

O-379-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3426620
IN THE NAME OF ADELE SAVAGE
TO REGISTER AS A TRADE MARK:**

PRETTY SAVAGE

FOR GOODS IN CLASSES 3 AND 21

AND

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 418888
BY PARFUMS CHRISTIAN DIOR**

BACKGROUND AND PLEADINGS

1. On 6 September 2019 (“**the Relevant Date**”), Adele Savage (“**the Applicant**”) applied to register the words “PRETTY SAVAGE” as a UK trade mark in respect of goods in classes 3 and 21. The application was published for opposition purposes in the Trade Marks Journal on 20 September 2019. After restriction by the Applicant, the specified goods are as follows:

Class 3: *Soaps, cakes of soap, wax melts, scented wax melts, exfoliants, body butters; body scrubs, bath salts, bath preparations, solid objects for use in bathing and showing¹ which effervesce when wet, shampoos, shampoo bars, preparations for the care of hair.*

Class 21: *Dishes for soap, soap holders.*

2. Parfums Christian Dior (“**the Opponent**”) filed a Form TM7 notice of opposition, seeking refusal of the application in its entirety. The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”).
3. For its claims under **sections 5(2)(b) and 5(3)** the Opponent relies on the following international registration designating the European Union:

“The Opponent’s Mark”:

International registration (IR) No. WE00001218251 designating the EU in respect of the trade mark:

“SAUVAGE”

Date of international registration and designation of the EU: 2 July 2014

Date protection granted in EU: 17 August 2015

Registration is based on a trade mark filed originally in France, with a priority date of 13 January 2014.

¹ I take this to be a mistyping of the word “showering”.

The Opponent relies for both grounds only on the following goods from its registration:

Class 3: *cleaning preparations²; perfumery products, particularly perfumes, toilet water, eau de Cologne, essential oils; cosmetic products, cosmetic products for face and body care, particularly creams, serums, oils, deodorants for personal use; perfumed body, bath and shower gels, milks; soaps; shaving products.*

4. The Opponent claims that it owns an earlier mark under the Act, that the parties' marks are similar, and that their goods are identical or similar such that there is a likelihood of confusion whereby the relevant public will believe that the marks are used by the same undertaking or think that there is an economic connection between the users of the trade marks.
5. It also claims that the Opponent's Mark benefits from a reputation for the goods relied on such that use of the Applicant's mark would take unfair advantage of, or would be detrimental to, the reputation and distinctive character of the Opponent's Mark. It claims in particular:
 - i. that the Opponent has established a substantial goodwill and reputation in connection with its mark and that the Applicant is trading on the back of this goodwill and reputation such that the Applicant could increase its own sales of products bearing the mark applied for without having had to make the associated investment; the Applicant's marketing could be made easier by association with the Opponent's mark, thereby gaining an advantage that is unfair advantage;
 - ii. that detriment could be caused to the reputation of the Opponent's Mark since the Opponent has no control over these Applicant's activities or the quality of the goods to which the mark applied for may be applied. It claimed that use of the mark applied for could have a negative influence on the reputation of the Opponent's Mark, diminishing its power of attraction, and that the Opponent's reputation could be harmed and tarnished as a result of a connection being made by the consumer between the goods offered by the respective parties;
 - iii. that use of the mark applied for could cause dilution and blurring of the distinctive character of the Opponent's Mark, weakening of its ability to identify the goods for which it is registered and used as coming from the Opponent; the consumer could not quickly

² It is noted that the registered specification is for "*cleaning, polishing, degreasing and abrasive preparations*;" not 'cleaning preparations' alone.

or accurately identify the source of the goods and this could affect the decision making of the consumer in the purchasing process.

6. For its **section 5(4)(a)** ground, the Opponent claims to have used the sign “SAUVAGE” (“**the Opponent’s Sign**”) throughout the UK since 2015, in relation to:

“perfumery products; fragrances, perfumes, eau de toilette, body spray, aftershave lotion, aftershave balm, bath and shower gel, shower soap; deodorants; moisturisers”

The Opponent thus claims to be the proprietor of an earlier right; it claims that use of the Applicant’s mark in relation to any of the applied-for goods would be actionable on the basis of the tort of passing off. It claims that the Applicant’s mark is confusingly similar to the Opponent’s Mark such that the consumer will be deceived as to from where the goods bearing the applied-for trade mark originate, and that the Opponent will suffer damage as a result of loss of sales and a negative effect on its goodwill and reputation.

The Applicant’s defence

7. The Applicant filed a Form TM8 notice of defence, including a counterstatement from which I note the following points:
- i. in relation to the **section 5(2)(b)** claim, the Applicant highlighted certain goods in Class 3 which it admitted to be identical or similar – I refer to these where I deal with comparison of the goods. It denied any similarity in relation to its goods in Class 21;
 - ii. that PRETTY SAVAGE hangs together as a complete sign and it would be unlikely that the average consumer for these types of goods would extract an element of it to confuse with the earlier but different term SAUVAGE;
 - iii. on the same reasoning, the Applicant denied that any link would be made between the marks for the purposes of the **section 5(3)** claim;
 - iv. it denied the claimed substantial goodwill or reputation for the goods for which it is protected;
 - v. it stated that absence of control is not a sufficient basis for asserting detriment and the allegation of detriment is “pure speculation”;
 - vi. the consumer will have no difficulty distinguishing the marks and the Applicant has in any event due cause to use the SAVAGE name as it is her surname and she would have an own name defence in the event of an infringement claim;

- vii. in relation to the **section 5(4)(a)** claim, the Applicant put the Opponent to proof of its goodwill, denied any misrepresentation and denied that use of the Applicant's mark would cause damage.

