

O/103/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2519091
BY SANDRA AMALIA MARY ELLIOTT
TO REGISTER THE TRADE MARK**

LUV

**AND THE OPPOSITION THERETO UNDER NO. 99720
BY LRC PRODUCTS LIMITED**

AND

**IN THE MATTER OF APPLICATION NO. 2534564
BY LRC PRODUCTS LIMITED
TO REGISTER THE TRADE MARK**

LOVE

**AND THE OPPOSITION THERETO UNDER NO. 100555
BY SANDRA AMALIA MARY ELLIOTT**

Background and the issues in dispute

1. On 20 June 2009, Sandra Amalia Mary Elliott applied to register LUV as a trade mark in class 10 for the following goods:

Massage instruments and apparatus; manually operated massage devices; instruments and apparatus for vibromassage; sexual massage devices and apparatus; stimulators; vibrators; dildos; apparatus for the treatment of sexual dysfunction; erection aids; sex toys; sexual aids and appliances; parts and fittings for all the aforesaid goods.

2. The application was published in the *Trade Marks Journal* on 7 August 2009 and on 6 November 2009 it was opposed by LRC Products Limited (“LRC”) on the grounds that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) because there would be a likelihood of confusion with its earlier marks, as follows:

(i) Community Trade Mark (“CTM”) 3052768

LOVE

Class 5: Contraceptive preparations and substances, spermicidal gels, liquids and creams; hygienic lubricants and disinfectants.

Class 10: Condoms; contraceptive, hygienic or prophylactic devices.

Date of filing: 11 February 2003

Date of completion of registration procedure: 13 October 2005

(ii) 2432028

WE MAKE LOVE

Class 3: Non-medicated wipes; toiletries; sanitary preparations; non-medicated preparations for the bath in the form of salts, oils and soaks; moisturising preparations; essential oils; massage oils; room sprays.

Class 5: Pharmaceutical preparations and substances; contraceptive preparations and substances; spermicidal gels, liquids and creams; hygienic lubricants; lubricants for personal use; disinfectants.

Class 10: Condoms; contraceptive, hygienic or prophylactic devices; massage apparatus, instruments and appliances; electric and electronic massage apparatus, instruments and appliances; body massagers; personal massagers; vibrators; vibrating rings; marital aids; sex aids; parts and fittings for all the aforesaid goods.

Date of filing: 8 September 2006

Date of completion of registration procedure: 23 March 2007

3. LRC claims that there is a likelihood of confusion as, in the case of its earlier mark LOVE, LUV and LOVE are phonetically and conceptually identical; the two spellings are interchangeable; and the goods in the application are complementary to those of its earlier mark, will be used together and sold through the same trade channels. In the case of its earlier mark WE MAKE LOVE, LRC claims that there is a likelihood of confusion because the spellings of LUV and LOVE are interchangeable and the addition of WE MAKE does not substantially alter the distinctive character of WE MAKE LOVE. It claims the goods are either identical (class 10) or similar, being complementary.

4. Ms Elliot filed a counterstatement on 7 January 2010, denying the grounds of opposition¹. Meanwhile, on 16 December 2009, LRC filed a trade mark application for LOVE in class 10, the amended specification² of which now reads:

Massage apparatus; personal massagers; vibrators; vibrating rings; parts and fittings for all the aforesaid goods.

It was published on 26 February 2010 and was opposed by Ms Elliott on 26 May 2010. Her grounds of opposition are as follows:

(a) Under section 3(1)(c) of the Act:

“The word LOVE is one which might often be used in association with the above goods. For example, it could be used in the term “to make love”. Many of the relevant goods would be used by persons who are “in love”. Additionally, the word LOVE may be used as a simple laudatory term, eg “I love this product”. For these reasons and others, it is maintained that the opposed mark consists exclusively of signs or indications which may serve, in the trade, to designate the kind, quality, intended purpose and/or other characteristics of the goods.”

