

**O-351-14**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3005859  
BY BE CONNECTED INTERNATIONAL GENERAL TRADING L.L.C  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 3, 35 & 44:**

**KØKØ  
NAIL**

**AND**

**OPPOSITION THERETO (NO. 400797) BY KIKO SRL**

## **The background and the pleadings**

1) Trade mark application 3005859 was filed by Be Connected International General Trading L.L.C (“the applicant”) on 14 May 2013. It was published in the Trade Marks Journal on 7 June 2013. The mark and the goods and services for which registration is sought are set out below:



**Class 3:** Cosmetics, hand lotion and creams and beauty care products, all the aforementioned goods relating to nails.

**Class 35:** Retail services including retail store services and/or electronic retail services connected with the sale of cosmetics, perfumery, hand lotion and creams, nail polish, nail treatments, hand and feet scrubs, nail care preparations, toiletries, skin care preparations, non-medicated beauty preparations, make-up preparations; business management and business administration; business consultancy, information or enquiries; advertising; marketing and sales promotion services; marketing in the field of perfumery, cosmetics, beauty preparations, nail polish, nail treatments, hand and feet scrubs, nail care preparations and make-up preparations; organization of exhibitions and competitions for commercial or advertising purposes; distribution of prospectuses and samples; distribution of advertising and promotional samples; all the above services related to nails.

**Class 44:** Health care services; manicure and pedicure services; beauty salons; rental of machines or apparatus for use in beauty salons, beauty consultancy, make-up services; cosmetics consultancy services, hygienic and beauty care for human beings; all the above services related to nails.

2) Kiko Srl opposes the registration of the mark. It is the proprietor of the following three earlier Community Trade Mark (“CTM”) registrations:

- i) 1141126 which was filed on 12 April 1999 and which completed its registration process on 15 May 2003. The mark consists of the word: **KIKO** and is registered in respect of the following goods:

**Class 3:** Make-up for women.

- ii) 7474059 which was filed on 17 December 2008 and which completed its registration process on 20 February 2012. The mark consists of the word **KIKO** and is registered in respect of the following goods:

**Class 3:** Body and skin care and beauty preparations (not for medical purposes); milks, tonics, lotions, creams, emulsions, gels for the face and body; non-medicated cleansing preparations for the face and body; skin astringents not for medical purposes; body mist; non-medicated foot baths, depilatory creams; pumice stones for personal use; soaps; bubble bath; shower creams and gels; skin exfoliating products; make-up removing preparations for the face; talcum powder; shampoos; hair lotions, oils, conditioners and repair preparations; hair dyes; hair spray, gel and mousse; hair brighteners; hair mascaras; shaving creams and gels; after-shave gels and lotions; perfumery; deodorants for personal use; essential oils; bath beads; bath oils and salts; cosmetics; masks; foundation cream; blush; bronzing powder; make up powder; facial shimmer preparations; mascara; eyeliners; cosmetic eye and lip pencils; eye shadows; lip balms; lip gloss; lipsticks; makeup removing preparations; nail polish; nail forms; false nails; nail polish remover; cuticle creams; preparations for strengthening nails; non-medicated concealer sticks; body glitter; sun-tanning lotions and creams for the face and body; fake tan lotions and creams for the face and body; sunscreen creams; aftersun lotions and creams for the face and body.

**Class 8:** Scissors, nail files, tweezers, manicure and pedicure sets, razors.

**Class 16:** Pencil sharpeners for cosmetics, dry wipes for removing make-up.

**Class 20:** Make-up mirrors.

**Class 21:** Cosmetic brushes, shaving brushes, sponges for applying facial make-up, toilet sponges, powder puffs; stick make-up applicators, nail brushes, eyebrow brushes, toilet brushes, combs, perfume vaporisers, powder compacts, soap holders, soap dispensers, cases for cosmetics, containers for cosmetics, jars.

