

O-687-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3341446 BY
LECLAIR COSMETICS**

TO REGISTER THE TRADE MARK:

LeClair Cosmetics

FOR GOODS IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION TO ITS REGISTRATION
UNDER NO. 414583**

**BY
VISIONMED**

Background and pleadings

1) On 27 September 2018 LeClair Cosmetics (“the Applicant”) applied to register the following trade mark (“the opposed mark”) for the following goods:

LeClair Cosmetics

Class 3: *Face creams for cosmetic use.*

The application was published for opposition purposes on 05 October 2018.

2) The application is opposed by Visiomed (“the Opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon EU trade mark registration no. 10961894 (“the earlier mark”) for the following mark and goods:

T.LECLERC

Class 3: Cosmetics.

3) The earlier mark was filed on 13 June 2012, claiming seniority from 19 November 1997, and completed its registration procedure on 24 October 2012. The significance of the respective dates given above is that (1) the earlier mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed more than five years before the publication of the Applicant’s mark¹.

4) The Opponent is represented by Bristows LLP. The Applicant is represented by Withers & Rogers LLP. The Opponent claims that the mark applied for is similar to the earlier mark, that it is to be registered for identical or highly similar goods, and that there consequently exists a likelihood of confusion on the part of the public,

¹ The proceedings having been commenced before the amendments made by the *Trade Marks Regulations 2018/825* came into force on 14 January 2019, the version of section 6A in force prior to that date is to be applied.

including a likelihood of association between them. The Applicant filed a notice of defence and counterstatement, denying the grounds of opposition, and requiring proof of use of the earlier mark. The period during which genuine use of the marks must be proved (“the relevant period”) is 06 October 2013 to 05 October 2018.

5) Only the Opponent filed evidence. Both the Opponent and the Applicant filed written submissions during the evidence rounds. Neither party requested a hearing, and the Opponent filed further written submissions in lieu of attendance at a hearing. I therefore give this decision after a careful review of all the papers before me.

Evidence summary

6) In a witness statement of 19 April 2018 Mr. Eric Sebban states that he is the Opponent’s President and founder, and that the T.LECLERC brand was acquired by the Opponent in August 2018.

7) **Exhibit ES1** contains material obtained using the WayBack website, and dated from 2013 to 2018, evidencing a wide range of the goods offered under the trade mark T.LECLERC. Mr. Sebban explains that the trade mark T.LECLERC has been used throughout the European Union since at least 2013 in relation to cosmetic products sold via a network of exclusive distributors. Extracts from relevant distribution agreements are attached as **Exhibit ES3**. He points to Annex 1 within the distribution agreements as evidencing the cosmetic products offered and sold under the trade mark T.LECLERC, namely: *loose powder, pressed powder, fluid foundation, ageing foundation, tinted cream, beauty make-up base, compact foundation, powder blush, correcting fluid, concealer, mascara, eyeliner, eyeshadow, eye pencil, eyebrow pencil, lip contour pencil, lip gloss, lipstick, nail enamel, ridge filler, nail hardener, cosmetics brushes sponges and cosmetic puffs.*

8) **Exhibit ES4** provides copies of packaging designs to show how the T.LECLERC mark was displayed on pressed powder, loose powder, lipstick, anti-age radiant perfecter, eye pencil, mascara, lip balm, anti-fatigue eye pencil, eyebrow pencil, lip pencil, powder blush, powdery compact foundation and loose powder during the relevant period.

Attached as **Exhibit ES5** are photographs showing how the cosmetic products bearing the T.LECLERC mark have been displayed in stores “within the last few years” in the Olfattorio shop in Torino Italy, in Wiesbaden Germany, at Marks & Spencer in the UK and the UK distributor Medusa Apothecary and on the UK website MyShowcase, and at Claudia di Paolo in Madrid.

9) **Exhibit ES6** contains examples of third parties' references to the products bearing the T.LECLERC mark from websites serving the UK, Italy, Germany and Poland between 2013 and 2015; Mr. Sabban describes them as representative.

10) Mr Sabban explains that **Exhibit ES7** contains sample invoices for products sold by the Opponent’s predecessor under the T.LECLERC mark in the UK, Italy, the Netherlands, and Poland in the period 2016-2018 (all dated within the relevant period) prior to the Opponent’s acquisition of the mark (though he confirms that T.LECLERC cosmetics have been sold continuously in the EU since at least 2013). The products covered by these invoices are those given in the list in paragraph 7 above.