(b) Under section 3(1)(d) of the Act:

“The word LOVE is commonly used in the relevant sectors of trade, for example as a more acceptable substitute for the word “sex”. The word LOVE is very often used as a component of trading names, domain names, and the like, in connection with relevant goods. It is maintained that the opposed mark is one which consist exclusively of signs or indications that have become customary in the current language or in the *bona fide* and established practices of the trade.”

(c) Under section 5(2)(b) of the Act on the basis of Ms Elliott’s earlier trade mark application 2519091, which is itself opposed by LRC, as detailed above.

5. LRC filed a counterstatement on 2 August 2010 in which it denied all of Ms Elliott’s grounds of opposition.

¹ I will not summarise here the contents of the counterstatement because they formed part of the submissions made at the substantive hearing, which I will refer to later.

² Following the filing of two Form TM21s on 15 March 2011 and 28 November 2011.

6. The proceedings were consolidated by the Trade Marks Registry. Both parties filed evidence and I heard their representatives' submissions at a hearing on 12 January 2012. Ms Elliott was represented by Dr. Jonathan Banford, for Franks & Co. (South) Ltd, her trade mark attorneys. LRC was represented by its trade mark attorney, Mr Niall Tierney, for Contego IP LLP.

7. At the hearing, Mr Tierney confirmed that LRC withdrew its defence against Ms Elliott's section 5(2)(b) ground of opposition. The effect of this is that if LRC's opposition against Ms Elliott's application were to fail, its own application would be refused because Ms Elliott would win her case on the undefended section 5(2)(b) ground, regardless of the success or failure of her section 3 grounds. However, if LRC's opposition against Ms Elliott were to be completely or partially successful, and her application refused or partially refused, I would still need to assess her section 3 grounds against LRC, the section 3 grounds being absolute rather than relative. It appears sensible that I should look firstly at LRC's section 5(2)(b) ground against Ms Elliott's application for LUV.

Evidence

8. As neither party claims a reputation in their respective earlier marks and none of the marks are subject to the proof of use regulations³, I will concentrate on the evidence which addresses the parties' claims that LOVE and LUV are interchangeable and the parties' goods are similar, particularly that they are complementary and share channels of trade (LRC's claims) and that LOVE is descriptive and/or a term of art (Ms Elliott's claim).

LRC's evidence

9. LRC has filed witness statements from Ms Isabel Gass, Mr Giles Pennington and Mr Terry Rundle (two witness statements). Messrs Pennington and Rundle are trade mark attorneys at the firm of Wilson Gunn, who LRC had previously instructed in these proceedings. Ms Gass is Group Trade Marks Advisor for LRC's parent company, SSL International PLC.

Isabel Gass

10. Ms Gass exhibits definitions of LUV from two on-line dictionaries, Dictionary.com and Collins Cobuild English Dictionary for Advanced Learners (exhibit IG1). The references say that LUV is a written form of 'love' when it is being used as an informal way of addressing someone (Collins) and that it is an affectionate, dialectal, or a colloquial spelling of 'love'.

11. Ms Gass states that LRC supplies condoms, personal lubricants and devices (which are sex aids). She states that they are routinely sold together through the same outlet, placed in the same part of retail stores and are "intended to be used together". She shows a photograph of LRC's goods displayed in a branch of Tesco

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

(exhibit IG2). The goods are Durex condoms, Durex Play personal lubricants and Durex Play Vibrations devices. They are placed underneath pregnancy test kits and adjacent to first aid plasters. Ms Gass says that personal lubricants “may be used” with devices. Devices “may be used” with or without a condom. The Durex Pleasure Box product includes a vibrating ring vibromassage product and condoms in the same package (exhibit IG3). The information on the back of the vibrating ring packet is that the ring “can be used with or without a condom”. The product information leaflet for the Durex Play Touch finger-tip vibrator (exhibit IG4) says that one can massage “a little lube” onto erogenous zones. It does not appear to be an instruction, but is more of a suggestion. Exhibit IG5 shows a photograph of packaging for a vibrator and a suggestion to “try” using it with lubricant. Exhibit IG6 comprises copies from third party websites about using lubricants during sex or when using sex aids for comfort or enhanced pleasure. Exhibit IG7 comprises prints from third party websites which feature articles about using condoms with sex aids. The contents of the articles show that using condoms with vibrators is not necessary for solo use but is advisable in certain circumstances for hygiene purposes. Ms Gass exhibits (IG8) prints from a page from condoms.co.uk which shows a Durex vibrating ring and Durex lubricant in a combined pack, and a competitor’s (Trojan) vibrating ring which includes a free condom. Exhibit IG9 shows packaging for a Trojan fingertip vibrator (i.e. it fits over a fingertip) which includes a bonus condom. It is not suggested that these can be used together, and Ms Gass does not explain the exhibit’s significance. I presume it is to show a shared channel of trade.