Papers filed, representation and hearing

8. During the evidence rounds both parties filed evidence in chief and the Opponent filed evidence in reply; I give a summary below. The Applicant requested an oral hearing, which took place before me by video conference on 16 July 2020. The Applicant is represented by Lucas & Co, with Barbara Cookson representing at the hearing. The Opponent is represented by D Young & Co LLP, with Jackie Johnson representing at the hearing. Both sides filed skeleton arguments in advance. I take this decision having carefully read all papers filed, and shall refer to points from the evidence and from submissions where and to the extent that I consider it warranted.

EVIDENCE

9. The **Opponent's evidence in chief** comprises a **witness statement** of **Céline Fourniol** dated 20 March 2020, with **Exhibits CF1 - CF14**. Ms Fourniol has been the Opponent's Head of IP since January 2017 and gives evidence based on her personal knowledge or from the Opponent's records. Her evidence refers to Dior having launched *Eau Sauvage* in 1966, which remains among the best-selling men's fragrances in Europe, and that in 2015 Dior launched a new fragrance line under the brand "Sauvage", promoted with Johnny Depp as the face of the line.
10. **Exhibit CF2** shows screenshots from the UK-facing Dior website, where Sauvage-branded products offered for sale (retailing in pounds sterling) include after-shave lotion and balm, deodorant, shower gel, moisturizer, and a bar of black charcoal soap (£40) marked as "#New". The exhibit also shows the same sort of range of products as offered under the Opponent's "EAU SAUVAGE" trade mark, including on soap (£20). These initial screenshots are not dated, but at pages 20 - 23 there are screenshots of the French website from 2015 – May 2019 promoting the Sauvage-branded "parfums pour homme"; Ms Fourniol confirms such promotions also reflect the UK website at that time. The historical screenshots do not make clear what products were offered under the range.

11. **Exhibit CF3** shows numbers of visitors to Sauvage product pages on the UK version of the website from September 2015 – January 2019. Numbers range between particular products and years from a few hundred visits to a few thousand - for example, over 2200 visitors for Sauvage shower gel in 2018, rising to nearly 4000 in January 2019. Numbers for the Sauvage eau de toilette are of a notably higher - over 50,000 visits in 2017 to nearing 90,000 in January 2019. Certain products are marked as not yet launched (for example the Sauvage all-purpose moisturizer had not been launched by the end of 2018). The exhibit makes no reference to soap.
12. Ms Fourniol states that the Sauvage products are available to purchase at the stores and websites of various well-known high street retailers. **Exhibit CF4** comprises website screenshots from 2020 showing Sauvage eau de toilette and eau de parfum for sale in stores such as Boots, Debenhams and Selfridges and to have been for sale at John Lewis since November 2015. **Exhibit CF7** shows representative invoices 2015 – 2018 relating to Boots, House of Fraser and Debenhams. The invoices show products under the Opponent’s Mark, including Sauvage aftershave balm lotion, Sauvage shower gel and (in 2015) deodorant spray/stick; some of the invoices also highlight distribution of *Eau Sauvage* products.
13. **Exhibit CF5** is *Daily Mail* article dated 29 November 2019 reporting that Dior Sauvage appeared to be the top-selling male scent for Christmas 2019. **Exhibit CF6** states retail figures “for Sauvage products in UK” indicating invoiced turnover of over 20 million EUROS in 2016 to over 50 million EUROS in 2019. The exhibit does not show what the products were, although from the other evidence, there seems little doubt that the products were predominantly the fragrances i.e. eau de toilette/parfum/aftershave.
14. Ms Fourniol provides evidence on the Opponent’s advertising and promotional expenditure. **Exhibit CF8** is presented to show annual advertising spend in creating and producing the advertising campaigns for Sauvage products between 2014 and 2019. The sums (in EUROS) range from nearly 3 million (2015), to over 6 million (2016), to nearly 10 million by 2019. Whereas the figures of Exhibit CF8 are on a worldwide basis; **Exhibit CF9** gives annual “media investment specifically in the UK for Sauvage products between 2015 and 2019”. These sums exceed the development costs per Exhibit CF8 and run to 5.7 million pounds annually 2016 – 2018 and over 7 million pounds in 2019.

