

**O-751-22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3328072  
BY MARICO LIMITED IN RESPECT OF THE FOLLOWING TRADE MARK**

**COCO  
SOUL**



**IN CLASS 3**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 414671 BY  
CHANEL LIMITED**

## **Background and pleadings**

1. Marico Limited (“the applicant”) applied to register the trade mark no. 3328072 in the UK on 30 July 2018. It was accepted and published in the Trade Marks Journal on 12 October 2018 in respect of the following goods:

**Class 3:** *Hair oils, lotions and washes, hair growing and preserving preparations, hair tonics, hair dyes, hair creams and conditioners; dentifrices; toilet preparations and shampoos; soaps of all kinds included in class 3; cleaning, polishing, scouring, bleaching and abrasive preparations; perfumes, essential oil; cosmetics (non-medicated), natural flavourings; detergents (not for industrial use); shaving soaps.*

2. Chanel Limited (“the opponent”) originally opposed the trade mark on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). By email dated 15 June 2022, the opponent withdrew its opposition in respect to *cleaning, polishing, scouring, bleaching and abrasive preparations*. It also withdrew its ground based upon section 5(3) of the Act. Consequently, the opposition falls to be decided only in respect of the ground based upon section 5(2)(b). This ground is brought on the basis of a single earlier UK trade mark no. 3266055, the relevant details of which are:

COCO

Filing date: 25 October 2017

Registration date: 19 January 2018

**Class 3:** *Preparations for application to or care of the skin, scalp, hair or nails; soaps; perfumes; essential oils; make-up; deodorants; cosmetics; non-medicated toilet preparations; non-medicated dental care preparations*

3. The opponent asserts that the respective goods are identical or similar and that the marks are similar. It also relies upon use of its earlier mark COCO with other elements such as COCO NOIR and COCO MADEMOISELLE.

4. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of its claimed enhanced distinctive character of its mark.

5. Only the opponent has filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary. The applicant provided written submissions, that I will also keep in mind.

6. A Hearing took place on 20 July 2022, with the opponent represented by Mr Guy Tritton of Counsel, instructed by Withers & Rogers LLP and the applicant by Ms Alison Wilson for Murgitroyd & Company.

7. 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 law.

### **Evidence**

8. The opponent's evidence consists of the witness statement of Ms Lucy Kathryn Aboulian, Head of Intellectual Property (Regional) of the opponent, together with Exhibits LKA1 – LKA25. The purpose of this evidence is to provide a history of the opponent's mark and to demonstrate the use and promotion of the mark both on its own and as part of composite marks.

### **Decision**

9. Section 5(2)(b) of the Act is 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”.

10. The following principles are obtained from the decisions of the Court of Justice of the European Union (“the 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 and services**

11. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective 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 whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

13. Mr Tritton produced a table setting out what he submitted are “identical”, “identical or highly similar” or goods with “low similarity”. This is produced below:

| <b>Mark Applied For</b>   | <b>Opponent's Specification</b>  |
|---|--|
| <b>IDENTICAL</b>  |  |
| <i>Hair oils, lotions and washes, hair growing and preserving preparations, hair tonics, hair dyes, hair creams and conditioner</i> | <i>Preparations for application to or care of the ... scalp, hair</i>                                      |
| <i>Dentrifices</i>  | <i>Non-medicated dental care preparations</i>  |
| <i>Toilet preparations and shampoos</i>   | <i>Non-medicated toilet preparations<br/>Preparations for application to or care of the ...scalp, hair</i> |
| <i>Soaps of all kinds in Class 3</i>  | <i>Soaps</i>   |
| <i>Perfumes</i>   | <i>Perfumes</i>  |
| <i>Essential Oils</i>   | <i>Essential oils</i>  |
| <i>Cosmetics (non-medicated)</i>  | <i>Make-up; cosmetics</i>  |
| <i>Shaving soaps</i>  | <i>Soaps</i>   |
| <b>IDENTICAL OR HIGHLY SIMILAR</b>  |  |
| <i>detergents</i>   | <i>Preparations for application to or care of the skin,</i>  |
| <b>LOW SIMILARITY</b>   |  |
| <i>Natural flavourings</i>  | <i>Perfumes, essential oils</i>  |

14. Ms Wilson challenged only the similarity of *detergents* and *natural flavourings*. I accept Mr Tritton's characterisation of the first group of goods as being identical. In respect of *detergents*, Mr Tritton submitted that detergents are not limited to household cleaning preparations. I keep in mind the following comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), where he 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."

15. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment, he set out a summary of the correct approach to interpreting broad and/or vague terms that included:

"...the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services."

16. Ms Wilson submitted that *detergents* is a reference to household cleaning products and not to products for cleaning the skin. The word *detergent* means "A *water-soluble cleansing agent which combines with impurities and dirt to make them more soluble,*

and differs from soap in not forming a scum with the salts in hard water”.<sup>1</sup> As such, the definition does not identify a particular use, however, the ordinary and natural meaning of the word is not likely to include products for the use on the person. Rather it is a term commonly used to describe household cleansing agents. As an average consumer of numerous of the applicant’s goods such *hair ... washes, shampoos, soaps* and *shaving soaps*, all of which can be described as being primarily a cleaning agent, I am not aware that these goods are, or ever have been, described as *detergents*. With this in mind, the high point is that they may both possess cleansing properties, but they are fundamentally for the cleansing of different things and in different areas of trade and I conclude that there is very little similarity between the applicant’s goods and *detergents*.

17. In respect of the applicant’s *natural flavourings*, following a discussion at the hearing, it was suggested by Mr Tritton that these may be used in cosmetics such as lip balms, where flavour may be an important characteristic. Consequently, the high point of the opponent’s case is that *natural flavourings* are an ingredient in *cosmetics*. By analogy, the following comments of the General Court (“the GC”) in *Les Éditions Albert René v OHIM*, Case T-336/03, are relevant here:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

18. It is not obvious to me that their nature, purpose nor customers overlap to any degree. Further, they are not in competition, and I cannot see how they would share trade channels. Finally, whilst I accept that one is important for the manufacture of the other, there is no close connection in that customers may think that responsibility for the respective goods lies with the same undertaking in the sense described in *Boston Scientific*.<sup>2</sup> I conclude that there is no similarity.

---

<sup>1</sup> [DETERGENT | Meaning & Definition for UK English | Lexico.com](#)

<sup>2</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06




## Comparison of marks

19. 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 Court of Justice of the European Union 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.”

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

21. The respective trade marks are shown below:

| Opponent's Earlier Mark | Applicant's Mark   |
|-------------------------|--|
| COCO                    |  |

22. The opponent's mark presents as a single word and this is, self-evidently, its dominant and distinctive element. The applicant's mark consists of the words COCO and SOUL and an indeterminate device that has variously been described by the parties as a spoon, a mirror or a drip. It is also presented in a pale grey colour. Ms

Wilson submitted that the figurative element is combined into the letter “O” of the word SOUL in a way that results in the SOUL element being the dominant and distinctive element of the mark. On the other hand, Mr Tritton submitted that COCO is the dominant element. I agree with Mr Tritton. The word SOUL operates upon the word COCO, i.e. it presents with the same meaning as “the soul of Coco” (I discuss this more when considering the conceptual similarity of the mark). Therefore, despite the two words being the same size, the word COCO appears above the word SOUL. This, combined with the meaning of the words leads me to conclude that the word COCO is slightly more dominant than the SOUL element. The figurative element extends down from inside the letter “O” of the word SOUL Mr Tritton characterised the figurative element as “not adding much”, however, it is not negligible despite being less dominant than the word elements.

23. Keeping in mind this analysis, the marks share visual similarity because they have the word COCO in common. As pointed out by Mr Tritton, the letter style used in both marks is very similar. All the other aspects of the applicant’s mark are absent in the opponent’s mark and are points of difference. In light of this similarity and these differences, I conclude that the respective marks share a medium level of visual similarity.

24. Aurally, the opponent’s mark consists of the two syllables CO-CO. The applicant’s mark will be expressed as the three syllables CO-CO-SOLE. The figurative element present in the applicant’s mark is not likely to contribute to its aural characteristics. Consequently, the respective marks share the same two syllables CO-CO. Mr Tritton submitted that the hard “Cs” present in the shared first two syllables and the soft “S” in the third syllable of the applicant’s mark results in the CO-CO syllables being aurally dominant in the applicant’s mark. I agree. They differ in that the applicant’s mark’s third syllable is absent from the opponent’s mark. Based on these similarities and differences, I conclude that the respective marks share between a medium and high level of aural similarity.

