

**O-123-17**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 3076894**

**BY BARONY UNIVERSAL PRODUCTS PLC**

**TO REGISTER THE FOLLOWING SERIES OF TWO TRADE MARKS IN CLASS 3:**

**ALEXANDER OF PARIS**

**ALEXANDER of PARIS**

**AND**

**OPPOSITION THERETO (NO. 404440) BY  
ALEXANDRE DE PARIS INTERNATIONAL**

## **Background and pleadings**

1. This dispute concerns whether the following series of trade marks should be registered:

### **ALEXANDER OF PARIS**

### **ALEXANDER of PARIS**

Class 3: Non-medicated toilet preparations; toiletries; anti-perspirants; anti-perspirants in the form of sprays; deodorants; roll-on deodorants; body sprays; cosmetics; cosmetic creams, milks, lotions, washes; sprays, oils, mists, gels, scrubs and wipes for the face, body, scalp or hair; sprays, oils, mists, gels, scrubs and wipes for cosmetic purposes; sprays, oils, mists, gels, scrubs and wipes for air and room fragrancing purposes; non-medicated preparations for the care of the skin, scalp and of the body; talcum powder; cleansing preparations; cleansers; skin cleansers; moisturisers; moisturising lotions; moisturising creams; skin moisturisers; skin toners, facial toners; skin bracers; skin fresheners; skin tonics; astringents; water sprays for cosmetic purposes; thermal spring water sprays for cosmetic purposes; mineral water sprays for cosmetic purposes; facial and body water mists; facial and body misting sprays; facial and body water misting sprays; facial water mists; topical skin sprays for cosmetic purposes; facial lotion; facial washes; facial cleansers; facial scrubs; soaps; non-medicated bath preparations; shower gels; bubble bath preparations; essential oils; perfumery; perfumes; fragrances; fragrance preparations; fragrances for personal use; scents; scented water; toilet waters; scented toilet waters; eau de cologne; non-medicated preparations for application to the skin for suntanning and/or suncreening and/or suncare purposes; after sun moisturisers; aftersun preparations; aftersun misting sprays; cosmetics and toiletries; shampoos; preparations for the hair; hair lotions; depilatory preparations; shaving preparations; aftershave lotions; dentifrices.

2. There is no material difference between the two applied for marks insofar as they impact on these proceedings. I will, therefore, refer to the marks in the singular, focusing on the first mark depicted above. The mark was filed on 14 October 2014 by Barony Universal Products Plc (“the applicant”) and it was published for opposition purposes on 20 February 2015.

3. Alexandre de Paris International (“the opponent”) oppose the registration of the mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following two earlier marks:

- i) European Union Trade Mark (“EUTM”) registration 7004501 for the mark



which was filed on 19 June 2008 and registered on 13 May 2009. The mark is relied upon (and a statement of use made) in respect of the following goods:

Combs; hair bands; barrettes (hair slides); hair curlers; pins for hair curlers; hat ornaments; hair pins, hair curling pins, hair nets, plaited hair, hair clips, false hair, hair ornaments, wigs, bows for the hair.

Given its date of registration, the mark is subject to the use conditions set out in section 6A of the Act.

- ii) EUTM registration 11736428 for the mark **ALEXANDRE DE PARIS** which was filed on 12 April 2013 and registered on 6 September 2013. The mark is relied upon in respect of all of the goods for which it is registered, namely:

**Class 14:** Jewellery, bijoux and watches; Hair decorations of precious metals; Tie clips; Badges of precious metal; Cuff links; Medals; Ornamental hair pins of precious metals; Hat ornaments of precious metal; Semi-precious stones; Precious stones; Paste jewellery.

**Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; Leather goods namely: Handbags, Evening bags, Evening pouches of leather or imitations of leather; Vanity cases, toiletry cases; Purses; Pocket wallets; Boxes of leather or leather board; Leather laces; Leather straps; Leather twist; Trimmings of leather for hair ornaments; Travelling bags; Umbrellas.

**Class 26:** Lace and embroideries; Ribbons and braid, Buttons, Hooks and eyes, Pins and needles, Hair curling pins; Clothing accessories, in particular feathers, Beads other than for making jewelry; Artificial flowers, artificial fruit; Hair ornaments, Elastic ribbons; Hair pins, Hair slides, loop clips, Hair bands; Bows for the hair; Ornaments for hats.