15. **Exhibit CF10** shows example print and film campaigns for Sauvage between 2015 and 2019, such advertisements stated to have featured across all forms of media, including magazines, newspapers, television and internet UK and worldwide. **Exhibit CF11** shows at least some UK media attention to the involvement of Johnny Depp in the Sauvage campaign (for example an article in GQ in 2015).
16. **Exhibit CF12** shows social media postings by the Opponent and by Dior, including Instagram, Facebook and Twitter. For example, the Opponent has over a million followers on Instagram with over 87,000 Facebook likes for a posting of the Sauvage parfum and on YouTube over 1.65 million views (presumably worldwide) since September 2015 for the Dior Sauvage Johnny Depp video.
17. Ms Fourniol provides evidence of third party media coverage and awards. **Exhibit CF13** presents articles referencing Sauvage products from publications including Esquire, Grazia, The Sunday Times, Hello! Marie-Claire. **Exhibit CF14** shows various awards of recognition in relation to the Opponent's Mark: it shows that Sauvage by Dior won at the Fragrance Foundation Awards 2016 (declared to be known as the 'Oscars' of the fragrance industry) in the Best New Male Fragrance category and the Ultimate Launch category; Sauvage Very Cool spray won People's Choice for Men with Boots.com and Readers' Choice for Men with Men's Health (2018); and Sauvage Dior eau de parfum won Readers' Choice for Men The Evening Standard (2019).

Applicant's evidence

18. The Applicant's evidence comprised a **Witness Statement** dated 12 May 2020 by **Adele Savage** with **Exhibits AS1** and **AS2**. Ms Savage states that under the applied-for mark, which reflects her name, she sells handmade soap, bath bombs and wax melts, having set up a Facebook and UK domain using the sign created in October 2018. She explains that wax melts are like little candles which instead of using a wick are placed over a heater to melt and which are often used at bath time to create a pleasant atmosphere. Her evidence refers to the scale of the soap market in the UK: **Exhibit AS1** is an article dated 8 August 2019 published by the market research firm Kantar, showing UK sales of nearly 70 million pounds in first half of 2019. It refers to luxury brands embracing the trend towards bars of soap. Ms Savage admits the likelihood that the Opponent has goodwill and reputation in the UK for Sauvage in respect of men's fragrance (only), but argues that whereas everyone

uses soap of some description, the markets for soap and men’s fragrances are completely different. **Exhibit AS2** shows information from Kantar Media/Statista published in 2019 on sales numbers of certain brands of bars of soap in 2018 – neither Dior nor Sauvage is listed among those 40 or so soap brands.

The Opponent’s materials in reply

19. The Applicant filed a witness statement dated 9 June 2020 by Natasha O’Shea, an attorney with the Opponent’s representatives. She presents as **Exhibit NO1** the results of an internet search showing that it is common for luxury brands (including Chanel, Tom Ford and Hermès) to offer both fragrances and body products, including soaps.

DECISION

Status of the Opponent’s Mark

20. Section 6(1)(a) of the Act defines an “earlier trade mark” as:

“a registered trade mark, international trade mark (UK) or European Union 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.”

21. The Opponent’s Mark thus qualifies as an earlier trade mark within the definition of section 6(1) of the Act. The protection process for the Opponent’s Mark was completed less than five years before the Applicant filed her contested trade mark application; the Opponent’s Mark is consequently not subject to the proof of use provisions in section 6A of the Act, so the Opponent may rely on the goods protected by the earlier registration without having to prove use.

The section 5(2)(b) claim

22. Section 5(2)(b) of the Act, reads as follows:

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

(a) [...]

(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.

23. Determination of a section 5(2)(b) claim must be made in light of the following principles, which 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. The principles are:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

24. The goods to be compared are as follows:

The Applicant's goods	The Opponent's goods
<p>Class 3: <i>Soaps, cakes of soap, wax melts, scented wax melts, exfoliants, body butters; body scrubs, bath salts, bath preparations, solid objects for use in bathing and show[er]ing which effervesce when wet,</i></p>	<p>Class 3: <i>cleaning preparations; perfumery products, particularly perfumes, toilet water, eau de Cologne, essential oils; cosmetic products, cosmetic products for face and body care, particularly creams, serums, oils, deodorants for personal use; perfumed body, bath and shower gels, milks; soaps;</i></p>

<i>shampoos, shampoo bars, preparations for the care of hair.</i>	<i>shaving products.</i>
Class 21: <i>Dishes for soap, soap holders.</i>	

25. In *Gérard Meric v Office for Harmonisation in the Internal Market* the General Court stated that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.³ This well-established inclusion principle contributed to the admissions by the Applicant in its counterstatement that the following goods (colour corresponded in the above table) are identical or may be considered identical.

Soaps, cakes of soap – identical to the Opponent’s *soaps*

exfoliants, body butters – included within and therefore identical to the Opponent’s

cosmetic products, cosmetic products for face and body care

body scrubs, bath salts, bath preparations - the latter term in particular wide enough to include the Opponent’s *perfumed body, bath and shower gels, milks, which may therefore be considered identical.*

26. In determining the extent to which the goods may be considered similar, I take account of the factors identified by the Court of Justice of the European Union (“the CJEU”) in *Canon*⁴ where it stated that:

*“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. 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”.*⁵

³ Case T-133/05 at paragraph 29

⁴ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97C-39/97, at paragraph 23.

⁵ The essence of case law points on similarity made in relation to goods applies correspondingly to services.

