

BL O/621/22

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3640829
BY BYLIA LTD**

TO REGISTER THE TRADE MARK:

Bylia

IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60002002**

BY SOCIETA ITALO-BRITANNICA L. MANETTI-H. ROBERTS & C. PER AZIONI

Background and pleadings

1. On 13 May 2021, BYLIA LTD (“the applicant”) filed trade mark application number UK00003640829 (“the contested mark”) for the mark shown on the cover page of this decision. The application was accepted and published in the Trade Marks Journal for opposition purposes on 06 August 2021, in respect of goods in Classes 3, 4, 5, 6, 14, 18, 21, 24 and 25.

2. On 05 November 2021, Societa Italo-Britannica L. Manetti-H. Roberts & C. per azioni (“the opponent”) filed a fast track opposition, partially opposing the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its Form TM7F, the opponent indicated that the opposition is directed against goods in Class 3 of the application.¹

3. On 17 January 2022, following the partial opposition against the Class 3 goods only, the applicant elected to divide the application, resulting in UK00003640829 proceeding in respect of the Class 3 goods only.

4. The opponent relies upon its United Kingdom trade mark number 3322733, “BILBA” (“the earlier mark”). The earlier mark was filed on 05 July 2018, and became registered on 05 October 2018, in respect of goods in Class 3.²

5. In its notice of opposition, the opponent essentially argues that the marks at issue are highly similar and that the respective goods are identical and/or similar, resulting in a significant risk of a likelihood of confusion.

6. The applicant filed a counterstatement in which it denies that the marks are similar stating that they are aurally, visually and conceptually different, and therefore there is no likelihood of confusion.

7. Given the respective filing dates, the opponent’s mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified

¹ These will be listed in the goods comparison.

² These will be listed in the goods comparison.

within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

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

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

9. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

10. 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.

11. The opponent is professionally represented by IP LEGIS Ltd; the applicant is professionally represented by RightPro IP & Legal Consultancy Ltd. Only the opponent chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers before me, keeping all submissions in mind.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

DECISION

Section 5(2)(b)

13. Sections 5(2)(b) and 5A of the Act read as follows:

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

[...]

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

14. I am guided by the following principles which are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect

picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

16. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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. In *Gérard Meric v Office for Harmonisation in the Internal Market (‘Merici’)*, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

19. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><u>Class 3</u></p> <p>Barrier creams; exfoliant creams; depilatory creams; sun creams; suntan creams; creams for tanning the skin; washing creams; cosmetic creams; cleansing creams; night cream; hair creams; shower creams; day creams; anti-aging creams; toning creams [cosmetic]; body cream; eye cream; skin cream; face creams for cosmetic use; hand creams; cosmetic sun-protecting preparations; anti-wrinkle cream; beauty balm creams; skin cleansing cream; cosmetics in the form of creams; creams for firming the skin; sun protecting creams [cosmetics]; cosmetic hand creams; skin lightening creams; skin whitening creams; skin care creams [cosmetic]; skin conditioning creams for cosmetic purposes; make-up removing lotions; cleansing lotions; self-tanning lotions [cosmetic]; beauty lotions; eye lotions; body lotions; lotions for cosmetic purposes; tissues impregnated with cosmetic lotions; cosmetics in the form of lotions;</p>	<p><u>Class 3</u></p> <p>Perfumes; Perfume; Perfume oils; Perfumed soap; Amber [perfume]; Perfumed water; Perfumed powder; Perfumed creams; Perfume water; Perfumed soaps; Perfumed sachets; Perfuming sachets; Perfumed potpourris; Solid perfumes; Perfumed tissues; Liquid perfumes; Perfumed powders; Perfumed toilet waters; Perfumes for ceramics; Room perfume sprays; Fumigation preparations [perfumes]; Extracts of perfumes; Aromatics for perfumes; Perfumes for cardboard; Flower perfumes (Bases for -); Flowers (Extracts of -) [perfumes]; Perfumed lotions [toilet preparations]; Perfumes for industrial purposes; Sachets for perfuming linen; Linen (Sachets for perfuming -); Extracts of flowers [perfumes]; Bases for flower perfumes; Natural oils for perfumes; Perfumes in solid form; Room perfumes in spray form; Cushions impregnated with perfumed substances; Perfumed body lotions [toilet preparations]; Perfumed powder [for cosmetic use]; Cushions filled with</p>