Giles Pennington

12. Mr Pennington states that on 19 May 2010, he visited branches of Boots, Superdrug and Ann Summers in Manchester and took photographs of the displays in these stores. He exhibits these (GP1) and states that the displays in all three stores included a range of condoms, personal lubricants and devices originating from LRC and other parties. Although he does not mention it, there is also a photograph from Tesco showing Durex condoms and KY Jelly next to razors.

Terry Rundle

13. Mr Rundle’s first witness statement serves to bring in the results of internet searches he undertook on 8 March 2011 which, he says, show that online retailers of condoms also sell sex aids. I note that, for example, undercovercondoms.co.uk lists, amongst the goods it sells, personal lubricants, vibrating rings and condoms, as do funkycondom.co.uk, lovehoney.co.uk and johnnysinajiffy.com.

14. Mr Rundle’s second witness statement is to show that dictionary words are frequently used as part of complex trade marks and he exhibits a large number of trade mark register prints. It is unnecessary to detail these because they have no relevance to the points I need to consider.

Ms Elliott’s evidence

15. Ms Elliott has filed witness statements from Mr Ian Marshall (two witness statements), Dr Jonathan Banford (two witness statements) and Jasper Feversham. Mr Marshall is a director of Rocks Off Limited, an ‘adult products’ company which he

founded in 2003 with Ms Elliott, who is a co-director. Jasper Feversham is a CEO of a company which produces adult films. Dr Banford, as mentioned before, is Ms Elliott's trade mark attorney.

Ian Marshall

16. Mr Marshall says that the word LOVE is widely used in the adult market (I use this term to encompass contraception and sex aids, and also pornography in view of Mr Feversham's evidence) as an alternative term to 'sex'. Mr Marshall refers to examples of such use, such as 'love rings' instead of penis rings and vibrators called 'love eggs'. He exhibits prints (exhibit IPM1) from lovehoney.co.uk which show vibrating rings referred to as 'love rings' and inflatable dolls referred to as 'love dolls'.

17. Mr Marshall states that it would not be normal to use condoms with vibrators unless they were going to be shared or were made of inferior plastic. However, he does say that it would be normal to use a condom at the same time as a love ring (his terminology). Mr Marshall states that the market for condoms is structured differently from the market for vibrators and that he would not expect sales of vibrators in Boots and supermarkets to account for a significant proportion of the market. He says that customers would not expect that a condom manufacturer must also produce vibrators or vice versa.

18. Mr Marshall's second witness statement replies to LRC's evidence of the product displays in Boots and Tesco showing condoms and vibrating rings together. Mr Marshall states that the adjacent positioning of the Durex-branded products, Durex being a trade mark of LRC, simply reflects the commercial leverage of LRC. Mr Marshall has done his own retail store visiting and states that there is a difference in the way in which the products are displayed in adult stores, with condoms and lubricants next to the till, and with vibrators and the like displayed in their own 'department'. He illustrates his statement with a photograph (exhibit IM2) from the Nice N Naughty store in Chester. Mr Marshall says that most sales of vibrators and other such sex aids take place either through specialist adult stores or over the internet. He believes that a few recent sales of vibrating rings 'tagged' onto the sale of condoms is unrepresentative of the way sex aids and condoms are sold.

Jonathan Banford

19. Dr Banford exhibits (at JB1) an extract from the Collins Oxford English Dictionary (11th edition) giving definitions of LOVE. Those that are relevant are as follows:

Noun

1. - An intense feeling of deep affection; a deep romantic or sexual attachment to someone.
2. A great interest and pleasure in something.
3. A person or thing that one loves – Brit. informal a friendly form of address.