27. In *Boston Scientific*⁶, the General Court described goods as “complementary” in circumstances where “... *there is a close connection between [the goods], 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*”. I also take note that in *Kurt Hesse v OHIM*⁷, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.
28. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁸ 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.
29. In relation to its *wax melts, scented wax melts* Ms Jackson submitted that they are “identical or at least highly similar” to the Opponent’s *perfumery products, particularly perfumes, toilet water, eau de Cologne, essential oils*. I find that there is an overlap of purpose between the goods in that both perfumery products and wax melts may fragrance a room, and there is likely to be an overlap in the relevant public and distribution channels. There are also differences in their physical natures and methods of use. In my view, those goods are similar to a medium degree.
30. The term *solid objects for use in bathing and show[er]ing which effervesce when wet* describes what are also known as bath bombs, or their shower equivalents. They are used

⁶ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

⁷ Case C-50/15 P

⁸ *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

when one bathes or cleans oneself in the shower, providing a pleasant scent and they overlap in their intended purpose and method of use with the Opponent's *perfumed body, bath and shower gels, milks and soaps*. Those goods also share users and may be sold in the same places and one may choose one product over the other so involve a degree of competition. I find those goods may be considered similar to a high degree.

31. The Applicant's *shampoos, shampoo bars, preparations for the care of hair* are similar to a medium degree to the Opponent's *perfumed body, bath and shower gels, milks and soaps* since, for example, shower gels and shampoos overlap in nature, method of use, users, and are sold alongside one another.
32. The Applicant submitted that its goods applied for in Class 21 are dissimilar to the goods relied on by the Opponent. Certainly, the goods are quite different - for example, in physical nature, purpose and method of use, but I must consider whether there may be an element of complementarity between soap and a dish for soap. The purpose of examining whether there is a complementary relationship between goods is to assess whether the relevant consumers are liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings. While soap is centrally important for the use of a soap dish I do not think that the average consumer would think that the responsibility for those goods lies with the same undertaking; nothing in the evidence suggests otherwise. Daniel Alexander Q.C., as the Appointed Person stated in his decision in BL-0-255-13: "*It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes*" and "*... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.*"⁹ I therefore agree that the goods are dissimilar in Class 21. If I am wrong on that, any element of complementarity between soap and dishes for soap; soap holders would give rise only to a low degree of similarity.

The average consumer and the purchasing process

33. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select the goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in

⁹ *Sandra Amalia Mary Elliot v LRC Holdings Limited* (at paragraphs 18 and 21).

question.¹⁰ In *Hearst Holdings Inc*,¹¹ 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 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 word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”

34. The average consumer in this case will be drawn from the general public. The goods at issue may be bought in supermarkets, department stores, chemist’s and beauty stores and so on. The online equivalents of such businesses are also relevant. A consumer will peruse shelves and browse the internet to select the goods. Therefore, I consider the purchase to be a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations and requests, so I also take into account the aural impact of the marks in the assessment. Some soaps and toiletries of the type applied for in Class 3 may be more luxurious, but in general terms they are goods bought with a certain regularity and are not expensive. Consumers may be likely to check that the goods are compatible with their own needs and tastes (such as allergens and scents). I find that the average consumer will take no higher than a medium or average level of care in selecting the contested goods in this case. Perfumery products such as eau de cologne are typically bought with less frequency and at greater expense and may therefore engage a higher level of attention.¹²

Comparison of the marks

35. It is clear from *Sabel* 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 in *Bimbo* that: “.....it is necessary to ascertain, in each

¹⁰ *Lloyd Schuhfabrik*, cited above

¹¹ *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),

¹² I make this point in relation to the Opponent’s goods noting that an assessment of a likelihood of confusion must allow for potential confusion in either direction (as between the parties’ goods).

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

The Opponent’s Mark	The Applicant’s mark
SAUVAGE	PRETTY SAVAGE

37. The overall impression of the Opponent’s Mark of course resides in the single word “SAUVAGE” which has no meaning in English. The Applicant’s mark comprises the two ordinary English words “PRETTY” and “SAVAGE”. Ms Jackson submitted that the word “PRETTY” is a qualifier that does not significantly differentiate the marks and that the word should be considered as non-distinctive; I shall return to this point when I consider the likelihood of confusion. For now, I record my view that although the first word of the Applicant’s mark describes the second, in my view, each makes a roughly equal contribution to the overall impression of the mark, forming a phrase, with neither word standing out more than the other.
38. Visually, there is similarity between the marks in that the Opponent’s Mark includes all six letters of the second component of the Applicant’s mark. However, even though those letters are maintained in the same order, they are interrupted by the addition of the extra letter “U”, which has a visual impact, changing the word and its likely perception for the average consumer. Moreover, the first half of the Applicant’s mark is the additional word “PRETTY”, which does not feature in the single-word mark relied on by the Opponent. In my estimation, the respective marks are visually similar to a degree between low and medium.
39. Any aural similarity rests on the extent to which the second word of the Applicant’s mark aligns phonetically with the Opponent’s Mark. The word “SAVAGE” is an ordinary English

word that will be pronounced as “SAV-IJ” (with a hard “SA” sound is as in ‘sand’ and the IJ sound approximates to the AGE sound in the pronunciation of “cabbage”). The spoken emphasis is on the first of the two syllables – “SAV-IJ”. The Opponent’s Mark is a not an English word; it is a French word. In my view, the average consumer, even having little or no understanding of French, will likely say the word in line with its French pronunciation as, approximately, “SOH-VARJ”, where the emphasis falls more to the second syllable. However, I do not rule out that some of the general public may say the word differently, and pronounce the letters “AU” in line with their pronunciation in English words – perhaps as “OR” as in “sauce”, or as “O” (as in on’) as in “sausage”. Likewise the second syllable “AGE” may be pronounced as it is pronounced in the applied-for mark (“IJ”), or possibly as “AYJ” (as in “rage”). If the Opponent’s Mark is pronounced SOH-VARJ then the aural similarity with the applied-for mark (PRI-TEE SAVV-IJ) is very low. Even assuming a pronunciation of the Opponent’s Mark as SOR-VIJ (or as SOV-IJ), in my view there is an aural similarity that could - at most – be considered as to a degree between low and medium.