25. In respect of the conceptual comparison, it is the applicant’s position that COCO derives from the word COCONUT and is descriptive of goods that smell of coconut. No evidence has been presented in support of this assertion, but such a meaning is

confirmed by reference to a dictionary.<sup>3</sup> Mr Tritton submitted that COCO will be recognised as a women's name and that the consumer will associate the mark with Coco Chanel, the founder of the opponent. He submitted that the evidence illustrates that Coco Chanel is an iconic figure with a huge body of films and books about her and, consequently, the consumer is likely to perceive the word as a reference to that person. When considering this submission, I keep in mind the comments of the CJEU in Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, *EUIPO v Messi Cuccittini* and *J.M.-E.V. e hijos v Messi Cuccittini*. The CJEU held that all relevant factors should be taken into account in determining whether there is a likelihood of confusion. In an appropriate case, this could include the potential fame of the applicant on the average consumer's perception of the contested trade mark. In that case, the reputation of Lionel Messi was such that it was implausible that the average consumer would not associate the trade mark with the footballer when used on the goods at issue (in classes 9, 25 and 28); whilst some consumers may not make this association, they would not be typical of the average consumer of sports clothing and equipment. In assessing the likelihood of confusion, it was therefore permissible to take account of the conceptual difference between the marks as a factor which mitigated the risk of confusion from the visual and aural similarities between them.

26. Further, in *Retail Royalty Company v Harringtons Clothing Limited*, Phillip Harris, as the Appointed Person, considered the argument that the letters "AE" had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning "AMERICAN EAGLE". He said:

"74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public as a *trade mark* [original emphasis].

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a

---

<sup>3</sup> [COCO | Meaning & Definition for UK English | Lexico.com](https://www.lexico.com/definition/coco)

level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark's reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the "reputation" element in those cases related to the fame attached to the names of the individuals for their roles in society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation."

27. It is clear from these authorities that a mark or element of a mark may be perceived as having a conceptual meaning resulting from the reputation of a thing or person, but this is rare and such a finding must take account all the surrounding facts. Mr Tritton pointed me to the following evidence:

- Gabrielle "Coco" Chanel founded the opponent in 1910 as a haute couture fashion house and that it was established in the UK in 1925. The opponent also became "extremely well known" for its fragrance, beauty, watches and jewellery products";<sup>4</sup>
- Today, the opponent is regarded as one of the leading fashion houses in the world and in many countries it sells "an exclusive range of goods including ... perfumes, cosmetics and skincare products";<sup>5</sup>
- COCO is one of the opponent's "most valuable trade marks" and is the name that Gabrielle Chanel was affectionately known. The mark is used as a homage to the opponent's founder and has been used for "several decades" and is "now synonymous with [the opponent's] business";<sup>6</sup>

---

<sup>4</sup> Ms Aboulian's witness statement, para 4

<sup>5</sup> Ditto

<sup>6</sup> Ditto, para 5

- The opponent has created a web-based documentary called “Inside Chanel” that features Ms Chanel, “her inspirations and the history behind her most iconic contributions to fashion, fragrance, beauty and jewellery”. Chapter 5, first published in 2013, consist of the history of Ms Chanel and describes how she became known as “Coco”. This has received in excess of 7,800,000 views on YouTube;<sup>7</sup>
- There has been “a wealth of books published and films produced in the UK documenting Coco Chanel’s life, legendary achievements and the profound changes that she brought about in the fashion industry”. Ms Aboulian lists ten of these all published between 1990 and 2009. Four of these use “Coco” as part of their title and Ms Aboulian points out that one of these also has an entire chapter entitled “COCO”. Further, they all refer prominently to “Coco Chanel”;<sup>8</sup>
- There are a number of educational books aimed at children, one of which appears to be exclusively about Ms Chanel and two others that refer to her. These were published in 2016 or 2017 and extracts are provided;<sup>9</sup>
- There is a musical about Ms Chanel’s life entitled “Coco” that was performed on Broadway in 1970 and also a number of films, namely, “Coco Before Chanel” (“Coco Avant Chanel”) starring Audrey Tautou and “Coco & Igor”, both released in 2009.<sup>10</sup>

