

BLO/519/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3317717

BY AVENTUAL LTD

TO REGISTER THE SERIES OF TWO TRADE MARKS:

LOMNI

lomni

IN CLASSES 3, 21 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 413348

BY PARFUMS PAROUR

Background and pleadings

1. On 14 June 2018, Aventual Ltd (“the applicant”) applied to register the series of two trade marks ‘LOMNI’ and ‘lomni’. The application was published for opposition purposes in the Trade Marks Journal, on 29 June 2018. Registration is sought for the following goods and services:

Class 3: *Cosmetics; Cosmetics all for sale in kit form; Cosmetics and cosmetic preparations; Cosmetics containing hyaluronic acid; Cosmetics containing keratin; Cosmetics containing panthenol; Cosmetics for animals; Cosmetics for children; Cosmetics for eye-brows; Cosmetics for eye-lashes; Cosmetics for personal use; Cosmetics for protecting the skin from sunburn; Cosmetics for suntanning; Cosmetics for the treatment of dry skin; Cosmetics for the use on the hair; Cosmetics for use in the treatment of wrinkled skin; Cosmetics for use on the skin; Cosmetics in the form of creams; Cosmetics in the form of eye shadow; Cosmetics in the form of gels; Cosmetics in the form of lotions; Cosmetics in the form of milks; Cosmetics in the form of oils; Cosmetics in the form of powders; Cosmetics in the form of rouge; Cosmetics preparations; Organic cosmetics; Organic makeup.*

Class 21: *Cosmetics applicators; Cosmetics brushes.*

Class 44: *Consultancy in the field of body and beauty care; Consultancy provided via the Internet in the field of body and beauty care; Consultancy relating to cosmetics; Cosmetic body care services; Cosmetic electrolysis; Cosmetic electrolysis for the removal of hair; Cosmetic facial and body treatment services; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of skin; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of tattoos; Cosmetic laser treatment of toenail fungus; Cosmetic laser treatment of unwanted hair; Cosmetic laser treatment of varicose veins; Cosmetic make-up services; Cosmetic skin tanning services for human beings; Cosmetic surgery services; Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face; Cosmetic treatment for the hair; Cosmetic treatment services for the body, face and hair; Cosmetician services;*

Cosmetics consultancy services; Eyebrow dyeing services; Eyebrow shaping services; Eyebrow tattooing services; Eyebrow threading services; Eyebrow tinting services; Eyelash curling services; Eyelash dyeing services; Eyelash extension services; Eyelash perming services; Eyelash tinting services; Facial beauty treatment services; Facial treatment services; Foot care; Foot massage services; Hair braiding services; Hair care services; Hair coloring services; Hair colouring services; Hair curling services; Hair cutting; Hair cutting services; Hair dressing salon services; Hair perming services; Hair replacement; Hair salon services; Hair salon services for children; Hair straightening services; Hair styling; Hair styling services; Hair tinting services; Hair treatment; Hair treatment services; Hair weaving; Haircare services ;Hairdressing; Hairdressing salon services; Hairdressing salons; Hairdressing services; Health spa services; Healthcare advisory services; Herbalism; Homeopathic clinical services; Hygienic and beauty care; Hygienic and beauty care for human beings; Hygienic and beauty care services; Information relating to beauty; Information relating to beauty care; Information relating to massage; Information relating to nutrition; Laser hair removal services; Laser removal of spider veins; Laser removal of tattoos; Laser removal of toenail fungus; Laser removal of varicose veins; Laser skin rejuvenation services; Laser skin tightening services; Laser vision correction services; Laser vision surgery services; Make-up application services; Manicure and pedicure services; Manicure services; Manicuring; Manicuring services; Massage; Massage and therapeutic shiatsu massage; Massage services; Massages; Microdermabrasion services; Nail care services; Nail salon services; Permanent hair removal and reduction services; Permanent makeup services; Personal hair removal services; Personal therapeutic services relating to cellulite removal; Personal therapeutic services relating to circulatory improvement; Providing information about beauty; Salon services (Beauty -); Salon services (Hairdressing -); Salons (Beauty -); Salons (Hairdressing -); Services for the care of the face; Services for the care of the feet; Services for the care of the hair; Services for the care of the scalp; Services for the care of the skin; Services of a hair and beauty salon; Skin care salon services; Skin care salons; Skin tanning service for humans for cosmetic purposes; Acupressure therapy; Acupuncture; Acupuncture services; Addiction treatment

services; Advice relating to allergies; Advice relating to cosmetics; Advice relating to hair care; Advice relating to immunology; Advice relating to nutrition; Advice relating to the feeding of animals; Advice relating to the medical needs of elderly people; Advice relating to the personal welfare of elderly people [health]; Advisory and consultancy services relating to the use of non-chemical treatments for sustainable agriculture and horticulture; Advisory services relating to beauty; Advisory services relating to beauty care; Advisory services relating to beauty treatment; Advisory services relating to cosmetics; Advisory services relating to degenerative diseases; Advisory services relating to diet; Advisory services relating to health; Advisory services relating to horticulture; Advisory services relating to medical apparatus and instruments; Advisory services relating to medical instruments; Advisory services relating to medical services; Advisory services relating to nutrition; Advisory services relating to pharmaceuticals; Advisory services relating to pharmacies; Advisory services relating to slimming; Advisory services relating to surgical instruments; Advisory services relating to the care of animals; Advisory services relating to the care of birds; Advisory services relating to the care of fish; Advisory services relating to the care of pet animals; Advisory services relating to the design of gardens; Advisory services relating to the design of turf; Advisory services relating to the laying of turf; Advisory services relating to the selection of turf; Advisory services relating to the treatment of degenerative diseases; Advisory services relating to water gardening; Advisory services relating to weight control; Advisory services relating to weight loss; Aerial and surface spreading of fertilisers and other agricultural chemicals; Aerial and surface spreading of fertilizers and other agricultural chemicals; Aerial seeding; Aerial spreading of agricultural chemicals; Aerial spreading of fertilisers; Aerial spreading of fertilizers; Aesthetician services; Agricultural advice; Agricultural advisory services; Agricultural consultancy; Agricultural, horticulture and forestry services; Agricultural information services; Agricultural machinery (Rental of -); Agricultural services; Agricultural services relating to environmental conservation; Agriculture, aquaculture, horticulture and forestry services; Agriculture, horticulture and forestry services; Agriculture, horticulture and forestry services relating to the recultivation of industrial wastelands; Agriculture services; Airbrush tanning salon services; Airbrush tanning