Given its date of registration, the mark is not subject to the use conditions and may be relied upon for all of the goods for which it is registered.

4. The opponent considers the words in the respective marks to be virtually identical (and certainly similar), that the goods are either all beauty products or else are used to enhance the appearance of the purchaser, with the result that there is bound to be confusion in the marketplace.

5. The applicant filed a counterstatement in which it:

- i) Put the opponent to proof of use of EUTM 7004521.
- ii) Denied any similarity between the respective marks and the respective goods.
- iii) Denied that there is a likelihood of confusion.

6. Both sides are professionally represented, the applicant by Murgitroyd & Company, the opponent by Stevens Hewlett & Perkins. Both sides filed evidence and written submissions. Neither side requested a hearing. The applicant filed written submissions in lieu of a hearing, the opponent did not.

## **The evidence**

### ***The opponent's evidence***

7. This comes in the form of a witness statement from Mr Sebastien Bailly, a “permanent representative of Bailly Industries SAS in Alexandre de Paris International”. The following emerges from the evidence:

- A statement that the brand “Alexandre de Paris” has been used in the UK since 1996 in respect of what can be characterised as hair accessories.
- Appendix 1 contains a brochure from 2014 headed with a word and device very similar to EUTM 7004501 which depicts various hair accessories and hair brushes. Some of the goods (the brushes for example) have the words ALEXANDRE DE PARIS physically printed on them. The prices are listed in EUROS. There is some use of English in the brochure including the contents page which is headed “Summary by Themes”.
- Turnover in the UK has ranged between 218k Euro in 2010 to 490k Euro in 2014.
- Appendix 2 contains a large number of invoices issued by Bailly Creations to UK customers (mainly to Harrods and a company called Ellamoda Ltd). Part of the email address used on the invoices includes “@alexandredeparis-accessories.com.”
- Appendix 3 contains some articles from the UK press, namely:
  - An article from the Women’s Room Blog, published in November 2012, which discusses hair accessories. A number of different brands are

highlighted including “Alexandre of Paris” which, apparently, has a shop on Sloane Street and can also be found in Harrods. Reference is made to purchasing the goods if a person wishes to splash out.

- An article from The Upcoming from November 2012 about Alexandre de Paris unveiling its 2013 hair accessory collection. Reference is made to the goods being luxury in nature. Reference is made to its boutique in Knightsbridge and that the goods are also available in Harrods.
- An article from The Telegraph from June 2012. Various beauty products are mentioned, but in a section headed “Where to go for decent hair accessories” reference is made to Alexandre de Paris products which are available from its first London shop in Sloane Square. Further information identifies the brand as being the incarnation of the French hairstylist Louis Alexandre Raimon.
- Part of a blog from Raganbone.blogspot in which reference is made to a product sold by Alexandre de Paris but supplied only in Harrods in the UK – this blog dates from August 2010.
- An article from CDC Lifestyle dating from June 2012. It is about its Boutique of the Week with reference being made to Alexandre de Paris. Reference is made to the origin of the brand stemming from Louis Alexandre Raimon and that it has a boutique in Sloane Square which is near its partner concession in Harrods.

8. The opponent’s submissions are borne in mind, but I do not consider it necessary to separately summarise them here.

### ***The applicant’s evidence***

9. This comes from Ms Louise McCullagh, the opponent’s Marketing Director. The following emerges from the evidence:

- The opponent was founded in 1994 to produce personal care and beauty products and the mark ALEXANDER OF PARIS is one of its major brands. The brand has been used since 2000 in relation to personal care products, beauty care products, perfumery, body sprays and deodorants.
- The examples of packaging show use of the name, but also various other sub-brands: URO, MIRAGE, TREBIEN to name just a few. The examples are of body sprays and fragrances.
- Between 2011 and 2015 sales of around 3.5 million units have been made. However, as some goods are exported, it is not clear how many sales were made in the UK.
- Around £100k is spent on trade shows and other promotional initiatives, although, this is not specified with reference to any particular period.
- Examples of advertising material are provided in Exhibit LM3, but there is no information as to where any advertisements were placed. The same exhibit contains photographs of the applicant attending trade shows which Ms McCullagh states were taken at an exhibition in Bologna.
- Monthly sale figures of various products are provided in Exhibit LM4, but, again, it is not clear if these are UK or worldwide figures.
- Ms McCullagh is not aware of any confusion between the respective marks having taken place.

