

O/717/22

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003645917 BY SHENZHEN HAPPY
PLUS TECHNOLOGY CO., LTD TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASSES 3 AND 8

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 427647 BY INTERPARFUMS SUISSE**

Background and Pleadings

1. On 24 May 2021, Shenzhen Happy Plus Technology Co., Ltd ('the Applicant') applied to register the trade mark, shown on the cover of this Decision, number UK00003645917. The application was published for opposition purposes in the *Trade Marks Journal* on 23 July 2021. Registration is sought in respect of the following goods:

Class 3: *Foot smoothing stones; Essential oils for personal use; non-medicated hair treatment preparations for cosmetic purposes; hair conditioners; eyeliner pencils; massage oils and lotions; nail tips; lotions for face and body care; adhesives for cosmetic purposes; false eyelashes; adhesives for affixing false eyelashes.*

Class 8: *Fingernail polishers; electric curling tongs; electric nasal hair trimmers; electric hair clippers; electric eyelash curlers; electric hair straightening irons; electric fingernail polishers; artificial eyelash tweezers; curling tongs; Fingernail polishers, electric or non-electric; hair clippers for personal use, electric and non-electric.*

2. On 20 October 2021, the application was opposed by Interparfums Suisse ('the Opponent') based on on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The Opposition is directed against all of the Applicant's goods. The Opponent relies on the following earlier registration for its section 5(2)(b) ground, relying upon all of the goods in its specification:

UK00917911434

LANVIN

Filing date: 1 June 2018

Date registration completed: 18 October 2018

Registered for the following goods:

Class 3:	<i>Perfume; Cologne; Toilet water; Personal deodorants; Cosmetic creams and lotions; After-shave creams, gels and lotions; Shower gels; Foaming bath gels; Bath salts, not for medical purposes; Soaps; Make-up preparations.</i>
----------	---

3. The Opponent claims that:

- the applied-for mark is highly similar to the Opponent's two earlier marks;
 - that the parties' respective goods and services are identical and/or highly similar;
- and
- that, therefore, there exists a likelihood of confusion between the parties' marks.

4. Evidence and written submissions have been filed in the evidence round by the Opponent only. A hearing was neither requested nor considered necessary. Neither party has filed written submissions in lieu of a hearing.

5. The Opponent is represented by Williams Powell; the Applicant is represented by RevoMark.

6. The following decision has been made after careful consideration of the papers before me.

Opponent's evidence

7. The Opponent's evidence comes from Nicola Harrison of Williams Powell, the Opponent's UK representative. Ms Harrison's Witness Statement is dated 16 March 2022 and introduces evidence intended to support the Opponent's submission that the Opponent's *Cosmetic creams and lotions* in class 3 are 'highly similar' to the Applicant's *Foot smoothing stones* in class 3 and that there is complementarity between them. There is one Exhibit, 'Exhibit 1', which comprises:

- 5 product listings for footcare gift sets sold by Amazon (three listings), Bare Feet (one listing) and LookFantastic (one listing), four of which include a lotion

or cream. Two of the Amazon listings include a pumice stone (i.e. a foot-smoothing stone), while the remaining listing includes what appears to be a roller-type implement for smoothing the skin on the feet. The Bare Feet and Cowshed listings include a foot file.

- Pages from Boots.com showing the results for a search of the term ‘footcare’. The product listings include, inter alia: 4 listings for footcare tools (a ‘pedi’ tool for foot smoothing, a footspa, a ‘ped egg’ for foot smoothing, a foot file for hard skin removal); and 7 listings for foot creams (‘Eucerin dry Skin UreaRepair’, ‘Flexitol Rescue Heel Balm’, ‘Flexitol Intensely Nourishing Foot Cream’, ‘Canesten Dual Action Cream’, ‘O’Keeffe’s Healthy Feet Foot Cream’, ‘Boots CARE Moisturising Foot Cream’ and ‘Flexitol Rapid Revive Overnight Cream’).

8. It is accepted that both foot creams and footcare tools will often be found in the same section of a shop or online store e.g. a ‘footcare’ section. However, it is not necessarily the case that inclusion of the respective goods in the same gift set indicates that they are complementary.