Verb

Feel a deep romantic or sexual attachment to, like or enjoy very much.

Phrases

Make love: have sexual intercourse

20. Dr Banford attaches (exhibit JB2) prints from the register of trade marks which contain the word LOVE in the same classes as the marks the subject of these consolidated proceedings. Dr Banford asserts that this is not merely “state of the Register” evidence as he has only included trade marks which are actually in use; to support this, he also exhibits websites relating to the various undertakings which use the marks he has exhibited. The websites originate from the UK and/or show pricing in sterling. The prints are all dated 5 August 2010. The LOVEHONEY site shows goods called love eggs, love rings and love dolls. The FUNFACTORY website refers to “sensual love fluid” for massage. The LOVESHACK website also refers to love dolls and love ropes (ankle and hand cuffs).

21. Dr Banford’s second witness statement concerns the business of Rocks Off Limited, which is not relevant to these proceedings, and submissions relating to the pleadings, which I do not need to detail here.

Jasper Feversham

22. Mr Feversham states that he has come into contact over the previous eight years with all the “major players” in the ‘adult’ industry; his evidence is given as an expert in this industry. Mr Feversham states that the market for vibrators and other such sex aids does not overlap “to any real extent” with the market for condoms and contraceptives. He states that some retailers use small quantities of branded condoms for sex aid marketing purposes, but not their core business. Further, condoms are offered or promoted by businesses in the adult industry in order to appear to be ‘responsible’ businesses, such as showing condom awareness advertisements at the beginning of adult films. Mr Feversham says ‘love’ is a very commonly used word in the adult industry, often used as a euphemism for ‘sex’ at the softer end of the industry.

Decision

23. Earlier in this decision, I said that I would look firstly at LRC’s section 5(2)(b) ground against Ms Elliott’s application for LUV. LRC relies on two different earlier marks which have different goods specifications. I will start with LRC’s mark LOVE (CTM 3052766).

24. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the CJEU (“Court of Justice of the European Union”): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that: (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

Average consumer and the purchasing process

25. The average consumer for the goods of both parties is the adult (or over the age of consent) general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but his/her level of attention is likely to vary according to the category of goods. I think it unlikely that a particularly close level of attention will be paid to the purchase of many of the goods, although the evidence shows that some of the sex aids/devices/appliances can be more specialist in nature and so these may be subject to a closer degree of analysis before being bought. The purchasing process is overwhelmingly visual: this is borne out by the evidence of both parties which shows the goods on supermarket shelves and websites. Indeed, the nature of the goods of most interest to the parties is such that consumers may be attracted to the online mode of purchase as this preserves a degree of anonymity for the purchaser. As Dr Banford submitted, gone are the days when condoms were asked for in a whisper in a chemist's shop. They are now displayed on shelves in supermarkets, in high street pharmacies and on websites, as shown in the parties' evidence. They are also sold in public toilets from coin-operated dispensing machines. The aural aspect to the purchasing process is considerably reduced in proportion to the visual aspect.

Comparison of goods

26. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* ("Canon") where the CJEU stated at paragraph 23 of its judgment:

"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."

'Complementary' was defined by the General Court ("GC") in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 ("Boston"):

"82 It is true that goods are complementary if 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...".

27. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 for assessing similarity between goods and services included an assessment of the channels of trade of the respective goods or services. Jacob J also said, in *Treat*:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the

purposes of trade. After all a trade mark specification is concerned with use in trade”.

28. Finally, if goods or services fall within the ambit of terms within the competing specification, they are considered to be identical⁴.

