

O/827/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3574252

**IN THE NAME OF
NOBLE TRENDS
LIMITED**

**TO REGISTER THE FOLLOWING TRADE
MARK:**

FEMME LUXE

IN CLASSES 3, 14, 18, 25, 26 & 35


AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425848
BY FEME LIMITED**

Background and pleadings

1. On 4 January 2021, Noble Trends Limited¹ (“the applicant”) applied to register the trade mark “**FEMME LUXE**” in the UK. It was accepted and published in the Trade Marks Journal on 30 April 2021. The applicant seeks protection for a range of goods and services in classes 3, 14, 18, 25, 26 & 35. The opposed goods and services are set out in paragraph 16 of this decision.

2. On 29 July 2021, Feme Limited (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of the following UK Trade Mark:

Trade mark no.	3283736
Trade Mark	
Filing and Registration Date	Filing date: 19 January 2018 Date of entry in register: 01 June 2018

3. The opponent relies upon all its registered goods in Classes 3, 21 and 26 as set out in paragraph 16 of this decision.

4. By virtue of its earlier filing date of 19 January 2018, the above registration constitutes an earlier mark within the meaning of section 6 of the Act.

¹ The application was originally applied for in the name of Mehdi Pishbin however, on 9 September 2021 a change of ownership was recorded, and the application was assigned to Noble Trends Limited.

5. The opponent submits that there is a likelihood of confusion because the applicant's registration is similar to the opponent's and the respective goods are identical or similar.

6. The applicant filed a counterstatement accepting that the goods are at least similar but stating that due to the dissimilarity of the marks, the opposition should be refused.

7. The opponent is represented by Briffa whereas the applicant is represented by Wilson Gunn. Neither party filed evidence in these proceedings. No hearing was requested however, both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

8. 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 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.

Proof of Use

9. As the opponent's mark had not completed its registration process more than 5 years before the filing date of the application in issue, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Decision

10. 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”.

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (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

12. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

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

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

13. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

14. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für 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”.

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

16. The goods and services to be compared are as follows:

Opponent	Applicant
<p>Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; hair care preparations; shampoos; hair conditioners; hair tonics; hair balms; hair gels; hair creams; hair oils; hair mousse; hair lacquer; hair cosmetics; hair styling preparations; hairspray; hair dyes; hair colorants; adhesives for cosmetic purposes; adhesives for affixing natural and synthetic hair; adhesive removers; hair emollients; nail gel; nail enamel; nail varnish; nail tips; nail strengtheners; nail glitter; nail buffing preparations; nail care preparations; false nails; nail cream; adhesives for fixing false nails; nail polish; nail enamel remover; nail varnish remover [cosmetics]; aftershave balm; aromatherapy oils and creams; bath and shower oils (non-medicated); body and facial butters; body and facial creams [cosmetics]; body and facial gels [cosmetics]; body and facial oils; body and facial massage oils; body and facial scrubs [cosmetic]; body wash; cosmetic kits; essences and essential oils for personal use; exfoliants for the care of the skin; eye gels; facial beauty masks; face wash [cosmetic]; lip balms; moisturising skin creams and lotions [cosmetic]; perfumed water; shaving creams, oils, gels, lotions and soaps; shower gels; skin balms [cosmetic]; skin</p>	<p>Class 3: Cosmetics; make-up; face, lip and cheek make-up; cosmetic kits; compacts; foundations; concealers; make-up primers; blushers; rouges; face powder; face glitter; lipstick; lip gloss; lip liner; non-medicated lip balm; pencils for cosmetic purposes; lip pencils; eye pencils; eye make-up; eye shadow; mascaras; eyeliners; eye creams; eye gels; eye balms; eyebrow cosmetics; toiletries; soaps; perfumery; hair lotions; shampoo and conditioner; hair care products; essential oils; shower and bath preparations; shower and bath gels; bath foams; bath oils; bubble baths; skincare preparations; skincare cosmetics; anti-aging skincare preparations; skin moisturisers; skin cleansers; skin toners; skin lotions; skin care exfoliants; skin care masks; deodorants; antiperspirants; false eyelashes; false nails; artificial eyelashes; artificial fingernails; adhesives for affixing artificial eyelashes and fingernails; nail glitter; nail polish; nail polish remover; make-up remover; shaving preparations; shaving creams, foams, lotions and gels; after-shave preparations; depilatory preparations; anti-wrinkle creams; beauty creams; beauty lotions; beauty gels; skin make-up; cosmetic preparations for skin tanning; artificial tanning preparations;</p>