services; Airbrush tanning services for the human body; Alcohol screening for medical purposes; Alternative medicine services; Ambulant medical care; Analysis of human serum for medical treatment; Analysis of human tissues for medical treatment; Animal beautician services; Animal beautician services for cats; Animal beautician services for dogs; Animal breeding; Animal clipping; Animal feed rationing service; Animal grooming; Animal grooming services; Animal healthcare services; Animal hospitals; Animal husbandry; Animal performance testing services; Animals (Artificial insemination of -); Anti-smoking therapy; Application of cosmetic products to the body; Application of cosmetic products to the face; Aquaculture services; Aromatherapy services; Arranging of accommodation in convalescent homes; Arranging of accommodation in rest homes; Arranging of accommodation in sanatoria; Arranging of medical treatment; Art therapy; Artificial suntanning services ;Ayurveda therapy; Beautician services; Beauticians (Services of -); Beauty advisory services; Beauty care; Beauty care for animals; Beauty care for human beings; Beauty care of feet; Beauty care services; Beauty care services provided by a health spa; Beauty consultancy; Beauty consultancy services; Beauty consultation; Beauty consultation services; Beauty counselling; Beauty information services; Beauty salon services; Beauty salons; Beauty spa services; Beauty therapy services; Beauty therapy treatments; Beauty treatment; Beauty treatment services; Beauty treatment services especially for eyelashes; Body waxing services for hair removal in humans; Body waxing services for the human body; Bodywork therapy; Cellulite treatment services; Cellulitis treatment services; Chiropody; Chiropractic; Chiropractic services; Chiropractics; Chiropractitioner services; Colour analysis [beauticians' services]; Cosmetics consultancy services.

2. The application is opposed by Parfums Parour ("the opponent"). The opposition is based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is, under each of these grounds, directed against all of the goods and services in the application. For its grounds under Sections 5(2)(b) and 5(3) the opponent relies upon EUTM registration number 13396304 for the trade mark LOMANI, which has an application date of 23 October 2014 and registration date of 16 March 2015. The opponent relies upon all the goods for which its mark is registered, namely:

Class 3: *Perfumary; Perfumery; Toilet water; Perfume water; Cosmetics; Essential oils; Dentifrices; Baths (Cosmetic preparations for -); Bath soaps in liquid, solid or gel form; Deodorants for personal use; Cosmetic bath salts; Oils for toilet purposes; Cleansing milk for toilet purposes; Cosmetic goods for care of the skin; Polishing stones; Toiletries; Hair lotions; Sun-tanning preparations [cosmetics]; Eyelash and eyebrow cosmetics; Eyebrow pencils; Make-up and make-up removing preparations for the face and body; Make-up; Mascara; Foundations and concealers; Lipstick; Lip gloss; Nail polish; Talcum powder, for toilet use; Shampoo; Lacquer-removing preparations.*

3. The opponent's mark is an earlier mark within the meaning of Section 6(1) of the Act because it has a filing date earlier than the filing date of the contested application. As the earlier mark completed its registration process less than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act.

4. For the purposes of its opposition based upon Section 5(2)(b) of the Act, the opponent claims that the respective marks are similar and that the goods and services are identical or similar.

5. For the purposes of its opposition based upon Section 5(3) of the Act, the opponent claims that it has a reputation for all goods for which its mark is registered and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier mark.

6. For the purposes of its opposition based upon Section 5(4)(a) of the Act, the opponent claims that it has used the sign LOMANI throughout the UK since December 2011 in respect of *perfumes, toilet water, perfume water and deodorant for personal use.*

7. The applicant filed a defence and counterstatement, denying all the grounds.

8. Only the opponent filed evidence in these proceedings. Both parties filed written submissions. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing.

9. The applicant is not professionally represented; the opponent is represented by Potter Clarkson LLP. I now make this decision after a careful consideration of the papers before me.

The opponent's evidence

10. The opponent's evidence comes from Ramy Ghandour, the opponent's Chairman. Mr Ghandour's witness statement is dated 01 February 2019. I do not propose to summarise the evidence here, but I will refer to it where appropriate in this decision.

DECISION

Section 5(2)(b)

11. Section 5(2)(b) of the Act reads:

“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.”

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

13. In comparing the respective specifications, all the relevant factors should be taken into account. In the judgment of the Court of Justice of the European Union (CJEU) in *Canon*, (Case C-39/97), the Court stated at paragraph 23:

“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”.

14. 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 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.

15. In *Kurt Hesse v OHIM* (Case C-50/15 P), the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, (Case T-325/06), the General Court (GC) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

16. The law requires that goods be considered identical where one party’s description of its goods encompasses the specific goods covered by the other party’s description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC.