10. Whilst I do not intend to summarise the applicant's submissions in detail (although they are borne in mind), I nevertheless note here that various criticisms were made of the opponent's evidence including that there is no evidence about the relationship between the opponent and Bailly Industries, that the brochure does not appear to be directed at UK consumers, that there is no use of EUTM 7004501 on the other items of evidence (beyond the brochure), and the use shows may be in relation to retail services not the goods.

### ***The opponent's reply evidence***

11. This comes, again, from Mr Bailly. He provides evidence about two Bailly companies and their relationship with the opponent. At Appendix 5 he provides an extract from the Belgian Register of Companies relating to the opponent which lists Bailly Industries as a “legal representative” of the opponent.

12. Mr Bailly comments on the brochure provided in his previous witness statement. He explains that it was not cost effective to produce a separate brochure priced in pounds for the UK market and that UK stockists are able to readily convert the currency. In relation to the invoices, he refers again to the use of the email address and states that the supply of the invoiced goods should be taken in context with the brochures. A brochure of a similar nature is provided in Appendix 6 covering the period of time in which most of the invoices were dated.

13. In relation to the goods, Mr Bailly states that it is common that the goods of the application are sold alongside the goods of the earlier mark. He provides the following examples:

- Appendix 8 - Extracts from the website of Toni & Guy which have for sale Toni & Guy branded hair care products and Toni & Guy hair accessories.
- Appendix 9 – Extracts from Superdrug showing the sale of hair care products and hair accessories under the Superdrug mark.
- Appendix 9 – Extracts from the website GHDHAIR.COM showing both hair care products and hair clips – however these clips are not necessarily hair accessories but more a hair dividing tool to be used whilst undertaking hair styling.



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

14. The two earlier marks are both EUTMs. However, one is subject to the use conditions, the other is not. I will begin my analysis with the mark which is not subject to the use conditions, returning to the other earlier mark only to the extent necessary.

15. 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.”

16. The following principles are gleaned from the judgments 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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Average consumer and the purchasing act**

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

18. The applied for goods are in the field of cosmetics and beauty products. Although the cost of these can vary, they are not, generally speaking, highly expensive and will be purchased fairly frequently. I consider the purchasing process to be a normal, reasonably considered one. The goods will most often be self-selected from a shelf (or the online equivalents) and the marks may be exposed visually in advertising and on websites etc. I consider that the visual impact of the marks will take on more importance, although, I will not ignore the aural impact completely as sometimes sales advisors are involved in the process (for certain types of cosmetic product such as perfume). It could be said that certain types of cosmetics (again, such as perfume) are purchased with a greater degree of care because they can be expensive. However, this should not be overplayed because whilst there may be some expensive products, there are also much cheaper versions of the same thing; confusion must be considered from that perspective also.

19. Much of what I have said applies in equal measure to the goods of the earlier mark, particularly those for which the opponent appears to have its stronger case (hair

accessories). The evidence shows that the opponent's goods are at the luxury end of the scale, however, for the reasons given above, the determination must not be limited to that.

### **Comparison of marks**

20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

**ALEXANDER OF PARIS**

**v**

**ALEXANDRE DE PARIS**

22. In terms of overall impression, both marks comprise the name of a person coupled with the expression OF PARIS/DE PARIS. Whilst the grasp of foreign languages by average consumers in the UK is notoriously poor, I think they will understand DE PARIS to mean “.. of Paris” or “...from Paris”. Paris is a city famed for style and luxury which means that the endings of both marks take on a descriptive or suggestive significance indicating that the goods or the business, or the person responsible for them (Alexander/Alexandre), is from Paris. This results in the name itself playing a stronger role in the overall impression. However, it is the marks as a whole which must be compared and the endings are not negligible in the overall impression they portray.

