

O-695-19

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3372434
BY CHLOE CANNON AND JESSICA BURKE
TO REGISTER

Eden Aesthetics

AS A TRADE MARK IN CLASS 44

AND

OPPOSITION THERETO
UNDER NO. 600001138
BY THE BARONS EDEN GROUP LIMITED

Background and pleadings

1. On 04 February 2019, Chloe Cannon and Jessica Burke (“the applicants”) applied to register the trade mark shown below under number 3372434:

Eden Aesthetics

2. The application was published for opposition purposes on 12 April 2019 for the following services in Class 44 (“the contested services”):

Cosmetic treatment.

3. The Barons Eden Group Limited (“the opponent”) filed a notice of opposition under the fast-track opposition procedure on 5 June 2019. The opposition, which is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the services in the application. The opponent relies upon the following UK trade mark:

Mark: Eden Pure

UK registration no. 3134337

Filing date: 02 November 2015

Goods and services relied upon:

Class 3 Beauty care preparations

Class 44 Spa treatments; beauty salon treatments

4. The applicants filed a counterstatement denying the grounds of opposition. As these are the only submissions I have from the applicants, they are reproduced below in full:

“We are medical professionals providing only non-surgical procedures. We only fit into section 44. We feel we do not conflict with Eden Pure or spa as we do not provide ‘beauty’ treatments. Our name ‘Eden Aesthetics’ states aesthetics. We are also not based near Eden Pure. We feel, other than ‘Eden’ we are not similar and will not be confused. The Eden Baron Group have also recently changed their name via Company House and does not include the word Eden! We believe that Eden

Aesthetics is in no way direct competition to Eden Pure owned by Eden Baron Group (changed name). We only offer dermaplaning skin care treatments but mainly aesthetics. Eden pure does not offer aesthetics treatments. We are Manchester based, and have not used the title Eden without aesthetics. We feel our name isn't similar even if it has the name Eden as we are differentiated by Aesthetics. Eden Pure do not own the word Eden. Eden Pure are a spa and hotel, we would not be confused. Branding is different”.

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Neither party filed written submissions.

8. The opponent is represented by Rod Trow and the applicants are litigants in person.

DECISION

Sections 5(1), 5(2)(a) and 5(2)(b)

9. The opposition is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act, which read as follows:

“5. (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

10. An earlier trade mark is defined in s. 6 of the Act, the relevant parts of which state:

“6. - (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

11. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration

process more than five years before the application date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Sections 5(1) and 5(2)(a)

12. In order to get an objection under the above sections off the ground, the competing trade marks must be identical. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held, that:

“54 [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer”.

13. Further, I take into account the ruling in *Reed Executive plc v Reed Business Information Ltd*, Court of Appeal [2004] RPC 767, where Jacob L.J. found that ‘Reed’ was not identical to ‘Reed Business Information’ even for information services. He stated that:

“40. It was over “Reed Business Information” that battle was joined. The composite is not the same as, for example, use of the word “Reed” in the sentence: “Get business information from Reed”. In the latter case the only “trade-marky” bit would be “Reed”. In the former, the name as a whole is “Reed Business Information”. The use of capital letters is of some visual significance – it conveys to the average user that “Business Information” is part of the name. If the added words had been wholly and specifically descriptive – really adding nothing at all (eg “Palmolive Soap” compared to “Palmolive”) the position might have been different. But “Business Information” is not so descriptive – it is too general for that.”

14. Both marks have the common word “Eden” at the beginning. The remainder of the applicants’ mark contains the word “Aesthetics” whereas the opponent’s mark contains the word “Pure”. I do not consider that “Pure” is wholly and specifically descriptive. Its

presence is noticeable such that the differences between the competing marks will not be unnoticed by the average consumer. As there is no identity between the competing marks, the opposition under ss. 5(1) and 5(2)(a) is dismissed accordingly.

Section 5(2)(b) – case law

15. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) The average consumer normally perceives the 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 to mind the earlier mark, is not sufficient;

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

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

Comparison of goods and services

16. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia,

their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. The applicants’ contention that they offer dermaplaning, an aesthetic treatment which is distinctly different from the opponent’s services, is irrelevant for the issue of comparison. The correct comparison is between the specifications as they appear on the register: see *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84 and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at paragraph 66. Differences between the actual services offered by the parties, for example, are not relevant unless such differences are apparent from the specifications.