40. In relation to the conceptual similarity between the marks, Ms Jackson stated that the earlier Mark translates into English as "wild" or "savage". Ms Jackson submitted that the public has a degree of understanding of the French language and will therefore consider the marks to have the same meaning. By contrast, Ms Cookson submitted that the Opponent’s Mark will be seen as “a fancy French word”, not having “much of a concept”.
41. In my view, a relatively small minority of the UK public will have a sufficient understanding of the French language to immediately and reliably translate that French word to its English equivalent. I allow that even for those among the UK public who do not possess that level of fluency in French, the overlap between the words may permit a guess that the French word SAUVAGE can translate as the English word SAVAGE. For others, perhaps a majority, the Opponent’s Mark will be perceived to carry no particular concept or else none beyond it simply being a French word, or at least a non-English word. This latter construction aligns with the view offered by Ms Cookson. I find that for any portion of the general public that I have just described, the word will be perceived as a word that is not English, even if some consumers may then able to ascribe a concept to it.
42. Ms Cookson submitted that the word SAVAGE in the Applicant’s mark will more likely be seen as carrying the concept of a name – thus someone who has the surname of the Applicant and is pretty. Alternatively, Ms Cookson submitted that the Applicant’s mark would

be perceived as carrying the juxtaposition of the concept of a fierce or untamed being who is also pretty. Ms Jackson submitted that the word PRETTY could be taken to mean “quite”. Although I recognise that SAVAGE can be a surname, it seems to me more likely that the average consumer will give the word its ordinary meaning in English and will therefore conceive of either a wild/fierce being that is also good-looking - which in the context of the body-focus of the goods may be the more likely concept - or else of a phrase meaning ‘quite wild/fierce’.

43. The upshot of this analysis is that I find that the Opponent’s single-word mark has either no real concept to the average consumer, or the concept of a non-English word, likely French, which a minority may perceive to translate into English as ‘wild’ or ‘savage’. By contrast the Applicant’s mark carries a clear and immediate playful concept using English words signifying a good-looking wild person, or else someone or thing that is quite/rather wild/fierce. There is at most a low degree of conceptual similarity between the marks.

Distinctive character of earlier trade mark

44. The distinctive character of the earlier mark must be considered. In *Lloyd Schuhfabrik*¹³ 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

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

¹³ *Lloyd Schuhfabrik*

and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

45. The earlier mark is not a word in the English language; it has no obvious connection to the goods relied on and is inherently distinctive to a good degree. Moreover, the evidence shows significant expenditure and output in the promotion of the mark, notably in relation to men’s fragrance so that it was one of the most popular scents for men in 2019. I am satisfied that the use of the Opponent’s Mark has enhanced its distinctiveness for goods that are men’s fragrances – eaux de toilette/parfum/cologne, aftershave and probably body spray, noting the evidenced recognition for the Very Cool Spray (**Exhibit CF14**). The Opponent’s mark may therefore be considered very highly distinctive for men’s fragrances, which goods are reflected in the specification as *perfumery products, particularly perfumes, toilet water, eau de Cologne* and *shaving products* and (arguably) *deodorants for personal use*. I also accept that such fragrance goods are sometimes complemented by other toiletry goods – this is borne out for example by the evidence at **Exhibit NO1**, and the invoices at **Exhibit CF7** show the supply of shower gel and deodorant under the Opponent’s Mark (Sauvage). However, there is nothing to indicate the scale on which these ancillary goods have sold or been promoted. Nothing suggests that there is any significant market share for more ordinary, and more commonly purchased goods such as shower gel, deodorant or soap. Nonetheless, I am prepared to extend the reach of the enhancement through use to shower gel and deodorant, which appear at least to have been offered for sale on the UK-facing Dior website (**Exhibit CF2**) and which feature in the invoice evidence. However, I am doubtful that the enhancement can be said to extend to soap, since the evidence appears to show that by the Relevant Date there had been no use of the Opponent’s Mark for soap (**Exhibits CF2** and **CF3**).
46. Ms Jackson, as part of her submissions around the distinctiveness of the Opponent’s Mark, also referred to the Opponent’s longer-standing use of another mark - EAU SAUVAGE. Ms Cookson acknowledged a mark may acquire a distinctive character as a result of it being used as part of, or in conjunction with, another mark,¹⁴ but argued that the older, Eau Sauvage sign was a different mark and one on which the Opponent could have relied, but had chosen not to. In my view it is possible for the Opponent’s Mark “SAUVAGE” to benefit

¹⁴ This is in line with case law principles such as expressed by the General Court in *China Construction Bank Corp. v EUIPO*, Case T-665/17 (at paragraph 52 of the judgment).

in some degree from the EAU SAUVAGE use; insofar as EAU SAUVAGE may have been used in relation to eau de toilette, eau de parfum or eau de cologne, then its “SAUVAGE” component may be considered more distinctive than its EAU component.¹⁵ In this case I do not think it makes a material difference, because I have already found that the Opponent’s Mark is very highly distinctive for men’s fragrances, taking account of the enhancement through use in its own right.