23. Visually, both marks have a three word structure comprising a long word (ALEXANDER/ALEXANDRE), a short word (OF/DE) and a medium length word (PARIS/PARIS). The middle words have no visual similarity. The end words are identical. The first words start with the same 7 letters (ALEXAND-) and the endings (RE/DR) have some similarity as they consist of the same letters, but in reverse. Whilst there are some differences (the end of the first word and the different middle word) I conclude that the marks are visually similar to a very high degree.

24. Aurally, a similar analysis is applicable with the similarities and differences noted above impacting on the respective articulations. I consider there to be a very high degree of aural similarity.

25. Conceptually, both marks make reference to a person called Alexandre/Alexander either from, or of, Paris. Given that the names are so similar, and with Alexandre likely to be perceived as the French form of the masculine name Alexander, I conclude that there is a very high degree of conceptual similarity.

### **Comparison of goods**

26. When making a comparison, all relevant factors relating to the goods/services in issue 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.”

27. 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.”

28. 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 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).”

29. 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.”

30. 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

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

narrow meaning<sup>2</sup>. I also note the judgment of Mr Justice Floyd (as he then was) 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.”

31. The applicant seeks registration for:

Class 3: Non-medicated toilet preparations; toiletries; anti-perspirants; anti-perspirants in the form of sprays; deodorants; roll-on deodorants; body sprays; cosmetics; cosmetic creams, milks, lotions, washes; sprays, oils, mists, gels, scrubs and wipes for the face, body, scalp or hair; sprays, oils, mists, gels, scrubs and wipes for cosmetic purposes; sprays, oils, mists, gels, scrubs and wipes for air and room fragrancing purposes; non-medicated preparations for the care of the skin, scalp and of the body; talcum powder; cleansing preparations; cleansers; skin cleansers; moisturisers; moisturising lotions; moisturising creams; skin moisturisers; skin toners, facial toners; skin bracers; skin fresheners; skin tonics; astringents; water sprays for cosmetic purposes; thermal spring water sprays for cosmetic purposes; mineral water sprays for cosmetic purposes; facial and body water mists; facial and body misting sprays; facial and body water misting sprays; facial water mists; topical skin sprays for

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



cosmetic purposes; facial lotion; facial washes; facial cleansers; facial scrubs; soaps; non-medicated bath preparations; shower gels; bubble bath preparations; essential oils; perfumery; perfumes; fragrances; fragrance preparations; fragrances for personal use; scents; scented water; toilet waters; scented toilet waters; eau de cologne; non-medicated preparations for application to the skin for suntanning and/or suncreening and/or suncare purposes; after sun moisturisers; aftersun preparations; aftersun misting sprays; cosmetics and toiletries; shampoos; preparations for the hair; hair lotions; depilatory preparations; shaving preparations; aftershave lotions; dentifrices.

32. In terms of goods similarity, the opponent's evidence focus on the link between hair care products and hair accessories. Thus, the most relevant goods of the earlier mark appear to be:

**Class 14:** ...Hair decorations of precious metals; ....; Ornamental hair pins of precious metals; ....

**Class 18:** ....

**Class 26:** ..... Hair curling pins; ....; Hair ornaments, Elastic ribbons; Hair pins, Hair slides, loop clips, Hair bands; Bows for the hair; ....

33. I will make a comparison, in the first instance, with any goods covered by the application which are for the care of the hair such as "shampoos; preparations for the hair; hair lotions".

34. There can be no doubt that the physical nature of the goods is very different. The applied for goods are sold in bottles or similar containers, with the contents being liquid, semi-liquid, cream or foam. The goods of the earlier mark will be plastic, metallic or potentially material based, with no need for them to be held in a bottle or container.

35. In terms of purpose, the goods of the earlier mark are used to decorate the hair (for fashion purposes) and/or to assist in the holding of a particular style (partings, buns etc.) in place. On the other hand, the goods of the application include preparations for cleaning or adding condition to the hair, so as to enhance its health and appearance. Further, goods such as mousse or hairspray, could also be used to help certain hairstyles stay in place. Similarity of purpose with cleaning and conditioning preparations is, therefore, not overly significant. The best one can say is that all of the goods make a contribution to the appearance of a person's hair, but I accept that this is relatively superficial. There is greater similarity in purpose with items such as hairsprays and mousse, which also creates a degree (but not a high degree) of competition.