Decision

Section 5(2)(b) of the Act and related case law

9. Section 5(2)(b) of the Act states:

“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.”

10. In accordance with section 6 of the Act, the Opponent’s mark is an earlier mark by virtue of its earlier filing date, which fell before the filing date of the applied-for mark on 24 May 2021.
11. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the application date (or priority date) of the applied-for mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is not engaged because the earlier mark had been registered for less than 5 years on the date on which the Applicant filed its application, i.e. 24 May 2021. The Opponent is therefore entitled to reply upon all the goods that it seeks to rely upon.
12. The following principles are derived from the decisions of the Court of Justice of the European Union (“CJEU”)¹ 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 C120/04; Shake di L. Laudato & C. Sas v OHIM, Case C-334/05P; and Bimbo SA v OHIM, Case C-591/12P

The principles:

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

¹ 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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 and services

13. 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.”

14. I must therefore be mindful of the fact that the appearance of respective goods in the same class is not a sufficient condition for similarity between those services, and neither are they to be found dissimilar simply because some services may fall in a different class.

15. I must also bear in mind the decision of the General Court (‘GC’) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05:

“29. ... 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”.

16. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to a parties' goods and services must be taken into account:

“[23] “In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281², identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

² *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

19. The Tribunal may group goods (or services) together for the purposes of assessment:

Separode Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

20. The goods to be compared are as follows:

Opponent's (earlier) mark:	Applicant's (contested) mark:
<u>Class 3</u> <i>Perfume; Cologne; Toilet water; Personal deodorants; Cosmetic creams and lotions; After-shave creams, gels and lotions; Shower gels; Foaming bath gels; Bath salts, not for</i>	<u>Class 3</u> <i>Foot smoothing stones; Essential oils for personal use; non-medicated hair treatment preparations for cosmetic purposes; hair conditioners; eyeliner pencils; massage oils and lotions; nail</i>

<p><i>medical purposes; Soaps; Make-up preparations.</i></p>	<p><i>tips; lotions for face and body care; adhesives for cosmetic purposes; false eyelashes; adhesives for affixing false eyelashes.</i></p> <p><u>Class 8</u></p> <p><i>Fingernail polishers; electric curling tongs; electric nasal hair trimmers; electric hair clippers; electric eyelash curlers; electric hair straightening irons; electric fingernail polishers; artificial eyelash tweezers; curling tongs; Fingernail polishers, electric or non-electric; hair clippers for personal use, electric and non-electric.</i></p>
--	--

21. I have considered the Opponent's evidence, summarised above at [7], intended to demonstrate similarity and complementarity between *cosmetic lotions and creams* and *foot smoothing stones*. It is accepted that both foot creams and footcare tools will often be found in the same section of a shop or online store e.g. a 'footcare' section. However, it is not necessarily the case that inclusion of the respective goods in the same gift set indicates that they are complementary.

22. The Opponent has argued³ that the following comparisons apply:

Opponent's goods	Applicant's goods	Level of similarity claimed
<p>Class 3 <i>Perfume; Cologne; Toilet water; Personal deodorants</i></p>	<p>Class 3 <i>Essential oils for personal use</i></p>	<p>Identical or highly similar</p>

³ Opponent's written submissions, at paragraphs [9] and [11].

Class 3 <i>Cosmetic creams and lotions</i>	Class 3 <i>lotions for face and body care; massage oils and lotions</i>	Identical or highly similar
Class 3 <i>Cosmetic creams and lotions; soaps</i>	Class 3 <i>Non-medicated hair treatment preparations for cosmetic purposes; hair conditioners</i>	Identical or highly similar
Class 3 <i>Cosmetic creams and lotions</i>	Class 3 <i>Foot smoothing stones</i>	Highly similar
Class 3 <i>Make-up preparations</i>	Class 3 <i>Adhesives for cosmetic purposes; false eyelashes; adhesives for affixing false eyelashes; eyeliner pencils; nail tips</i>	Identical or highly similar
Class 3 <i>Perfume; Cologne; Toilet water; Personal deodorants; Cosmetic creams and lotions; After-shave creams, gels and lotions; Shower gels; Foaming bath gels; Bath salts, not for medical purposes; Soaps; Make-up preparations.</i>	Class 8 <i>Fingernail polishers; electric curling tongs; electric nasal hair trimmers; electric hair clippers; electric eyelash curlers; electric hair straightening irons; electric fingernail polishers; artificial eyelash tweezers; curling tongs; Fingernail polishers, electric or non-electric; hair clippers for personal use, electric and non-electric</i>	Highly similar