17. The grounds of opposition under Section 5(2)(b) of the Act require at least some degree of similarity between the goods and services. The goods and services to be compared are:

Applicant's goods and services	Opponent's goods
<p>Class 3: <i>Cosmetics; Cosmetics all for sale in kit form; Cosmetics and cosmetic preparations; Cosmetics containing hyaluronic acid; Cosmetics containing keratin; Cosmetics containing panthenol; Cosmetics for animals; Cosmetics for children; Cosmetics for eye-brows; Cosmetics for eye-lashes; Cosmetics for personal use; Cosmetics for protecting the skin from sunburn; Cosmetics for suntanning; Cosmetics for the treatment of dry skin; Cosmetics for the use on the hair; Cosmetics for use in the treatment of wrinkled skin; Cosmetics for use on the skin; Cosmetics in the form of creams; Cosmetics in the form of eye shadow; Cosmetics in the form of gels; Cosmetics in the form of lotions; Cosmetics in the form of milks; Cosmetics in the form of oils; Cosmetics in the form of powders; Cosmetics in the form of rouge; Cosmetics preparations; Organic cosmetics; Organic makeup.</i></p> <p>Class 21: <i>Cosmetics applicators; Cosmetics brushes.</i></p> <p>Class 44: <i>Consultancy in the field of body and beauty care; Consultancy provided via the Internet in the field of body and beauty care; Consultancy relating to cosmetics; Cosmetic body care services; Cosmetic electrolysis; Cosmetic electrolysis for the</i></p>	<p>Class 3: <i>Perfumery; Perfumery; Toilet water; Perfume water; Cosmetics; Essential oils; Dentifrices; Baths (Cosmetic preparations for -); Bath soaps in liquid, solid or gel form; Deodorants for personal use; Cosmetic bath salts; Oils for toilet purposes; Cleansing milk for toilet purposes; Cosmetic goods for care of the skin; Polishing stones; Toiletries; Hair lotions; Sun-tanning preparations [cosmetics]; Eyelash and eyebrow cosmetics; Eyebrow pencils; Make-up and make-up removing preparations for the face and body; Make-up; Mascara; Foundations and concealers; Lipstick; Lip gloss; Nail polish; Talcum powder, for toilet use; Shampoo; Lacquer-removing preparations.</i></p>

removal of hair; Cosmetic facial and body treatment services; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of skin; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of tattoos; Cosmetic laser treatment of toenail fungus; Cosmetic laser treatment of unwanted hair; Cosmetic laser treatment of varicose veins; Cosmetic make-up services; Cosmetic skin tanning services for human beings; Cosmetic surgery services; Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face; Cosmetic treatment for the hair; Cosmetic treatment services for the body, face and hair; Cosmetician services; Cosmetics consultancy services; Eyebrow dyeing services; Eyebrow shaping services; Eyebrow tattooing services; Eyebrow threading services; Eyebrow tinting services; Eyelash curling services; Eyelash dyeing services; Eyelash extension services; Eyelash perming services; Eyelash tinting services; Facial beauty treatment services; Facial treatment services; Foot care; Foot massage services; Hair braiding services; Hair care services; Hair coloring services; Hair colouring services; Hair curling services; Hair cutting; Hair cutting services; Hair dressing salon services; Hair perming services; Hair replacement; Hair salon services; Hair salon services for children; Hair straightening services; Hair styling; Hair styling services; Hair tinting services; Hair

treatment; Hair treatment services; Hair weaving; Haircare services ;Hairdressing; Hairdressing salon services; Hairdressing salons; Hairdressing services; Health spa services; Healthcare advisory services; Herbalism; Homeopathic clinical services; Hygienic and beauty care; Hygienic and beauty care for human beings; Hygienic and beauty care services; Information relating to beauty; Information relating to beauty care; Information relating to massage; Information relating to nutrition; Laser hair removal services; Laser removal of spider veins; Laser removal of tattoos; Laser removal of toenail fungus; Laser removal of varicose veins; Laser skin rejuvenation services; Laser skin tightening services; Laser vision correction services; Laser vision surgery services; Make-up application services; Manicure and pedicure services; Manicure services; Manicuring; Manicuring services; Massage; Massage and therapeutic shiatsu massage; Massage services; Massages; Microdermabrasion services; Nail care services; Nail salon services; Permanent hair removal and reduction services; Permanent makeup services; Personal hair removal services; Personal therapeutic services relating to cellulite removal; Personal therapeutic services relating to circulatory improvement; Providing information about beauty; Salon services (Beauty -); Salon services (Hairdressing -); Salons (Beauty -);

Salons (Hairdressing -); Services for the care of the face; Services for the care of the feet; Services for the care of the hair; Services for the care of the scalp; Services for the care of the skin; Services of a hair and beauty salon; Skin care salon services; Skin care salons; Skin tanning service for humans for cosmetic purposes; Acupressure therapy; Acupuncture; Acupuncture services; Addiction treatment services; Advice relating to allergies; Advice relating to cosmetics; Advice relating to hair care; Advice relating to immunology; Advice relating to nutrition; Advice relating to the feeding of animals; Advice relating to the medical needs of elderly people; Advice relating to the personal welfare of elderly people [health]; Advisory and consultancy services relating to the use of non-chemical treatments for sustainable agriculture and horticulture; Advisory services relating to beauty; Advisory services relating to beauty care; Advisory services relating to beauty treatment; Advisory services relating to cosmetics; Advisory services relating to degenerative diseases; Advisory services relating to diet; Advisory services relating to health; Advisory services relating to horticulture; Advisory services relating to medical apparatus and instruments; Advisory services relating to medical instruments; Advisory services relating to medical services; Advisory services relating to

nutrition; Advisory services relating to pharmaceuticals; Advisory services relating to pharmacies; Advisory services relating to slimming; Advisory services relating to surgical instruments; Advisory services relating to the care of animals; Advisory services relating to the care of birds; Advisory services relating to the care of fish; Advisory services relating to the care of pet animals; Advisory services relating to the design of gardens; Advisory services relating to the design of turf; Advisory services relating to the laying of turf; Advisory services relating to the selection of turf; Advisory services relating to the treatment of degenerative diseases; Advisory services relating to water gardening; Advisory services relating to weight control; Advisory services relating to weight loss; Aerial and surface spreading of fertilisers and other agricultural chemicals; Aerial and surface spreading of fertilizers and other agricultural chemicals; Aerial seeding; Aerial spreading of agricultural chemicals; Aerial spreading of fertilisers; Aerial spreading of fertilizers; Aesthetician services; Agricultural advice; Agricultural advisory services; Agricultural consultancy; Agricultural, horticulture and forestry services; Agricultural information services; Agricultural machinery (Rental of -); Agricultural services; Agricultural services relating to environmental conservation; Agriculture, aquaculture, horticulture and