36. Being general consumer items, the users of the goods will be the same, but this is superficial to the extreme as this will apply to a whole range of what may be quite different goods. In terms of channels of trade, there is no evidence to show how closely the competing goods will be to each other in a bricks and mortar store. However, as all of the goods are for application to the hair, it is reasonable to assume, and my experience backs this up, that the goods will be in fairly close proximity, although not necessarily side by side. It is implicit from what I have said that the same type of shops will sell the goods, including in supermarkets (which itself is not a high point considering the range of goods that such establishments sell) but also in chemists and shops which specialise in personal care/appearance products. The opponent has filed some evidence showing three websites which sell the competing goods (although the third example is not that relevant as it does not appear to be in respect of the type of goods covered by the earlier mark). I should add that this evidence does not add materially to my assessment. There be many things that a retailer sells, even under the same mark, on the same website, but this does not necessarily equate to similarity. The applicant made such a point in its submissions with reference to the Superdrug example.

37. Weighing the similarities and differences, and bearing in mind the level of generality of the aspects of similarity, I conclude that there is a moderate (between low and medium) level of similarity with goods such as hairsprays and mousses (as the goods could all be used for the finishing touches to a hairstyle, to keep it in place),

but only a low degree of similarity with other types of hair preparation (on the basis that they all in some way contribute to the appearance and maintenance of a person's hair and are likely to be sold in fairly close proximity to each other).

38. In terms of the other goods covered by the application, I will now make an illustrative comparison with goods such as body sprays, deodorants and fragrances. The goods are, again very different in nature. The purpose is also quite different, one being to decorate the hair and/or to assist in the holding of a particular style, the other being used to fragrance the body and/or to prevent perspiration. Whilst they could all be sold in the same shop, they are unlikely to be sold in close proximity to each other. The goods are not competitive. Nor do I think they are complementary as neither is important for the use of the other and there is no real link between them. The argument put forward by the applicant that all of the goods are beauty products is far too general an assessment. I come to the view that these goods are not similar.

39. I will now take these findings and apply them to the specification as filed, breaking down the goods as necessary. In short, my view is that goods for application to the hair have some similarity, but other goods have none:

Non-medicated toilet preparations; toiletries; Cosmetics and toiletries; Cleansing preparations; cleansers;

40. All of these terms are broad enough to cover preparations for use on the hair. As per the findings I have already made, such goods are similar to a low or a moderate degree. However, the goods are not similar in so far as they relate to goods for use on the skin, face or body.

Anti-perspirants; anti-perspirants in the form of sprays; deodorants; roll-on deodorants; body sprays; perfumery; perfumes; fragrances; fragrance preparations; fragrances for personal use; scents; scented water; toilet waters; scented toilet waters; eau de cologne

41. As already discussed, these type of goods are not similar.

Cosmetics; cosmetic creams, milks, lotions, washes; sprays, oils, mists, gels, scrubs and wipes for the face, body, scalp or hair; non-medicated preparations for the care of the skin, scalp and of the body

42. In so far as these terms are specified as being in relation to the scalp or the hair, I consider that they are similar to a low or moderate degree. They are not similar in so far as they are specified for the skin, face or body.

Sprays, oils, mists, gels, scrubs and wipes for air and room fragrancing purposes

43. Such goods, self-evidently, are not for the hair - indeed they are for room fragrancing. The goods are not similar.

Talcum powder

44. I am not aware of talcum powder having any application for the hair. There is no obvious aspect of similarity. The goods are not similar.

Moisturisers; moisturising lotions; moisturising creams;

45. There is no reason why a moisturising preparation could not be used on the hair. By parity of reasoning with the other hair products, I consider there to be a low degree of similarity with the goods of the earlier mark. The goods are not similar in so far as they relate to moisturising preparations for the skin, face or body.

Skin moisturisers; skin toners, facial toners; skin bracers; skin fresheners; skin tonics; skin cleansers; facial lotion; facial washes; facial cleansers; facial scrubs

46. The goods are for application to the skin/face, not the hair. There is no obvious aspect of similarity. The goods are not similar.

Astringents;

47. Astringents are, as far as I know, for application to the skin. The same finding as above is applicable. The goods are not similar.