Class 3

23. Contested goods: *Essential oils for personal use*

I do not find these goods to be identical with any of the Opponent's goods. In my

view, none of the Opponent's terms will encompass, or be encompassed by, *essential oils for personal use*. I therefore consider the extent to which there may be similarity between the parties' respective goods. I compare the Applicant's goods against the Opponent's *perfumes*. The Opponent's goods will, in my view, cover fragrances used about the person or to create an aroma in a room. *Essential oils for personal use* are natural fragranced oils typically obtained by distillation from plants (e.g. lavender or eucalyptus oils) which are applied to the body for a variety of reasons, including, *inter alia*: during massage; to lift one's mood/reduce stress; for relaxation; to improve sleep. The purposes of the respective goods will coincide to the broad extent that both sets of goods are scented. The specific purposes will, however, differ; the primary purpose of the Opponent's goods is to impart a pleasant aroma, whereas the Applicant's essential oils, although scented, have a variety of other primary purposes. I consider that the purpose for which the Applicant's goods are purchased goes beyond mere fragrance. Users will overlap; consumers of perfumes may also purchase essential oils for personal use. Methods of use will often overlap; both sets of goods might be dabbed on the body. Trade channels will overlap somewhat; both sets of goods might be offered by the same physical shops/websites. The natures of the goods will, at times, coincide; perfumes are sometimes in the form of oils. I do not consider the respective goods to be in competition because perfumes are purchased purely for their fragrant properties whereas, as noted above, *essential oils for personal use* are purchased for other reasons incidental to their fragrant properties. I therefore find the respective parties' goods to be similar to at least a medium degree.

24. Contested goods: *lotions for face and body care*

I agree with the Opponent's submission that the Applicant's *lotions for face and body care* are identical with the Opponent's *Cosmetic creams and lotions*. The Applicant's term will be wholly encompassed by the Opponent's term. The respective goods are therefore 'Merici' identical. The Applicant's *massage [...] lotions* will, in my view, have medium-high level of similarity to the Opponent's *Cosmetic creams and lotions*. The respective goods will coincide in users, trade channels and natures. *Massage [...] lotions* may also moisturise the skin as well as cosmetic lotions.

25. Contested goods: *massage oils and lotions*

I compare these goods against the Opponent's *Cosmetic creams and lotions*. *Massage oils and lotions* are applied to the skin during a massage (although they may also bring about cosmetic enhancement). *Cosmetic creams and lotions* are applied to the skin with the aiming of enhancing personal appearance. The primary purposes of the goods are therefore different. Users of the respective goods will often overlap. In my view, users will comprise both the general and professional public; both sets of goods may be purchased for home use or by professionals (e.g. health or beauty spas). Trade channels will also overlap; both sets of goods will be sold by the same physical shops/websites. The natures of the respective goods will differ; creams and lotions typically being aqueous (water-based) preparations, whereas the Applicant's goods are oils. Methods of use will coincide to the extent that both sets of goods will be applied topically and 'rubbed' or massaged into the skin. I do not find the respective goods to be in competition; the Opponent's goods aim to provide cosmetic enhancement whereas the Applicant's goods will be used for therapeutic reasons e.g. soothing of muscles; relaxation etc. I do not find complementary between the goods, either; although the average consumer might presume both sets of goods to derive from the same undertaking, neither set of goods is necessary or important for the other. I find the respective goods to be similar to a medium degree.

26. Contested goods: *non-medicated hair treatment preparations for cosmetic purposes; hair conditioners*

I compare these terms against the Opponent's *Cosmetic creams and lotions*. The Opponent's terms will include creams/lotions for the hair. I therefore find the respective goods to be 'Merik' identical. If I am wrong about that, then the respective goods are highly similar: trade channels, users and natures will coincide.

