

BL O/0491/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003659652

BY FONIKA LTD

TO REGISTER THE TRADE MARK:



IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427358

BY NATURA COSMÉTICOS S.A.

BACKGROUND AND PLEADINGS

1. On 23 June 2021, Fonika 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 the 20 August 2021. The applicant seeks registration for the following goods:

Class 3 Masks (Beauty -); Beauty lotions; Beauty masks; Beauty milks; Beauty gels; Beauty creams; Beauty serums; Beauty milk; Beauty soap; Facial beauty masks; Beauty care cosmetics; Beauty balm creams; Beauty care preparations; Non-medicated beauty preparations; Beauty masks for hands; Distilled oils for beauty care; Beauty preparations for the hair; Beauty creams for body care; Perfumery products; Soap products; Body cleaning and beauty care preparations; Beauty serums with anti-ageing properties.

2. The application was opposed by NATURA COSMÉTICOS S.A. (“the opponent”) on 22 September 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

NATURA

Comparable UK trade mark (EU) registration no UK00904303426

Filing date 22 February 2005.

Registration date 14 March 2007.

Relying upon some of the goods for which the earlier mark is registered, namely:

Class 3 Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps, perfumery, essential oils, cosmetics, bath and shower gels, bath oils, bath salts, bath beads, skin care preparations, namely, lotions, creams, cleansers, scrubs, masks and toners; hair care and hair styling preparations, namely, shampoos, conditioners, hair lotions, sprays, gels, mousses and

balms, preparations in aerosol form for hairdressing and haircare, hair lacquers; hair-colouring and hair-decolorizing preparations; permanent waving and curling preparations; personal deodorants, sun-tanning preparations; sunscreen oils, gels and lotions; shaving preparations; scented room fragrances, incense sticks, potpourri and sachets; dentifrices; salts not for medical purposes; after-sun preparations (cosmetics); moisturizers; toiletries; make up products.

3. As shown above, the opposition is based upon the opponent's comparable UK trade mark (EU),¹ claiming that there is a likelihood of confusion because the applicant's mark incorporates the entirety of the opponent's mark, which is the dominant and distinctive element, and the goods are either identical or very highly similar.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use.

5. The opponent is represented by Baker & McKenzie LLP and the applicant is unrepresented. A hearing was neither requested nor considered necessary, however, the opponent filed evidence in chief and submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

EVIDENCE

6. The opponent's evidence consists of the witness statement of Ms Renata Campos dated 23 September 2022. Ms Campos is the Group Intellectual Property Counsel Associate of the opponent, a position she has held since 2009. Ms Campos' statement was accompanied by 15 exhibits (RC1-RC15).

7. I have taken all of the evidence and submissions into account in reaching this decision.

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

RELEVANCE OF EU LAW

8. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

10. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) and 6(1)(ab) as its filing date is an earlier date than the filing date of the applicant’s mark.

11. As the opponent’s mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

12. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

13. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

15. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicant’s mark, i.e. 24 June 2016 to 23 June 2021. As the opponent’s mark is a comparable mark, the relevant territory for the period before IP Completion Day (31 December 2020) is the EU, and for the remainder of the period is the UK.

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

[EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

17. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

18. I note that any evidence that falls outside of the relevant period, falls outside of the relevant territory (EU or UK), or is undated, will not be referred to within my decision if it does not assist the opponent. I note the following from the opponent's evidence:

- a) The opponent is a parent company of Natura & Co Holding S/A which owns the brands Avon, Natura, The Body Shop and Aesop.
- b) NATURA is a Brazilian cosmetics company which is present in 17 countries amongst Europe, North America, Latin America and Asia.
- c) The opponent is an eco-friendly sustainable company which uses only natural and ethically-sourced beauty and cosmetic products.
- d) **Exhibit RC6** contains a 2019, 2020 and 2021 report which contains the following figures:

2019

- a) Natura & Co has 200 million consumers around the world in 100 countries and a gross revenue of \$10 billion.
- b) Natura & Co has 6,900 employees in Europe for its Avon, Natura, The Body Shop and Aesop brands.
- c) For just its NATURA brand, its annual growth increased by 6.7% from 2018 to 2019, with the net revenue at \$8,447 billion in 2018 and \$9,012 billion in 2019.