29. The parties’ respective specifications are:

LRC’s specification	Ms Elliott’s specification
<p>Class 5: <i>Contraceptive preparations and substances, spermicidal gels, liquids and creams; hygienic lubricants and disinfectants.</i></p> <p>Class 10: <i>Condoms; contraceptive, hygienic or prophylactic devices.</i></p>	<p>Class 10: <i>Massage instruments and apparatus; manually operated massage devices; instruments and apparatus for vibromassage; sexual massage devices and apparatus; stimulators; vibrators; dildos; apparatus for the treatment of sexual dysfunction; erection aids; sex toys; sexual aids and appliances; parts and fittings for all the aforesaid goods.</i></p>

30. It is convenient to make the assessment by grouping the goods of Ms Elliott’s specification into two categories⁵:

- (i) *Massage instruments and apparatus; manually operated massage devices; instruments and apparatus for vibromassage;*
- (ii) *sexual massage devices and apparatus; stimulators; vibrators; dildos; apparatus for the treatment of sexual dysfunction; erection aids; sex toys; sexual aids and appliances;*

whilst not forgetting that *parts and fittings* relates to the goods of both categories. The second category refers entirely to goods of a sexual nature, whilst the first category is wider. It encompasses sexual vibration massage goods but also massage apparatus of a non-sexual nature.

31. Mr Tierney (for LRC) focussed his submissions on two aspects of the *Canon* test; namely, whether the parties’ goods are complementary and whether they share channels of trade. His arguments centred on LRC’s condoms and lubricants compared to Ms Elliott’s goods. Mr Tierney submitted, referring to some of the

⁴ General Court in *Gérard Meric v OHIM*, case T-133/05.

⁵ As per the decision of Mr Geoffrey Hobbs Q.C. , sitting as the appointed person, in *Separode Trade Mark* BL O-399-10, with reference to *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ECR I-1455 at paragraphs [30] to [38]: “The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

exhibits I have detailed above, that Ms Elliott's goods and condoms are complementary because, e.g. vibrating rings can be used with a condom. He said that when the vibrator is being shared, it is necessary to use a condom for health and safety reasons. Further, because vibrators and condoms are sold together, their use is complementary.

32. As stated above, the legal definition of 'complementary', as per *Boston*, is that the goods must be "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". It is not sufficient that the goods "can" be used together; nor is it sufficient that they are sold together. The evidence shows that it is unnecessary to use a condom with a vibrator and vice versa⁶. The reasons why one might use a vibrator and a condom together are a) to prevent pregnancy and b) to prevent sexually transmitted disease. Neither of these would apply if the vibrator was for 'solo' use (i.e. without a partner being present); nor would a) apply if pregnancy was desired or unlikely for other reasons. It is plainly unnecessary to use a vibrator when using a condom. Condoms and Ms Elliott's goods, in either category, are not complementary.

33. Mr Tierney put a similar line of argument to me in relation to lubricants and Ms Elliott's goods. He conceded that vibrators and lubricants/gels can be used without each other but said that they are very often used together. Referring to a third party website in the evidence, which shows "Lubricant guide for sex toys", he said:

"The type of lubricant you can use with a vibrator depends on what the vibrator casing is made of. Again, it shows that vibrators and lubricants can be used together...sometimes vibrators must be used with a lubricant [for comfort]".

34. The key point here is that they can be used together, not that there is a dependency. This is not enough to demonstrate a complementary relationship in law. Mr Tierney also submitted that lubricants can be used for massage. I do not think that this is how the average consumer would view lubricants. Lubricants are to reduce friction to moving parts and although massage oils are to ease the friction of massage, to go back to the words in *Treat*:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade".

LRC has cover for "hygienic lubricants" in class 5: this term cannot be stretched to include what the average consumer would naturally consider to be goods for massaging purposes.

35. LRC is on stronger ground with its argument that its condoms and lubricants and Ms Elliott's goods share the same channels of trade. I note from the evidence that

⁶ Exhibit IG3, the vibrating ring and condom package, says that the vibrator "can be used with or without a condom"; see paragraph 11 above.