28. There is a clear difference between the use of the word COCO as or within a trade mark compared to the authorities referred to above. This is that the word COCO, if it is perceived as a name, is a forename that is inherently less distinctive for the goods in issue than a surname or full name (that was in issue in the *MESSI* case). Therefore, whilst it is clear from the evidence why the opponent is using the word COCO as a mark, I must evaluate to what degree the average consumer will see the mark COCO as a reference to Ms Chanel rather than merely a female forename or some other meaning (such as “coconut” as suggested by the applicant). It has used COCO for a much shorter time than the opponent company has been in

---

<sup>7</sup> Ditto, para 6 and Exhibit LKA1

<sup>8</sup> Ditto, para 7

<sup>9</sup> Ditto, para 8 and Exhibit LKA2

<sup>10</sup> Ditto, para 9

existence and whilst I acknowledge the existence of numerous books and films about Ms Chanel, it is unclear to what degree these have assisted in educating the UK average consumer to understand the COCO mark to be a reference to Ms Chanel. I note that at least one of the films has a French title and may not be an English language film. The Broadway stage show was in 1970 and presumably ran only for a short time. This will clearly have a very negligible, if any, impact upon the UK average consumer as of the relevant date in these proceedings.

29. Further, the use shown is always in close proximity to the opponent's house mark CHANEL and it is possible that it is that particular form of use of these marks, in close proximity, that may prompt the average consumer to perceive COCO as a reference to Ms Chanel rather than the capacity of COCO alone to do so. In respect of the opponent's documentary on YouTube, on the face of it, 7.8 million views is impressive, but I am unable to identify how many of these relate to viewers from the UK or how many viewed it before the relevant date. It is also not possible to know if it is targeted at UK consumers or even if it is in English.

30. Taking all of this into account, I am unable to conclude that a significant proportion of average consumers in the UK, upon encountering either the opponent's mark or the applicant's mark will perceive the COCO element as a reference to Ms Chanel. However, neither can I discount that some may recognise the word as a reference to her.

31. In light of all of this, I conclude that the conceptual contribution of the word COCO in both marks is likely to be as a forename but that some consumers will recognise it as a specific reference to Ms Chanel or as an allusion to coconut.

32. In respect of the meaning of the word SOUL present in the applicant's mark, Mr Tritton submitted that because of the word's spiritual connotations it is often used to suggest goods are green, organic, healthy, spiritual, real not fake or not materialistic or main stream. He put it that, therefore, the word has connotations of healthy, responsibly sourced, spiritual goods. The word SOUL has a number of meanings, the most relevant of which are:

“1. The spiritual or immaterial part of a human being or animal, regarded as immortal.

...

2. *mass noun* Emotional or intellectual energy or intensity, especially as revealed in a work of art or an artistic performance.”<sup>11</sup>

33. In light of these meanings, I disagree with Mr Tritton that the word will be understood as suggesting green, organic, healthy, real or unmaterialistic. However, I do accept that it may suggest spiritual connotations to the average consumer. It may also be understood as being allusive of the intensity. Therefore, when used together with the word COCO the word elements of the mark allude to the energy of someone named COCO or, less likely, it may suggest an intensely coconut scented product. Regardless of how it is perceived, the opponent’s mark contains no equivalent and the word SOUL creates a point of conceptual difference between the marks.

34. The applicant’s mark also contains the ambiguous figurative element. I conclude that because of the ambiguity it is unlikely to contribute anything to the conceptual identity of the mark.

35. In summary, I conclude that the respective marks share a medium level of conceptual similarity.

### **Average consumer and the purchasing act**

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

---

<sup>11</sup> [SOUL | Meaning & Definition for UK English | Lexico.com](https://www.lexico.com/definition/soul)

37. 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.”

38. Mr Tritton submitted that the average consumer is the general public and that the goods are everyday goods where the level of attention during the purchasing process is likely to be low to average. He also submitted that the purchasing process is mainly visual in nature but with aural considerations sometimes playing a part such as when consulting a sales assistant. I agree with this assessment.

### **Distinctive character of the earlier trade mark**

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not



contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. As I have already found, the mark COCO is likely to be perceived as a forename or, less likely, as an indication of “coconut”. It is, therefore, not endowed with the same level of distinctive character as an invented word. Forenames are not generally endowed with a great deal of distinctive character and in respect of the goods of the opponent, I conclude that it is endowed with a reasonably low level of inherent distinctive character.