11) Mr. Sebban gives the following table of sales figures (in pounds Sterling) for T.LECLERC branded cosmetic products in the UK from 2014 to 2016:

	2014	2015	2016
January	466.58	1,878.39	3,589.4
February	593.25	4,038.15	4,895.08
March	1,281.82	4,054.95	6,229.05
April	783.11	3,001.92	6,447.21
May	1,251.24	4,023.58	4,390.77
June	1,254.45	4,895.59	4,079.67
July	772.01	3,416.98	5,845.54
August	573.64	1,917.01	3,750.67
September	821.74	6,045.48	3,652.17
October	1,701.89	7,465.55	3,767.79
November	2,878.23	10,676.63	-
December	2,400.35	4,997.15	-
Total	14,778.31	56,411.38	46,647.35

12) Attached as **Exhibit ES8** is a report related to the sales of the T.LECLERC cosmetic products in the UK between 2014 and 2015, and the events organised and efforts made by the UK distributor to increase the brand awareness in the UK. A number of trading partners are shown in the UK. This document also sets out examples of expenditure for developing the presence of the T.LECLERC make-up products in the Marks & Spencer stores. **Exhibit ES9** contains data on sales through 19 Marks & Spencer stores throughout the UK for the last week of June 2016.

13) **Exhibit 10** is a copy of *MyShowcase* catalogues dated 2013 and 2015 showing a range of make-up products bearing the T.LECLERC mark. **Exhibit ES11** contains copies of email correspondence between the UK distributor and the company operating the website *MyShowcase*, dated October 2014 and October 2016, showing product orders.

14) **Exhibit ES12**, contains examples of advertising copy featuring use of the T.LECLERC brand in relation to a range cosmetic products; 17 seem to relate to German publications in 2013 (many early in the year before the start of the relevant period, but I accept that this advertising will have produced effects within the relevant period), 2 seem to relate to Poland in 2014 and 21 to Italy between 2013 and 2015). **Exhibit ES13** contains undated promotional material in English, with a reference to the UK distributor and **Exhibit 14** contains further material apparently aimed at the Italian market in 2017. Mr. Sebban states that these are representative of the type of material the Opponent has also produced over the years more generally in the European Union. Attached as **Exhibit ES15** are invoices made out to the UK distributor between 2014 and 2016 for various advertising and promotional services to promote products offered under the T.LECLERC mark.

Proof of use

15) In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) ("*Walton*") Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally

and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

[.....]

118. *The law with respect to genuine use in the Union.* Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark “in the Union”. In this regard, the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]-[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory

of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].

16) With the exception of the UK sales figures reproduced in paragraph 11 above, I have no overall figures for sales or promotional expenditure, either for the whole EU or broken down by individual countries. The UK sales figures and the expenditure figures in Exhibit ES8 and Exhibit ES15 provide a starting point, however, against which the invoices in Exhibit 7 and the promotional material and evidence in the other exhibits can be viewed. The figures provided may be modest in terms of what must be a huge EU market for cosmetics, but they are not insignificant. It would have been helpful to have had fuller overall figures for the EU broken down by product and area. However, I must look at all the evidence submitted and, in doing so, I must not simply consider each item of evidence individually, but step back and consider the evidence as a whole to see what it establishes. The evidence shows a reasonable degree of geographic spread, continuity of effort and consistency of purpose in relation to a range of cosmetic products.

17) Viewing the evidence in the round, including the evidence of sales and product promotion in Italy, Germany, Spain, the UK, the Netherlands and Poland, and applying the principles identified by Arnold J in points 1-11 of his summary of the relevant law in *Walton*, I am satisfied that there has been genuine use of the earlier mark in the European Union during the relevant period on the following products: *loose powder, pressed powder, fluid foundation, ageing foundation, tinted cream, beauty make-up base, compact foundation, powder blush, correcting fluid, concealer, mascara, eyeliner, eyeshadow, eye pencil, eyebrow pencil, lip contour pencil, lip gloss, lipstick, nail enamel, ridge filler, nail hardener, cosmetics brushes sponges and cosmetic puffs.*

A fair specification

18) In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as follows:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

19) In the context of revocation proceedings in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) Mr Justice Carr summed up the law as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of

the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

20) The Opponent submits that *cosmetics* is a fair specification of the goods for which it has proved genuine use. The Applicant denies that the Opponent is entitled to rely on this term, claiming that it is too broad. In support of this contention it cites the decision of Mr Daniel Alexander, Q.C., sitting as the Appointed Person, in *Awareness limited v Plymouth City Council*, Case BL 0/236/13 at paragraph 22:

"The evidence should make it clear, with precision, what specific use there has been and explain why, If the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

21) I note that in Case BL O/424/14 Mr Alexander also observed:

“64. The real question is not whether a narrow specification would suffice, but whether the wider specification is justifiable and makes more sense.