the supermarket and high street pharmacies display condoms, lubricants and a limited range of vibrators (rings, in fact) side by side. That said, the photographs also show these side by side with first aid plasters, pregnancy testing kits and razors. The proximity of the 'Durex' branded goods in product displays, in which lubricants, condoms and vibrating rings are shown together, may be due in part to the fact that like-branded goods are displayed together, rather than it being a common feature of high street retailing practice to display condoms, lubricants and vibrators together. However, I think it fair to say that goods which are related to sexual activity are sold together in supermarkets and pharmacies. In the case of 'adult shops', everything inside such shops is related to sexual activity. In relation to Ms Elliott's category (ii) goods, there is some similarity in terms of channels of trade with LRC's condoms and lubricants. The evidence of vibrating rings and condoms in a pack supports this type of similarity rather than Mr Tierney's view that vibrating rings and condoms are complementary. The combined packs of condoms and vibrating rings say more about the convenient purchase of items, or free goods with purchased items, which are part of a sexual experience, i.e. a channel of trade point, than they do about them needing to be used together. This follows through to Ms Elliott's category (i) goods, to the extent that they cover sexual massaging apparatus; however, none of LRC's goods share channels of trade with non-sexual massaging apparatus.

36. Although Mr Tierney's submissions focussed upon the complementary and trade channel aspects of the similarity assessment, I will also look at the other elements of the *Canon* test. There is no shared nature between condoms and lubricants and any of Ms Elliott's goods. In terms of intended purpose, condoms are to prevent pregnancy and disease. There may be an ancillary sexual stimulation function to them, but this is not their primary intended purpose. The method of use of condoms and massaging apparatus and vibrators is not the same; the best that can be said is that there is some similarity in how vibrating rings and condoms are placed onto the male human body. Condoms and vibrators are not in competition with each other. In relation to lubricants, their intended purpose has nothing in common with vibrators and sex aids in general. Their method of use is entirely different and they are not in competition with one another.

37. The other goods in LRC's specifications, *contraceptive preparations and substances, spermicidal gels, liquids and creams; disinfectants; contraceptive, hygienic or prophylactic devices* are even further removed from any of Ms Elliott's goods than condoms and hygienic lubricants. The high point of LRC's case on similarity between the goods is that there is a shared channel of trade between its condoms and hygienic lubricants and Ms Elliott's *massage instruments and apparatus; manually operated massage devices; instruments and apparatus for vibromassage; sexual massage devices and apparatus; stimulators; vibrators; dildos; apparatus for the treatment of sexual dysfunction; erection aids; sex toys; sexual aids and appliances*. As far as I can see, this is the only point of similarity. Consequently, in relation to Ms Elliott's category (ii) goods, there is a low level of similarity. This extends to the category (i) goods insofar as it covers sexual massage goods. However, in relation to Ms Elliott's non-sexual massage goods in category (i), there is no similarity with any of LRC's goods.

Comparison of marks

38. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

39. The respective marks are:

LRC's mark	Ms Elliott's mark
LOVE	LUV

40. As each mark consists entirely of a single component, these are self-evidently the dominant and distinctive components of each mark.

41. LRC's mark consists of four letters and Ms Elliott's consists of three; of these, only two letters are similar, L and V. The vowels are different. The first letter of each mark is L, but the last letters are different. The marks are short and these differences have, proportionately, a large effect: there is a low level of visual similarity between the marks. Aurally, however, the marks are identical. This is because the O in LOVE is pronounced more as a U and the final E of LOVE is silent.

42. The meanings of LOVE are well-known to anyone with a command of English and were set out in Ms Elliott's evidence. As both parties accepted, and as I take on judicial notice, LOVE and LUV are alternate spellings: love is the formal spelling and luv the informal version of it, the latter much seen on car stickers and in text messages and online blogs. LOVE and LUV both mean, depending on context, a feeling of deep affection; a deep romantic or sexual attachment to someone; a great interest and pleasure in something; person that one loves, or an informal mode of address ("alright love/luv?"). The marks are conceptually identical.

43. In summary, the marks are identical aurally and conceptually but similar on a visual level to only a very low degree. I will bring forward these points when I come to the global comparison.

Distinctive character of the earlier mark

44. It is necessary to consider the distinctive character of LRC's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁷. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public⁸.

⁷ *Sabel BV v Puma AG* [1998] RPC 199.