18. The competing goods and services are as follows:

Opponent’s goods and services	Applicants’ services
<u>Class 3</u> Beauty care preparations	<u>Class 44</u> Cosmetic treatments
<u>Class 44</u> Spa treatments; beauty salon treatments	

19. I will begin by comparing the parties’ services in Class 44.

20. The most relevant definition in the *Oxford English Dictionary (OED)* of *cosmetic* is as having power to adorn, embellish, or beautify (*esp.* the complexion)¹. That reinforces my understanding that cosmetic treatments are those services aimed at enhancing one’s physical appearance. As far as I am aware, these treatments will include all types of non-surgical procedures, from facials and skin lightening to Botox and fillers. I find that the phrase *beauty salon treatments* in the opponent’s specification will include those same non-surgical procedures aimed at beautifying the face and body. In this regard, I note the applicants claim that they offer non-surgical

¹ <https://www.oed.com/view/Entry/42208?rskey=wJgwSj&result=1&isAdvanced=false#eid> [accessed 8 November 2019]. It is appropriate for a decision maker to use dictionary references to confirm his or her own understanding of the meaning of words, even where those references are not in evidence: see *Forex*, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, BL O/100/09, at paragraph 16

procedures. Therefore, I consider that cosmetic treatments and beauty salon treatments are identical services.

21. That being the case, I do not consider it necessary to compare either the opponent's *spa treatments* in Class 44 or *beauty care preparations* in Class 3 with the contested services, as it will not place the opponent in a better position in these proceedings.

Comparison of marks

22. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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.”

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

24. The trade marks to be compared are as follows:

Opponent's trade mark	Applicants' trade mark
Eden Pure	Eden Aesthetics

25. The opponent's mark is comprised of the words "Eden" and "Pure" both presented in an ordinary font. The mark has no additional stylisation. Both words contribute to the overall impression of the mark. However, given that the word "pure" means unmixed or unadulterated and is allusive of services which are free from unnecessary or extraneous elements, its relative weight in the overall impression is lesser than that of the word "Eden".

26. The components of the applicants' mark are the words "Eden" and "Aesthetics" both presented in an ordinary font without stylisation. The most relevant definition of "aesthetic" in the *OED* is "designating surgery or dentistry intended to restore or improve a person's appearance; of or relating to such treatment"². I also note that the applicants use "aesthetics" and "aesthetics treatments" descriptively in their counterstatement. Whilst the dictionary definition refers to surgery, it appears from the applicants' own comments that the term is also descriptive in relation to cosmetic treatments. This reinforces my own impression that "aesthetics" would be perceived as descriptive, or at least non-distinctive, by the average consumer. The overall impression will, therefore, be dominated by the word "Eden".

27. Visually, both marks consist of two words, and they coincide in the first part "Eden". In general, the beginnings of the words tend to have more visual impact than the ends on a UK consumer who reads from left to right³. The differences in the marks are the presence of the additional words "Aesthetics" and "Pure" and the length of these words; 10 and 4 letters, respectively. Weighing up the similarities, differences and my assessment of the overall impression, I consider that the marks are visually similar to a medium degree.

28. In an aural comparison, both marks are formed of dictionary words. Both elements of the opponent's mark will be articulated; given the descriptiveness of "Aesthetics", it

² <https://www.oed.com/view/Entry/3237?rskey=h5qWLn&result=1&isAdvanced=false#eid> [accessed 8 November 2019].

³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02 and *Enercon GmbH v OHIM*, T-472/07

is possible that the average consumer may articulate both parts of the applicants' mark or only the element "Eden". The marks coincide in the first word "Eden", pronounced identically. The word "Pure" in the opponent's mark shares no aural similarity whatsoever with the word "Aesthetics" in the applicants' mark. Balancing all the relevant factors, I conclude that the competing marks are aurally similar to a medium degree if both parts of the applicants' mark are pronounced; there will be a reasonably high level of aural similarity if only "Eden" in the applicants' mark is articulated.