2020

- a) As shown on the map within the brochure, the only NATURA stores that are located within the EU are located in France.

2021

- d) This brochure only contains the consolidated net revenue of \$40.16 billion for its Avon, Natura, The Body Shop and Aesop brands.
- e) In her witness statement, Ms Campos provides the “combined total of NATURA only UK sales between 2018-2021” set out in the following table:

Relevant period	UK number of units sold	UK Sales (GBP)
2018-2021	43,707	270,767

- f) The above table is supported by invoices for its customers located in the UK exhibited in **RC7**. Invoices are also exhibited in **RC8** which are in relation to the opponent’s UK third party distributors (including Latest In Beauty and CHICMI which are referred to below). I note that this is evidence of sales, however, all of the invoices are provided in another language, without any translation. I am, therefore, unable to determine what goods were sold.
- g) The opponent has advertised its goods through its website and social media channels. Ms Campos has provided me with a table within her witness statement which contains a breakdown of its European followers for its Facebook, Twitter, Instagram and YouTube pages. However, I haven’t been provided with a date in which these figures were extracted.
- h) **Exhibit RC11** contains screenshots of websites in which the opponent has been featured, including the following:
- a. A screenshot from the CHICMI.com website titled “The Natura online sample sale from April 2021”. This is supported by Instagram screenshots which shows that CHICMI had a Natura online sample sale from 29 April to 3 May, which was exclusive to the UK. The website states that’s that Natura is a fair trade Brazilian company which has received a top UN environmental award twice and a B Corporation certificate on New York Environmental Stock Exchange. “After the super

successful event last year, we will introduce even more of Natura's best-selling products".

- b. A blog called "NATURA: GET TO KNOW THE BRAND THAT GIVES BACK" from latestinbeauty.com dated 23 November 2020. The opponent's NATURA brand has 2 ranges called EKOS and CHRONOS. The CHRONOS range is specifically a facial skincare range which includes the intense purifying cleanser, the firming and radiant 45+ night face cream and the aqua auto-replenish gel hydrator which is a moisturising gel. The blog also refers to the opponent's "Acai Hand Cream" and "Castanna Exfoliating Shower Gel". I note that the blog includes the following photos of the opponent's products:





- c. A blog called “THE BEAUTY THREAD: HOW TO SWITCH UP YOUR SKINCARE THIS AUTUMN” from latestinbeauty.com dated 21 October 2020. This mentions the opponent’s Natura Nourishing Hand Cream which “glides on, absorbs quickly and any excess can be massaged into the nails to strengthen the cuticles”.

- i) latestinbeauty.com also launched a 7 day takeover campaign in November 2020 which involved the opponent’s products being sold on its website, and live social media engagement/promotion of its goods. I note that **exhibit RC12** contains the details of the campaign, such as the Instagram live which occurred on the 30 October which announced the takeover and introduced 7 of the opponent’s products. The screenshot provided of this shows customer engagement including a customer referring to the opponent’s aqua auto-replenish gel hydrator in the Instagram comments. I also note that latestinbeauty’s Instagram post, newsletter, blog and the website home page

announced the takeover on 1 November. **Exhibit RC12** also includes screenshots of its products which were advertised during this week (on Instagram and the latestinbeauty website), including:

- a. Natura's Castanha Nourishing Hand Cream
 - b. Natura's Murumuru Hair Leave-In Conditioner
 - c. Natura's Acai Hand Cream
 - d. Natura's Patau Hair Strengthening Oil
 - e. Natura's Murumuru Restoring Hair Mask
 - f. Natura's Castanha Exfoliating Shower Gel
 - g. Natura's Firming and Radiance 45+ Night cream
 - h. Natura's Deep Purifying Pore Cleanser
 - i. Natura's Aqua Auto-Replenish Gel Hydrator
- j) The Castanha Nourishing Hand Cream has seven 5 star reviews from UK customers on the latestinbeauty website dated from 3 to 17 November 2020.
- k) Lastly, I note that Ms Campos provides a table of awards won in 2020 and 2021 by Natura such as being ranked highly as a sustainable or carbon clean company, and being ranked as the world's strongest cosmetic brand in 2021 by Brand Finance.

19. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that (my emphasis):

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestle, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

20. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the

mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA

were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

21. The opponent’s mark has been used as registered. I am also satisfied that the use in a slightly stylised typeface, as shown above, is use of the word mark as registered.²

22. The opponent’s mark has also been used in the following variant:



23. The addition of the abstract flower device does not alter the distinctive character of the mark and therefore I consider it is acceptable variant use.

24. In regard to the opponent’s above evidence, there are clearly some issues with some of the exhibits, which are either undated or fall after the relevant period.

25. However, I have been provided with the UK sales figure for 2018 to 2021 which amounts to £270,767, which is supported by invoice evidence. Albeit the sale figure is not broken down into the goods sold by the opponent, and the invoices are provided in another language, the invoices do establish that there were sales to customers and distributors based in the UK. The opponent has also provided evidence of the goods which were advertised and sold on the UK distributors websites, including latestinbeauty, which also advertised the goods on its Instagram takeover, including the NATURA branded hand cream, hair oil, hair mask, hair conditioner, skin cleanser and moisturizers. I note that the opponent has not provided me with a UK market share figure, but based on the above, I consider it would only be a small market share. However, I appreciate that the opponent is clearly operating within a market which is significantly sized and highly saturated. Therefore, taking all of the above into account,

² *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

I consider that the opponent has established genuine use of its mark, in relation to the above class 3 beauty skincare goods in the UK.

26. Furthermore, the case law above is clear that use of a mark in an area of the European Union constituting one-member state may be sufficient to demonstrate genuine use in the European union as a whole. I consider this to be the case here for the relevant period that falls before IP completion day. I am satisfied that the opponent has demonstrated use of its mark in the EU for that part of the relevant period.

27. I must now consider whether, or the extent to which, the evidence shows use of the goods and services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

28. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the

services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

29. The goods for which the earlier mark is registered and upon which the opponent relies is its class 3 beauty skincare goods.

30. As highlighted above, the earlier mark has been put to genuine use in relation to hand cream, hair oil, hair masks, hair conditioners, cleansers and moisturizers. For the remainder of the class 3 goods for which its mark is registered, the opponent hasn't shown genuine use.

31. Consequently, I consider a fair specification of the earlier mark to be:

Class 3 Skin cleansers; hand creams; hair conditioners; hair oils; hair masks; moisturizers.

Section 5(2)(b) - case law

32. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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

33. The competing goods are as follows:

Opponent's goods	Applicant's goods
-------------------------	--------------------------

<p><u>Class 3</u></p> <p>Skin cleansers; hand creams; hair conditioners; hair oils; hair masks; moisturizers.</p>	<p><u>Class 3</u></p> <p>Masks (Beauty -); Beauty lotions; Beauty masks; Beauty milks; Beauty gels; Beauty creams; Beauty serums; Beauty milk; Beauty soap; Facial beauty masks; Beauty care cosmetics; Beauty balm creams; Beauty care preparations; Non-medicated beauty preparations; Beauty masks for hands; Distilled oils for beauty care; Beauty preparations for the hair; Beauty creams for body care; Perfumery products; Soap products; Body cleaning and beauty care preparations; Beauty serums with anti-ageing properties.</p>
---	---

34. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the 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.”

35. Guidance on this issue has 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

36. 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 trade mark application (Case T-388/00 Institut for 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.”

37. 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.”

38. 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.”

39. 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 Harmonization 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 the responsibility for those goods lies with the same undertaking.”

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

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not

follow that wine and glassware are similar goods for trade mark purposes.”
Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Whilst on the other hand:

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

Beauty care cosmetics; Beauty care preparations; Non-medicated beauty preparations.

41. I consider that the applicant’s above goods would cover a broad range of products, intended for use on the face and body, for beautification purposes. I therefore consider that the opponent’s “moisturizers” fall within all of the applicant’s broader terms. They are identical on the principle outlined in *Meric*. Even where the applicant’s term covers goods other than moisturizers, there will be an overlap in user, method of use, purpose, nature and trade channels and the goods will be highly similar.

Body cleaning and beauty care preparations.

42. I consider that the opponent’s “skin cleansers” falls within the applicant’s above broader term. They are identical on the principle outlined in *Meric*. Even where the applicant’s term covers goods other than cleansers, there will be an overlap in user, method of use, purpose, nature and trade channels and the goods will be highly similar.

Beauty preparations for the hair.