forestry services; Agriculture, horticulture and forestry services; Agriculture, horticulture and forestry services relating to the recultivation of industrial wastelands; Agriculture services; Airbrush tanning salon services; Airbrush tanning services; Airbrush tanning services for the human body; Alcohol screening for medical purposes; Alternative medicine services; Ambulant medical care; Analysis of human serum for medical treatment; Analysis of human tissues for medical treatment; Animal beautician services; Animal beautician services for cats; Animal beautician services for dogs; Animal breeding; Animal clipping; Animal feed rationing service; Animal grooming; Animal grooming services; Animal healthcare services; Animal hospitals; Animal husbandry; Animal performance testing services; Animals (Artificial insemination of -); Anti-smoking therapy; Application of cosmetic products to the body; Application of cosmetic products to the face; Aquaculture services; Aromatherapy services; Arranging of accommodation in convalescent homes; Arranging of accommodation in rest homes; Arranging of accommodation in sanatoria; Arranging of medical treatment; Art therapy; Artificial suntanning services ;Ayurveda therapy; Beautician services; Beauticians (Services of -); Beauty advisory services; Beauty care; Beauty care for animals; Beauty care for human beings; Beauty care of feet;

<p><i>Beauty care services; Beauty care services provided by a health spa; Beauty consultancy; Beauty consultancy services; Beauty consultation; Beauty consultation services; Beauty counselling; Beauty information services; Beauty salon services; Beauty salons; Beauty spa services; Beauty therapy services; Beauty therapy treatments; Beauty treatment; Beauty treatment services; Beauty treatment services especially for eyelashes; Body waxing services for hair removal in humans; Body waxing services for the human body; Bodywork therapy; Cellulite treatment services; Cellulitis treatment services; Chiropody; Chiropractic; Chiropractic services; Chiropractics; Chiropractitioner services; Colour analysis [beauticians' services]; Cosmetics consultancy services.</i></p>	
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18. The applicant argues that the parties operate in different sectors, namely cosmetics and perfumery. It also relies on the fact that consumers are extremely discerning and will always investigate the company behind the products before making a purchase; this, the applicant says, will avoid any likelihood of confusion or connection being made between the marks.

19. Regrettably for the applicant, that is not the correct approach. These are familiar arguments in trade mark oppositions. They are often made by those, such as the applicant, who are new to these matters and have no legal representation. Therefore, before going any further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

20. As regards the first argument, since the opponent's earlier registered mark is not subject to proof of use, the opponent is entitled to protection against a likelihood of confusion with the applicant's mark, based on the 'notional' use of the earlier mark for the goods on which the opponent relies for the purposes of this opposition. The earlier mark is registered (and relied upon) for, inter alia, *cosmetics*. Even if the opponent had not actually used the earlier mark in relation to *cosmetics*, it would still be entitled to protection in relation those goods, based on the registration of the earlier mark. Consequently, the fact that the opponent might have used the mark only in relation to perfumes (and not to cosmetics), is not pertinent.

21. As regards the second argument, a finding of confusion requires the existence of some kind of thought process by which the consumer concludes from the similarity of the marks and the similarity of the goods and services being provided, that the goods and services must come from the same source. The test looks at the assumption the average consumer is likely to make in the context of him having an immediate reaction, not after checking the facts for himself.

Class 3

22. The opponent's *cosmetics* covers all of the contested cosmetic products in class 3, including *Organic makeup*, which would fall within the broad term *cosmetics* in the opponent's specification. These goods are identical on the principle outlined in *Meric*.

Class 21

23. Whilst different in nature, the contested *cosmetics applicators* and *cosmetics brushes* have the same purpose, namely to beautify and enhance one's appearance, as the opponent's *cosmetics* and *make-up* products in class 3. Moreover, they have the same users and distribution channels, may have the same producers and are complementary in the sense that one is indispensable or important for the use of the other, in such a way that consumers may think that the responsibility for the production of those goods lies with the same undertaking. These goods are similar to a high degree.

Class 44

24. The opponent has not made any specific submissions in relation to how and to what extent the contested services in class 44 overlap with its cosmetic, toiletry and perfumery products in class 3.

25. The opponent's goods consist of beauty products and include, inter alia, cosmetics, make up, perfumes, shampoo and hair lotions. The contested specification in class 44 covers a wide range of services, including several beauty care and haircare services (and related consultancy services). These services often include treatments with cosmetic preparations, body lotions, creams, fragrances, essential oils and/or treatments requiring posterior treatment with body lotions, moisturizing cream, etc. Whilst it is true that the goods and services differ in their nature, they still share the same general purpose, i.e. beauty care and hair care. Furthermore, the opponent's goods are important, if not essential, in order to provide the contested beauty care and haircare services and target the same consumers. Finally, the goods and services share trade channels: beauty salons and hair salons often sell their own beauty and haircare products and recommend them for further home treatments. Therefore, the commercial origin of these goods and services can coincide. On that basis, I find that the following services in the applicant's specification in class 44 are similar to a medium degree to the opponent's goods:

Consultancy in the field of body and beauty care; Consultancy provided via the Internet in the field of body and beauty care; Consultancy relating to cosmetics; Cosmetic body care services; Cosmetic electrolysis; Cosmetic electrolysis for the removal of hair; Cosmetic facial and body treatment services; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of skin; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of tattoos; Cosmetic laser treatment of toenail fungus; Cosmetic laser treatment of unwanted hair; Cosmetic laser treatment of varicose veins; Cosmetic make-up services; Cosmetic skin tanning services for human beings; Cosmetic surgery services; Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face; Cosmetic treatment for the hair; Cosmetic treatment services for the body, face and hair; Cosmetician services; Cosmetics consultancy services;