65. That depends to some degree on the nature of the wider specification. If it contains a broad range of diverse goods which may, for example, be supplied for different purposes and through different trade channels and it is clear that use has only been in relation to a small sub-set, it would be wrong to permit a specification to the whole wider class on the basis of proof of use of the smaller sub-set.”

22) In paragraph 17 above I have found genuine use of the earlier mark in respect of a range of cosmetic products. I must bear in mind that a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration²; and that, in framing a fair specification I must identify and define not the particular examples of goods or services for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify in accordance with to the perceptions of the average consumer³.

23) The Applicant submits that the Opponent’s goods for which I have found genuine use can be grouped into three categories: *make-up*, *nail treatments* and *make-up applicators*. Applicant then contends that, by reason of the nature, method of use and intended purpose of the goods in these categories, they are dissimilar to those of the Applicant. It reasons, for example: “*For Instance, "lip gloss" is for application on the lips alone for the purpose of adding colour. Whereas "face cream" is known in the industry as a synonym for moisturiser. Moisturisers are for moisturising the skin, whereas make-up is applied to accentuate or conceal facial features*”

24) *The Oxford Dictionary of English* (3rd edition, 2010) defines “cosmetic” as “a preparation applied to the body, especially the face, to improve its appearance”. With the exception of *cosmetics brushes, sponges and puffs*, which might well be described, as the Applicant suggests, as “make-up applicators”, all the Opponent’s other goods for which I have found genuine use are preparations applied to the body, especially the face, to improve its appearance. I believe that the average

² See *Maier v Asos Plc* [2015] EWCA Civ 220 at paragraphs 56 and 60.

³ See *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.

consumer would perceive them as sharing this common nature and purpose, and would take the range of products for which I have found genuine use as realistically exemplifying the category *cosmetics*. In case I am wrong about this, however, I shall also take into account as fair specifications for the purpose of my comparison of goods and global assessment the categories suggested by the Applicant: *make-up*, *nail treatments* and *make-up applicators*.

Section 5(2)(b)

25) Section 5(2)(b) of the Act reads 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”.

26) The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 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.

The average consumer and the purchasing process

27) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

28) The average consumer of cosmetic products will be a member of the general public. The goods will often be self-selected from a shelf (or the online or catalogue equivalent) and the marks may be exposed visually in advertising and websites etc. However, it is not unusual to find sales assistants and advisors involved in the purchasing process, so aural considerations may play a part. Even in these cases, however, the customer will normally see the goods before completing a purchase. The purchasing act is therefore likely to be primarily a visual one, but aural considerations will not be ignored in my assessment. Cosmetics are likely to be available in a range of prices – though, as a general rule, they are relatively low value, fairly frequent purchases, and are unlikely to demand a higher level of attention to be paid in their selection than that necessary to establish suitable skin

type, perfume, active ingredients, and so on. The purchasing process will be a normal, reasonably considered one, the level of attention neither higher nor lower than the norm.

Comparison of goods

29) In the judgment of the CJEU in *Canon*, Case C-39/97, the court 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”.

30) 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.

31) In *Gérard Meric v OHIM* Case T- 133/05 (“*Meric*”), the General Court (“the GC”) stated that:

“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 where 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”).

32) Face creams are applied to the face to moisturise the skin. This may be done for medical purposes (though in that case they would be appropriate to Class 5 rather than Class 3). It is most commonly done, however, in order to keep the face looking young and unwrinkled – in other words, to improve its appearance – and face creams are formulated and sold for this purpose. The Applicant’s specification explicitly limits its product to this cosmetic purpose. *Face creams for cosmetic use* fall squarely within the ambit of *cosmetics*. If I am correct in allowing *cosmetics* as a fair specification of the goods for which the Opponent has shown use, therefore, the goods to be compared are identical under the principle in *Meric*.