27. Contested goods: *eyeliner pencils*

I compare these goods against the Opponent's *Make-up preparations*. A

'preparation' is a mixture that has been prepared for use; in this case, as a cosmetic. In my view, *eyeliner pencils* will be encompassed by the Opponent's *Make-up preparations*. The respective goods are therefore 'Merici' identical.

28. Contested goods: *Foot smoothing stones*

I compare this term against the Opponent's *Cosmetic creams and lotions*. The Applicant's goods comprise abrasive stones used for sloughing off dry skin from the feet. The purposes of the respective goods will overlap only to the broad extent that both are concerned with improving the appearance or condition of an aspect of the person. Users will overlap; the respective goods will be purchased by both the general and professional public (e.g. health spas or beauty salons). Trade channels will overlap; both sets of goods will be sold from the same outlets in physical shops or online. This is borne out by the Opponent's evidence at Exhibit 1. The goods will differ in terms of physical nature; the Applicant's goods comprising items of 'hardware' i.e. a durable objects, as compared to the Opponent's creams and lotions which take the form of substances whose volumes deplete with use. Although the respective goods share a broad purposes, I do not consider them to be in competition. I do not consider the respective goods to be complementary; although lotions and creams for the feet might be used with the *foot smoothing stones*, neither is important to, or indispensable for the other. I do not consider that the average consumer would presume both sets of goods to originate from the same undertaking. I find the respective goods to be similar to a low degree.

29. Contested goods: *nail tips; false eyelashes*

I disagree with the Opponent's contention that the Applicant's goods are 'make-up preparations' and, therefore, identical with the Opponent's goods. I therefore compare these goods against the Opponent's *Make-up preparations* using the approach set out in the *Treat* case⁴. The Applicant's goods comprise items which are affixed to the nails or eyelashes by way of adornment. The parties' respective

⁴ *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

goods will coincide in purpose to the broad extent that both focus on personal appearance. Methods of use will differ to the extent that the Applicant's goods are 'affixed' to the person by way of an adhesive, whereas the Opponent's goods are preparations which are applied directly and can be used in varying amounts (e.g. an eyeshadow can be applied lightly or heavily). Users will overlap; consumers of the Applicant's goods will often also wear make-up. Trade channels will also overlap; both parties' goods will be sold by the same outlets, often in the same section (e.g. the 'beauty section'). The natures of the parties' goods will differ; the Applicant's goods being decorations/ornaments affixed to the nails/eyelids as compared to the Opponent's goods being substances which are applied or 'painted on to' the person. In my view, there is competition between the parties' goods; one might deliberate over whether to purchase a nail polish (a make-up preparation) or *nail tips*, or whether to purchase a mascara (a make-up preparation) or *false eyelashes*. I do not, however, find complementarity. Although the average consumer may presume both sets of goods to originate from the same undertaking, neither set of goods is important for, or indispensable to, the other. I find the respective parties' goods to be similar to a medium degree.

30. Contested goods: *adhesives for cosmetic purposes; adhesives for affixing false eyelashes.*

I compare these goods against the Opponent's *Make-up preparations*. The purposes of the respective goods overlap only to the broad extent that both are used to enhance personal appearance. The specific purposes of the respective goods will differ; the purpose of the Applicant's goods being to fix false eyelashes or other ornamental items (e.g. crystals or glitter) in place. Methods of use are similar insofar as both are substances applied to the person, albeit the Applicant's goods are fixatives for other items. Users and trade channels will coincide for the reasons provided above at [29]. I do not consider the goods to be competitive; the Applicant's goods will be sought for their adhesive qualities which cannot be provided by the Opponent's goods instead. I find the respective goods to be similar to a medium degree.