Eyebrow dyeing services; Eyebrow shaping services; Eyebrow tattooing services; Eyebrow threading services; Eyebrow tinting services; Eyelash curling services; Eyelash dyeing services; Eyelash extension services; Eyelash perming services; Eyelash tinting services; Facial beauty treatment services; Facial treatment services; Foot care; Foot massage services; Hair braiding services; Hair care services; Hair coloring services; Hair colouring services; Hair curling services; Hair cutting; Hair cutting services; Hair dressing salon services; Hair perming services; Hair replacement; Hair salon services; Hair salon services for children; Hair straightening services; Hair styling; Hair styling services; Hair tinting services; Hair treatment; Hair treatment services; Hair weaving; Haircare services; Hairdressing; Hairdressing salon services; Hairdressing salons; Hairdressing services; Health spa services; Healthcare advisory services; Hygienic and beauty care; Hygienic and beauty care for human beings; Hygienic and beauty care services; Information relating to beauty; Information relating to beauty care; Information relating to massage; Laser hair removal services; Laser removal of spider veins; Laser removal of tattoos; Laser removal of toenail fungus; Laser removal of varicose veins; Laser skin rejuvenation services; Laser skin tightening services; Make-up application services; Manicure and pedicure services; Manicure services; Manicuring; Manicuring services; Massage; Massage and therapeutic shiatsu massage; Massage services; Massages; Microdermabrasion services; Nail care services; Nail salon services; Permanent hair removal and reduction services; Permanent makeup services; Personal hair removal services; Personal therapeutic services relating to cellulite removal; Personal therapeutic services relating to circulatory improvement; Providing information about beauty; Salon services (Beauty -); Salon services (Hairdressing -); Salons (Beauty -); Salons (Hairdressing -); Services for the care of the face; Services for the care of the feet; Services for the care of the hair; Services for the care of the scalp; Services for the care of the skin; Services of a hair and beauty salon; Skin care salon services; Skin care salons; Skin tanning service for humans for cosmetic purposes; Advice relating to cosmetics; Advice relating to hair care; Advisory services relating to beauty; Advisory services relating to beauty care; Advisory services relating to beauty treatment; Advisory services relating to cosmetics;

Advisory services relating to medical services¹; Aesthetician services; Airbrush tanning salon services; Airbrush tanning services; Airbrush tanning services for the human body; Application of cosmetic products to the body; Application of cosmetic products to the face; Arranging of medical treatment²; Artificial suntanning services; Beautician services; Beauticians (Services of -); Beauty advisory services; Beauty care; Beauty care for human beings; Beauty care of feet; Beauty care services; Beauty care services provided by a health spa; Beauty consultancy; Beauty consultancy services; Beauty consultation; Beauty consultation services; Beauty counselling; Beauty information services; Beauty salon services; Beauty salons; Beauty spa services; Beauty therapy services; Beauty therapy treatments; Beauty treatment; Beauty treatment services; Beauty treatment services especially for eyelashes; Body waxing services for hair removal in humans; Body waxing services for the human body; Cellulite treatment services; Cellulitis treatment services; Chiropody; Colour analysis [beauticians' services]; Cosmetics consultancy services; Information relating to massage.

26. Similar considerations apply to the contested *Information relating to nutrition; Advice relating to nutrition; Advisory services relating to diet; Advisory services relating to health³; Advisory services relating to nutrition; Advisory services relating to slimming; Advisory services relating to weight control; Advisory services relating to weight loss*. This is because the opponent's *cosmetics* include goods such as anti-cellulite slimming creams, which could be used to help with weight loss. This leads to some complementarity between goods and services. Despite being different in nature, the goods and services have the same overall purpose which is beauty and healthcare. Further, the distribution channels can overlap, and the target public is identical. I consider these services to be similar to a medium degree to the opponent's goods.

27. The opponent's goods do not cover specifically animal grooming preparations. However, it covers *cosmetics* at large, which is broad enough to cover *cosmetics for*

¹ This would include advisory services in relation to cosmetic surgery

² These could relate to the arranging of cosmetic surgery treatments

³ This would include advisory services relating to nutrition.

animals, such as for example, dog shampoo. Consequently, for similar reasons to those outlined in the preceding paragraphs, I find that the applied for *Animal beautician services; Animal beautician services for cats; Animal beautician services for dogs; Beauty care for animals; Animal grooming and Animal grooming services* are similar to a medium degree to the opponent's *Cosmetics*.

28. The contested services also include services concerned with the care and health of pets and animals, namely *Advice relating to the feeding of animals; Animal breeding; Animal clipping; Animal feed rationing service; Animal healthcare services; Animal hospitals; Animal husbandry; Animal performance testing services; Animals (Artificial insemination of -); Advisory services relating to the care of animals; Advisory services relating to the care of birds; Advisory services relating to the care of fish; Advisory services relating to the care of pet animals*. Even allowing for the opponent's *cosmetics* to cover cosmetics for animals, the purpose of these services is not cosmetic and would not involve the use of the opponent's *cosmetics*. These services are two steps removed from the opponent's goods in class 3. Therefore, they are dissimilar.

29. The opponent's goods include *essential oils* which could be used in the context of the contested *Aromatherapy services*. Again, there is a certain degree of complementarity and whilst the nature of the goods and services is different, they have the same purpose, target the same users and share trade channels. These goods are similar to a medium degree.

30. The contested *Herbalism; Homeopathic clinical services; Acupressure therapy; Acupuncture; Acupuncture services; Ayurveda therapy; Alternative medicine services; Bodywork therapy; Chiropractic; Chiropractic services; Chiropractics; Chiropractitioner services*; concern therapeutic or personal development techniques. These services involve working with the human body in a form involving manipulative therapy or complementary medicine in order to relieve pain and/or improve wellness. The purpose of these services is different from that of the opponent's beauty products. Whilst the users can be the same, the uses, methods of use and trade channels are different, the goods and services are neither complementary nor in competition. These goods are dissimilar.