33) In case I am wrong in allowing the broad term *cosmetics* as a fair specification, however, I shall also make my comparison on the basis that the narrower categories suggested by the Applicant might also serve as a fair specification of the goods for which I have found genuine use, namely: *make-up*, *nail treatments* and *make-up applicators*. I accept that *face creams for cosmetic use* could include creams used for purely moisturising purposes – overnight creams, for example – which might not be regarded by the consumer as falling within the category of *make-up*. Nevertheless, I do not think that the consumer would see such a strict demarcation

between the competing goods as the Applicant suggests. There will be a considerable area of overlap in function, purpose and method of use: moisturising creams may serve a cosmetic purpose and vice versa: the Opponent's *ageing foundation, tinted cream* and *beauty and make-up base*, for example, all have, or may have, a moisturising function and purpose as well as a cosmetic one. This overlap in function and purpose can also give rise to an element of competition. Even if moisturising creams are displayed on a different part of the shelves from make-up, they will certainly be found in close proximity. Moreover, the overlap described above may in any case make it difficult to segregate the products. The consumer will easily believe that the Applicant's *face creams for cosmetic use* may be supplied by the same producer as the Opponent's *make-up*. The competing goods are therefore in any event highly similar. I do not find it necessary to undertake a comparison with the Opponent's *nail treatments* and *make-up applicators*, since they offer the Opponent no better case.

Comparison of the marks

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

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

35) It would be wrong, therefore, to dissect the trade marks artificially, 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.

36) The marks to be compared are shown below:

The opposed mark	The earlier mark
LeClair Cosmetics	T.LECLERC

I cannot agree with the Opponent's contentions (at paragraphs 24, 26.b, 27, 30 and 33 of its final submissions of 6 September 2019) that "The word LECLERC constitutes the dominant and distinctive element in the Earlier Mark", that the initial letter T is "isolated" or "is barely noticeable in the Earlier Mark", and that "the distinctive words LECLERC and LECLAIR will catch the attention of consumers and will be remembered more than the letter T which is insignificant". On the contrary, I find that the initial T and full stop, which precede the rest of the earlier mark without a gap, play an integral role in, and contribute to, its overall impression. They will not be overlooked. No part of the earlier mark is descriptive or allusive; its distinctiveness lies in the mark as a whole.

37) The word "Cosmetics" in the opposed mark is completely descriptive. I therefore agree entirely with the Applicant's concession (at paragraph 8 of its submissions filed on 30 July 2019) that "The dominant and distinctive elements of the marks for comparison are LeClair and T.LECLERC, since the word "cosmetics" is descriptive in relation to the Applicant's Goods".

38) In making my visual comparison I bear in mind that notional and fair use of the marks to be compared would include use in both upper and lower case⁴, so letter

⁴ See *Peek & Cloppenburg v OHIM*, T-386/07 at paragraph 47 and *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, C-291/0 at paragraph 54.

case is irrelevant to the comparison. (Moreover, I bear in mind that, where the earlier mark has been used, then, in the absence of argument or evidence to the contrary, the way in which the proprietor has used it can be said, at the very least *prima facie*, to be the paradigm case of its use in a notional fair manner⁵. I note that the evidence shows use of the earlier mark on products and product display shelves in upper and lower case combination as follows: T.LeClerc).

39) The Opponent submits that “The elements LECLERC and LECLAIR share 5 identical letters out of 7 and differ by only two letters”, making them “highly similar”. I agree that the beginnings of those elements are similar, but their endings are different; they share their first four letters, LECL, and differ in their final three, ERC and AIR respectively. Although the letter R appears in both endings, its position in the respective letter combinations is different, so as to produce the quite different-looking endings ERC and AIR.

40) There is a well settled rule of thumb in the case law that the consumer normally attaches more importance to the beginnings of word marks. This is no more than a rule of thumb. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks⁶. In this case I think it is useful to bear it in mind. The beginnings of the marks – LECL ... and T.LECL ... respectively – are clearly different, as are their endings. Overall, there is a fairly low degree of visual similarity between the marks.

41) From an aural perspective the Opponent contends (at paragraph 33 of its final submissions) that “the relevant consumers would understand and know the national origins of the T.LECLERC trade mark, especially as it is common knowledge that

⁵ see *Premier Brands v Typhoon* [2000] E.T.M.R. 1071, [2000] F.S.R. 767; *Open Country* [2000] R.P.C. 477 CA; *Kerly's Law of Trade Marks and Trade Names*, 16th Ed. at paragraph 11-080.