Class 8

31. Contested goods: *Fingernail polishers; electric fingernail polishers; Fingernail polishers, electric or non-electric*

I compare these goods against the Opponent's *Make-up preparations*. The *broad* purposes of the respective goods are shared to the extent that both are aimed at enhancing the appearance. The *specific* purposes of the respective goods will differ: the Applicant's goods are intended to enhance the appearance of the nails; whereas *make-up preparations* are used to enhance the appearance of the face. Methods of use will therefore differ; the Applicant's goods being tools to 'buff' the nails, whereas the Opponent's goods are preparations that are typically applied to the face (it is nevertheless acknowledged that 'body make-up' is used to conceal tattoos or blemishes etc). Users of both sets of goods will comprise both the general and professional public: individuals seeking to improve the appearance/condition of their nails; and professionals in the beauty business, e.g. beauty salons and the like. Trade channels may overlap; the same outlet may sell both nail grooming tools as well as *make-up preparations*. The goods will be very different in nature; the Applicant's goods comprising tools as compared to the Opponent's preparations which would often be in liquid form in bottles. I do not consider the goods to be competitive; neither good is substitutable for the other. I do not find the respective goods to be complementary; neither is necessary or important for the other, and I consider it unlikely that an average consumer would attribute both sets of goods to the same undertaking. I therefore find the respective goods to have a very low level of similarity.

32. Contested goods: *electric nasal hair trimmers; electric hair clippers; electric nasal hair trimmers; electric hair clippers; electric curling tongs; electric hair straightening irons; curling tongs.*

I do not find these goods to have any level of similarity with the Opponent's goods. Although both parties' goods are used about the person, and there may be trade channel and user overlap, this is insufficient to support a finding that parties' goods are similar.

33. Contested goods: *electric eyelash curlers; artificial eyelash tweezers.*

I compare these goods against the Opponent's *make-up preparations*. The purposes of the respective goods are shared only to the broad extent that both parties' goods are aimed at enhancing personal appearance: the Applicant's goods focus on the eyelashes; and the Opponent's goods will include mascaras. The methods of use will differ; the Applicant's goods are tools used to curl the eyelashes or to put false eyelashes in place, whereas mascara, a make-up preparation, is applied to the eyelashes using a brush. I consider that users of both sets of goods will comprise: the general consumer intending to enhance the appearance of their eyelashes/wear false eyelashes; and the professional public, e.g. beauty salons and the like. Trade channels with overlap somewhat; both sets of goods may be sold by the same outlets. The physical natures of the goods are different; the Applicant's goods comprise tools/implements whereas the Opponent's goods are makeup preparations (it is acknowledged that mascara is presented in a tube with an integrated brush to apply the product to the lashes). I do not consider the goods to be in competition; neither of the Applicant's sets of goods are substitutable for the Opponent's goods. I do not find complementarity, either; although mascaras may be used with eyelash curlers, I consider it unlikely that the average consumer would presume both parties' goods to originate from the same undertaking. I therefore find the parties' respective goods to have a low level of similarity.

Average consumer and the purchasing act

34. In *Hearst Holdings Inc*⁵ Birss J. (as he then was) described the average consumer thus:

“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

⁵ *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).

objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

35. The following of the Applicant’s goods come into play in this Opposition:

Class 3:

Foot smoothing stones; Essential oils for personal use; non-medicated hair treatment preparations for cosmetic purposes; hair conditioners; eyeliner pencils; massage oils and lotions; nail tips; lotions for face and body care; adhesives for cosmetic purposes; false eyelashes; adhesives for affixing false eyelashes.

Class 8:


Fingernail polishers; electric eyelash curlers; electric fingernail polishers; artificial eyelash tweezers; Fingernail polishers, electric or non-electric.

36. Dealing with the class 3 goods first, in my view, the average consumer will be predominantly the general public, with a smaller number of purchases made by professional consumers. The goods will be purchased from physical and online shops. The purchasing act will be primarily visual, the goods being self-selected from shelves/displays in physical shops, or ‘clicked on’ in the case of goods online. There will also be an aural aspect to the purchasing process where the purchaser makes oral requests to staff. Where the goods are located in physical shops, I consider that they will often be located in the ‘beauty’ or ‘toiletries’ sections. The goods are fairly frequent purchases with a low price point. In my view, the average consumer will pay a level of attention in the medium range when purchasing these goods. Factors considered during the purchasing process may include, *inter alia*: the ingredients (although this does not apply to foot smoothing stones); the suitability of the goods for the consumer’s requirements; whether the goods have been tested on animals.