31. I also do not see any points of similarity between the earlier goods and the following:

Laser vision correction services; Laser vision surgery services; Addiction treatment services; Advice relating to allergies; Advice relating to immunology; Advice relating to the medical needs of elderly people; Advice relating to the personal welfare of elderly people [health]; Advisory and consultancy services relating to the use of non-chemical treatments for sustainable agriculture and horticulture; Advisory services relating to degenerative diseases; Advisory services relating to horticulture; Advisory services relating to medical apparatus and instruments; Advisory services relating to medical instruments; Advisory services relating to pharmaceuticals; Advisory services relating to pharmacies; Advisory services relating to surgical instruments; Advisory services relating to the design of gardens; Advisory services relating to the design of turf; Advisory services relating to the laying of turf; Advisory services relating to the selection of turf; Advisory services relating to the treatment of degenerative diseases; Advisory services relating to water gardening; Aerial and surface spreading of fertilisers and other agricultural chemicals; Aerial and surface spreading of fertilizers and other agricultural chemicals; Aerial seeding; Aerial spreading of agricultural chemicals; Aerial spreading of fertilisers; Aerial spreading of fertilizers; Agricultural advice; Agricultural advisory services; Agricultural consultancy; Agricultural, horticulture and forestry services; Agricultural information services; Agricultural machinery (Rental of -); Agricultural services; Agricultural services relating to environmental conservation; Agriculture, aquaculture, horticulture and forestry services; Agriculture, horticulture and forestry services; Agriculture, horticulture and forestry services relating to the recultivation of industrial wastelands; Agriculture services; Alcohol screening for medical purposes; Ambulant medical care; Analysis of human serum for medical treatment; Analysis of human tissues for medical treatment; Anti-smoking therapy; Aquaculture services; Arranging of accommodation in convalescent homes; Arranging of accommodation in rest homes; Arranging of accommodation in sanatoria; Art therapy. They are dissimilar.

The average consumer and the nature of the purchasing act

32. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods and services at issue; I must then determine the manner in which these goods and services will be selected in the course of trade. 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.”

33. The average consumer of the opponent’s goods and the applicant’s goods and services is a member of the general public. Such goods and services are, in my experience, selected fairly frequently, although the services are, I think, likely to be selected less frequently than the goods. As the goods at issue are most likely to be obtained by self-selection from the shelf of, for example, a supermarket or a beauty/hair saloon or from the pages of a website, visual considerations are likely to dominate the selection process. However, the selection of the goods could also require the intervention of a sales assistant and the goods could be discussed with beauticians/hairdressers, so aural consideration must not be ignored completely. As regards the contested beauty and wellbeing services, they will, in my view, be selected primarily from signage on the high street or from the pages of magazines and websites, so, once again, visual considerations are likely to dominate in the selection process. However, as such services are, in my experience, the subject of oral recommendations, aural considerations must not be ignored.

34. As to the degree of care the average consumer will display when selecting the goods at issue, the cost of the goods can vary considerably, however, given their

nature, it will be at least average. Moving on to the services, all of the services at issue are designed to enhance aesthetic appearance and promote wellbeing and are not inexpensive. I would therefore expect an above average degree of attention to be paid to their selection.

Comparison of marks

35. 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 them, 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.”

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

Applied for mark (series of two)	Opponent’s mark
LOMNI lomni	LOMANI

37. The overall impression of the opponent's mark is that it is simply the word 'LOMANI'.

38. The applicant's trade mark consists of the words 'LOMNI' in a standard typeface, the only difference being that the first trade mark in the series is in upper case and the second one in lower case. In its written submissions, the opponent refers to the applicant's mark as 'LOMNI lomni', however, the series of marks for which the applicant seeks registration consists of two separate signs 'LOMNI' and 'lomni', not of the repetition of the same element 'LOMNI'. Consequently, the overall impression of the applied for mark resides in the single element of which it is composed: the word 'LOMNI'. It makes no difference whether the second mark in the series is in lower case letters; as it is a word-only mark, notional and fair use of the mark also covers use in upper case letters.

39. The marks 'LOMNI' and 'LOMANI' share the same beginning 'LOM' and end 'NI' and differ by the letter A in the middle of the opponent's mark. They are visually and aurally similar to a high degree. In its written submissions, the applicant refers to the letter 'A' in the opponent's mark being "distinctively curved", however, this is not how the opponent's mark appears on the register, so I will disregard the submission. Conceptually, the applicant states that 'LOMNI' means "love" in her "her deceased father's language", however, there is no evidence that the UK public would be aware of that meaning. Consequently, I find that both 'LOMNI' and 'LOMANI' will be perceived as invented words, without a meaning in the English language and the conceptual position is neutral.

Distinctive character of earlier mark

40. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*²⁶, 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).”

41. The opponent’s mark is an invented word, with no descriptive or allusive message. It is inherently distinctive to a high degree.

42. The level of inherent distinctiveness of a trade mark may be enhanced through use in the UK. The opponent has filed evidence of use to support its claim to enhanced distinctiveness and reputation. This consists of some turnover figures, an undated screenshot from the opponent’s website and some examples of invoices. I have reviewed the evidence carefully, but I am unable to conclude that the mark ‘LOMANI’ has acquired an enhanced level of distinctive character in the UK. The sale figures provided are relatively small amounting to just under £190k worth of UK sales for the period 2012-2017. Although the EU figures are higher, being in the region of € 1.4 million, it is only the perspective of the UK consumer that is relevant in assessing whether a mark’s distinctive character has been enhanced and therefore makes confusion amongst UK consumers more likely. In any event, as the earlier mark ‘LOMANI’ has been found to enjoy an inherently high level of distinctiveness, a finding of enhanced distinctiveness would not have materially improved the opponents’ position.

Likelihood of confusion

43. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services vice versa. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

44. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

45. To determine whether there is a likelihood of direct or indirect confusion I now draw together my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the factors I have set out above.