<p>cleansers [cosmetic]; skin toners [cosmetic]; washing preparations; parts, fittings and accessories for all of the aforesaid goods.</p>	<p>self-tanning preparations; sunscreen; suntan lotions and sprays; sun-tanning preparations; after-sun creams and sprays; tanning oils; tanning creams; tanning preparations not for use with tanning beds or in tanning bed salons, tanning creams not for use with tanning beds or in tanning bed salons; tanning oils not for use with tanning beds or in tanning bed salons; tanning lotions not for use with tanning beds or in tanning bed salons; sunscreens not for use with tanning beds or in tanning bed salons; sun tan lotions and creams not for use with tanning beds or in tanning bed salons; after sun lotions and creams not for use with tanning beds or in tanning bed salons.</p>
<p>Class 21: Combs and sponges; brushes (except paint brushes); hair brushes; hair combs; hair styling utensils; nail brushes; parts, fittings and accessories for all of the aforesaid goods.</p>	
<p>Class 26: Pins and needles; natural hair; human hair; synthetic hair; hair substitutes; fibres (natural and man-made) for use as replacement hair or hair extensions; wigs; toupees; hairpieces; hairnets; hair fasteners; hair tresses; hair curlers; hair rollers; hair ornaments; hair wraps; hair pins; hair buckles; hair slides; hair clips; hair barrettes; hair grips; hair ribbons; hair scrunchies; hair bands; hair weaves; hair extensions; hair netting; hair bows; twisters [hair accessories]; hair curling papers; hair curling pins; hair colouring caps; hair frosting caps; elastic for tying hair; non-electric hair rollers; sticks for use in styling the hair; strips of plastics for use in highlighting of hair; strips of plastics for use in tinting of hair; tape for fixing wigs; parts, fittings and accessories for all of the aforesaid goods.</p>	<p>Class 26: Lace, braid and embroidery, and haberdashery ribbons and bows; buttons, hooks and eyes, pins and needles; artificial flowers; hair decorations; false hair; haberdashery; hair bands; hair bows; hair clips; hair grips; hair slides; hair pins; hair fasteners; hair ribbons; hair ornaments; hat ornaments.</p>
	<p>Class 35: Retail and wholesale services in connection with the sale of cosmetics, make-up, face, lip and cheek make-up,</p>

	<p>cosmetic kits, compacts, foundations, concealers, make-up primers, blushers, rouges, face powder, face glitter, lipstick, lip gloss, lip liner, non-medicated lip balm, pencils for cosmetic purposes, lip pencils, eye pencils, eye make-up, eye shadow, mascaras, eyeliners, eye creams, eye gels, eye balms, eyebrow cosmetics, toiletries, soaps, perfumery, hair lotions, shampoo and conditioner, hair care products, essential oils, shower and bath preparations, shower and bath gels, bath foams, bath oils, bubble baths, skincare preparations, skincare cosmetics, anti-aging skincare preparations, skin moisturisers, skin cleansers, skin toners, skin lotions, skin care exfoliants, skin care masks, deodorants, antiperspirants, false eyelashes, false nails, artificial eyelashes, artificial fingernails, adhesives for affixing artificial eyelashes and fingernails, nail glitter, nail polish, nail polish remover, make-up remover, shaving preparations, shaving creams, foams, lotions and gels, after-shave preparations, depilatory preparations, anti-wrinkle creams, beauty creams, beauty lotions, beauty gels, skin make-up, cosmetic preparations for skin tanning, artificial tanning preparations, self-tanning preparations, sunscreen, suntan lotions and sprays, sun-tanning preparations, after-sun creams and sprays, tanning oils, tanning creams, tanning preparations not for use with tanning beds or in tanning bed salons, tanning creams not for use with tanning beds or in tanning bed salons, tanning oils not for use with tanning beds or in tanning bed salons, tanning lotions not for use with tanning beds or in tanning bed salons, sunscreens not for use with tanning beds or in tanning bed salons, sun tan lotions and creams not for use with tanning beds or in tanning bed salons, after sun lotions and creams not for use with tanning beds or in tanning bed salons, lace, braid and embroidery,</p>
--	--

	and haberdashery ribbons and bows, buttons, hooks and eyes, pins and needles, hair decorations, false hair, haberdashery, hair bands, hair bows, hair clips, hair grips, hair slides, hair pins, hair fasteners, hair ribbons, hair ornaments, hat ornaments.
--	---

17. The applicant in its counterstatement accepts that “the opposed goods are at least similar to the goods of the earlier registration.” For the sake of completeness, I will continue to carry out a full assessment regarding the level of similarity of all the contested goods and services.