⁶ Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-438/07*:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

many of the main cosmetic brands come from France or Italy. UK consumers would perceive the national origins of cosmetics / fashion brands and make the effort of pronouncing them as would a French-speaking consumer, for example *Louis Vuitton*, *Chanel* and *Givenchy*. Also, the French surname LECLERC is known to the English public and would be pronounced as would a French-speaker, resulting in a pronunciation that is identical to the pronunciation of the word LECLAIR that is the distinctive element of the Application". The Opponent contends further that the pronunciation of the name of the French racing driver Charles LeClerc illustrates this and (at paragraph 35) that consumers in the UK "would understand and pronounce the 'LECLERC' element as it would be pronounced in French, i.e. 'LECLER(C)', the last letter C would remain silent" – thus rendering the pronunciation of the LECLAIR and LECLERC elements aurally identical.

42) In fact I have no direct evidence of how the average UK consumer would pronounce these elements when encountering them used on cosmetics in the UK. *Louis Vuitton*, *Chanel* and *Givenchy* are famous brands of long-standing in the UK market; exposure to years of extensive advertising, promotional activities and use on sound media such as TV, radio, etc. may well have educated UK consumers to pronounce those brand names in a particular way. I do not think that one can validly draw from this any inference as to the manner in which the average member of the UK public tackles the pronunciation of French names or words generally, or cosmetic brands in particular. Similarly, professional sports commentators, for example, may take pains to familiarise themselves with the pronunciation of the names of sporting personalities such as Charles LeClerc; but even if one were to assume that such usage has familiarised followers of motor racing in the UK with the correct French pronunciation of the name LeClerc, I do not consider that one could legitimately infer from this that the average consumer of cosmetics in the UK would pronounce the name in that way.

43) It is a notorious fact that the average UK consumer's grasp of foreign languages – and, in particular, their pronunciation – is not very sophisticated. The pronunciation of foreign words and names is therefore normally heavily anglicised. I do not think that the average UK consumer would necessarily see the word LECLERC on its own as a name; but even if the average consumer sees it as being

a word of potentially French origin, I do not consider that he or she will omit to sound the final C when pronouncing it. Nor do I agree that the addition of the initial T of the earlier mark “does not result in marks that are substantially different from each another”. I think the earlier mark will be pronounced TEE-LER-KLERK (to rhyme with the English word “perk”). It is unlikely that the word COSMETICS will be spoken in oral use of the opposed mark, since it is a simple description of the relevant products; the opposed mark will be pronounced LER-KLAIR (to rhyme with “air”). Overall, there is a low degree of aural similarity with the earlier mark.

44) In his witness statement Mr Sebban states (at paragraph 24) that “The term LECLERC refers to a famous French surname which comes from 'le clerc', i.e. 'the clerk', occupational name for a scribe or secretary. One can encounter great variation in the spelling of French surnames. The spelling of the names was not yet standardised during the early development of the written French language and spellings would change according to region. Variations of the name Leclerc included Leclair”. In its final submissions the Opponent states (at paragraph 37) that “Conceptually, the signs coincide in the words LECLERC / LECLAIR, which refer to a famous French surname”.

45) The Applicant counters (at paragraph 13 of its submissions) that “it is reasonable to assume that the English-speaking public's awareness of the French language would extend to the understanding that the French word 'le' translates as 'the'. However, it would be fanciful to jump to the conclusion that consumers would immediately perceive T.LECLERC as a French surname or translation of the word clerk. Equally, it would be unrealistic to generalise that consumers would know that the word "Clair" in French means light in the context of colours or clear in the context of an explanation. Rather, it is more likely that English-speaking consumers would perceive a variation of spelling for the common name for a girl: Claire”.

46) Like the Applicant, I reject the suggestion that the average consumer of cosmetics in the UK would have sufficient understanding of the origins of French surnames to perceive LeClair as a spelling variation of the name LeClerc. On the other hand, nor do I think that the consumer will necessarily associate the Applicant's mark with the female forename Claire. I do not consider that the average

UK consumer would necessarily see the word LECLAIR as a name. I think that some consumers may perceive it as a word of potentially French origin, but I do not consider that the average consumer, encountering it, for example, in a shop, online, or in an advertisement, will analyse it as being in particular a personal name, or a place, or a word the meaning of which he or she is unfamiliar with, or an invented word; they will simply perceive it, without further thought, as a cosmetics brand.

47) Similar considerations apply in respect of the word LECLERC, though I think that placing an initial T followed by a full stop before it, as in the Opponent's mark, makes it more likely that it will be perceived as a name. Even if the earlier mark is perceived as a name, however, it has no clear and immediately recognisable semantic content⁷; and neither does the opposed mark. Even where consumers perceive the marks as containing elements of potentially French origin, this would be too tenuous a concept to give rise to any material conceptual similarity (there are in any case numerous French brands on the UK cosmetics market). Overall, there is neither conceptual similarity nor conceptual dissimilarity between the marks.