46. Since similarity between goods and services is essential for finding a likelihood of confusion, where no similarity is found, the Section 5(2)(b) claim fails⁴. **Therefore, the opposition fails against the following applied for services:**

Class 44: *Advice relating to the feeding of animals; Animal breeding; Animal clipping; Animal feed rationing service; Animal healthcare services; Animal hospitals; Animal husbandry; Animal performance testing services; Animals (Artificial insemination of -); Advisory services relating to the care of animals; Advisory services relating to the care of birds; Advisory services relating to the care of fish; Advisory services relating to the care of pet animals; Herbalism; Homeopathic clinical services; Acupressure therapy; Acupuncture; Acupuncture services; Ayurveda therapy; Alternative medicine services; Bodywork therapy; Chiropractic; Chiropractic services; Chiropractics; Chiropractitioner services; Laser vision correction services; Laser vision surgery services; Addiction treatment services; Advice relating to allergies; Advice relating to immunology; Advice relating to the medical needs of elderly people; Advice relating to the personal welfare of elderly people [health]; Advisory and consultancy services relating to the use of non-chemical treatments for sustainable agriculture and horticulture; Advisory services relating to degenerative diseases; Advisory services relating to horticulture; Advisory services relating to medical apparatus and instruments; Advisory services relating to medical instruments; Advisory services relating to pharmaceuticals; Advisory services relating to pharmacies; Advisory services relating to surgical instruments; Advisory services relating to the design of gardens; Advisory services relating to the design of turf; Advisory services relating to the laying of turf; Advisory services relating to the selection of turf; Advisory services relating to the treatment of degenerative diseases; Advisory services relating to water gardening; Aerial and surface spreading of fertilisers and other agricultural chemicals; Aerial and surface spreading of fertilizers and other agricultural chemicals; Aerial seeding; Aerial spreading of agricultural chemicals; Aerial spreading of fertilisers; Aerial spreading of fertilizers; Agricultural advice; Agricultural advisory services; Agricultural consultancy;*

⁴ eSure Insurance v Direct Line Insurance, [2008] ETMR 77

Agricultural, horticulture and forestry services; Agricultural information services; Agricultural machinery (Rental of -); Agricultural services; Agricultural services relating to environmental conservation; Agriculture, aquaculture, horticulture and forestry services; Agriculture, horticulture and forestry services; Agriculture, horticulture and forestry services relating to the recultivation of industrial wastelands; Agriculture services; Alcohol screening for medical purposes; Ambulant medical care; Analysis of human serum for medical treatment; Analysis of human tissues for medical treatment; Anti-smoking therapy; Aquaculture services; Arranging of accommodation in convalescent homes; Arranging of accommodation in rest homes; Arranging of accommodation in sanatoria; Art therapy.

47. With regard to the remaining goods and services, I have found them to be either identical or similar to a medium to high degree. I have also found that they will be selected visually with a degree of attention varying from average to above average. The respective marks are visually and aurally similar to a high degree. Conceptually, a comparison is not possible and so the position is neutral. The earlier mark is an invented word and is inherently distinctive to a high degree. Taking into account that in the process of comparison the consumer will rarely have a perfect recollection of the comparator mark, I consider that given the degree of visual and aural similarity between the marks, neither of which has any conceptual meaning which might serve to differentiate them, it is likely that the average consumers will misremember the LOMANI mark and when they see the LOMNI mark will confuse it for the LOMANI mark. **There is a likelihood of direct confusion.**

48. **To summarise, the Section 5(2)(b) claim succeeds against the following goods and services:**

Class 3: *Cosmetics; Cosmetics all for sale in kit form; Cosmetics and cosmetic preparations; Cosmetics containing hyaluronic acid; Cosmetics containing keratin; Cosmetics containing panthenol; Cosmetics for animals; Cosmetics for children; Cosmetics for eye-brows; Cosmetics for eye-lashes; Cosmetics for personal use; Cosmetics for protecting the skin from sunburn; Cosmetics for suntanning; Cosmetics for the treatment of dry skin; Cosmetics for the use on*

the hair; Cosmetics for use in the treatment of wrinkled skin; Cosmetics for use on the skin; Cosmetics in the form of creams; Cosmetics in the form of eye shadow; Cosmetics in the form of gels; Cosmetics in the form of lotions; Cosmetics in the form of milks; Cosmetics in the form of oils; Cosmetics in the form of powders; Cosmetics in the form of rouge; Cosmetics preparations; Organic cosmetics; Organic makeup.

Class 21: *Cosmetics applicators; Cosmetics brushes.*

Class 44: *Consultancy in the field of body and beauty care; Consultancy provided via the Internet in the field of body and beauty care; Consultancy relating to cosmetics; Cosmetic body care services; Cosmetic electrolysis; Cosmetic electrolysis for the removal of hair; Cosmetic facial and body treatment services; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of skin; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of tattoos; Cosmetic laser treatment of toenail fungus; Cosmetic laser treatment of unwanted hair; Cosmetic laser treatment of varicose veins; Cosmetic make-up services; Cosmetic skin tanning services for human beings; Cosmetic surgery services; Cosmetic treatment; Cosmetic treatment for the body; Cosmetic treatment for the face; Cosmetic treatment for the hair; Cosmetic treatment services for the body, face and hair; Cosmetician services; Cosmetics consultancy services; Eyebrow dyeing services; Eyebrow shaping services; Eyebrow tattooing services; Eyebrow threading services; Eyebrow tinting services; Eyelash curling services; Eyelash dyeing services; Eyelash extension services; Eyelash perming services; Eyelash tinting services; Facial beauty treatment services; Facial treatment services; Foot care; Foot massage services; Hair braiding services; Hair care services; Hair coloring services; Hair colouring services; Hair curling services; Hair cutting; Hair cutting services; Hair dressing salon services; Hair perming services; Hair replacement; Hair salon services; Hair salon services for children; Hair straightening services; Hair styling; Hair styling services; Hair tinting services; Hair treatment; Hair treatment services; Hair weaving; Haircare services; Hairdressing; Hairdressing salon services; Hairdressing salons; Hairdressing services; Health spa services; Healthcare advisory services; Hygienic and beauty care;*