Class 3 Goods

18. The terms *Soaps; perfumery; essential oils; cosmetics; hair lotions; shampoo and conditioner; eye gels; nail glitter; false nails; shaving creams, gels, lotions; bath oils; shower gels; skin cleansers; skin toners; skin lotions* appear in both specifications; these goods are identical.

19. The applicant’s *hair care products; non- medicated lip balms; skin care masks; adhesives for affixing fingernails; nail polish; nail polish remover; aftershave preparations; skin care exfoliants; skin moisturisers; adhesives for affixing artificial eyelashes; artificial fingernails* have direct counterparts in the opponent’s specification, albeit expressed in slightly different terms.

20. The terms *make-up; face, lip and cheek make-up; cosmetic kits; compacts; foundations; concealers; make-up primers; blushers; rouges; face powder; face glitter; lipstick; lip gloss; lip liner; pencils for cosmetic purposes; lip pencils; eye pencils; eye make-up; eye shadow; mascaras; eyeliners; eyebrow cosmetics; skincare cosmetics; skin make-up; cosmetic preparations for skin tanning; False eyelashes and artificial eyelashes* in the applicant’s specification fall within the opponent’s broader term *cosmetics*. They are therefore identical on the principle outlined in *Meric*.

21. I consider *toiletries; shower and bath preparations* in the applicant's specification to be identical to the opponent's *bath and shower oils* on the principle outlined in *Meric*.

22. I find the opponent's *skin creams and lotions [cosmetic]* would encompass the applicant's *skincare preparations; anti-aging skincare preparations; anti-wrinkle creams; beauty creams; beauty lotions; beauty gels*. On that basis, they are identical in line with *Meric*.

23. I find the applicant's term *make-up remover* would encompass *face wash [cosmetic]* in the opponent's specification. As such, they are identical in line with *Meric*.

24. *Shaving preparations* and *depilatory preparations* in the applicant's specification would encompass *shaving creams, oils, gels, lotions and soaps*. They are therefore identical in line with *Meric*.

25. I consider the applicant's *artificial tanning preparations; self-tanning preparations; sunscreen; suntan lotions and sprays; sun-tanning preparations; after-sun creams and sprays; tanning creams; tanning preparations not for use with tanning beds or in tanning bed salons, tanning creams not for use with tanning beds or in tanning bed salons; tanning lotions not for use with tanning beds or in tanning bed salons; sunscreens not for use with tanning beds or in tanning bed salons; sun tan lotions and creams not for use with tanning beds or in tanning bed salons; after sun lotions and creams not for use with tanning beds or in tanning bed salons* to be identical to the opponent's *skin creams and lotions [cosmetic]* in line with *Meric*.

26. The opponent's *body and facial oils* would encompass the applicant's *tanning oils; tanning oils not for use with tanning beds or in tanning bed salons*. On this basis, I consider them to be identical.

27. I find that the applicant's *shaving foams* would differ in terms of physical nature from *shaving creams, oils, gels, lotions and soaps* however, they share the same intended purpose and would no doubt be found next to one another in a pharmacy, supermarket or their online equivalents. There would also be an overlap in users and

a degree of competition between the goods. I consider there to be a high degree of similarity between these goods.

28. Although the applicant's *bath gels; bath foams; bubble baths* differ slightly in terms of nature to the opponent's *bath oils*, they are all items used in the bath resulting in an overlap in users and trade channels. Further, I consider their method of use to be highly similar and there would also be a degree of competition between the respective goods. Overall, these goods are highly similar.

29. I consider the applicant's *eye creams* and *eye balms* to have a highly similar nature and identical method of use to the opponent's *eye gels*. There would also be an overlap in users and trade channels in addition to a degree of competition. These goods are highly similar.