47. A further question arises as to whether the use of the EAU SAUVAGE sign may have implications for the extent of the goods in respect of which the Opponent’s Mark could be considered to benefit from enhancement of its distinctiveness through use. I have found that in relation to all of its registered goods the Opponent’s Mark is *inherently* distinctive to a good degree, and that for some of its goods, its distinctiveness has been enhanced through use, so that it is very highly distinctive for men’s fragrances. I have particularly excluded soap from the scope of that enhancement since SAUVAGE had not been used for those goods by the relevant date. There is some evidence that soap had been offered under the EAU SAUVAGE sign by the Relevant Date, but there is no evidence of the scale of those soap sales or their promotion. I do not accept that use of that (different) sign in relation to soap has served to enhance the distinctiveness of Opponent’s Mark (Sauvage solus) for such goods; however, if the point is in doubt, and given that soap is a central aspect of the goods applied for, I shall consider the alternative possibility as part of my global assessment of likelihood of confusion below.

Assessment of likelihood of confusion

48. Some similarity between the goods is a necessary criterion required by section 5(2)(b); since my primary finding is that the Opponent’s goods are dissimilar to those applied for in Class 21, the Opponent’s claim under this ground must fail in respect of those goods.
49. Turning to the goods applied for in Class 3, my global assessment of likelihood of confusion in relation 3 must take account of the various principles from case law outlined in paragraph 23 above and of my findings set out in the foregoing sections of this decision, which may be summarised as including the following:

¹⁵ This premise being also in line with the CJEU ruling in *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, albeit that that ruling concerned the absolute grounds provisions of the relevant Directive.

- i. the parties' goods in Class 3 include some that are identical – soap for instance – and some that are similar to a medium or high degree;
 - ii. the average consumer is a member of the public and, for most of the goods, the purchasing process will entail a level of attention no higher than a medium/average, but the attention level may be higher than that for certain perfumery products (such as eau de cologne);
 - iii. the consumer will primarily encounter the marks visually and I have found the marks to be visually similar to a degree that is between low and medium;
 - iv. the consumer may also encounter the marks by oral recommendation or reference, and there is an aural similarity that could - at its highest – be considered as to a degree between low and medium;
 - v. there is at most a low degree of conceptual similarity between the marks;
 - vi. for all of its registered goods, the Opponent's earlier trade mark has, on an inherent basis, a good degree distinctiveness and the evidence is sufficient to establish enhancement of its distinctive character on the basis of use, certainly in respect of men's fragrances, which appear the focus of the Opponent's use. As to the toiletry goods that may be sold as part of the fragrance range, I have allowed shower gel and deodorant to be encompassed by the reach of the enhancement through use; however, my primary finding is that the distinctiveness of the Opponent's Mark does not benefit from enhancement in relation to soap. Nonetheless, in case I am wrong about that, I will consider the position based on the premise that the Opponent's Mark benefits from some degree of enhanced distinctiveness across all of the goods relied on (even if the highest level of distinctiveness attaches only to the men's fragrances such as the cologne or eau de toilette).
50. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.
51. Consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties.¹⁶ It is clear from case law that actual confusion

¹⁶ See *Oakley v OHIM* (Case T-116/06) at paragraph 76.

is not the issue for section 5(2) claims.¹⁷ Reference by the Applicant as to the absence of any actual confusion between the parties to date is thus of no material assistance. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public.¹⁸

52. The factors in the global assessment of likelihood of confusion involve a measure of interdependency, such that, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods. Even allowing for the possibility that a mark may be imperfectly recalled and that marks are rarely directly compared side by side, I find no likelihood that the average consumer, deemed reasonably well informed, and reasonably circumspect and observant, will mistake one mark for the other. The Applicant's mark comprises two English words, the Opponent's Mark a single non-English word. I have borne in mind the distinctiveness of the Opponent's Mark, but in my view the differences between the marks are such that even were the marks used in relation to goods that are identical, **there will be no direct confusion.**

53. I turn therefore to consider whether there is a risk of indirect confusion. Iain Purvis QC, sitting as the Appointed Person, considered indirect confusion (and the difference between direct confusion) in *L.A. Sugar Limited v By Back Beat Inc*,¹⁹ stating as follows:

"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 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.

¹⁷ For example, see paragraph 78 of the judgment of Kitchin L.J in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

¹⁸ Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34. See too Mann J at paragraph 27 of *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch), in turn referencing Arnold J in *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch).

¹⁹ Case BL-O/375/10

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

54. At the hearing, Ms Johnson submitted that if the tribunal were to find that there was no likelihood of direct confusion, then it should at least be found that there is a likelihood of indirect confusion, arguing that the first two of the above examples given by Mr Purvis in *L.A. Sugar* applied on the facts of this case. Ms Johnson submitted that “the similar elements are striking and distinctive”, that “PRETTY is a non-distinctive element that has been added to a highly similar Mark” and adding that “overall the consumer will likely conclude that products branded PRETTY SAVAGE are some sort of extension to the existing brand of the Opponent.”