37. I now address the class 8 goods. The average consumer of these goods will also, in my view, be predominantly the general public, with a smaller number of purchases made by professional consumers. The goods will be purchased from

physical and online shops. My comments above on the visual and aural aspects of the purchasing process also apply here. In physical shops, I consider that the goods may be located in a 'beauty' or 'personal grooming' section. In my view, the goods will be priced fairly low. I recognise that *fingernail polishers* will include non-electric nail 'buffers' which are disposed of when the 'buffing' surface is no longer effective. These will have a much lower price point than the electrical items, and will, in my view, be purchased with a low level of attention. The electrical items will, to my mind, be purchased with a medium level of attention. Factors influencing the purchasing decision will include: whether the goods are battery or mains operated; the size of the goods (e.g. whether they fit into a handbag/are conveniently sized for travel). The *artificial eyelash tweezers*, in my view, will also have a low price point, and will be purchased with a low level of attention.

Comparison of the marks

<p>Opponent's (earlier) mark:</p> <p style="text-align: center;">LANVIN</p>	<p>Applicant's (contested) mark:</p> 
--	---

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

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public,

and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

40. The Opponent’s mark is a word mark⁶ consisting of the single word ‘LANVIN’, all characters rendered in a plain sans-serif font and in upper case. The overall impression of the mark resides in the mark in its entirety.

41. The Applicant’s mark comprises the word ‘Lanvier’, rendered in a cursive script. The final character ‘r’ is embellished by a form which might be seen as either a feather or four fronds from a plant; each of the four ‘fronds’ appears to graduate in tone, incrementally from the top, from black to light grey. The overall impression of the mark resides in the mark in its entirety, with the word element playing the most dominant role by virtue of the fact that it can be read or articulated, whereas the frond/feather embellishment cannot. The embellishment cannot be considered negligible because it will be noticed by the average consumer.

42. Visual comparison

The Opponent has, in its written submissions⁷, presented its mark in a cursive script, as follows:

⁶ In *LA Superquimica v EUIPO*, Case T-24/17, at paragraph [39] it was held that:

‘[...] it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).’

⁷ Opponent’s written submissions, paragraph [4].

Lanvin

The Opponent argues⁸ that its mark, as a word mark, ‘can be shown in any font or stylisation’ and that, therefore, the stylisation of the Applicant’s mark ‘does nothing to differentiate it from the Opponent’s mark’.

43. The Applicant has argued in its counterstatement⁹ that ‘the stylisation of the last letter [of the Applicant’s mark]¹⁰ is dominant within the mark and the eye is automatically drawn to it. The different ending is therefore emphasised with reduces the possibility of confusion’.

44. In my view, the Opponent’s iteration of its mark in the cursive script, set out at paragraph [4] of its written submissions, amounts to normal and fair use of the mark. In finding this, I have borne in mind the case of *Dreamersclub Ltd v KTS Group Ltd*¹¹ in which Mr Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

dreams

Given that I have found that normal and fair use of the Opponent’s word mark will include its use in a similar font to that used by the Applicant, on the basis that this will not alter the distinctive character of the mark as registered, the Applicant’s choice of font, therefore, does little to differentiate between the marks visually.

45. The respective marks share the first five characters ‘LANVI’. The points of visual difference are:

- the presence of the characters ‘ER’ at the end of the Applicant’s mark, which are absent from the Opponent’s mark;

⁸ As above, paragraph [3].

⁹ Applicant’s Counterstatement, at section (8).

¹⁰ Text in parentheses is my own.

¹¹ BL O/091/19.

- the presence of the character 'N' at the end of the Opponent's mark, which is absent from the Applicant's mark;
- and
- the presence of the feather/frond embellishment in the Applicant's mark, which is absent from the Opponent's mark.

I find the respective marks to have a just above a medium level of visual similarity.

46. Aural comparison

In my view, a significant portion of the average UK consumer will articulate the Opponent's mark as 'LAN-VIN' and the Applicant's mark as 'LAN-VEE-UH' or LAN-VEE-AIR. The first syllables of the respective marks will therefore be identical. The points of aural difference are:

- the fact that the Opponent's mark consists of two syllables, as compared to the Applicant's mark of three syllables;
- and
- the Opponent's mark ending in the sound 'VIN' as compared the Applicant's mark ending in the sounds 'VEE-UH'.