- iii) 8454126 which was filed on 28 July 2009 and which completed its registration process on 31 January 2010. The mark consists of the word **KIKOCOSMETICS** and is registered in respect of the following goods and services:

**Class 3:** Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 35:** Organisation of the wholesaling and retailing for others, including on-line, of: soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, scissors, nail files, clippers, manicure and pedicure cases, razors, pencil sharpeners for cosmetics, dry wipes for removing make-up, make-up mirrors, cosmetic brushes, shaving

brushes, face sponges for applying make-up, toilet sponges, powder puffs, stick make-up applicators, nail brushes, eyebrow brushes, toilet brushes, combs, perfume vaporisers, powder compacts, soap holders, soap dispensers, cases for cosmetics, containers for cosmetics, jars.

3) The opponent relies on the above marks under section 5(2)(b) of the Trade Mark Act 1994 (“the Act”). The opponent claims that the marks are highly similar given that KOKO is the dominant and distinctive element of the applied for mark, that the goods/services are either identical or highly similar, that the earlier marks are all distinctive, and that there is a likelihood of confusion on the part of the average consumer. The opponent also relies on the use of the following sign in the UK since January 2011 in respect of a range of cosmetic products to found a ground of opposition under section 5(4)(a) of the Act:



4) The applicant filed a counterstatement denying the claims. It put the opponent to proof of use in respect of earlier mark 1141126 because the earlier mark completed its registration process more than five years prior to the publication of the applicant’s mark (section 6A of the Act refers). It should be noted that the other two earlier marks are not subject to the requirement to prove genuine use because of the more recent dates on which they completed their registration processes. The consequence of this is that the other two earlier marks may be relied upon for the full range of goods and services they cover.

5) Only the opponent filed evidence. Neither side requested a hearing or filed written submissions in lieu. I will, though, take into account all of the arguments that have been made in the papers before me. I do not consider it necessary to make any findings in relation to the conflict with earlier mark 1141126. I say this because this earlier mark does not advance the opponent’s case beyond earlier mark 7474059 which is for the same mark, is not subject to proof of use, and covers goods which are wider than 1141126.

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

#### **The legislation and leading case-law**

6) Section 5(2)(b) of the Act states that:

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

.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7) The Court of Justice of the European Union (“CJEU”) has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases<sup>1</sup>:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

### **Evidence pertinent to section 5(2)(b)**

8) The content of the opponent's evidence has been fully considered. The only aspect of the evidence which may have potential relevance to this ground of opposition is the evidence regarding the use that has been made of the earlier marks which could, potentially, enhance their level of distinctive character. Beyond that, all the witness adds is some submissions on whether there is a likelihood of confusion (submissions which I note) and evidence on how the applied for mark is being used in Kuwait. The use in Kuwait is simply the use of the applied for mark (or at least the KOKO part of it) applied to some nail polish. This does not really take matters any further forward because it is something, in any event, that would have been countenanced in the notional and fair use of the mark.

9) In terms of the use made of the earlier marks, although they are CTMs, the position in the UK market at the relevant date is the only pertinent matter. This is because whether there exists a likelihood of confusion is to be measured from the perspective of the average consumer in the UK. The relevant date is the 14 May 2013. The opponent's witness is Mr Massimo Dell'Acqua, its CEO. His evidence includes much supporting material in relation to its business in the cosmetics field, much of it overseas. However, in terms of its UK business, the first KIKO store was opened on 14 September 2011 (in Westfield Trafford Shopping Centre) and the second two days later (in the Westfield White Shopping Centre in London). There are many more stores in other EU countries which Mr Dell'Acqua considers to be in popular locations likely to have been seen by UK tourists. The opponent launched a UK website on 5 January 2012 and on the same day activated a Facebook page. A further UK store was opened in Regent Street on 23 November 2013, after the relevant date in these proceedings. Goods are sometimes sold by third parties; an example is given of House of Fraser making an order for its goods as far back as 2006.

10) In terms of net sales in the UK, this was EURO 369k in 2011 and EURO 1.8 million in 2012. Some website statistics are provided but as they were taken after the relevant date they have little pertinence. Details of advertising and promotion in publications and online blogs etc during 2013 are provided. In terms of those that pre-date the relevant date, there are over 100 and I recognise some as well known publications. Most are in the form of advertorials, editorials products comparisons etc.