<p>cosmetic facial lotions; eye wrinkle lotions; lotions for cellulite reduction; moisturising skin lotions [cosmetic]; skin care lotions [cosmetic]; milky lotions for skin care; lotions for face and body care; sun-tanning gels; moisturising gels [cosmetic]; age retardant gel; eye gels; cosmetic eye gels; cosmetics in the form of gels; aloe vera gel for cosmetic purposes; oils for cosmetic purposes; scented oils; mineral oils [cosmetic]; suntanning oil [cosmetics]; after-sun oils [cosmetics]; oils for perfumes and scents; body oils [for cosmetic use]; cosmetics in the form of oils; natural oils for cosmetic purposes; suntan oils for cosmetic purposes; sun blocking oils [cosmetics]; skin care oils [cosmetic]; oil baths for hair care; perfume oils for the manufacture of cosmetic preparations; lip cream; nail cream; body mask cream; retinol cream for cosmetic purposes; cold cream; cleansing masks; beauty masks; body masks; facial masks; skin masks [cosmetics]; skin moisturizer masks; cleaning masks for the face; make-up foundations; body powder; cosmetic white face powder; make-up powder; body talcum powder; dusting powder; soap; cosmetic soaps; cream soaps; deodorant soap; toilet soap; beauty soap; hand soaps; soaps for personal use; liquid bath soaps; soaps for body care; liquid soaps for hands and face; bar soap; perfumed soaps; shower soap; non-medicated toilet soaps; body cream soap; perfume; perfumed creams; perfumed powder [for cosmetic use]; synthetic perfumery; natural perfumery; toilet water; cologne; bath foam; bath oils for cosmetic purposes; cosmetic preparations for baths; depilatory preparations; antiperspirants [toiletries]; deodorants for body care; deodorants and antiperspirants; tints for the hair; hair rinses [shampoo-conditioners]; cosmetic dyes; hair care lotions; shampoos; hair emollients; hair bleaching preparations; hair lighteners; hair conditioners; hair gel; hair mousse;</p>	<p>perfumed substances; Extracts of flowers being perfumes; Oils for perfumes and scents; Perfuming preparations for the atmosphere; Perfumed powders [for cosmetic use]; Perfumed oils for skin care; Essential oils as perfume for laundry purposes; Perfume oils for the manufacture of cosmetic preparations; Cosmetics; Cosmetics and cosmetic preparations ; Milks [cosmetics]; Eyebrow cosmetic s; Cosmetic dyes; Creams (Cosmetic -); Cosmetic soaps; Cosmetic soap; Cosmetic pencils; Pencils (Cosmetic); Nail cosmetics; Functional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Eye cosmetics; Cosmetic preparations; Cosmetics preparations; Cosmetic creams; Multifunctional cosmetics; Dyes (Cosmetic -); Cosmetic kits; Kits (Cosmetic); Tonics [cosmetic]; Natural cosmetics; Cosmetic rouges; Cosmetic moisturisers; Cosmetic masks; Cosmetic oils; Hair cosmetics; Mousses [cosmetics]; Decorative cosmetics; Colour cosmetics; Lip cosmetics; Organic cosmetics; Skin balms [cosmetic]; Cosmetic bath salts; Cleansing creams [cosmetic]; Non-medicated cosmetics; Cosmetic eye pencils; Suntan lotion [cosmetics]; Body paint (cosmetic); Bath powder [cosmetics]; Cosmetic massage creams; Cosmetic eye gels; Cosmetic hand creams; Facial washes [cosmetic]; Cosmetic facial lotions; Facial masks [cosmetic]; Cosmetic facial packs; Body scrubs [cosmetic]; Facial gels [cosmetics]; Cosmetic body mud; Cosmetic tanning preparations; Cosmetic face powders; Sun block [cosmetics]; Skin care cosmetics; Nail hardeners [cosmetics] ; Moisturising concentrates [cosmetic]; Powder compacts[cosmetics]; Skin creams [cosmetic]; Nail primer [cosmetics]; Facial creams [cosmetics]; Facial lotions [cosmetic]; Cosmetic sunscreen preparations; Cosmetic facial masks; Cosmetic nail preparations; Lip stains [cosmetics]; Humectant preparations [cosmetics]; Cosmetic skin enhancers; Body creams [cosmetics]; Sun barriers</p>
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<p>hair moisturisers; hair glaze; hair wax; hair fixers; hair nourishers; hair dye; combing oil; hair moisturising conditioners; hair protection gels; hair texturizers; cosmetic preparations for the hair and scalp; hair dyeing preparations; hair waving preparations; styling lotions; colouring lotions for the hair; hair fixing oil; wax treatments for the hair; cosmetic hair dressing preparations; hair straightening preparations; hair preparations and treatments; mousses [toilettries] for use in styling the hair; shampoo-conditioners; dry shampoos; dandruff shampoos, not for medical purposes; preparations for setting hair; cosmetics for the use on the hair; hair spray; conditioning creams; shaving balm; shaving soap; shaving foam; shaving gel; shaving lotion; shaving preparations; pre-shaving preparations; pre-shave creams; make-up; make-up removing preparations; make-up for the face and body; lipsticks; sun blocking lipsticks [cosmetics]; nail polish; fingernail tips; nail gel; nail art stickers; nail care preparations; preparations for reinforcing the nails; nail polish remover; abrasive paper for use on the fingernails; adhesives for affixing artificial fingernails; artificial nails for cosmetic purposes; douching preparations for personal sanitary or deodorant purposes [toilettries]; washing preparations for personal use; hand washes; tanning preparations; sun-tanning oils; sun bronzers; artificial tanning preparations; sun block preparations; tanning milks [cosmetics]; waterproof sunscreen; cosmetics for protecting the skin from sunburn; cosmetics for use in the treatment of wrinkled skin; wrinkle removing skin care preparations; moisturising skin creams [cosmetic].</p>	<p>[cosmetics]; Lip protectors [cosmetic]; Facial cleansers [cosmetic]; Skin Masks [cosmetics]; Night creams cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics]; Toning creams [cosmetic]; Moisturising gels [cosmetic]; Cosmetic cotton wool; Skin fresheners [cosmetics]; Cosmetic nourishing creams; Face wash [cosmetic]; Facial scrubs [cosmetic]; Cosmetic suntan lotions; Face packs [cosmetic]; Suntan oils [cosmetics]; Tanning oils [cosmetics]; Cosmetics containing keratin; Smoothing emulsions [cosmetics]; Cosmetic mud masks; Acne cleansers, cosmetic; Mineral oils [cosmetic]; Facial Moisturisers [cosmetic]; Cosmetic-impregnated tissues; Cosmetics for animals; Facial toners [cosmetic]; Lip coatings [cosmetic]; Cosmetics for suntanning; Skin cleansers [cosmetic]; Skin toners [cosmetic]; Cosmetic skin fresheners; Henna [cosmetic dye]; Body care cosmetics; Tanning milks [cosmetics]; Tanning gels [cosmetics]; Facial creams [cosmetic]; Cosmetic sun oils; Cosmetic suntan preparations; Tanning preparations [cosmetics]; Facial packs [cosmetic]; Suntanning oil [cosmetics]; Beauty care cosmetics; Cosmetic hair lotions; Cosmetic body scrubs; Fluid creams [cosmetics]; Shampoos; Shampoo; Pet shampoos; Shampoo-conditioners; Hair shampoos; Car shampoos; Emollient shampoos; Body shampoos; Dry shampoos; Hair shampoo; Vehicle shampoos; Baby shampoo; Dandruff shampoo; Shampoo bars; Waterless shampoo; Waterless shampoos; Carpet shampoo; Shampoos for pets; Shampoo for animals; Non-medicated shampoos; Baby shampoo mousse; Pets (Shampoos for -); Shampoos for vehicles; Shampoos for babies; Shampoos for personal use; Non-medicated hair shampoos; Non-medicated pet shampoos; Hair rinses [shampoo-conditioners]; Shampoos for human hair; Refill packs for shampoo dispensers; Dandruff shampoos, not for medical purposes; Shampoos for pets [non-medicated grooming preparations]; Shampoos for animals</p>
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	[non- medicated]; grooming preparations]; Tooth paste; Tooth whitening pastes; Tooth powders; Tooth gel; Tooth whitening creams; Tooth polish; Tooth polishes; Tooth powder; Tooth cleaning preparations; Tooth care preparations; Moistened tooth powder; Tooth whitening preparations; Abrasive paste; Chewable tooth cleaning preparations; Tooth powder [for cosmetic use]; Tooth powders [for cosmetic use];Razor strops (Pastes for -); Pastes for cleaning shoes; Pastes for razor strops; Styling paste for hair; Cosmetics containing hyaluronic acid.
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20. With regard to the similarity of the goods the opponent states the following:³