41. The opponent claims that its mark benefits from a significant enhanced level of distinctive character and provides evidence of the use of its COCO mark. Ms Wilson submitted that the earlier mark was only filed on 25 October 2017 and therefore, the use shown does not constitute substantial use over “many” years as claimed by the opponent. The relevant date in these proceedings is the filing date of the contested mark, namely, 30 July 2018. This is the date at which distinctive character of the earlier mark must be assessed. In doing so, there is no reason why use prior to the filing date of the earlier mark cannot be taken into account. The evidence provided in support of this was detailed, by Mr Tritton, in a helpful annex to his skeleton argument. The main points shown in this evidence can be summarised as follows (some of which is subject to a confidentiality order and has been redacted in the publicly available version of this decision):

- The opponent’s COCO mark was used in respect of a fragrance in 1984 and since then it has extended its family of COCO marks. In 2001 the COCO MADEMOISELLE fragrance was launched and COCO NOIR in 2012.<sup>12</sup> The

---

<sup>12</sup> Ms Abouljian’s witness statement, para 10

COCO range includes moisturising body lotion, soap, deodorant, shower gel, bath gel and body cream;<sup>13</sup>

- Examples of use are provided.<sup>14</sup> Some of these are obtained from the John Lewis website and are dated between February 2015 and February 2017. Typical of this use is the example shown in the two images below:



<sup>13</sup> Ditto

<sup>14</sup> Exhibit LKA3



- The COCO fragrance is described as a “oriental-floral fragrance” with “the citrus note of mandarin, the richness of jasmine and the enveloping presence of petunia” and not coconut;<sup>15</sup>
- The opponent’s range of lipstick under the names ROUGE COCO, ROUGE COCO SHINE, ROUGE COCO STYLO and ROUGE COCO GLOSS have been heavily featured in the media.<sup>16</sup> Examples of use of these are provided<sup>17</sup> and some are dated (2015 – 2017) extracts from the John Lewis website. It is difficult to read text on the products themselves, but images of the products are also accompanied by a description such as “CHANEL ROUGE COCO Ultra Hydrating Lip Colour”. Ms Aboulian states that they are all unscented;<sup>18</sup>
- Annual wholesale figures are provided in respect of COCO branded goods<sup>19</sup> for the period 2013 to 2018. These are in excess of between [REDACTED] a year in respect of fragrances, in excess of between [REDACTED] a year in respect of body lotion, soap, deodorant, shower gel, bath gel and body cream, and in excess of between [REDACTED] in respect of lipsticks.<sup>20</sup> In addition during the same period, sales of COCO

<sup>15</sup> Ms Aboulian’s witness statement, para 11

<sup>16</sup> Ditto

<sup>17</sup> At Exhibit LKA4

<sup>18</sup> Ms Aboulian’s witness statement, para 12

<sup>19</sup> Ditto, para 14

<sup>20</sup> The figures relating to lipsticks also includes sales in respect of ROUGE ALLURE because it was not possible to separate the figures

MADAMOISELLE fragrance and skincare products was between [REDACTED] and [REDACTED] a year and, in respect of COCO NOIR fragrance and skin care products, between [REDACTED] and [REDACTED];<sup>21</sup>

- A selection of 32 partially redacted invoices are provided to UK customers such as House of Fraser, John Lewis and Stena Line, all dated between July 2013 and January 2018.<sup>22</sup> These list various items some of which have descriptions that includes the word COCO. Examples of these descriptions include: “LIP ROUGE COCO BOY 2011”, “COCO SPRAY EDP 35ml”, “COCO-PARFUM 15ml”, “COCO-BATH SOAP 150g”, “COCO LUXURY BODY LOTION 200ML”, “LIP: ROUGE COCO MADAMOISELLE”, “COCO SPRAY DEODRANT”;
- The share of the female fragrance market in the UK for the opponent’s COCO fragrance is stated as being between [REDACTED] between 2013 and 2018 that equated to an annual ranking of between [REDACTED];<sup>23</sup>
- The opponent’s COCO branded lipstick had between [REDACTED] of annual market share between 2015 and 2018 with an annual ranking during the same period between [REDACTED];<sup>24</sup>
- The opponent’s COCO products are sold through seven of its own fashion boutiques in the UK and, in addition, COCO products are stocked in a further 870 UK outlets that includes department stores such as John Lewis and House of Fraser.<sup>25</sup>