### **The distinctiveness of the earlier mark**

11) The more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

12) From an inherent perspective, the earlier marks consists of the word KIKO and KIKOCOSMETICS. The latter mark will be broken down by the average consumer as KIKO COSMETICS, and, given the descriptive nature of the word cosmetics, KIKO is clearly its dominant and distinctive component. As far as I am aware, KIKO is an invented word. The word has no allusive or suggestive characteristics. The marks are, in my view, inherently distinctive to a high degree.

13) The use made is not longstanding. The turnover figures are reasonable, at least in 2012. However, the geographical spread, at least in terms of physical sales, is limited given that it has just two shops, both of which are in London. The sales on the UK website may potentially be more widespread. But there is nothing to inform me as to the split between website sales and physical sales, and where its web customers are based, so it is difficult to make any form of deduction as to the impact made. The advertising information is useful, but this merely covers the five months before the relevant date. I come to the view that whilst the earlier marks have clearly been used, the evidence does not establish that their already high degree of inherent distinctive character has been enhanced to any material extent.

### **The average consumer**

14) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses can vary depending on what is involved.

15) The conflict focuses, in the main, on cosmetic goods and services. The goods are purchased reasonably frequently. They will be purchased by a member of the general public. The cost of the goods could vary, some cosmetics are more expensive than others and even when the same product is purchased (e.g. some face creams cost just a few pounds, but others cost much more). In most scenarios the goods will be purchased with a reasonable degree of care and attention, but certainly no higher than the norm. The goods will most often be

purchased from a shelf (or the online equivalent), however, cosmetics are often purchased after discussion with a salesperson so aural similarity still has a role to play. Similar observations apply to most of the services, although, in so far as the class 44 services are concerned they may be used slightly less frequently. However, the degree of care and attention will not be materially higher. Some of the services (advertising and marketing relating to nail products) could be more business to business services so the position is slightly different here and the selection of a service provider somewhat more considered.

### **Comparison of goods/services**

16) When comparing the respective goods and services, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 – “Meric”*) even if there are other goods within the broader term that are not identical. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* 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.”

17) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

18) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“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 (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

19) In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

20) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in 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 the trade”<sup>1</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. I also note the

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<sup>1</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>2</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... 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) (IPTRANSLATOR)* [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.”

21) The goods of the earlier marks cover:

### **KIKO**

**Class 3:** Body and skin care and beauty preparations (not for medical purposes); milks, tonics, lotions, creams, emulsions, gels for the face and body; non-medicated cleansing preparations for the face and body; skin astringents not for medical purposes; body mist; non-medicated foot baths, depilatory creams; pumice stones for personal use; soaps; bubble bath; shower creams and gels; skin exfoliating products; make-up removing preparations for the face; talcum powder; shampoos; hair lotions, oils, conditioners and repair preparations; hair dyes; hair spray, gel and mousse; hair brighteners; hair mascaras; shaving creams and gels; after-shave gels and lotions; perfumery; deodorants for personal use; essential oils; bath beads; bath oils and salts; cosmetics; masks; foundation cream; blush; bronzing powder; make up powder; facial shimmer preparations; mascara; eyeliners; cosmetic eye and lip pencils; eye shadows; lip balms; lip gloss; lipsticks; makeup removing preparations; nail polish; nail forms; false nails; nail polish remover; cuticle creams; preparations for strengthening nails; non-medicated concealer sticks; body glitter; sun-tanning lotions and creams for the face and body; fake tan lotions and creams for the face and body; sunscreen creams; aftersun lotions and creams for the face and body.

**Class 8:** Scissors, nail files, tweezers, manicure and pedicure sets, razors.

**Class 16:** Pencil sharpeners for cosmetics, dry wipes for removing make-up.

**Class 20:** Make-up mirrors.

**Class 21:** Cosmetic brushes, shaving brushes, sponges for applying facial make-up, toilet sponges, powder puffs; stick make-up applicators, nail brushes, eyebrow brushes, toilet brushes, combs, perfume vaporisers, powder compacts, soap holders, soap dispensers, cases for cosmetics, containers for cosmetics, jars.