30. *Deodorants* and *antiperspirants* come in the form of sprays, liquids and creams and are used to prevent perspiration. Though they differ in terms of nature and intended purpose to *shower gels*, I find they are usually used directly after showering as part of a personal care regime. There would therefore be an overlap in users and trade channels and the goods would be found near one another in a supermarket or pharmacy. I find there is a medium degree of similarity between these goods.

Class 26 Goods

31. The terms *pins and needles; hair bands; hair bows; hair clips; hair grips; hair bows; hair slides; hair pins; hair fasteners; hair ribbons; hair ornaments* appear in both specifications and are clearly identical.

32. The term *false hair* in the applicant's specification is self-evidently identical to the opponent's *synthetic hair*.

33. I consider the term *hair decorations* in the applicant's specification to be identical to the opponent's *hair ornaments*.

34. I find the applicant's terms *Lace, braid and embroidery, and haberdashery ribbons and bows* are all items which can be fastened to the hair as a decoration, and they are therefore identical to the opponent's *hair ornaments* based on the principle outlined in *Meric*.

35. *Buttons, hooks and eyes, artificial flowers; haberdashery* in the applicant's specification would be considered as *parts, fittings and accessories for all of the aforesaid goods* in class 26 of the opponent's specification. On that basis, I consider these goods to be identical.

36. The applicant's *hat ornaments* share some similarities in terms of nature and purpose to the applicant's *hair ornaments* as they are decorative accessories to be worn on the head. I also find there may be an overlap in users and trade channels. There may be a competitive element between the respective goods as a consumer may choosing to purchase an accessory to be worn on the head may choose between a hair ornament or a hat ornament, although I do not find the items enjoy a complementary relationship. I find there is a medium level of similarity between these goods.

Class 35 Services

37. I first note that the applicant's services in class 35 are in relation to retail and wholesale of goods covered by classes 3 and 26 the opponent's specification. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

38. Accordingly, although the respective goods and services have different natures, purposes and methods of use, I find the applicant's retail and wholesale services to be complementary to the opponent's goods in classes 3 and 26. The opponent's goods are important to the operation of the applicant's services to the extent that consumers may believe that the responsibility for them lies with the same undertaking². Further,

² *Boston Scientific Ltd v OHIM*, Case T-325/06

the respective goods and services will be offered through shared trade channels and to the same users. Overall, I consider the respective goods and services to be similar to a medium degree.

The average consumer and the nature of the purchasing act

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

40. The average consumer for the contested goods and services will be a member of the general public. The goods and services will be purchased reasonably frequently and may be relatively expensive or relatively inexpensive. Considerations such as individual taste and suitability of the product will be taken into account when selecting the goods whereas factors such as stock and price of goods offered are likely to be considered when selecting the services. I am of the view that a medium degree of attention will be paid during the purchasing process.

41. The goods are likely to be self-selected by the general public from a pharmacy, department store, supermarket or a website. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought

from sale assistants, and orders may be placed over the phone, I do not discount an aural component to the purchase.

42. In respect of the services, I consider these would typically be available from physical retail outlets and their online equivalents. When making their selection, the average consumer would most likely consider promotional material (such as flyers, posters, media campaigns or online adverts) and signage appearing on the high street. I therefore find that visual considerations will be an important part of the selection process however, I do not exclude aural considerations entirely given that word of mouth recommendations may also play a part.


Comparison of marks

43. 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 relevant 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.”

44. 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 trade 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.

45. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
	<p data-bbox="991 584 1206 613">FEMME LUXE</p>

Overall impression

46. The opponent's mark consists of the words "The Feme Collection" presented in a white font. The words are presented on a round pink background. The word "Feme" is larger than the remaining words and is positioned in the centre of the pink background in a stylised cursive font. I find that the word "Feme" in the centre of the mark plays the most dominant role in the overall impression followed by the remaining words. The cursive font and pink background, though playing a lesser role, will not be ignored by the average consumer.

47. The applicant's mark consists of the words "Femme Luxe". When considered in respect of the goods and services for which registration is sought, I agree with the opponent that the word "Luxe" will be indicative of a concept of luxury and therefore plays a laudatory role. With this in mind, I find that the word "Femme" is the dominant element of the mark with the word "Luxe" playing a secondary role.

