

O-177-18

TRADE MARKS ACT 1994
IN THE MATTER OF
INTERNATIONAL REGISTRATION NO WO000001321953 DESIGNATING THE
UNITED KINGDOM
BY AMOREPACIFIC CORPORATION
TO REGISTER THE TRADE MARK


primera

IN CLASS 3
AND OPPOSITION THERETO (UNDER NO. 408796)
BY
PRIMAVERA LIFE GMBH

Background & pleadings

1. Amorepacific Corporation (“the holder”) is the holder of international registration WO1321953 (“the designation”) in respect of the mark *primera*. Protection in the UK was requested on 21 October 2016 in respect of the following class 3 goods: *Laundry glaze; perfume; cosmetics; lavender oil; false nails; beauty masks; cleaning preparations; shampoos; liquid bath soaps; dentifrices; shampoos for pets; toiletries; cleaning, polishing, scouring and abrasive preparations; perfumery; adhesives for affixing false hair; soaps for personal use; false eyelashes; cosmetic preparations for baths; make-up removing preparations; cosmetic preparations for skin care.*

2. The IR was published in the United Kingdom, for opposition purposes, on the 16 December 2016. Primavera Life GmbH (‘the opponent’) opposes the designation under Section 5(2)(b) of the Trade Marks Act 1994 (‘The Act’) on the basis of its earlier UK and EU trade marks outlined below.

<p>UK TM 1503432</p>  <p>Filing date: 12 June 1992 Registration date: 29 April 1994</p>	<p>Essential oils, cosmetics, perfumery, soaps, perfumes and fumigating preparations; pot pourri; all included in Class 3</p>
<p>EU TM 10620541</p> <p>PRIMAVERA</p> <p>Filing date: 7 February 2012 Date of entry in register: 9 July 2012</p>	<p>Class 3: Perfumery goods; Cosmetics; Cosmetics; Soaps; Hair lotions; Essential oils for personal use; Essential oils for aromatic mixtures and scented candles; Essential oils for incense burners, aroma lamps, fragrance lights and scented stones; Essential oils for saunas; Air sprays based on essential oils; Perfume based on essential oils; Perfume oils for the manufacture of cosmetic preparations.</p>

	<p>Class 21: Incense burners; Aroma lamps, Fragrance lights, incense burners, in particular of ceramic, Metal, Glass or Stone.</p> <p>Class 35: Retail services and Wholesaling services, Also provided via the Internet, In the fields of cosmetic goods, Perfumery, Hair lotions, Soaps and Essential oils, incense burners, aroma lamps, fragrance lights and scented stones, air sprays.</p>
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3. The opponent's above mentioned trade marks have filing dates that are earlier than the date of holder designated the UK and, therefore, they are both earlier marks, in accordance with Section 6 of the Act. EUTM 10620541 is not subject to proof of use, having not been registered for five years prior to the publication date of the contested designation. As the registration procedure for UK TM 1503432 was completed more than 5 years prior to the publication date of the contested designation, it is subject to the proof of use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the services it relies on.

4. The holder filed a counterstatement in which it denied the grounds of opposition and requested that the opponent produce evidence of use.

5. In these proceedings, the holder is represented by CMS Cameron McKenna Nabarro Olswang LLP and the opponent is represented by Taylor Wessing LLP.

6. Both parties filed evidence and written submissions in lieu of a hearing. I make this decision based on the papers before me.

Approach

7. The opponent relies on the two marks set out above in paragraph 2. Reliance on the earlier UK mark does not provide the opponent with a firmer footing than does its earlier EU mark. This is because the UK mark is presented in a stylised font, being an additional point of difference with the contested designation absent in the earlier EU mark. Further, the slight differences in the scope of the specification of goods of the earlier marks are such as to not materially affect the outcome of the proceedings. Therefore, my considerations will be based on the opponent's case insofar as it is based only upon its earlier EU mark.

Section 5(2)(b)

8. Section 5(2)(b) of the Act states as follows:

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

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

9. The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

10. The opponent indicated that it relies on its earlier EU mark for goods and services in classes 3, 21 and 35 but made no further reference to class 21 or 35 in its submission. So I intend to carry out the comparison only in respect of goods in class 3 as, if it does not succeed in relation to these goods, it will be in no stronger position in relation to its goods or services in the other classes.