29. Conceptually, the competing marks coincide in the word "Eden", which means the abode of Adam and Eve at their creation, or when used metaphorically implies a state of supreme happiness. The inclusion of the additional words "pure" and "aesthetics" in the respective marks do not alter the meaning of the common word "Eden". As I have indicated, "Pure" is likely to be perceived as suggestive of a quality, whilst "Aesthetics" is descriptive. Weighing up the similarities and differences, I consider that the marks are conceptually similar to a reasonably high degree.

The average consumer and the nature of the purchasing act

30. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which these services are likely to be selected by the average consumer.

31. 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".

32. I consider that the average consumer of the services at issue is a member of the general public. These services may be used fairly frequently, at regular intervals or only occasionally depending upon the type of service. The service providers are most likely to be selected after perusal of the internet, catalogues, or visiting traditional outlets. Visual considerations are, therefore, likely to dominate the selection process. These services may also be selected further to word-of-mouth recommendations. In such circumstances, I do not discount an aural element to the process. When making a choice, the average consumer will give attention to customer reviews, the qualifications and experience of the staff, costs (which will vary according to the type of service) etc. They may also book a consultation with the service provider before making the final decision. These factors suggest that the average consumer will pay a medium to a reasonably high degree of attention when making their selection.

Distinctiveness of the earlier mark

33. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

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

34. As the opponent filed no evidence, I have only the inherent position to consider. The earlier mark is comprised of the words “Eden” and “Pure”. I note that the word “Eden” is not suggestive of any characteristics of the services at issue whereas the word “pure” is. I therefore conclude that, as a whole, the earlier mark has a medium degree of distinctive character.

Likelihood of confusion

35. A likelihood of confusion is made on a global assessment of all factors relevant to the circumstances of the case (*Sabel* at [22]). It is necessary for me to factor in the distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion (*Sabel* at [24]). I must also have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). I must also keep in mind the average consumer for the services, the nature of the purchasing process and that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

36. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

37. In my view, the non-coinciding components of the competing marks are sufficiently prominent to avoid direct confusion. That leaves only indirect confusion to be considered.

38. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

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

39. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

40. Earlier in this decision, I concluded:

- That the contested services are identical to the services covered under the opponent’s mark;
- That the services will be selected primarily by visual means, with a medium to a reasonably high degree of attention;
- That the marks are visually similar to a medium degree, aurally similar to a medium or reasonably high degree, depending on how the marks are articulated, and conceptually similar to a reasonably high degree;
- That the opponent’s mark, as a whole, is distinctive to a medium degree.

41. I find that the visual, aural and conceptual similarity arising from the presence of a distinctive common word at the beginning of the marks is enough to cause indirect confusion, even where the marks are aurally similar only to a medium degree and a reasonably high degree of attention is paid to the purchase. The average consumer would think, upon seeing the respective marks, that the marks are variant marks used by the same undertaking or economically linked undertakings to provide the identical services: the presence of the common element “Eden” in both marks outweighs the differences introduced by the less distinctive elements and will lead to indirect confusion. It follows that confusion is only more likely where a lesser degree of attention is paid to the purchase or where there is greater aural similarity between the marks. Accordingly, I find that the average consumer will be indirectly confused in respect of the contested services in Class 44.

Final remarks

42. The applicants have indicated that the opponent does not operate in the Manchester area. However, the opponent’s mark is entitled to protection throughout the UK, which includes the area in which the applicants operate. The registration of the applicants’ mark would also confer UK-wide coverage and, therefore, offend against the opponent’s mark. Even were a geographical limitation applied to the application, the protection to which the opponent’s mark is entitled would extend to the area of the applicants’ use. In those circumstances, I do not consider it appropriate to offer the applicants the opportunity to adopt a limitation and my finding above remains undisturbed.

Conclusion

43. The opposition has succeeded in full. The application will be refused.

Costs

44. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I note both parties did not file evidence. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Total:	£300

45. I order Chloe Cannon and Jessica Burke to pay The Barons Eden Group Limited the sum of **£300**. This sum is to 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 15th November 2019

Karol Thomas
For the Registrar
The Comptroller-General