## **KIKOCOSMETICS**

**Class 3:** Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 35:** Organisation of the wholesaling and retailing for others, including on-line, of: soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, scissors, nail files, clippers, manicure and pedicure cases, razors, pencil sharpeners for cosmetics, dry wipes for removing make-up, make-up mirrors, cosmetic brushes, shaving brushes, face sponges for applying make-up, toilet sponges, powder puffs, stick make-up applicators, nail brushes, eyebrow brushes, toilet brushes, combs, perfume vaporisers, powder compacts, soap holders, soap dispensers, cases for cosmetics, containers for cosmetics, jars.

22) I will make the comparison with reference to the applied for goods and services:

***Class 3: Cosmetics, hand lotion and creams and beauty care products, all the aforementioned goods relating to nails.***

23) The impact of the qualification “all the aforementioned goods relating to nails” limits the applied for cosmetics and beauty care products to those for the nails. As can be seen in the specification of the earlier marks, they cover various forms of cosmetic preparations including, in the case of the KIKO mark:

Nail polish; nail forms; false nails; nail polish remover; cuticle creams; preparations for strengthening nails

24) The KIKO mark also includes the term “beauty preparations” and KIKOCOSMETICS the term “cosmetics” both of which cover cosmetic products for nails. **The applied for goods are identical to goods covered by both earlier marks.**

***Class 35: Retail services including retail store services and/or electronic retail services connected with the sale of cosmetics, perfumery, hand lotion and creams, nail polish, nail treatments, hand and feet scrubs, nail care preparations, toiletries, skin care preparations, non-medicated beauty preparations, make-up***

*preparations; business management and business administration; business consultancy, information or enquiries [all the above services related to nails].*

25) The limitation to the services as being “related to nails” is an incongruous one because the subject matter of the retail service includes the retailing of goods (perfumery for example) which cannot relate to nails. However, given that the earlier mark covers a broad range of goods including all beauty products and cosmetics means that such incongruity does not matter. In short, the applied for retailing is in relation to the type of goods covered by both earlier marks.

26) The issue of similarity between retail services and goods was considered by the General Court (“GC”), in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06. This dealt with the similarity between goods and a retail services specification which was both unrestricted and restricted in scope; it was stated:

“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau- und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

and

62 It follows from all of the foregoing that the Board of Appeal was right to consider that services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’, and ‘retail and wholesale services, including on-line retail store services’, are similar to the goods covered by the earlier trade mark.”

27) Obviously, the matter here must be considered in the cosmetics field. However I consider the retailing of cosmetic products to be similar to cosmetic products because they are complementary and share similar trade channels. However, the goods and services are different in purpose and nature and not in competition. There is a reasonable degree of similarity between the opponent’s class 3 goods (both marks) and the applicant’s retail services listed above. The KIKOCOSMETICS mark also covers:

“Organisation of the wholesaling and retailing for others, including on-line, of...cosmetics..”

28) Whilst this term does not cover retailing per se (because it is the organisation of wholesaling and retailing for others" (my emphasis) it seems to me that there is a very clear and obvious complementary relationship with retailing per se. I consider there to be a reasonable degree of similarity here also.

***Class 35: Advertising; marketing and sales promotion services; marketing in the field of perfumery, cosmetics, beauty preparations, nail polish, nail treatments, hand and feet scrubs, nail care preparations and make-up preparations; organization of exhibitions and competitions for commercial or advertising purposes; distribution of prospectuses and samples; distribution of advertising and promotional samples; all the above services related to nails.***

29) The term covered by the KIKOCOSMETICS mark I mentioned in paragraph 27 is the organisation of retailing/wholesaling for others. It seems to me that such organisation would well include advertising and marketing services for those others and, therefore, should be considered identical. If this is wrong then there is still a clear complementary relationship and the services are at least reasonably similar.

***Class 44: Health care services; manicure and pedicure services; beauty salons; make-up services; beauty consultancy; cosmetics consultancy services, hygienic and beauty care for human beings; all the above services related to nails.***

30) The services are all of the type to be offered in beauty salons. This is so even for health care services [related to nails] as a beautician will take care of the health of one's nails as well as applying nail varnish etc. In comparison to the cosmetic goods of the earlier mark, there is a similarity in purpose (they are all for the purpose of beautification), have similar trade channels in some contexts (beauty products are often sold in beauty salons and some shops will offer beauty services within), they are offered to the same end users. There is also a degree of competition as someone may purchase a particular product to use at home or, alternatively, use the services to gain the same result. The inherent nature is, of course, different. Nevertheless, I still consider there to be a reasonable degree of similarity.