“All the contested goods are cosmetic preparations used to cleanse, beautify, or protect the appearance (hair, skin, nails, or complexion) of the human body. As such they are identical or at least highly similar to the goods of the Earlier mark, either because they are identically contained in both lists (including synonyms), or because they are identically contained in a border category of overlap with the Contested Goods.

.... both the use and the user of the goods of the Earlier and Contested Marks will clearly overlap as the goods will be used by members of the general public. There will also be an overlap in nature and method of use, as the goods are used for cleaning, beautifying, or protecting the body. The goods are likely to be sold through the same trade channels and appear next to each other in aisles, in general retailers such as supermarkets, therefore the goods are highly competitive. Consequently, the goods shall be considered similar to between a medium and high degree.”

21. In regard to the goods comparison, I will group items together where I feel it is appropriate to do so.

³ Written submissions in lieu.

Perfumes; Perfume; Perfume oils for the manufacture of cosmetic preparations; Perfume oils; Perfumed soap; Perfumed soaps; Perfumed powder [for cosmetic use]; Perfumed powders [for cosmetic use]; Perfumed powder; Perfumed powders; Perfumed creams; tanning milks [cosmetics]; Dyes (Cosmetic -); Cosmetic dyes; Creams (Cosmetic -); Cosmetic creams; Cosmetic soaps; Cosmetic soap; Skin masks [cosmetics] Facial masks [cosmetic]; Cosmetic facial masks; Cosmetic oils; Hair cosmetics; Cleansing creams [cosmetic]; Cosmetic eye gels; Cosmetic hand creams; Skin creams [cosmetic]; Cosmetic facial lotions; Body creams [cosmetics]; Night creams cosmetics]; Toning creams [cosmetic]; Moisturising gels [cosmetic]; Mineral oils [cosmetic]; Cosmetic-impregnated tissues; Facial creams [cosmetic]; Cosmetic hair lotions; Fluid creams [cosmetics]; Shampoos; Shampoo; Non-medicated shampoos; Shampoo-conditioners; Dry shampoos; Dandruff shampoo; Dandruff shampoos, not for medical purposes; Hair rinses [shampoo-conditioners]; Oils for perfumes and scents

22. The above contested goods all have direct equivalents in the opponent's specification. I am therefore of the view that the competing goods are identical due to their identical or near-identical wording.

Suntan lotion [cosmetics]; Sun block [cosmetics]; Cosmetic sunscreen preparations; Sun barriers [cosmetics]; Cosmetic suntan lotions; Suntan oils [cosmetics]; Tanning oils [cosmetics]; Cosmetics for suntanning; Cosmetic sun oils; Cosmetic suntan preparations; Tanning preparations [cosmetics]; Suntanning oil [cosmetics]; Tanning gels [cosmetics]; Cosmetic tanning preparations; Moisturisers [cosmetics]; Cosmetic moisturisers; Moisturising concentrates [cosmetic]; Cosmetic masks; Cosmetic mud masks; Cosmetic mud masks; Facial packs [cosmetic]; Cosmetic facial packs

23. The above contested goods, although worded slightly differently, all have direct equivalents in the opponent's specification. Accordingly, I find the competing goods are identical either due to their near-identical wording or based on the *Meric* principle.