43. I consider that the opponent’s “hair masks”, “hair conditioners” and “hair oils” fall within the applicant’s above broader term. They are identical on the principle outlined in *Meric*. Even where the applicant’s term covers goods other than hair masks,

conditioners and oils, there will be an overlap in user, method of use, purpose, nature and trade channels and the goods will be highly similar.

Beauty creams; Beauty balm creams; Beauty creams for body care.

44. The applicant's above goods covers a range of creams, which are used on the face, hands or body, for moisturising purposes. I therefore consider that the opponent's "hand creams" fall within the applicant's above broader categories, and are therefore identical on the principle outlined in *Meric*. Even where the applicant's term covers goods other than hand creams, there will be an overlap in user, method of use, purpose, nature and trade channels and the goods will be highly similar.

Beauty lotions.

45. The applicant's above goods covers a range of lotions, which are used on the hands or body, for moisturising purposes. I therefore consider that the opponent's "moisturizers" falls within the applicant's broader category of "beauty lotions", and is therefore identical on the principle outlined in *Meric*. Even where the applicant's term covers goods other than moisturizers, there will be an overlap in user, method of use, purpose, nature and trade channels and the goods will be highly similar.

Beauty gels.

46. The applicant's above goods would cover gels used to beautify, moisturize and hydrate the skin. I note that the opponent's "moisturizers" can come in a gel form, and therefore fall within the applicant's broader category of "beauty gels". They are identical on the principle outlined in *Meric*. Even where the applicant's term covers goods other than moisturizers, there will be an overlap in user, method of use, purpose, nature and trade channels and the goods will be highly similar.

Distilled oils for beauty care.

47. I consider that "beauty care" products would cover a range of goods such as hair care, body care and skincare items. Therefore I consider that the opponent's "hair oils"

falls within the applicant's above broader category. They are identical on the principle outlined in *Meric*. Even where the applicant's term covers goods other than hair oils, there will be an overlap in user, purpose, nature and trade channels and the goods will be highly similar.

Beauty soap.

48. I consider that the applicant's above goods are soaps which are used to cleanse the users face, and therefore overlaps with the opponent's "skin cleansers". There will be an overlap in purpose and user. The goods will also overlap in trade channels and distribution channels (with the goods being sold in the same aisle of a beauty retail store). However, the goods will not overlap in nature as the applicant's goods would most likely appear in a bar form, whereas the opponent's goods would most likely be in a water or oil-based liquid form. The goods will not be complementary, but they will be in competition. Consequently, the goods are similar to a high degree.

Beauty milks; Beauty milk.

49. The applicant's above goods would include cleansers and lotions which contain or are infused with plant-based milks (such as rice milk) which have hydrating properties. I therefore consider that these goods overlap with the opponent's "skin cleansers". The goods are all used for beautifying and moisturising purposes, and would be sold by the same beauty/skincare undertakings, and found in the same aisle of a beauty retailer. All of the goods are used on the body and appear in a thin lightweight (and even milky) consistency. Therefore the goods overlap in method of use and nature. The goods are not complementary but may be in competition. I therefore consider that the goods are similar to a high degree.

Beauty serums.

50. I consider beauty serums can be made from a variety of different ingredients which gives them different properties, including moisturisation. I note that they can range in the type of consistency they appear in, which includes a thicker gel-based form. I therefore consider that these goods overlap in nature, purpose and method of use with

the opponent's "moisturizers" as the goods would be used to moisturise the face, and sold by the same beauty/skincare undertakings. The goods would also be sold in the same aisle of a beauty retail store. The goods are not complementary; however, they may be in competition. I consider that the goods are similar to a high degree.

Beauty serums with anti-ageing properties.

51. I note that moisturizers can also have anti-aging properties and therefore the same comparison applies in paragraph 50 above. The goods are similar to a high degree.

Beauty masks for hands.

52. The applicant's above goods can both take the form of a sheet mask, or a thicker cream dispensed from a tub or tube. I consider that these goods therefore overlap in purpose with the opponent's "hand creams" as they are all used on the hands for moisturizing purposes. They will also overlap in nature and method of use if the applicant's goods appear as a thick cream. I consider that the goods would be sold by the same undertakings, and found in the same aisle of a beauty retail store. The goods are not complementary, but they are in competition. The goods are therefore similar to a high degree. However, for the applicant's goods which take the form of a sheet mask (differ in nature and to some extent method of use), I consider that they are similar to no more than a medium degree.