11. The case law relating to the comparison of goods and services is set out below. With regard to the comparison of services, in *Canon*, the CJEU stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

13. In relation to the assessment of the respective specifications, I note that in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

14. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and*

Another, [2000] F.S.R. 267, Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

15. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) (*‘Meric’*), the General Court (*‘GC’*) held:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

16. The goods and services to be compared are:

Opponent’s goods	Holder’s goods
Class 3: Perfumery goods; Cosmetics; Cosmetics; Soaps; Hair lotions; Essential oils for personal use; Essential oils for aromatic mixtures and scented candles; Essential oils for incense burners, aroma lamps, fragrance lights and scented stones; Essential oils for saunas; Air sprays	Class 3: Laundry glaze; perfume; cosmetics; lavender oil; false nails; beauty masks; cleaning preparations; shampoos; liquid bath soaps; dentifrices; shampoos for pets; toiletries; cleaning, polishing, scouring and abrasive preparations; perfumery; adhesives for affixing false hair; soaps

based on essential oils; Perfume based on essential oils; Perfume oils for the manufacture of cosmetic preparations.	for personal use; false eyelashes; cosmetic preparations for baths; make-up removing preparations; cosmetic preparations for skin care.
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17. In paragraph 3.8 of the written submissions dated 17 January 2018, the holder submits that,

“This case concerns *some* goods that are evidently identical in class 3 because the terms used to describe them are the same”.

18. The holder did not name the goods it states are ‘evidently identical’ whereas the opponent on page 2 of its submission dated 17 January 2018 submits that,

“The EU registration covers general terms such as “perfumery goods; cosmetics; soap; hair lotions; essential oils for personal use”. These are identical to the following goods in the application [the designation]: - perfume; cosmetics; lavender oil; shampoos; liquid bath soaps; shampoos for pets; toiletries; perfumery; adhesives for fixing false hair; soaps for personal use; cosmetic preparations for baths; cosmetic preparations for skincare”

19. I would agree with the above submission on the identical nature of the goods listed with the exception of ‘shampoos for pets’. Whilst at a general level there is some similarity of physical nature and use between ‘hair lotions’ in the opponent’s goods and ‘shampoo for pets’ in the applicant’s goods in that both are used to clean and condition hair/fur. But there is no crossover in terms of the users of either product or the trade channels used to reach consumers. Even if both products are found in the same retail establishment such as a supermarket, they would be sold in separate aisles. Further I do not see how either products could be competitive or complementary to each other. On that basis I find the goods to be dissimilar.

20. For the remainder of goods in the holder’s specification, namely *Laundry glaze; false nails; beauty masks; cleaning preparations; dentifrices; cleaning, polishing,*

scouring and abrasive preparations; false eyelashes; make-up removing preparations, these fall into four discrete groups.

21. Firstly I would categorize *Laundry glaze; cleaning preparations; cleaning, polishing, scouring and abrasive preparations* as being household cleaning detergents. These are not goods for use on the person and would be purchased for cleaning clothes, furniture, kitchens, bathrooms and the like. There would be different trade channels for the goods to reach consumers. Such goods would be sold in separate aisles in a self-selection environment such as supermarket. Further I do not find that these goods would be competitive or complementary to the goods of the earlier right.

22. Secondly with regard to *false nails; beauty masks; false eyelashes*, I would regard these goods as being cosmetic in nature given that the purpose of a cosmetic is something applied to the body to improve its appearance. Such goods would have the same users and channels of trade as the 'cosmetics' found in the earlier mark. They would also be found in the same retail environment and in the same aisle of a supermarket. Overall I find these goods to be identical to 'cosmetics'.

23. Thirdly, the term *dentifrices* which covers teeth cleaning preparations. Whilst some teeth cleaning preparations may contain whitening effects for cosmetic impact, the purpose of a dentifrice is to clean teeth. The users and trade channels would be different for these goods and they would be sold separately in supermarkets. As a result I do not find these goods to be similar.

24. Lastly turning to *make-up removing preparations*, these goods will be found alongside cosmetic products and will share the same users and trade channels. I consider these good to be complementary to 'cosmetics' as one is usually used in conjunction with the other.

Average consumer and the purchasing act

25. I now consider who the average consumer is for the contested goods and how those goods are purchased. 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*.

26. 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.”

27. In this case the average consumers of the contested goods are the general public. The goods are a regular type of purchase. They are likely to vary in price especially for goods such as perfume so, ordinarily, I would expect a normal level of attention to be paid by the consumer when selecting such goods. The purchasing act will be mainly visual as goods will be selected by viewing product shelves or by smelling or skin testing the goods in traditional bricks and mortar retail premises, or from perusal of images on Internet websites or in catalogues. However, I do not discount any aural considerations from word of mouth recommendations which may also play a part.

Comparison of the marks

28. The marks to be compared are:

Opponent's mark	Holder's mark
PRIMAVERA	primera

29. 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 Court of Justice of the European Union 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.”

30. 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.

31. The opponent’s mark consists of the single word PRIMAVERA presented in block capitals. The overall impression is based solely on this word.

32. The holder’s mark consists of a single stylised word *primera*. The overall impression is based solely on this presentation.