Amber [perfume]; Perfumed water; Perfume water; Perfumed sachets; Perfuming sachets; Solid perfumes; Perfumed tissues; Liquid perfumes; Perfumes for ceramics; Room perfume sprays; Fumigation preparations [perfumes]; Extracts of perfumes; Aromatics for perfumes;

Perfumes for cardboard; Flower perfumes (Bases for -); Flowers (Extracts of -) [perfumes]; Perfumes for industrial purposes; Sachets for perfuming linen; Linen (Sachets for perfuming -); Extracts of flowers [perfumes]; Bases for flower perfumes; Perfumes in solid form; Room perfumes in spray form; Extracts of flowers being perfumes; Perfuming preparations for the atmosphere

24. The above contested goods are included in the broad terms *perfume*, *synthetic perfumery* and *natural perfumery* contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric*.

Perfumed potpourris; Cushions impregnated with perfumed substances; Cushions filled with perfumed substances

25. The contested goods are aromatic goods. *Perfumed potpourris* generally consist of a mixture of fragranced dried plant materials; *cushions impregnated with perfumed substances* and *cushions filled with perfumed substances* are cushions containing scented material. In general, these contested goods are placed in, for example, rooms or in chests of drawers and wardrobes, etc., to impart a pleasant scent to an area, or to clothing and linen, etc., stored in drawers and wardrobes. Although these goods may not be considered as *perfumery* in the true sense of the word, the ordinary meaning of *perfumery* would not only be a scent applied to the body but also includes scents applied to enhance the fragrance of a room. Accordingly, the contested goods share a similar purpose to the opponent's *synthetic perfumery* and *natural perfumery*. On this basis I consider that the opponent's *synthetic perfumery* and *natural perfumery* would encompass the contested perfumed goods and therefore I find the competing goods to be identical. However, if I am wrong in this assessment, I consider the contested goods to be similar to a high degree on the basis that they have a similar purpose and have the same end users. Further, the channels of trade can also coincide.

Natural oils for perfumes; Perfumed oils for skin care; Essential oils as perfume for laundry purposes

26. The above contested goods are included in the broad term oils for perfumes and scents contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric*.

Perfumed toilet waters

27. The above contested goods are included in the broad term toilet water contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric*.

Perfumed lotions [toilet preparations]; body lotions [toilet preparations]; Cosmetic facial lotions; Facial lotions [cosmetic]; Perfumed body lotions [toilet preparations]

28. The above contested goods are included in the broad term lotions for face and body care contained in the opponent's goods and therefore are considered identical in line with the principle set out in *Meric*.

Cosmetics; Cosmetics and cosmetic preparations; Eyebrow cosmetics; Cosmetic pencils; Pencils (Cosmetic); Functional cosmetics; Cosmetic powder; Eye cosmetics; Cosmetic preparations; Cosmetics preparations; Multifunctional cosmetics; Cosmetic kits; Kits (Cosmetic -); Natural cosmetics; Cosmetic rouges;]; Decorative cosmetics; Colour cosmetics; Lip cosmetics; Organic cosmetics; Non-medicated cosmetics; Cosmetic eye pencils; Body paint (cosmetic); Skincare cosmetics; Skin care cosmetics; Cosmetics for animals

29. The above cosmetics and various cosmetic goods are all preparations applied to the body, especially the face, to improve its appearance, etc. Likewise, the opponent's make-up also relates to cosmetics which are applied to the face and body in order to improve its appearance. Accordingly, the opponent's *make-up* falls within the broad category of *cosmetics* and the various cosmetic goods listed above, therefore these goods are considered identical in line with the principle set out in *Meric*.

Milks [cosmetics]

30. The above contested term is a broad term and encompasses the term milky lotions for skin care contained in the opponent's goods and therefore these goods are considered identical in line with the principle set out in *Meric*.

Nail cosmetics

31. The above contested term is a broad term and encompasses the terms nail polish; nail gel; nail art stickers; nail care preparations contained in the opponent's specification and therefore these goods are considered identical in line with the principle set out in *Meric*.

Mousses [cosmetics]; Baby shampoo mousse

32. The above contested goods overlap with the opponent's hair mousse, therefore the competing goods are identical based on the *Meric* principle.

Cosmetic bath salts; Bath powder [cosmetics]

33. The above contested goods are encompassed by the broad term cosmetic preparations for baths contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Acne cleansers, cosmetic; Skin cleansers [cosmetic]; Facial toners [cosmetic]; Skin toners [cosmetic]; Cosmetic skin fresheners

34. The above contested goods are encompassed by the broad terms skin cleansing cream and cleansing lotions contained in the opponent's specification. Therefore, the competing goods are identical based on *Meric*. However, it is acknowledged that *skin fresheners* can also be in the form of sprays rather than creams or lotions. As such, while my identical finding in relation to *cosmetic skin fresheners* may be wrong due to their potentially different physical nature, I am of the view that the above goods would be similar to a high degree to

the opponent's *skin cleansing cream* and *cleansing lotions* on the basis that they have a similar purpose and have the same end users. Further, the channels of trade can also coincide.