Hygienic and beauty care for human beings; Hygienic and beauty care services; Information relating to beauty; Information relating to beauty care; Information relating to massage; Laser hair removal services; Laser removal of spider veins; Laser removal of tattoos; Laser removal of toenail fungus; Laser removal of varicose veins; Laser skin rejuvenation services; Laser skin tightening services; Make-up application services; Manicure and pedicure services; Manicure services; Manicuring; Manicuring services; Massage; Massage and therapeutic shiatsu massage; Massage services; Massages; Microdermabrasion services; Nail care services; Nail salon services; Permanent hair removal and reduction services; Permanent makeup services; Personal hair removal services; Personal therapeutic services relating to cellulite removal; Personal therapeutic services relating to circulatory improvement; Providing information about beauty; Salon services (Beauty -); Salon services (Hairdressing -); Salons (Beauty -); Salons (Hairdressing -); Services for the care of the face; Services for the care of the feet; Services for the care of the hair; Services for the care of the scalp; Services for the care of the skin; Services of a hair and beauty salon; Skin care salon services; Skin care salons; Skin tanning service for humans for cosmetic purposes; Advice relating to cosmetics; Advice relating to hair care; Advisory services relating to beauty; Advisory services relating to beauty care; Advisory services relating to beauty treatment; Advisory services relating to cosmetics; Advisory services relating to medical services; Aesthetician services; Airbrush tanning salon services; Airbrush tanning services; Airbrush tanning services for the human body; Application of cosmetic products to the body; Application of cosmetic products to the face; Arranging of medical treatment; Artificial suntanning services; Beautician services; Beauticians (Services of -); Beauty advisory services; Beauty care; Beauty care for human beings; Beauty care of feet; Beauty care services; Beauty care services provided by a health spa; Beauty consultancy; Beauty consultancy services; Beauty consultation; Beauty consultation services; Beauty counselling; Beauty information services; Beauty salon services; Beauty salons; Beauty spa services; Beauty therapy services; Beauty therapy treatments; Beauty treatment; Beauty treatment services; Beauty treatment services especially for eyelashes; Body waxing services for hair removal in humans; Body waxing services for the human body; Cellulite

treatment services; Cellulitis treatment services; Chiropody; Colour analysis [beauticians' services]; Cosmetics consultancy services; Information relating to massage; Information relating to nutrition; Advice relating to nutrition; Advisory services relating to diet; Advisory services relating to health; Advisory services relating to nutrition; Advisory services relating to slimming; Advisory services relating to weight control; Advisory services relating to weight loss; Animal beautician services; Animal beautician services for cats; Animal beautician services for dogs; Beauty care for animals; Animal grooming; Animal grooming services; Aromatherapy services.

49. Since the Section 5(2)(b) claim has only succeeded in part, I shall consider the Section 5(3) and 5(4)(a) claims against the remaining services.

Section 5(3) of the Act

50. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

51. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

52. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

53. The best evidence filed by the opponent is that of turnover. Whilst the invoices exhibited suggest that the mark has been used primarily in relation to perfumes, Mr Ghandour states that the mark 'LOMANI' has been used in relation to "men and women's toiletries"; these would include products other than perfumes such as, dentifrices, soaps, deodorants, talcum powders, which are listed in the registered specification and in relation to which the opponent claims reputation. Furthermore, the figures provided are not broken down in any way which enables me to apportion any volume of sales to any particular goods or types of goods and, at no point during the proceedings, the opponent has limited its claim of reputation to perfumes. But even if I were to assume that all of the sales relate to perfumes, the UK turnover is relatively small amounting to approximately £190k over a 5-year period and is provided without market share context. Further, there is no promotional evidence prior to the relevant date, i.e. the date of the UK application, namely 14 June 2018. Though the EU figures are higher, they suffer from the same deficiencies, and even if I were to accept that the mark has a reputation in the EU (which I do not) there is no evidence of spill over reputation in the UK, so no link would be made from the perspective of the UK average consumer. Accordingly, I find that the it has NOT been shown that, at the relevant date, the earlier mark had acquired a reputation for any of the goods in relation to which it is registered. Without a reputation, the Section 5(3) ground fails at the first hurdle.

SECTION 5(4)(a)

54. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

55. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

56. Whether there has been passing off must be judged at a particular point (or points) in time. Since the applicant has not filed any evidence to support that it has used its mark before it applied to register it, the date at which I must assess the Section 5(4)(a) claim is the date of the UK application, namely 14 June 2018.

Goodwill

57. The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co’s Margerine Ltd* [1901] AC 217 at 223:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a

business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

Misrepresentation

58. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton* in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England* 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

59. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion, it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing

with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.' ”

60. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchin L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

61. Although this was an infringement case, the principles apply equally under Section 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal’s later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

62. The opponent’s Section 5(4)(a) claim is based on its alleged earlier rights in the sign LOMANI, which it claims to have used in the UK in relation perfumes since 2011. Even if I were to take the generous view that most of the UK sales relate to perfumes, I would find that the opponent has a small, but more than trivial⁵, goodwill for perfumes. I would also find that, similarly to what I found in relation to the other cosmetic products

⁵ *Hart v Relentless Records* [2003] FSR 36

in the opponent's registered specification, these goods are not similar to the contested services in relation to which the Section 5(2)(b) claim has failed. In other words, I would not consider that for the services which the Section 5(2)(b) claim failed, the Section 5(4)(a) based on the opponent's goodwill for perfumes, would succeed. Whilst recognising the difference in legal tests between likelihood of confusion and misrepresentation, the outcome is the same. The distance between the goods and services is such that I do not consider that a substantial number of members of the public will be misled into purchasing the applicant's services in the belief that it is the opponent's, or that there is an economic association. The passing off ground fails.

COSTS

63. As both parties have achieved a measure of success, I direct that they bear their own costs.

Dated this day 05th September 2019

Teresa Perks
For the Registrar
The Comptroller – General