55. Arguing against such confusion, Ms Cookson submitted that the crux of this opposition is the consumer perception of PRETTY SAVAGE; I agree with Ms Cookson on that. Sitting as the Appointed Person in *Eden Chocolat*²⁰, James Mellor QC stated as follows:

“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining²¹ in more formal terms the sort of mental process involved at the end of his [16], he made it

²⁰ Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017)

²¹ In *L.A. Sugar* – above.

clear that the mental process did not depend on the common element alone: 'Taking account of the common element in the context of the later mark as a whole.' (my emphasis)."

56. Notwithstanding the degree of distinctiveness attaching to the Opponent's Mark, it looks and sounds rather different from the applied-for mark. The overall impression of the Opponent's Mark inevitably emanates solely from the word "SAUVAGE", which has no meaning in English. Its non-Englishness (its French-ness) contributes substantially to the mark as a whole.²² Such an aspect is absent from the Applicant's mark, which involves two ordinary English words "PRETTY" and "SAVAGE", which together form a unit or phrase, which is distinctive. Even though there may be a degree of conceptual overlap for those among the average consumer group who discern the Opponent's Mark to translate into English as "savage", the impression is still different, since it involves translation from one language to another – it involves a different word.
57. Moreover, the impression and context of that English word is changed or - to reflect Ms Johnson's description 'qualified' - by the addition of the opening word PRETTY, which I have found to make a roughly equal contribution to the overall impression. The resultant phrase gives rise to an immediately graspable concept that the consumer would likely perceive as indicating a playful notion of a good-looking wild thing. Although I recognise that PRETTY in this context may also be understood as meaning "quite" or "rather", I do not find that that renders it non-distinctive. The reasonably well informed, and reasonably circumspect and observant average consumer would not perceive the applied-for mark as associated with the Opponent's Mark; they would not see it as, for example, and as Ms Johnson suggested at the hearing, "a new range for a feminine or a lighter fragrance" of Opponent's goods. In my view, to reach such a conclusion involves artificial dissection of the trade marks, which is wrong in law. It would require overlooking the fact that the applied-for mark does not include the distinctive word of the Opponent's Mark, but an ordinary English-word "SAVAGE". There is no logical or consistent reason why a highly distinctive single word mark, would change its national character (if I can put it away) and couple with another English word. Viewing the marks as wholes, I conclude that none of Mr Purvis's illustrative formulations applies in this case; indeed I see no basis for finding indirect confusion.

²² Iain Purvis QC, sitting as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, emphasised the importance bearing in mind what it is about the earlier mark which gives it distinctive character (paragraph 39).

58. For completeness, and for the avoidance of doubt, in reaching this conclusion, I have not overlooked the impact of the CJEU's judgment in *Bimbo*,²³ on the court's earlier judgment in *Medion v Thomson*.²⁴ Both *Bimbo* and *Medion* were cited at the hearing. I note that in *Whyte and Mackay Ltd v Origin Wine*, Arnold J (as he then was) said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is *similar* to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

²³ Case C-591/12P, above

²⁴ Case C-120/04, above

59. In line with my reasoning that I set out at some length above, this is not an instance where the principles from *Medion* or *Bimbo* lead to a likelihood of confusion.

Outcome: There is no likelihood of confusion. **The opposition on the basis of the claim under section 5(2)(b) fails.**

The section 5(3) claim

60. Section 5(3) of the Act, reads as follows:

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b). [...]

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 European Union trade mark or international trade mark (EC), in the European Union) 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.

61. And section 5(3A) states:

(3A) “Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

62. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure*, Case C-487/07 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 of 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*).

63. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I “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.”
64. The evidence shows considerable expenditure on promotional activity, the achievement of top sales for men's fragrances, and various awards and recognition relating to the Opponent's Mark. I find that the Opponent's Mark has the reputation component required under section 5(3), in relation to men's fragrance goods, namely those such as eau de toilette and aftershave.
65. Another key component necessary for success under section 5(3) is that the applied-for mark must be apt to provoke a mental link to the earlier reputed mark. Bearing in mind the case law principles listed above,²⁵ in making my global assessment of the relevant factors as to whether a link will be made, I find as follows:
- i. that the reputation attributable to the Opponent's Mark in relation to men's fragrance goods may be considered a strong one;
 - ii. that that reputation attributable to the Opponent's Mark is not directly in relation to the goods applied-for under the Applicant's mark;