Cosmetic massage creams

35. The above contested goods are encompassed by the broad term cosmetic creams contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Facial washes [cosmetic]

36. The above contested goods are encompassed by the broad term washing preparations for personal use contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Facial gels [cosmetics]; Facial moisturisers [cosmetic]; Facial creams [cosmetics]

37. The above contested goods are encompassed by the broad terms cosmetic facial lotions and moisturising gels [cosmetic] contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Cosmetic face powders; Powder compacts[cosmetics]

38. The above contested goods are encompassed by the broad term powder [for cosmetic use] contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Nail cosmetics; Nail hardeners [cosmetics]; Nail primer [cosmetics]; Cosmetic nail preparations; Nail tips [cosmetics]; Nail paint [cosmetics]

39. The above contested goods overlap with the opponent's nail polish; fingernail tips; nail gel; nail art stickers; nail care preparations; preparations for reinforcing the nails, therefore the competing goods are identical based on the *Meric* principle.

Lip coatings [cosmetic]; Lip cosmetics; Lip stains [cosmetics]; Lip protectors [cosmetic]

40. The above contested goods overlap with the opponent's lip cream; lipsticks; sun blocking lipsticks [cosmetics], therefore the competing goods are identical based on the *Meric* principle.

Facial cleansers [cosmetic]

41. The above contested goods overlap with the opponent's cleansing lotions, therefore the competing goods are identical based on the *Meric* principle.

Cosmetic nourishing creams

42. The above contested goods are encompassed by the broad term cosmetic creams contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Cosmetics containing hyaluronic acid

43. Hyaluronic acid is a naturally occurring substance found in the body which helps skin soak up and lock in moisture. Furthermore, some cosmetic products such as foundations, moisturisers, face creams, serums and gels now also contain *hyaluronic acid* with the pledge of delivering hydration to the skin. Accordingly, as the opponent's *make-up foundations* are *cosmetics* that may contain *hyaluronic acid*, I find these goods to be similar to a high degree to the contested *cosmetics containing hyaluronic acid* on the basis that they have a similar purpose and have the same end users. Furthermore, the channels of trade can also coincide.

Face wash [cosmetic]

44. The above contested goods are encompassed by the broad term washing preparations for personal use contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Facial scrubs [cosmetic]; Body scrubs [cosmetic]; Cosmetic body scrubs

45. Cosmetic scrubs are creams or gels containing tiny coarse granules or abrasive materials and are used primarily to exfoliate the outermost layer of the skin. Accordingly, the above contested goods overlap with the opponent's exfoliant creams, therefore the competing goods are identical based on the *Meric* principle.

Henna [cosmetic dye]

46. The above contested goods are encompassed by the broad term cosmetic dyes contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Body care cosmetics; Beauty care cosmetics

47. The above contested goods overlap with the opponent's lotions for face and body care; beauty balm creams; beauty lotions, therefore the competing goods are identical based on the *Meric* principle.

Pet shampoos; Hair shampoos; Car shampoos; Emollient shampoos; Body shampoos; Hair shampoo; Vehicle shampoos; Baby shampoo; Shampoo bars; Waterless shampoo; Waterless shampoos; Carpet shampoo; Shampoos for pets; Shampoo for animals; ; Pets (Shampoos for -); Shampoos for vehicles; Shampoos for babies; Shampoos for personal use; Non-medicated hair shampoos; Non-medicated pet shampoos; Shampoos for human

hair; Refill packs for shampoo dispensers; Shampoos for pets [non-medicated grooming preparations]; Shampoos for animals [non-medicated grooming preparations]

48. The above contested goods are encompassed by the broad term shampoo contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Skin balms [cosmetic]

49. The above contested goods overlap with the opponent's beauty balm creams, therefore the competing goods are identical based on the *Meric* principle.

Styling paste for hair

50. The above contested goods are encompassed by the broad term hair preparations and treatments contained in the opponent's specification. Therefore, the competing goods are identical based on the *Meric* principle.

Smoothing emulsions [cosmetics]; Cosmetics containing keratin

51. Cosmetic smoothing emulsions are water-based moisturisers which aim to deliver nutrients to deeper layers of the skin; Keratin is a structural protein that helps form the outer layer of the skin (epidermis). It can be extracted from, amongst other things, human hair or sheep's wool and can be incorporated as an ingredient in cosmetic products such as rejuvenating serums and skin and hair moisturisers. Keratin has strong moisturising properties that when used on the skin can enhance its elasticity, resulting in smoother looking skin. Accordingly, I find that the above contested goods overlap with the opponent's anti-wrinkle cream; cosmetics in the form of creams; cosmetics in the form of lotions that may also deliver smoother looking skin. Therefore, the competing goods are identical based on the *Meric* principle.

Tonics [cosmetic]; Facial toners [cosmetic]; Skin toners [cosmetic]; Skin fresheners [cosmetics]

52. The above contested goods overlap with the opponent's lotions for cosmetic purposes, therefore the competing goods are identical based on the *Meric* principle.

Cosmetic skin enhancers

53. In principle, *cosmetic skin enhancers* are cosmetic creams or lotions containing smoothing agents which aim to improve the appearance of the skin by minimising minor imperfections, shadows or fine lines. Accordingly, I find that these goods are encompassed by the opponent's broad terms, cosmetics in the form of creams; cosmetics in the form of lotions. Therefore, the competing goods are identical based on the *Meric* principle.