42. Ms Aboulian refers to the finding of the hearing officer in Case BL O-192-19<sup>26</sup> where, at paragraph 43, the hearing officer stated the following:

“... I accept the Opponent’s claim that the distinctiveness of the mark has been enhanced through use in the UK by 8 May 2017 (the priority date of the holder’s mark). This is especially the case for its fragrance and lipsticks; I note that the opponent does not feature the COCO body lotion, soap, deodorant, shower gel, bath gel and body cream specifically in its advertising, but I accept that these

---

<sup>21</sup> Ms Aboulian’s witness statement, para 40

<sup>22</sup> At Exhibit LKA8

<sup>23</sup> Ms Aboulian’s witness statement, para 31

<sup>24</sup> Ms Aboulian’s witness statement, para 32

<sup>25</sup> Ditto, para 38

<sup>26</sup> Ditto, para 19 and Exhibit LKA6

goods are scented with the COCO fragrance, are put on the market with and sold adjacent to the fragrance, such that the enhanced distinctive character in respect of the fragrance “spills over” to the associated body range ...”

43. The relevant date in those proceedings was 8 May 2017, compared to 30 July 2018 in the current proceedings. However, I note that the sales figures detailed earlier are not significantly different in 2018 than in 2017 and 2016 and therefore, it appears that the position in the market place at the relevant date of the two proceedings was not materially different. Whilst I do not know what evidence was before the hearing officer in that case, his conclusions broadly match the impression I take from the evidence in the current case.

44. I accept that use in respect of marks such as ROUGE COCO contributes to the enhanced distinctive character of COCO solus because the COCO element will lead the consumer to perceive the goods at issue as originating from the same undertaking that is using the mark COCO.<sup>27</sup>

45. Ms Wilson also submitted that the consumer is only aware that the element COCO is being used within the cosmetic industry because it is descriptive of coconut. Whilst I accept that in certain circumstances the word may convey such an allusion, the use shown by the opponent does not present the mark in this way to the consumer. Further, the allusion is not so strong that this will be the immediate impression created by the word. It will be more likely to be perceived as a female forename. Therefore, I conclude that the fact that COCO may, in certain circumstances be seen as an allusion to coconut, this does not undermine the opponent’s evidence of enhanced distinctive character.

46. Taking all of the above into account, I conclude that the evidence illustrates that the opponent’s mark has acquired an above average level of distinctive character through use.

---

<sup>27</sup> See *Spa Monopole, compagnie fermière de Spa SA/NV v. OHIM*, Case T-131/12

## GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

47. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

48. The opponent relies upon a claim that it has a family of COCO marks. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or

services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

49. The factual background of the above case included the fact that the opponent was relying on ten earlier marks. In the current case, the opponent relies on only one earlier mark. At the hearing, I asked for Mr Tritton's submissions on the implications of the marks being relied upon as constituting a family of marks not being relied upon by the opponent as earlier marks (except COCO of course). He suggested that there is no rule of law or case law that would require this. Section 5(2)(b) states that a "*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*" [my added emphasis]. Therefore, section 5(2)(b) speaks of registration being refused on the basis of earlier trade marks (as defined by section 6). It follows that these earlier marks must be listed in the statement of grounds. I take

support for this view from the Registry's Tribunal Practice Notice ("TPN") 1/2018 where it is stated:

*"For the purposes of establishing the 'family' an opponent/applicant for invalidation should rely only on earlier marks [my emphasis] that it can show were present on the UK market at the relevant date. Further, it should be borne in mind that while a big family may be a more emphatic illustration of the distinctiveness of the common element, adding many more earlier marks to the "several" required to constitute a 'family' entails diminishing returns and may make for inefficient proceedings."*

50. Whilst I am not aware of any case law on this point, I observe that the case relied upon by Mr Tritton (*Il Ponte Finanziaria SpA v OHIM*, T-194/03) relates to a claim of a family of marks where those marks ARE all listed as earlier marks and are, therefore, consistent with my view.

51. In light of all of the above, I find that the opponent is not able to rely upon a family of marks argument because it only relies upon one earlier mark.