***Class 44: Rental of machines or apparatus for use in beauty salons***

31) A service relating to the rental of a machine is a business to business service. The service will not be used by a member of the general public even though what is being rented may subsequently be used on them. Given this, the closest term of the earlier mark appears to be the term covered by the KIKOCOSMETICS mark I mentioned in paragraph 27, the organisation of retailing/wholesaling for others. As I have already stated, the running of a beauty salon and the sale of cosmetic goods are inextricably linked. Thus, there seems to me to be a complementary link between these services as both would be offered to a business person in the beauty field to assist them with their business.

However, as one relates to retailing/wholesaling and the other to the goods for the actual beauty salon business, I conclude that any similarity is of only a moderate degree on a complementary basis.

### **Comparison of the marks**

32) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

**KØKØ**  
NAIL

v **KIKO and KIKOCOSMETICS**

33) In the KOKO mark, the word NAIL performs a purely descriptive function. Furthermore, the stylisation to the Os is just that, a form of presentation. The dominant and distinctive element of the mark is the word KOKO. The KIKO mark has just one element and, so, is its dominant and distinctive element. The KIKOCOSMETICS mark, as already observed, will be broken down as KIKO COSMETICS, the former word being its dominant and distinctive element. I will, of course, bear in mind that the marks must still be considered in totality.

34) The elements KOKO and KIKO are of similar length, each being of four letters with three of them K-KO being shared in the same order and position. There is, though, the difference between the second letter O/I. I bear in mind the other differences (the stylisation and the additional words NAIL/COSMETICS), but I still conclude that there is at least a reasonable degree of visual similarity.

35) From an aural perspective KO-KO will be articulated as COE-COE and KIKO as either KEY-COE or KICK-O, but either way the articulation of the dominant elements of the marks are of two syllables, with an identical/very similar ending and a similar beginning sound. Obviously, the other aspects are borne in mind but I still consider there to be at least a reasonable degree of aural similarity.

36) Conceptually the position is neutral because I do not believe that the average consumer will perceive a meaning from any of the marks.

### **Likelihood of confusion**

37) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors

from the viewpoint of the average consumer and determining whether they are likely to be confused.

38) I will consider, firstly, the position in relation to the class 3 goods. Here the goods are identical and there is a reasonable degree of both visual and aural similarity, the conceptual position being neutral. A reasonable (but not high) degree of care and consideration will go into the selection process. I must take into account the concept of imperfect recollection. This is a very good example of when imperfect recollection can result in a likelihood of confusion, particularly in a case like this where the dominant and most memorable part of the marks consists of an invented word, so meaning that there is nothing for the average consumer to pin their recollections upon. **I find that there is a likelihood of confusion with respect to the class 3 goods on the basis of both earlier marks.**

39) I extend the above finding to the retailing services in class 35 and the various beauty services in class 44. Although the degree of goods/service similarity is reduced, it is of still a reasonable level and the nature of the inherent relationship between the goods/services is one where the average consumer will believe that the goods come from the same or a linked undertaking when the closeness of the marks is considered.

40) That leaves the more business to business services in class 35 (the advertising/marketing services) and class 44 (the rental services). Again, although the matter is somewhat different here and although I accept that a greater amount of care will be adopted when the services are selected, the similarity between the marks (in this case it is with the KIKOCOSMETICS earlier mark) together with the similarity of services as assessed, will still result in a likelihood of confusion. **Therefore, there is a likelihood of confusion in relation to all of the services in classes 35 and 44. The opposition succeeds.**

41) Given the above finding, the matter under section 5(4)(a) does not need to be addressed.

### **Costs**

42) The opponent has succeeded and is entitled to a contribution towards its costs, as follows:

*Official Fee - £200*

*Preparing a statement and considering the other side's statement - £300*

*Filing evidence - £500*

**Total - £1000**

43) I hereby order Be Connected International General Trading L.L.C to pay Kiko Srl the sum of £1000 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 6th day of August 2014**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

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<sup>i</sup> The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 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, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).