33. In a visual comparison, both marks share the letters P, R, I, M, E, R and A, and run from left to right in the same order. This forms the entirety of the holder’s mark and seven out of the nine letters of the opponent’s mark. The holder submits that,

“The eye is particularly drawn to the central letter ‘A’ in the opponent’s mark, around which the other letters (four on each side) are positioned. This lends

the opponent's mark a certain symmetry that the applicant's mark lacks. As a result the marks are visually different".

Whereas the opponent contends that,

"Visually the holder's mark is very similar to the Opponent's mark commencing with the same first four letters. It is established principle that consumers read from left to right and remember the first part of the marks.

34. I note the opponent's submission that the shared letters at the beginning of the mark are more significant. But the opponent's mark looks visually longer than the holder's because of the two additional letters. Taking this in to account, I find there to be a medium degree of visual similarity.

35. In an aural comparison, the holder's mark consists of three syllables and can be pronounced in several ways as either PREEM-ER-A, PRIME-ER-A, or PRI-MARE-A. The opponent's mark can also be pronounced in two ways, either as PREEM-AVERA or as PRIME-AVERA. As the opponent's mark contains four syllables, PRI-MA-VAIR-A, the holder contends that,

"...the additional letters 'AV' in [the] opponent's mark have a very noticeable effect because the 'V' (at the start of the third syllable) is a hard sound and is emphasised. The mark are therefore aurally different".

36. Taking into account that the third syllable in the opponent's mark is absent in the holder's mark and that this has a noticeable impact upon the comparison of their aural character, I find there to be a medium degree of similarity.

37. With regard to a conceptual comparison, the average consumer may recognise that both marks consist of non-English words, PRIMERA being the Spanish word for 'first' and PRIMAVERA being the both Spanish and Italian word for the season of Spring. It may be that some average consumers will know the meaning of these words whereas others will not. The applicants submits that consumers may recognise PRIMAVERA as being a culinary term used in Italian cuisine. That may

be the case but the goods at issue are not foodstuffs but cosmetics, toiletries and the like in class 3 so the average consumer may not bring to mind the same concept for these goods as they would for food related goods. Further, it is not obvious to me that the average consumer will know the meaning of either of the marks and in the absence of evidence to the contrary, I find that they are both likely to be perceived by the majority of average consumers as invented words with no meaning and, consequently, they are conceptually neutral. I recognise that some average consumers will understand their meanings and where this is so, there will be conceptual dissimilarity.

Distinctive character of the earlier mark

38. The distinctive character of the earlier EU mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 *Windsurfing Chiemsee 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).”

39. There is no evidence before me showing use of the earlier EU mark for the goods relied on so I can only consider the inherent distinctiveness of the earlier mark.

40. As previously outlined, the earlier mark, PRIMAVERA, is a non-English word but the majority of average consumers will not know its meaning and will regard it as an invented word. I find there is an average level of inherent distinctiveness.

Likelihood of confusion

41. I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors and the principles set out in paragraph 9:

- a) The interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc*).
- b) The principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*).
- c) The factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*).

42. So far I have found that some of the goods are identical and some are complementary and that the average consumer is a member of the general public who will select the goods by primarily visual means whilst paying a normal degree of attention during the purchasing process. In addition, I have found that the opponent's mark is of average distinctiveness. With regard to the comparison of the marks I have found that the marks are visually and aurally similar only to a medium degree and conceptually neutral to those average consumers who see the marks as

invented words or conceptually dissimilar to those do understand the meaning of the two marks.

43. I have reviewed my findings in conjunction with the principles outlined above and in paragraph 9 especially in relation to points (c) and (i). As these are both single word marks, the average consumer will perceive them as a whole and whilst there are a number of shared letters making up the words, there is no concept to either mark so even if one mark brought to mind the other because of a visual or aural resemblance, I would consider this to be mere association. Therefore I do not consider there to be a likelihood of direct confusion between the applicant's mark and the opponent's mark, on the part of an average consumer paying a normal level of attention.

Conclusion

44. The opposition fails under section 5(2)(b) of the Act. As I referred to earlier, I do not need to consider the opponent's earlier UK mark as it does not put the opponents in any stronger a position

Costs

45. As the holder has been successful, it is entitled to a contribution to its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN2/2016, I award costs as follows:

£200 Considering the other side's statement & preparing a defence

£300 Preparing submissions and considering the other side's submissions

£500 Total

46. I decline to award costs for the preparation of evidence as it was unnecessary for the decision made in this case.

47. I order Primavera Life GmbH to pay Amorepacific Corporation the sum of £500. This sum is to be paid within 14 days of the expiry of the appeal period or within 14

days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of March 2018

**June Ralph
For the Registrar,
The Comptroller General**