Masks (Beauty -); Beauty masks; Facial beauty masks.

53. The applicant's above goods usually appear in a cream paste-like form in a tub or foil packet, to be used and placed on the users face, for single-use purposes. These goods are normally used to improve the appearance of the user's skin, for beautification purposes. They can also have moisturizing properties. I therefore consider that these goods overlap in purpose with the opponent's "moisturizers". There would also be an overlap in user and trade channels as the goods would be sold from the same beauty and skincare undertakings and sold within the same aisle of a beauty retailer. I note that there would be an overlap in method of use, to the extent that the items are placed and used on the face. However, the applicant's goods would be

removed after the prescribed period of time, whereas moisturizers sink into the users skin. I also consider that the nature of the goods differ to some extent, as the applicant's goods are thicker and paste-like in consistency, using typical base-ingredients such as clay, whereas moisturizers can appear in a variety of forms from lotions to thick creams to gels. The goods are neither in competition nor complementary. Therefore, I consider that the goods are similar to no more than a medium degree.

Soap products.

54. The applicant's above goods have the primary purpose to clean the users hands, body or face. However, I note that they can also have secondary purposes, such as moisturising functions. Therefore, I consider that the applicants' goods overlap, to some extent, with the opponent's "hand creams" which are also used for moisturising purposes. There will be an overlap in trade channels as the same hygiene and beauty undertakings are likely to produce all of the above goods which would be sold in the same aisle of supermarkets, and beauty retail outlets.

55. Furthermore, I note that both soaps and hand creams can be sold together (as a duo), fragranced with the same scents, to be used alongside each other in the bathroom. Consequently they overlap in nature as they are both sold in a pump liquid form. The goods are not in competition nor complementary. Therefore, the goods are similar to a medium degree.

Perfumery products.

56. I consider that the applicant's above goods have some overlap with the opponent's "hand creams". I consider that albeit the goods differ in nature, method of use and purpose, and they are neither in competition nor complementarity, there may be an overlap in trade channels as these goods can be sold alongside each other as a set/gift set, and therefore produced by the same undertaking, and brought by the same user. They can also be fragranced with the same scents. Therefore, I consider that the goods are similar, but to between a low and medium degree.

The average consumer and the nature of the purchasing act

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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.”

58. The average consumer for the goods will be members of the general public, however, I do not discount that it could also include a professional user such as a beautician. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, aesthetic, scent and the suitability for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

59. The goods are likely to be obtained by self-selection from the shelves of a retail outlet, or online equivalent. I also note that beauty care goods can also be on display with tester products, for the user to test and use in store. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations are, therefore, likely to dominate the selection process.

60. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.


Comparison of the trade marks

61. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

62. 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.

63. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
NATURA	 NATURACARE

64. The opponent's mark consists of the word NATURA. There are no other elements to contribute to the overall impression which lies in the word itself.

65. The applicant's mark consists of a device composed of 3 green leaves hovering above an abstract blue device which I consider the average consumer will recognise as a hand, especially due to its placement "holding the leaves". Underneath the device, is the word NATURACARE, with the NATURA element in blue and the CARE element in green. Although the eye is naturally drawn to the element of the mark that can be read, given the size (being the largest part of the mark) and positioning of the hand and leaf device at the beginning of the mark, I consider that it plays a roughly equal role in the overall impression with the word NATURACARE.

66. Visually, the opponent's mark is wholly contained at the beginning of the applicant's word element: NATURA. This acts as a point of visual similarity. However, the applicant's word element ends in the word CARE, and contains the large hand and leaf device at the beginning of the mark. These act as visual points of difference. I therefore consider that the marks are visually similar to between a low and medium degree.

67. Aurally, the opponent's mark will be pronounced as NAT-CHUR-RAH. The applicant's mark will be pronounced as NAT-CHUR-RAH KH-AIR, with the device element not being articulated. Therefore, as the beginning of the marks overlap aurally, I consider that they are aurally similar to a medium degree.