²⁵ particularly paragraph 62(d) above

- iii. that in line with the evidence that the reputed goods commonly involve a range of toiletry goods, such as shower and body products, it is possible that there may be a (limited) measure of spill-over reputation;
 - iv. that some of such ancillary goods that may be touched by a potential spill-over reputation may be considered similar, even to a high degree, to some of the applied-for goods – for instance I found previously a high degree of similarity between the Opponent’s *perfumed shower gels* and the Applicant’s *solid objects for use in bathing and show[er]ing which effervesce when wet*;
 - v. even if (as Ms Cookson intimated at the hearing) there may be a perception that the applied-for goods are more likely to be of interest and attractive to female consumers, and the reputed goods (men’s fragrances) more so to male consumers, I find that there is a significant overlap between the relevant consumers, who are after all drawn from the public at large.
66. Having noted all of the above, I of course must also factor in the degree of similarity between the respective marks. I have set out my findings on visual, aural and conceptual similarity as part of my analysis for the section 5(2)(b) claim and there also considered the overall impressions that the marks will have on the average consumer. Under the section 5(2)(b) claim I found that the levels of similarity between the marks were not sufficient to give rise to a likelihood of confusion. In my view, under the section 5(3) claim, the crux of the matter remains the consumer’s perception of “PRETTY SAVAGE” and whether the similarity that exists between the second word of that mark and the Opponent’s Mark will mean that the latter will be called to mind when confronted with the Applicant’s mark. On this point, I note that the level of similarity required for the public to make a link between the marks for the purposes of section 5(3) may be less than the level of similarity required to create a likelihood of confusion. Thus, in relation in to equivalent provisions in EU legislation, the CJEU stated in *Intra-Press SAS v OHIM*:²⁶

“The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant

²⁶ Joined cases C-581/13P & C-582/13P (at paragraph 72 of its judgment)

section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

67. Taking account of all relevant factors, and despite both parties’ having a common interest in goods that are pleasantly fragranced, I consider the differences between the marks are such that the relevant public will make no connection at all between the marks. I have considered the visual similarity between the French word SAUVAGE and the English word SAVAGE and the conceptual overlap that some may discern in the translation, but having regard to the overall impressions of the respective marks I still conclude that the average consumer, on seeing the mark PRETTY SAVAGE used in relation to the *soaps, cakes of soap, wax melts, scented wax melts, exfoliants, body butters; body scrubs, bath salts, bath preparations, solid objects for use in bathing and showering which effervesce when wet, shampoos, shampoo bars, preparations for the care of hair* will not call to mind, even fleetingly, the reputed mark of the Opponent. Since establishing a link is a necessary component for success based on a section 5(3) claim, the opposition under this ground must also fail. The absence of the necessary link means that the application gives rise to no serious likelihood of any of the claimed types of injury. **The Opponent’s claim under section 5(3) of the Act fails.**

The claim under section 5(4)(a) of the Act

68. The Opponent claims to have used the sign “SAUVAGE” throughout the UK since 2015, in relation to *perfumery products; fragrances, perfumes, eau de toilette, body spray, aftershave lotion, aftershave balm, bath and shower gel, shower soap; deodorants; moisturisers*, and that, at the Relevant Date, use of the Applicant’s mark in the UK was liable to have been prevented by virtue of the law of passing off protecting the Opponent’s Sign used in the course of trade, and as such registration of the Applicant’s mark would be contrary to section

5(4)(a) of the Act. The tort of passing off, as described in case law²⁷, comprises three elements:

- (i) a goodwill or reputation attached to the relevant goods;
- (ii) a misrepresentation by the defendant to the public (whether or not intentional) leading, or likely to lead, the public to believe that the goods offered by him are those of the claimant; and
- (iii) damage to the claimant, arising from the erroneous belief (caused by the defendant's misrepresentation) that the source of the defendant's goods is the same as the source of those offered by the claimant.

69. Goodwill has been described²⁸ as “the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom.” I find that the evidence, for example at **Exhibits CF4** and **CF7**, establishes actionable goodwill (at least) in relation to *frangrances, perfumes, eau de toilette, body spray, aftershave lotion, aftershave balm, shower gel, and deodorants*. However, notwithstanding the necessary goodwill, for there to be a real effect on its trade or goodwill the Opponent still faces the challenge of having to show that, on a balance of probabilities, a substantial number of its customers or potential customers would be deceived.²⁹ The question of likely deception or misrepresentation of course involves considering the perceived closeness between the respective signs.

70. In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had 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 later Court of Appeal decision 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. He concluded that “... 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

²⁷ See, for example, Lord Oliver in *Reckitt & Colman Products Limited v Borden Inc* [1990] RPC 341

²⁸ House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL)

²⁹ See, for example, Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473

intervention of the court then it may properly find infringement.” Although *Comic Enterprises* was an infringement case, the principles apply equally under section 5(2).³⁰ The upshot of this is that although the test for likelihood of confusion under trade mark law may differ from the test for misrepresentation under the law of passing off, 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. In line with my earlier conclusions, I find that use of the applied-for mark would not be a misrepresentation actionable under the law of passing off. **The Opponent’s claim under section 5(4)(a) fails.**

OUTCOME

71. The opposition has failed on each of its grounds. The application may proceed to registration in its entirety.

COSTS

72. This opposition has failed in its entirety and the Applicant is entitled to a contribution towards its costs of defending its application, in line with the scale published in the annex to Tribunal practice notice (2/2016).

Considering the other side’s statement and preparing a counterstatement	£350
Preparing evidence and considering and commenting on the other side's evidence	£700
Preparing for and attending a hearing	£650
Total	£1700

73. I order Parfums Christian Dior to pay Adele Savage the sum of £1700 (one thousand seven hundred pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated this 4th day of August 2020

Matthew Williams
For the Registrar

³⁰ see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch)