filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers before me, keeping all submissions in mind.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

## **Decision**

### **The law**

8. Sections 5(2)(b) and 5A of the Act read 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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

9. 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

10. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) 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”.

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. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) 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 the 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”.

13. 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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”.

14. The goods to be compared are displayed above at paragraphs 1 and 2.

15. The applicant’s terms ‘soaps; [...] cosmetics, skin care preparations; [...] hair care preparations; [...] beauty care preparations; bath preparations’ are self-evidently identical to ‘cosmetics and cosmetic preparations; [...] skincare preparations; [...] soaps; hair care preparations; [...] bath preparations; [...] beauty care preparations’ in the opponent’s specification.

16. To my mind, ‘skin creams, lotions and gels’ are encompassed by the opponent’s broader term ‘skincare preparations’. As such, these goods are to be regarded as identical in accordance with *Meric*.

17. '*Non-medicated toilet preparations*' is a broad term which covers products used in washing and taking care of the body. In my view, it would include the opponent's terms '*skincare preparations; face care preparations; soaps; [...] bath preparations; body cleaning [...] preparations; body washes, lotions and shampoos*'. Accordingly, these goods are identical under the principle outlined in *Meric*.

18. The applicant's term '*perfumery*' refers to fragrant liquids which give a pleasant smell to the body. The opponent's term '*cosmetics*' describes preparations applied to the body, especially to the face, to improve its appearance. The nature of the respective goods differs. The primary purpose of respective goods is also different, though I note that cosmetics in the form of lotions and creams for the body are often scented. There is an overlap in method of use insofar as the respective goods are applied to the body as part of, for instance, a beauty regime or morning routine. It is not uncommon for some undertakings, such as perfume houses, to provide, for example, lotions which are scented with their own fragrances; these goods may be intended for use in conjunction with perfumes (that being, as part of a set of products all with the same scent). Therefore, to my mind there is a degree of complementarity between them. The respective goods are likely to reach the market through coinciding channels of trade, though I accept that perfumery and cosmetics are typically found in distinct areas of the same retailers. Users will be the same. There may be a degree of competition, albeit not particularly pronounced, between the respective goods, since a consumer could elect to purchase a scented lotion instead of perfume. Taking all of the above into account, I find that the respective goods are similar to between a low and medium degree.

19. '*Essential oils*' describes liquid compounds which, it is my understanding, have a number of uses. Given that the opponent's term '*cosmetics*' covers skin oils, there is an overlap in nature. Broadly speaking, there is also an overlap in the intended purpose of the respective goods to the extent that they can both be used for cosmetic reasons. As the respective goods may both be applied to the skin, there is also an overlap in method of use. The respective goods also share users. Although the respective goods are both sold in retail establishments, they are not typically found in close proximity to one another. In addition, they are unlikely to be produced by the same undertakings. There is no material competition between the respective goods.



Further, as they are neither important nor indispensable to one another, they are not complementary. In light of all of this, I find that the respective goods are similar to between a low and medium degree.

### **The average consumer and the nature of the purchasing act**

20. 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.”

21. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.<sup>3</sup>

22. I agree with the opponent that the average consumer of the goods at issue in these proceedings will be a member of the general public. Overall, the goods are likely to be purchased relatively frequently for the purposes of, for example, personal care and improving the condition and appearance of the skin and hair. The purchasing act will not require an overly considered thought process as, overall, the goods are relatively inexpensive; the selection process will be more casual than careful. However, I do not agree with the opponent that the average consumer will only pay a low level of attention across the full range of goods at issue. The average consumer will consider factors such as suitability and ingredients when purchasing the goods, since they will thereafter be applied to the skin and hair. The average consumer may also consider

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<sup>3</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

the effectiveness of the goods for achieving the desired result. Consequently, I find that the level of attention of the average consumer would be medium. However, I accept that in respect of some goods, such as, for example, 'soaps', the average consumer is likely to demonstrate a lower level of attention, since these are less costly, everyday purchases that require less consideration during the selection process. The goods are typically sold in supermarkets and other retail establishments, where they are likely to be self-selected from shelves. For this reason, the purchasing process is likely to be predominantly visual in nature. However, I do not discount aural considerations entirely as the average consumer may receive word of mouth recommendations or discuss the products with a sales assistant before purchasing the goods.

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

23. 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 *WindsurfingChiemsee 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).”

24. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

25. Further, the distinctive character of a mark may be enhanced as a result of it having been used in the market. However, the opponent has not pleaded that its mark has acquired enhanced distinctive character and has filed no evidence of use. Accordingly, I have only the inherent position to consider.

26. The earlier mark is in word-only format and comprises the word ‘SCIENTIA’. As there are no other elements in the mark, its distinctive character rests in the word itself. The opponent has submitted that the word means ‘knowledge’ in Latin, but that this meaning is unlikely to be apparent to the average consumer. I agree. Given that Latin has ceased to be a commonly used or understood language in the UK, I consider it highly unlikely that the average consumer would be aware of the meaning of the word. It will, instead, present as an invented word with no discernible meaning. The mark is neither descriptive nor allusive of the goods for which it is registered. I find that the earlier mark possesses a high level of inherent distinctive character.

### **Comparison of trade marks**

27. 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.”

28. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

29. The competing trade marks are as follows:

<b>The earlier mark</b>	<b>The contested mark</b>
SCIENTIA	Scentiana

#### Overall impressions

30. The competing marks consist of the words ‘SCIENTIA’ and ‘Scentiana’. As these are the only elements of the marks, their overall impressions lie in the respective words themselves.

#### Visual comparison

31. Visually, the competing marks are similar in that they begin with identical letters, i.e. ‘SC’/‘Sc’, and share a further five identical letters in the same order, i.e. ‘ENTIA’/‘entia’. Further, the marks are of similar length. The discrepancy in letter case

does not create a point of significant difference between the marks, since the registration of word-only marks provides protection for the words themselves, irrespective of whether they are presented in upper, lower or title case.<sup>4</sup> The competing marks visually differ as the common elements are separated by a letter 'l' in the earlier mark. Moreover, the contested mark ends with the letters 'na'. However, this difference appears at the end of the marks, a position which is generally considered to have less impact.<sup>5</sup> Bearing in mind my assessment of the overall impressions, I find that there is between a medium and high degree of visual similarity between the competing marks.

### Aural comparison

32. The competing marks both comprise four-syllable words. The contested mark will be pronounced as "SEN-TEE-AH-NAH", whereas the earlier mark will be pronounced as "SAI-EN-TEE-AH". The competing marks are aurally similar as they both begin with an 'S' sound. They also share two syllables, i.e. "TEE" and "AH", in the same order. However, these appear in slightly different positions in the respective marks. The competing marks also aurally differ in that the first and last syllables are not the same, though they are not entirely dissimilar. Overall, I find that the competing marks are aurally similar to between a medium and high degree.

### Conceptual comparison

33. For a concept to be relevant, it must be capable of immediate grasp by the relevant consumer.<sup>6</sup> As explained previously, the earlier mark is likely to be perceived by the average consumer as an invented word with no discernible meaning. To my mind, the contested mark has no obvious meaning either; therefore, it is also likely to be perceived as an invented word. As neither mark conveys any meaning, the conceptual position is neutral.

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<sup>4</sup> *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

<sup>5</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>6</sup> *The Picasso Estate v OHIM*, Case C-361/04 P

## **Likelihood of confusion**

34. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor 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 vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 they have retained in their mind.

35. 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.

36. Earlier in this decision, I concluded that:

- Some of the applicant's goods are identical to those of the earlier mark, while others are similar to between a low and medium degree;
- The average consumer is likely to be a member of the general public, who will demonstrate a medium level of attention when selecting some goods and a lower level of attention in respect of others;
- The purchasing process for the goods will be predominantly visual in nature, though I have not excluded aural considerations;
- The earlier mark has a high level of inherent distinctive character;

- The overall impressions of the competing marks are dominated by the words 'SCIENTIA' and 'Scintiana', being the only elements of the marks;
- The competing marks are visually and aurally similar to between a medium and high degree, while the conceptual position is neutral.

37. I acknowledge that the competing marks have different endings and that the presence of the letter 'l' in the earlier mark also creates a difference. Nevertheless, taking into account the levels of overall similarity between the competing marks, as well as the high level of inherent distinctive character possessed by the earlier mark, it is my view that these differences are likely to be insufficient to distinguish the applicant's goods from those of the opponent. The competing marks are of similar length and share two identical letters in the same order at their beginnings. The competing marks also share an identical five-letter string. The differences between the marks arise at their respective endings, a position which is generally considered to have less impact, and towards the centre of the marks, where the subtle difference created by the letter 'l' is arguably less noticeable. Neither of the marks will convey any meaning to the average consumer; they will, instead, be perceived as invented words. As such, neither provides any conceptual 'hook' that could assist the average consumer in distinguishing between them. Taking into account the principle of imperfect recollection, it is considered likely that the average consumer – paying no more than a medium level of attention – may not recall the respective marks with sufficient accuracy to differentiate between them. To my mind, it is highly likely that the average consumer may misremember the different endings of the marks and whether a letter 'l' follows the identical beginning 'SC'/'Sc'. Consequently, I find that there is a likelihood of direct confusion, even in relation to the goods that I have found similar to between a low and medium degree.

### **Conclusion**

38. The opposition under section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal against my decision, the application will be refused.

## **Costs**

39. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £700 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's counterstatement	£250
Preparing written submissions	£350
Official fees <sup>7</sup>	£100
<b>Total</b>	<b>£700</b>

40. I therefore order SAS La Véranda to pay Amelia Knight Limited the sum of £700. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings (subject to any order made by the appellate tribunal).

**Dated this 7<sup>th</sup> day of November 2022**

**James Hopkins**  
**For the Registrar**

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<sup>7</sup> I note that the opponent paid an official fee of £200 for the filing of its statement of grounds. This fee was applicable because the opposition was originally based upon section 5(4)(a) in addition to section 5(2)(b). However, following the filing of the applicant's counterstatement, the opponent withdrew its claim under section 5(4)(a). In the circumstances, the additional fees paid in respect of grounds other than 5(1) or 5(2) are not recoverable. Rather, I consider it reasonable and appropriate to make an award in line with that for an opposition based on section 5(2)(b) only.