68. Conceptually, the word NATURA in both marks would be recognised as a shortening of the word natural without the letter "L" at the end. I therefore consider that this word is highly allusive of the parties' class 3 goods because the average consumer will understand it to mean that the goods are all natural, or derive from natural products/ingredients. The word CARE in the applicant's mark will be assigned its ordinary dictionary definition (to nurture or to look after). I also consider that this is allusive of the applicant's goods as they look after the user's skin and hair. Furthermore, the hand device reinforces the meaning of CARE (a "caring hand"), and the leaves reinforces the meaning of NATURA (leaves being a product of nature).

Regardless, as both marks overlap in evoking the meaning of natural, I consider that they are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

69. 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 C108/97 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 promotion of 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).”

70. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

71. As highlighted above, the opponent's mark, NATURA, would be recognised as a shortening of the word natural, which is highly allusive of the opponent's class 3 goods because it will be understood as meaning that the goods are all natural, or derive from natural products/ingredients. As per *Formula One Licensing BV v OHIM*³, the earlier mark must be considered to have at least some distinctive character. Therefore, I consider that the opponent's mark is inherently distinctive to a low degree.

72. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

73. The opponent has provided UK sales figures, for the years 2018 to 2021, which amount to £270,767. However, I haven't been provided with any UK advertising figures, or market share figures. I note that based on the sale figure provided, the opponent would only have a small share of the market, which is significant in the UK and highly saturated. Therefore, I do not consider that the evidence is sufficient to establish enhanced distinctive character.

Likelihood of confusion

74. 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. 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. 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to

³ Case C-196/11P, paragraphs 41 to 44

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 he has retained in his mind.

75. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a low degree.
- I have identified the average consumer for the goods to be members of general public and beauticians, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical to similar to between a low and medium degree.

76. Taking all of the factors listed in paragraph 75 into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the lower visual similarity (to between a low and medium degree) between the marks, and the predominantly visual purchasing process. I also do not consider that the average consumer would overlook the hand and leaf device at the beginning of the applicant' mark, which as noted above, is also the biggest element within the mark. I also consider that, as the average consumer does not dissect the mark, that they would not overlook the "CARE" element at the end of the word NATURACARE in the applicant's mark. I do not consider there to be a likelihood of direct confusion.

77. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), 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.”

78. I note that the CJEU in *L’Oréal SA v OHIM*, Case C-235/05 P, confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion. I also bear in mind the recent appeal decision by Philip Harris, sitting as the Appointed person, in *Natural Pure NATURAL PURE WATER*, Case BL-O/0331/23, stated that:

“23. Accordingly, I think *Whyte & Mackay* goes much further than *Nicoventure*. I read the former case as holding that where the first mark is of low distinctiveness overall, and it is replicated (even wholly replicated) in a second mark, this suggests against a likelihood of confusion provided there is at least one element in the second mark which is sufficiently more distinctive than the element consisting of the first mark. This view also seems to me to be consistent with the extract from the *L’Oreal* judgment above.”

79. In this instance, the applicant’s mark has 2 additional elements; the hand/leaf device and the word CARE. As highlighted above, I consider that the word CARE is also allusive of the applicant’s goods which look after the user’s skin and hair, and the device reinforces the meaning of the mark overall; with the NATURA element reinforced by the leaf element (leaves being a product of nature), and the hand device

reinforcing the meaning of CARE (“a caring hand”). Consequently, these elements are not “sufficiently more distinctive” than the NATURA element.

80. Therefore, I consider that the common use of the same abbreviation “NATURA” will lead the average consumer to conclude that the marks originate from the same or economically linked undertakings. I consider that the average consumer will see the addition of the hand/leaf device and the word CARE, and perceive it as either an updated version of the same mark, and therefore indicative of re-branding, or a sub-brand mark (NATURA being the house brand, and NATURACARE being the sub-brand for its skincare and haircare products). Taking all of the above into account, I consider there to be a likelihood of indirect confusion.

CONCLUSION

81. The opposition is successful in its entirety and the application is refused.

COSTS

82. The opponent has been successful and 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 **£1,150** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant’s counterstatement	£200
Preparing and filing evidence	£500
Filing written submissions	£350
Official Fee	£100
Total	£1,150

83. I therefore order Fonika Ltd to pay NATURA COSMÉTICOS S.A the sum of £1,150. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of May 2023

L FAYTER

For the Registrar