I find the parties' respective marks to be aurally similar to slightly below a medium degree.

I have considered the possibility that a proportion of UK consumers will recognise that the contested mark appears to be of French origin; and might be inclined to articulate it as 'LON-VEE-AY' or 'LON-VEE-AIR'. I find this to be less likely with the earlier mark. In these situations, the marks will be aurally similar at best to a low degree.

47. Conceptual comparison

The Opponent's mark, 'LANVIN', will, in my view, be perceived by the average consumer as an invented word to which no meaning will attach. I recognise that some average consumers may perceive the word 'LANVIN' as an uncommon name. In either case, there will be no conceptual 'hook' for the mind to fix upon. I consider that the Applicant's mark, 'Lanvier', will also be perceived as an invented

word, or an uncommon name, or possibly a word of French origin; in either case, there will be no conceptual 'hook' for the average consumer. I therefore find the parties' marks to be conceptually neutral.

Distinctive character of the earlier mark

48. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).

49. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of

the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

50. 'LANVIN' does not appear in the English dictionary and will be seen by the average consumer as an invented word, or an uncommon name. It is neither descriptive of the goods in respect of which it is registered, nor does it allude to any characteristic of those goods. I find the Opponent's mark to have a high level of inherent distinctive character.

51. The Opponent has not adduced any evidence in relation to the use of its mark. The evidence that has been presented relates to the Opponent's argument that *Cosmetic creams and lotions* in class 3 are 'highly similar' to the Applicant's *Foot smoothing stones* in class 8. There is therefore no basis upon which to make a finding that the earlier mark enjoys an enhanced level of distinctive character.

Likelihood of confusion

52. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v Back Beat Inc*¹². Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹³, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

¹² Case BL O/375/10 at [16].

¹³ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

53. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [12]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

54. In my view, despite the identity and similarity between the parties’ respective goods, the net effect of the visual and aural differences is sufficient to overcome the similarities that I have identified. Notwithstanding the principle of imperfect recollection, the average consumer will, in my view, notice the different endings of the respective marks (i.e. the Opponent’s ‘n’/the Applicant’s ‘er’) which create a different number of syllables within the marks, as well as the presence of the embellishment on the end of the Applicant’s mark. Although the embellishment does not play a dominant role in the Applicant’s mark, it will nevertheless be registered by the average consumer visually owing to its size; and, therefore, play some part in the visual perception of the mark as a whole. I find that there is no likelihood of direct confusion.

55. I now consider whether there is a likelihood of indirect confusion. I note that in the recent case of *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.

56. Mr Purvis Q. C., as the Appointed Person, identified the following categories in *L.A. Sugar Limited v Back Beat Inc*¹⁴ where a finding of indirect confusion might be made:

¹⁴ Case BL O/375/10

(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)".

57. I note that these categories were not intended to be exhaustive. However, in my view, the instant case does not fall within any of the categories identified by Mr Purvis Q. C. I now consider, therefore, whether there is another basis upon which indirect confusion may occur. In my view, the different endings of the marks cannot plausibly give rise to the average consumer perceiving the parties' marks as brand variations or extensions relating to the same or economically linked undertakings. I can see no other mental process by which the average consumer would arrive at a conclusion indicative of indirect confusion. I can find no proper basis on which to make a finding that there is a likelihood of indirect confusion.

Conclusion

58. The Opposition has been unsuccessful. The Application may, subject to a successful appeal, proceed to registration.

COSTS

59. I award the Applicant the sum of **£200** as a contribution towards its costs, calculated as follows¹⁵:

¹⁵ Based upon the scale published in Tribunal Practice Notice 2/2016.

Consideration of the Opposition and preparation of Defence and Counterstatement	£200
Total:	£200

60. I therefore order Interparfums Suisse to pay to Shenzhen Happy Plus Technology Co., Ltd the sum of £200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of August 2022

N. R. Morris

**For the Registrar,
the Comptroller-General**