The distinctiveness of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined*

⁷ On the conceptual analysis of names see the observations of the General Court in *Luciano Sandrone v EUIPO*, Case T-268/18, at paragraphs 85-86.

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).”

49) I find that T.LECLERC, being neither descriptive nor allusive of cosmetic goods, has a reasonably high degree of inherent distinctiveness when used in respect of those goods. The Opponent submits that this inherent distinctiveness (or, more precisely, “the inherent distinctiveness of the element LECLERC”⁸) has been strengthened by the use made of it, as outlined in the witness statement of Mr. Sebban. I have considered the evidence of sales and advertising sufficient to establish genuine use of the earlier mark in the EU; but while I bear in mind the sales efforts evidenced for Marks & Spencer and other UK outlets, and while the relevant UK sales figures are not insignificant, their impact, and that of the promotional expenditure shown, can only be regarded as limited when considered against the background of what must be a vast UK market for cosmetics (the UK being the market on which confusion is to be assessed in these proceedings). Consequently, I consider that it falls well short of what is required to show that the mark’s distinctive character has been materially enhanced beyond what I have already found to be its reasonably high degree of inherent distinctiveness.

⁸ See paragraph 50 the Opponent’s submissions filed on 16 May 2019.

Likelihood of Confusion

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

51) I have found as follows:

- The average consumer of cosmetic products will be a member of the general public.
- The purchasing act is likely to be primarily a visual one, though aural considerations may play a part.
- The purchasing process will be a normal, reasonably considered one, the level of attention being neither higher nor lower than the norm.
- The goods are identical (or, even if not identical, they are in any case highly similar).
- There is a fairly low degree of visual similarity, a low degree of aural similarity, and neither conceptual similarity nor conceptual dissimilarity between the Applicant's and the Opponent's marks.
- The earlier mark has a reasonably high degree of distinctiveness.

52) I have explained that I reject the Opponent's contentions that the initial letter T "is barely noticeable in the Earlier Mark", and that "the distinctive words LECLERC and LECLAIR will catch the attention of consumers and will be remembered more than the letter T which is insignificant". On the contrary, I have found that the

initial T and full stop, which precede the rest of the earlier mark without a gap, play an integral role in, and contribute to, the mark's overall impression. Moreover, the endings of the marks – ERC and AIR respectively – are quite different. Even allowing for imperfect recollection, these differences will not be overlooked. The marks will not be mistaken for each other, even though used on identical goods. There will be no direct confusion.

53) Sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis, QC, explained (at paragraph 16) that indirect confusion can occur where the consumer has actually recognised 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". In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 (at paragraph 81), Mr James Mellor, QC, sitting as the Appointed Person, warned that the tribunal should guard against undertaking too detailed an analysis of what should be an emulation of an instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier mark in mind.

54) I have asked myself whether, despite recognising that the marks are different, and bearing in mind the principle of imperfect recollection and that I have found the earlier mark to have a reasonably high degree of distinctiveness, the consumer might perceive LECLERC to have significance independently of the whole mark T.LECLERC and, misremembering LECLERC for LECLAIR (or *vice versa*), be misled into believing that there was a connection between the respective undertakings⁹. I have come to the conclusion that this is not likely in this case. Firstly, although the elements LECLERC and LECLAIR begin identically, I consider that their endings are sufficiently different both visually and aurally to militate against such confusion, even allowing for imperfect recollection and even when used on

⁹ This was the situation considered by Arnold J in *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589 (Ch).

identical goods. Secondly, I think the consumer will in any case perceive the initial T. of the earlier mark as an integral and distinctive part of that mark, and will not intuitively regard its presence or absence from a mark as simply indicating the use of variant marks. Accordingly, I find that there is no likelihood of either direct or indirect confusion.

Outcome

55) The opposition fails in its entirety.

Costs

56) The Applicant has been successful and is entitled to a contribution towards its costs. In making my award I bear in mind that the Applicant's analysis of the Opponent's evidence of use was very brief. I hereby order Visiomed to pay LeClair Cosmetics the sum of £1,100. This sum is calculated as follows:

Preparing a statement and considering the other side's statement	£400
Considering the other side's evidence	£300
Preparing written submissions	£400

The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of November 2019

**Martin Boyle
For the Registrar,
The Comptroller-General**