Water sprays for cosmetic purposes; thermal spring water sprays for cosmetic purposes; mineral water sprays for cosmetic purposes; facial and body water mists; facial and body misting sprays; facial and body water misting sprays; facial water mists; topical skin sprays for cosmetic purposes;

48. On the face of it, there is nothing to suggest that such goods are applied to the hair. Some of the goods are specific to the face or body. The others (various water sprays) have no obvious use for the hair. There is no evidence to the contrary. The goods are not similar.

Sprays, oils, mists, gels, scrubs and wipes for cosmetic purposes

49. I see no reason why these goods could not be used on the hair. As per the findings I have already made, such goods are similar to a low or a moderate degree. However, the goods are not similar in so far as they relate to goods for use on the skin, face or body.

Soaps

50. Soap would not normally be used for a person's hair. By parity of reasoning with my earlier findings, these goods are not similar.

Non-medicated bath preparations

51. A bath preparation would not normally be specifically sold and used for the hair, so creating greater distance in terms of channels and trade and purpose. The goods are not similar.

Shower gels

52. Shower gels can be applied to both the body and the hair. However, the dual purpose means that they are less likely to be in close proximity to the goods of the earlier mark and have a more distinct purpose, less related to hair care. The goods are not similar.

Bubble bath preparations

53. These goods are not used on the hair, they are applied directly to bath water to produce bubbles which may also have a soothing effect on the bather. The goods are not similar.

Essential oils;

54. Such goods are often used for massage purpose or, perhaps, used for scent. They are not similar to the goods of the earlier mark.

Non-medicated preparations for application to the skin for suntanning and/or sunscreensing and/or suncare purposes; after sun moisturisers; aftersun preparations; aftersun misting sprays

55. Such goods have no application for the hair. They are not similar.

Shampoos; preparations for the hair; hair lotions

56. Given the findings already made, I consider these goods to be similar to those of the earlier mark. Shampoos and hair lotions to only a low degree, preparations for the hair to a moderate degree (because such a term would cover fixing products).

Depilatory preparations

57. Such goods are applied to various parts of the body in order to remove hair. They are not used for the removal of head hair. The goods are not similar.

### Shaving preparations; aftershave lotions

58. Whilst it is possible to shave one's head, the purpose of the goods and the channels of trade is more remote than with the other assessments made in relation to hair care products. The goods are not similar.

### Dentifrices

59. Such goods are for cleaning the teeth. There is no obvious similarity with the goods of the earlier mark. The goods are not similar.

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

60. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

61. From an inherent perspective, whilst the words “de Paris” are either wholly descriptive or at the very least highly suggestive, Alexandre is not. Although it is a name, this is no reason to accord a low level of inherent distinctiveness. Indeed, as a whole, I consider ALEXANDRE DE PARIS to have a reasonable level of distinctive character, although not of the highest level as would be the case with invented or highly fanciful trade marks.

62. Evidence has also been provided of the use of the mark. I have no doubt that the mark has been used. There is a shop in Sloane Square and a concession in Harrods. The applicant submits that the use may be in respect of retailing as opposed to being in relation to the goods themselves. I reject this argument. The context of the evidence as a whole demonstrates that the shop and concession sell what will be taken as Alexandre de Paris goods. The catalogue, for example, demonstrates that some of the goods actually have these words physically applied. Whilst some goods do not, it is not the case that third party brands are being sold. However, use per se does not equate to the mark’s distinctiveness necessarily having been enhanced. Whilst on the face of it the turnover of the goods is quite reasonable, this may not represent overly significant unit sales, particularly bearing in mind that the goods the opponent sells are luxury items. There are only two physical places where the goods are sold, which are in close proximity to each other. Whilst there is some evidence that press attention has been received, this does not appear to be overwhelming and there is no evidence of traditional advertising. The matter must be judged from the perspective of the average consumer. I do not consider that the use has been sufficient enough to have had any material impact upon the average UK consumer and, therefore, the opponent is left just with the inherent distinctiveness that I have already assessed.