52. Turning to the question of likelihood of confusion between that one earlier mark and the applied for mark, I keep in mind that I have found:

- Most of the respective goods are identical but the applicant's *detergents* have very little similarity and its *natural flavourings* are not similar to the opponent's goods;
- The distinctive character of the opponent's mark self-evidently resides in the single word COCO. The word COCO has slightly more dominance than the SOUL element in the applicant's mark with the figurative element playing a lesser but not negligible role;
- The respective marks share a medium level of visual and conceptual similarity and between a medium and high level of aural similarity;
- The average consumer is the general public who are likely to pay a low to average level of care and attention during the purchasing process that is



primarily visual in nature but I recognise that aural considerations may sometimes play a part;

- The inherent distinctive character of the earlier mark is relatively low but the evidence illustrates that this has been enhanced through use to an above average level of distinctive character.

53. There are additional elements present in the applied for mark that are absent in the opponent's mark. These differences are not likely to go unnoticed and, sensibly in my view, Mr Tritton focused his submissions on a claim of indirect confusion.

54. 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)".

55. 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.

56. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

57. Mr Tritton submitted that COCO is a highly distinctive house mark and used as part of a family of marks and that the public will perceive the applied for mark as use of the opponent's COCO mark together with, what he submitted, a less distinctive word as part of a sub-brand. I have already dismissed the "family of marks" argument. Therefore, these points do not advance the opponent's case.

58. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02<sup>28</sup>, the GC noted that the beginnings of word tend to have more visual and aural impact than the ends. The GC, in *Enercon GmbH v OHIM*, T-472/07, stated that this principle can also apply to a two-word mark.

---

<sup>28</sup> See paras 81 to 83

59. I keep all this guidance in mind. I note the categories identified by Mr Purvis Q.C. are not exhaustive and neither do I consider that the boundaries of each category are rigidly defined. Consequently, I must still consider the precise circumstances of the current case when reaching a conclusion. I have found that the opponent's mark is endowed with an above average level of distinctive character. Mr Purvis Q.C. uses the phrase "so strikingly distinctive" to describe the common element between the respective marks when defining the first category. In my view such a phrase can include marks with an above average level of distinctive character as in the current case. Whilst I do not rule out the possible "coconut" connotation in the word COCO, I consider that a significant proportion of the relevant public, upon encountering the applicant's mark, will make a connection to the opponent's mark in circumstances where the respective goods are identical. Consequently, I find that there exists a likelihood of indirect confusion.

60. In reaching this conclusion, I consider that a substantial number of the relevant public, when encountering the applicant's mark will perceive it as a reference to the energy of the person called COCO and, therefore, consider that the identical goods provided under the mark are provided by the same or a linked undertaking as those goods provided under the opponent's COCO mark. The presentation and figurative element present in the applicant's mark does not distract from this likely perception.

61. Ms Wilson submitted that the trade mark register contains a number of marks in the names of third parties that include the word COCO covering goods in Class 3 to advise that they smell of coconut. I place little weight on this because, as Mr Tritton submitted, it is well established<sup>29</sup> that such "state of the register" evidence is not sufficient to demonstrate that the distinctive character of the element in question has been weakened. This is because it is unknown how many of such trade marks are effectively used in the market place.

62. In summary, I find that the opposition succeeds against the following list of goods:

---

<sup>29</sup> See for example, *Zero Industry Srl v OHIM*, Case T-400/06 at para 73.

*Hair oils, lotions and washes, hair growing and preserving preparations, hair tonics, hair dyes, hair creams and conditioners; dentifrices; toilet preparations and shampoos; soaps of all kinds included in class 3; perfumes, essential oil; cosmetics (non-medicated); shaving soaps.*

63. The opposition is no longer pursued against *cleaning, polishing, scouring, bleaching and abrasive preparations* and the opposition fails in respect of *natural flavourings; detergents (not for industrial use)*.

### **Summary**

64. The opposition succeeds against the list of goods in paragraph 62, above. The application may proceed to registration in respect of the goods shown in paragraph 63.

### **COSTS**

65. The opponent has been substantially successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1850 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

|  |              |
|--|--------------|
| Official fee (reduced to £100 in light of the case proceeding only in respect of section 5(2)(b)): | £100         |
| Preparing and filing TM7 and considering the counterstatement:                                     | £350         |
| Preparing evidence:  | £700         |
| Preparing for, and attending hearing:  | £700         |
| <b>Total:</b>  | <b>£1850</b> |

66. I therefore order Marico Limited to pay Channel Limited the sum of £1850. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 1<sup>st</sup> day of September 2022**

**Mark Bryant**  
**For the Registrar**

REDACTED