Humectant preparations [cosmetics]

54. A humectant is a moisturising agent found in lotions, creams, shampoos and other beauty products and is known for its ability to retain moisture. Humectants can either be man-made or derived from nature. In terms of cosmetics, *humectants preparations* include hair conditioners and facial creams which purport to hydrate and moisturise the skin and hair. Accordingly, I find that the above contested goods overlap with the opponent's moisturising skin lotions [cosmetic]; hair moisturisers and are therefore identical based on the *Meric* principle.

Cosmetic body mud

55. *Cosmetic body mud* refers to a mud product that is used primarily on the skin to exfoliate and unclog pores, etc., therefore, these goods overlap with the opponent's exfoliant creams and as a consequence, are to be regarded as identical on the principles outlined in *Meric*. However, even if I am wrong in that regard, given the similarity in *inter alia*, the nature, intended purpose, method of use, users and trade channels, if not identical, I am of the view that the goods at issue are similar to a high degree.

Cosmetic cotton wool

56. In general, the contested goods are used to apply cosmetic lotions to the face and body and to remove makeup, dirt, grease and other impurities from the face and body. Similarly, the general purpose of the opponent's tissues impregnated with cosmetic lotions is to cleanse the skin and remove makeup, dirt and grease, etc. Accordingly, the competing goods coincide in purpose, nature, and methods of use. Further, the goods can coincide in producers and can target the same end users. Moreover, they can also be in competition. Therefore, the competing goods are highly similar.

Tooth cleaning preparations; Chewable tooth cleaning preparations; Tooth paste; Tooth whitening pastes; Tooth powders; Tooth gel; Tooth whitening creams; Tooth polish; Tooth polishes; Tooth powder; Tooth care preparations; Moistened tooth powder; Tooth whitening preparations; Abrasive paste; Tooth powder [for cosmetic use]; Tooth powders [for cosmetic use]

57. The general purpose of the above contested goods is to clean, protect or enhance the appearance of teeth and to help prevent bad breath. None of the opponent's goods are related to dental hygiene and therefore share no obvious similarity and differ in their nature, method of use, intended purpose and trade channels. In addition, the above contested goods will not be in competition with any of the opponent's goods, nor will they be complementary. While it is acknowledged that the opponent's goods include the term *soap* and the broad term *washing preparations for personal use*, I am of the view that the ordinary and natural meaning of these terms would not ordinarily include the contested dental products. While dental products may cleanse this is insufficient for a finding of similarity with *soap* and *washing preparations for personal use* keeping in mind the nature of the goods, trade channels, methods of use and the fact that they are neither in competition nor complementary. Accordingly, I find the above contested goods and all the opponent's goods to be dissimilar.

58. In respect of this finding, I acknowledge that the opponent's *soap* and *washing preparations for personal use*, could on a very broad interpretation, include goods for dental

use, however, in this regard it is important to keep in mind the guidance in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12], where Floyd J (as he was then) stated that:

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

Pastes for cleaning shoes

59. In general, the purpose of the contested goods is to remove dirt or stains and enhance the appearance of footwear. The opponent's soap is a broad category covering products used for, inter alia, household cleaning, vehicle cleaning, personal cleaning, as well as cleaning and conditioning leather articles. Further, the general purpose of soap also includes the removal of dirt or stains from something in order to clean it and enhance its appearance. The competing goods at issue can target the same consumer and be sold in the same retail outlets. Accordingly, I find that the goods are similar to a low degree.

Razor strops (Pastes for -); Pastes for razor strops

60. The contested goods are pastes for razor strops, being flexible strips of leather or other soft materials used to polish the blades of straight razors. The opponent's soap is a broad category covering products used for, inter alia, household cleaning, vehicle cleaning, personal cleaning, as well as cleaning and conditioning leather articles. Accordingly, I find that the purpose and nature of these goods coincide to a degree. Further, the competing

goods may target the same consumers and can coincide in channels of trade. Therefore, I find that the competing goods are similar to a low degree.

The average consumer and the nature of the purchasing act

61. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

62. 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.”

63. In my view the average consumer is the general public. The goods at issue broadly consist of *cosmetic, perfumery, cleaning and skin and hair care products*, being everyday consumer goods. The purchasing act will not require an overly considered thought process as, overall, the goods are relatively inexpensive. The average consumer will, nevertheless, consider factors such as suitability, desired effect, colour and ingredients when purchasing the goods. Taking these factors into account, I find that the level of attention of the general public would be medium. The goods are typically sold in brick-and-mortar retail establishments or their online equivalents, where the goods are likely to be purchased after perusing the shelves or viewing information on the internet. In these circumstances, the purchasing process will be predominantly visual in nature, though I do not exclude aural

considerations entirely as consumers may receive word of mouth recommendations or discuss the products with a sales assistant.