## Likelihood of confusion

63. 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. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“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.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even

where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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

64. The marks are highly similar, visually, phonetically and conceptually. The earlier mark has a reasonable level of inherent distinctiveness. The goods are purchased with an average level of care and consideration. However, where I have found similarity between the goods, I have found only a low or moderate level of similarity. This is important as it is necessary to reflect the interdependency principle that “a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa”. In my view, this is a clear example of where a low (or moderate) degree of goods similarity is offset by a greater degree of mark similarity (here the marks are highly similar). The average consumer will believe that the respective hair accessories/hair care products sold under the marks ALEXENDRE DE PARIS/ALEXANDER OF PARIS come from the same or a related economic undertaking. This could be on the basis of direct confusion in that the marks are mistaken for one another. Even if that were not the case then indirect confusion would be applicable because one will be seen as the anglicised version of the other (or vice versa). There is a likelihood of confusion in respect of the goods I have found to be similar. There is no likelihood of confusion in respect of the other goods because it is a pre-requisite for a positive finding under section 5(2)(b) for the goods to be similar to some degree<sup>3</sup>.

65. I have considered whether the other goods of the earlier mark (in classes 14 and 18) take the opponent any further forward. The only argument put forward is based

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<sup>3</sup> See, for example, the CJEU’s judgment in *Waterford Wedgwood plc v OHIM* (case C-398/07).

upon a claim that they are all beauty or fashion products. However such a claim is made on too high a level of generality and creates no meaningful degree of similarity. The opponent is in no better position.

### **The other earlier mark**

66. I do not consider it necessary to consider the other earlier mark. Whilst it is relied upon for some goods (brushes and wigs) which are not covered by its other earlier mark, such goods do not in my view create any new or different aspect of similarity with the goods I have found not to be similar. The goods are similar or dissimilar to the same extent.

### **Specification**

67. Much of the specification remains intact. Some goods require blue-lining from the specification. Other terms (which are wide in nature) require amendment to reflect acceptability in so far as they are for the skin, face or body. I set out below what I consider to be an appropriate specification. The parties have 14 days to comment on the specification. Such comments are to be restricted to the amendment I have proposed and whether it reflects the substance of my decision:

Class 3: Non-medicated toilet preparations [for the skin, face or body]; toiletries [for the skin, face or body]; anti-perspirants; anti-perspirants in the form of sprays; deodorants; roll-on deodorants; body sprays; cosmetics [for the skin, face or body]; cosmetic creams, milks, lotions, washes [all for the skin, face or body]; sprays, oils, mists, gels, scrubs and wipes for the face or body, ~~scalp or hair~~; sprays, oils, mists, gels, scrubs and wipes for cosmetic purposes [for the skin, face or body]; sprays, oils, mists, gels, scrubs and wipes for air and room fragrancing purposes; non-medicated preparations for the care of the skin, ~~scalp~~ and of the body; talcum powder; cleansing preparations [for the skin, face or body]; cleansers [for the skin, face or body]; skin cleansers; moisturisers [for the skin, face or body]; moisturising lotions [for the skin, face or body]; moisturising creams [for the skin, face or body]; skin moisturisers; skin toners, facial toners; skin bracers; skin fresheners; skin tonics; astringents; water

sprays for cosmetic purposes; thermal spring water sprays for cosmetic purposes; mineral water sprays for cosmetic purposes; facial and body water mists; facial and body misting sprays; facial and body water misting sprays; facial water mists; topical skin sprays for cosmetic purposes; facial lotion; facial washes; facial cleansers; facial scrubs; soaps; non-medicated bath preparations; shower gels; bubble bath preparations; essential oils; perfumery; perfumes; fragrances; fragrance preparations; fragrances for personal use; scents; scented water; toilet waters; scented toilet waters; eau de cologne; non-medicated preparations for application to the skin for suntanning and/or suncreening and/or suncare purposes; after sun moisturisers; aftersun preparations; aftersun misting sprays; cosmetics and toiletries[for the skin, face or body]; ~~shampoos; preparations for the hair; hair lotions; depilatory preparations; shaving preparations; aftershave lotions; dentifrices.~~

### **Costs and appeal**

68. The appeal period for my decision will run from the date on which I issue a supplementary decision confirming the specification for which the mark may proceed. In relation to costs, whilst much of the specification remains, some terms are to be blue-lined, others amended. As such, both parties have won some and lost some. The parties shall, therefore, bear their own costs.

**Dated this 20<sup>TH</sup> day of March 2017**

**Oliver Morris**

**For the Registrar,**

**The Comptroller-General**