⁸ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

45. LRC has not filed evidence of use of its mark, so there is no question of whether it is entitled to an enhanced degree of distinctive character gained through use. The assessment to be made is the degree of inherent distinctive character. Ms Elliott has filed evidence about this in order to support her claim that LRC's mark offends sections 3(1)(c) and (d) of the Act. Some of her evidence shows that at the date the evidence was printed, which falls after the date of her application, LOVE appeared to be a term used in relation to various sex aids, such as love dolls, love eggs, love ropes and love rings. However, there is no evidence before the relevant date to which I can point and say that LOVE was used as a descriptive term.

46. As Mr Tierney pointed out, I must bear in mind that LRC's CTM is to be considered validly registered, as per Article 99(1) of the Community Trade Mark Regulations⁹. That does not, however, mean that the mark necessarily possesses even an average level of distinctive character. In the context of the parties' goods, LOVE is a politer or more romantic expression for sexual intercourse, as in "making love". The relevant consumer, being reasonably well informed, would be aware of this meaning. It is a word likely to be used in the marketing of sex aids and contraceptives because it is less direct and more commercially appealing than using the word sex, particularly when the goods may be sold in more mainstream retail outlets. The average consumer would be likely to view its use in such a promotional context. Consequently, the mark LOVE for sex aids and contraceptives is inherently distinctive to a very low degree.

Likelihood of confusion

47. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency. In this regard, I found that the goods of the parties ranged from a low degree of similarity to no similarity. Where there is no similarity of goods there can be no likelihood of confusion (*Canon*).

48. I also found that the marks are phonetically and conceptually identical and that the level of visual similarity between them was of a low degree. The relevance of this point is that sometimes the characteristics of the purchasing process for some goods and services are more aural than visual. However, in the instant case, the average consumer's selection and contact with the parties' marks will be overwhelmingly visual via shop shelves and websites. Mr Tierney drew my attention to telephone numbers at the top of some of the website pages. Even so, I think it much more likely that a website visitor will make an online transaction. I disagree with Mr Tierney that the phonetic and visual perceptions should be given equal weight. In my view, the most relevant perception of the marks will be visual, and the level of visual similarity is very low. Against this is the identical meaning of the parties' marks; however, this, in turn, has to be balanced against the finding that LOVE has only a very low level of inherent distinctive character for the goods.

⁹ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark: "The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity."

49. In *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40, Jacob LJ said:

“83 Finally, although I agree with the judge's questioning of the Court's proposition of fact that “there is a greater likelihood of confusion with very distinctive marks” there is some truth with the opposite proposition. The Court in Lloyd said:

“23. 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 from those of other undertakings.

24. 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; ...”

84 The last sentence is an acknowledgement of a fact that has long been recognised: where a mark is largely descriptive “small differences may suffice” to avoid confusion (per Lord Simonds in *Office Cleaning Services v Westminster Window and General Cleaning* (1946) 63 R.P.C. 30 at p.43). This is not a proposition of law but one of fact and is inherent in the nature of the public perception of trade marks.

85 It is worth examining why that factual proposition is so—it is because where you have something largely descriptive the average consumer will recognise that to be so, expect others to use similar descriptive marks and thus be alert for detail which would differentiate one provider from another. Thus in the cited case “Office Cleaning Association” was sufficiently different from “Office Cleaning Services” to avoid passing off.

86 The same sort of consideration applies when there is use of two common surnames, as in this case. The average consumer will be alert for differences—just in the same way as one distinguishes WH Smith from other Smiths by the initials. That is of importance here in making the global assessment.”

50. It is clear from my findings above that I consider LOVE to have only a very low level of distinctiveness. The average consumer for sex aids and contraceptives will be alert for differences and small differences may suffice to avoid a likelihood of confusion.