Comparison of the marks

64. It is clear from *Sabel BV v Puma AG* 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

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

Opponent's mark	Applicant's mark
BILBA	Bylia

67. With regard to the similarity of the marks, in its counterstatement the applicant states the following:

“We respectfully disagree that the mark BILBA, which is the ground of the opposition and the contested application By Lia (stylised) are similar in a way to cause likelihood of confusion before the public. The opponent’s BILBA trademark is aurally, visually, conceptually different from the applied By Lia stylized mark, and the overall impression before the public is significantly different. The applicant’s “By Lia” mark consists of two words and the stylization of the same, with a capital “L” in the shape of a large knot, covering the “ia” letters till the end. Besides that it results in the pronunciation of the same as two words, meaning “provided by Lia”. Therefore, the conceptual difference also exists. Moreover, the contested goods are mainly cosmetics, where the consumer will have utmost care on selecting due to possible reactions on the skin and body. Hence, it is not likely for the average consumer to confuse both trademarks at the time of the purchase.”

68. With regard to the similarity of the marks the opponent states the following:⁴

“The Contested Mark is similar to the Opponent’s Earlier Registration. The Applicant states that the Contested mark consists of two words “by” and “Lia”. This is incorrect. Taking into account the representation of the Contested mark, it is clear that the sign “BYLIA” is all attached. In fact, it is impossible to discern two separate words. Furthermore, it is clear that the Contested Mark is just one word “BYLIA” because this corresponds with the Trade Name of the Applicant, which is BYLIA LTD (not By Lia LTD). The consumer will be surely led to perceive the contested Mark as “BYLIA all one. Therefore, the Applicant’s argument is fundamentally flawed.

[...]

The earlier mark is a word mark and therefore provides the broadest protection: in the case at stake, the word “BILBA” – of which the Earlier Mark consists of – protects the sign in whatever graphic representation or colour is presented.”

⁴ Written submissions in lieu.

The overall impression

69. The contested mark comprises the word “ByLia” presented in slightly stylised, upper and lower-case letters. The overall impression of the mark lies in the letters themselves however, the stylisation and size of the capital letter “L” within the mark cannot be overlooked. Furthermore, due to the capitalisation of the letters “B” and “L”, the mark is likely to be perceived as two words, namely “By” and “Lia”, conjoined. While I find that the overall impression of the mark is dominated by the word itself, the stylisation of the letter “L” plays a secondary role.

70. The opponent’s mark is the single word “BILBA”, presented in upper case letters. The overall impression resides in this single element.

Visual comparison

71. Both marks consist of five letters, four of which are shared. The first, third and fifth letters in the competing marks are presented in the same order, namely “B_L_A / B_L_a”. In terms of differences, the shared letter “l/i” is presented at the second position in the opponent’s mark and at the fourth position in the contested mark. The second letter “B” in position four of the opponent’s mark has no counterpart in the contested mark, and likewise, the letter “y” in position two of the contested mark has no counterpart in the opponent’s mark. Furthermore, the letter “L” in the contested mark is stylised and is noticeably larger than the other letters. Due to the stylisation the contested mark is likely to be perceived as the two words “By” and “Lia”, conjoined. This stylisation is not replicated in the opponent’s mark and therefore creates a further visual difference. Considering all these factors, I find that the marks are visually similar to a medium degree.

Aural comparison

72. With regard to the aural similarity of the marks the opponent states the following:

“Aurally, the first syllable of the marks will be pronounced identically, as this is one of the instances in which I and Y could be interchanged because they represent the

same phonetic sound “ai”. In fact, the earlier mark ‘BILBA’ should be pronounced “Bailba”.

[...]

The remaining syllable of both marks share the same ‘A’ sound at the end of the sign. Visually and aurally, the signs are the same in length (five letters / sounds each). Moreover, they coincide in the sequence of letters / sounds “Bail”, which account for the first three out of the five letters / sounds. Further, the signs coincide in their last letter / sound, ‘A’. Finally, from the aural perspective, the signs have the same rhythm and intonation, as they have the same length and the same number syllables (two). Therefore, the signs are aurally similar at least to a medium degree.”

73. The contested mark is most likely to be articulated as the ordinary word ‘BY’ followed by ‘LEE-UH’, meaning it consists of three syllables, contrary to the opponent’s submissions.

74. Since the opponent’s mark is an invented word, it is somewhat difficult to explain how it will be articulated. It appears from its submissions that the opponent suggests the letter ‘l’ in its mark will be pronounced as the diphthong vowel ‘ai’, as in the words ‘find’ and ‘wide’ but writes the pronunciation of BILBA as BAILBA. To me, BAILBA would be pronounced with the diphthong vowel ‘ei’, as in the words ‘aim’ and ‘paid’. However, I consider it far more likely that the average consumer would see the word BILBA and pronounce the ‘l’ as a short vowel, as in the words ‘bill’ and ‘bid’. As such, the earlier mark would be pronounced as the two syllables ‘BILL-BUH’.

75. Proceeding on this basis, the aural similarities between the marks are that they begin with the letter B and end with the sound ‘UH’. How the remainder of the marks are articulated is quite different. ‘BY-LEE-UH’ and ‘BILL-BUH’ are three- versus two-syllable words which also sound quite different. Overall, I find a low degree of aural similarity between the marks.

Conceptual comparison

76. With regard to the conceptual similarity of the marks the opponent states the following:

“both marks are likely to be viewed as invented or foreign language words, with no conceptual meaning for the average consumer. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs. Moreover, the Applicant contends that the contested mark has the meaning of “BY-LIA”. The Opponent already contested this baseless interpretation. But pretending this should be the case, also the sign “BILBA” would be aurally perceived as “BY-LBA” So, the conceptual meaning would be the same anyway.”

77. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

78. In my view, contrary to the opponent’s opinion, due to the use of the capital letters “B” and “L”, the contested mark will be perceived as two separate words i.e. “By Lia”. As such, the word “By” would be understood as a common preposition identifying the responsible entity “Lia”, which in turn will likely be perceived as a feminine given name. Accordingly, I find the only concept that the contested mark conveys is one of responsibility, for example, the goods at issue are provided and produced *by Lia*. With regard to the opponent’s mark “BILBA”, it will be perceived as an invented word and therefore has no conceptual content. Accordingly, taking all the above into account, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier trade mark

79. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, 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).”

80. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

81. In its submissions in lieu, the opponent states that its mark will be viewed as an invented or foreign language word, with no conceptual meaning to the average consumer and as such, must be considered inherently highly distinctive.

82. I agree with the opponent. The earlier mark comprises the word “BILBA”. As previously mentioned, I consider that this word will be viewed as an invented word which is neither allusive nor descriptive in relation to the goods for which the mark is registered. Therefore, I consider the opponent’s mark to be inherently distinctive to a high degree.

Likelihood of confusion

83. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is 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 goods and services, and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, as mentioned above, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

84. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

85. In their submissions the opponent states the following:

“The contested mark and the Earlier mark are visually similar to between a medium and high degree and aurally similar to at least a medium degree. The earlier mark is also inherently distinctive to a high degree. The average consumer will pay a low or, at best, medium degree of attention during the purchasing process, and the goods vary from being identical to being highly similar. The Earlier and Contested marks thus overlap in their nature, intended purpose, method of use, user and trade channels, and the fact that the goods are both in competition with and are complimentary to each other confirms this. Conclusively, the interdependency principle established in *Canon C-39/97* means that there would be a likelihood of confusion between the marks and the goods of the Applicant and the Opponent.”

86. I have found the marks to be visually similar to a medium degree, aurally similar to a low degree and conceptually dissimilar. The overall impression of the contested mark

“ByLia” lies in the word itself, however due to capital letter “B” and the stylisation and size of the capital letter “L” the mark is likely to be perceived as two words, namely “By Lia” and therefore the stylisation in the mark cannot be overlooked. The overall impression of the opponent’s mark “BILBA” resides in this single element. I have found the earlier mark to have a high degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who, whilst not ignoring aural considerations, will select the goods at issue by predominantly visual means whilst paying a medium degree of attention during that process. I have found the similarity between the goods to range from dissimilar to identical.

87. It is clear from *Sabel BV v Puma AG* (see paragraph 64 of this decision) 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.

88. I have found the marks conceptually dissimilar whereby the earlier mark is an invented word with no clear meaning and the applicant’s mark is likely to have the immediate concept of goods provided by *Lia*. Whilst conceptual differences do not always completely neutralise visual and aural similarities,⁵ where the meaning of one of the marks is grasped immediately, as is the case here, the conceptual differences may counteract the visual and aural similarities.⁶ I bear in mind that the goods will be purchased predominantly by visual means and there is a medium degree of visual similarity between the marks, however, for me to find that the marks may be recalled as one another would require me to find that the average consumer would overlook or forget the differences. The visual, aural and conceptual differences between the competing marks are sufficient to avoid consumers, paying a medium degree of attention, from mistaking the contested mark for the earlier mark (or vice versa), even on goods which are identical. Therefore, even when factoring in the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion.

⁵ *Nokia Oyj v OHIM* Case T-460/07

⁶ *The Picasso Estate v OHIM* Case C-361/04 P

89. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

90. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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.”

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).”

91. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

92. It is not sufficient that a mark merely calls to mind another mark:⁷ this is mere association not indirect confusion.

93. That said, the question remains whether consumers would consider the later mark to be another brand of the owner of the earlier mark, or that of a related undertaking, given that the marks both consist of five letters, three of which are presented in the same order.

94. To find indirect confusion in this case, it would be necessary to conclude that the average consumer will see in “BILBA” and “By Lia” respectively, an element common between the marks, leading them to conclude that due to the presence of the letters “B_L_a” in the contested mark this means that it is a brand of the owner of the earlier mark. I do not think this is likely. The differing letters and stylisation in the marks are not logical with a brand extension, sub-brand or a re-branding, neither are the common elements “B_L_A / B_L_a” so distinctive that consumers would assume that no one other than the owner of “BILBA” would use those letters in their mark. While I found the earlier mark to have a high degree of inherent distinctiveness, that is in the mark as a whole, and not in the common letters “B_L_A”. Accordingly, even for identical goods, I can see no reason why consumers would see the letters “B_L_A / B_L_a” in both marks and assume the undertakings are linked. The opponent’s mark is an invented word with no meaning, whereas the contested mark consists of two words conjoined, which indicates the origin of the goods, i.e. *By Lia*. Consequently, I do not consider there to be a likelihood of indirect confusion.

⁷ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Conclusion

95. The opposition under section 5(2)(b) of the Act has been unsuccessful and the contested mark may proceed to registration.

Costs

96. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 2/2016. For Fast Track opposition proceedings, costs are capped at £500, excluding the official fee. In the circumstances, I award the applicant the sum of £350, calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£250
Considering the opponent's submissions in lieu	£100
Total	£350

97. I therefore order Societa Italo-Britannica L. Manetti -H. Roberts & C. per azioni to pay BYLIA LTD, the sum of £350. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 21st day of July 2022

Sam Congreve
For the Registrar