51. In citing the above, I also bear in mind the judgment of the CJEU in *L'Oréal SA v OHIM* Case C-235/05 P the CJEU stated:

“43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between

two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

52. Of course, in this case, I am considering marks which consist only of single elements, rather than complex marks. Weighing together the following factors:

- (i) that there is a low degree (or no degree) of similarity between the goods;
- (ii) that the most important aspect of the comparison of marks is the visual perception because it is a visual purchasing act;
- (iii) but the visual similarity between the marks is low;
- (iv) and that the distinctive character of the earlier trade mark is very low,

their combined effect is that, for an average or reasonable degree of attention during purchase, the average consumer will not be confused into believing that the goods are the offerings of the same or linked undertakings. There will be no likelihood of confusion between LRC's LOVE mark and Ms Elliott's LUV mark.

53. LRC's other mark is WE MAKE LOVE. The average consumer assessment is the same as for its LOVE mark, with the additional comment that some of the class 3 goods are used by people of all ages. There is even less visual similarity between WE MAKE LOVE and LUV and less aural similarity (than between LOVE and LUV). I have said above that LOVE, in the context of the parties' goods, refers to the meaning 'to make love'. Although this makes for similarity conceptually, that meaning, as for LRC's LOVE mark, has a detrimental effect on the inherent level of distinctiveness of WE MAKE LOVE (there being no evidence of use). As is the case for LOVE, for sex aids and contraceptives, the level of distinctiveness of WE MAKE

LOVE must be at a very low level¹⁰. Applying the relevant authorities, referred to above, even in relation to identical goods (of which there are several), the combination of all these factors mean that there will not be a likelihood of confusion between WE MAKE LOVE and LUV.

Outcome

54. LRC has failed in its ground of opposition against Ms Elliott. The effect of this is that Ms Elliott's application stands as the earlier mark upon which she has founded her section 5(2)(b) opposition against LRC's application for LOVE. As LRC has withdrawn its defence against this ground of opposition, Ms Elliott's opposition against LRC's application succeeds. I do not, therefore, need to look separately at her section 3(1)(c) and (d) grounds against LRC's application. **LRC's application is to be refused.**

Costs

55. Ms Elliott has been successful and is entitled to an award of costs, as per the scale set out in Tribunal Practice Notice 4/2007. Dr Banford drew my attention to a procedural hearing earlier in the history of the proceedings in which Ms Elliott was the successful party. I will include an amount as a contribution towards her costs in respect of the procedural hearing. Mr Tierney referred to a failure on the part of Dr Banford to copy some letters; a late response to a Registry letter regarding hearing arrangements and Dr Banford's late-filed skeleton argument. I do not regard these points as causing LRC enough difficulty to warrant a reduction in the cost award to Ms Elliott. Mr Tierney also referred to the costs of having to travel to Newport for a hearing. It was his client, LRC, who asked for a hearing (a request which was late, as it happens). The hearing was to have taken place via video conference, with the parties attending in London whilst I was in Newport. However, Dr Banford preferred to travel to Newport rather than attend via the video conference facility, owing to a dislike of this method of communicating. Subsequently, Mr Tierney felt that he should also attend in Newport. Mr Tierney's decision to travel to Newport appears to have been borne of an apprehension that there would be some inherent disadvantage in appearing for the hearing in London whilst Dr Banford was in Newport. It made no difference to my understanding of the parties' evidence and submissions whether they were in London, Newport, or a mixture of both. There appears to be no reason why LRC should be compensated for this choice of action. Finally, although it was late in the day for LRC to withdraw its defence in relation to Ms Elliott's section 5(2)(b) ground, this did not substantially affect the evidence Ms Elliott filed, since the same ground was pleaded against her mark. As can be seen from the evidence, it was all directed to similarity of goods and the distinctiveness point, which needed to be addressed with or without LRC's defence against Ms Elliott's section 5(2)(b) ground.

56. The costs breakdown is as follows:

Preparing a counterstatement and considering LRC's notice of opposition	£350
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¹⁰ Again, Article 99(1) of the CTM Regulations is relevant.

Preparing notice of opposition and considering LRC's counterstatement	£350
Opposition fee	£200
Evidence	£600
Preparing for and attending procedural hearing	£200
Preparing for and attending substantive hearing	£600
Total:	£2300

57. I order LRC Products Limited to pay Sandra Amalia Mary Elliott the sum of £2300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of March 2012

**Judi Pike
For the Registrar,
the Comptroller-General**