Visual comparison

48. Both parties' marks contain the words "Femme" albeit, spelled slightly differently. I do not consider the stylisation of "Feme" used in the opponent's mark to

be a significant difference between the marks since notional and fair use would allow the applicant's mark to be presented in any standard typeface. The competing marks differ through the wording "The" and "Collection" in the opponent's mark which has no counterpart in the applicant's mark and the word "Luxe" in the applicant's mark which is not present in the opponent's. Furthermore, the opponent's mark contains a pink device which is not present in the applicant's mark. Overall, I consider the marks to be visually similar to a medium degree.

Aural comparison

49. The opponent's mark will be pronounced in five syllables using the usual English pronunciation of the words "THE FEMM COLLECTION" however, I accept that in some cases, consumers unfamiliar with this choice of spelling may pronounce the mark as "THE FEEM COLLECTION". The applicant's mark will be pronounced in two syllables as "FEMM LUX". Both marks share the word "Femme", however there is a point of difference in the ordering of these words and the opponent's mark is noticeably longer. In cases where the term is pronounced "FEMM" in both marks, I find them to be aurally similar to a medium degree. In cases where the opponent's mark is pronounced "FEEM", there are no common elements and as such, the marks are aurally dissimilar.

Conceptual comparison

50. Notwithstanding the variation in spelling, conceptually, the word "Feme/Femme" in both marks will likely be understood by consumers as the dictionary definition "woman"³. When considered in respect of the goods, the term "The Feme Collection" in the opponent's mark will likely convey the idea of a collection of beauty products intended for women. As outlined above though, some consumers may be unfamiliar with "feme" as an alternative spelling for "femme" and would therefore be unfamiliar with the dictionary definition. I do not find the pink device element would evoke a concept to the consumer. The applicant's mark "Femme Luxe" would be

³ [Feme definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-english/dictionary/feme)
[Femme definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/english-english/dictionary/femme)

perceived as “women’s” or “female luxury”. When the terms “Feme/Femme” are both understood by consumers as meaning “woman”, I find the marks to be conceptually similar to a medium degree. In cases where consumers do not understand the term “Feme”, the marks are conceptually dissimilar.

Distinctive character of the earlier mark

51. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, 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).”

52. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

53. The opponent has not filed any evidence to support that the earlier mark’s distinctive character has been enhanced through use. Consequently, I have only the inherent position to consider.

54. As previously outlined, when considered in respect of the registered goods, I find the term “The Feme Collection” to be indicative of a collection of beauty products intended for women. I therefore find the words in the opponent’s mark to be somewhat allusive of the goods. I acknowledge however that the pink device and the stylised writing will add slightly to the distinctiveness of the mark as a whole; however, pink is stereotypically used to indicate feminine attributes. As a result of the combination of these elements, I consider the mark to be inherently distinctive to a low degree.

Likelihood of confusion

55. I note that, in accordance with rule 19(2) of the Trade Mark Rules 2008, a Preliminary Indication (PI) was issued to both parties on 11 November 2021, where it was considered that there was a likelihood of indirect confusion between the contested marks in respect of all goods and services.

56. Preliminary indications are issued to give the respective parties an indication on a prima facie basis as to the likely decision in respect of the grounds of opposition, giving either party the opportunity to withdraw either the opposition or the application accordingly, without incurring costs. The preliminary indication is not binding, nor does it replace a full decision by a Hearing Officer. If either party does not accept the PI, it

has the right to formally give notice to that effect. In order to proceed, the parties must file form TM53, otherwise the opposition/application is accordingly deemed to be withdrawn for the indicated goods and services. In this instance, the applicant filed a form TM53 on 13 December 2021.

57. I am not bound by the preliminary indication, and consequently, following careful consideration of the papers before me and my own findings, I will now make my own assessment of the likelihood of confusion between the competing marks.

58. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

59. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis K.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

60. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask, 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

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

62. I have found the marks to be visually similar to a medium degree. In cases where the term is pronounced "Femm" in both marks, I found them to be aurally similar to a medium degree whereas if the term is pronounced "Feem" in the earlier mark, I found the marks to be aurally dissimilar. Where the terms "Feme/Femme" are both understood as meaning "woman", I found the marks to be conceptually similar to a medium degree. However, if this definition is not understood in respect of the earlier mark, I found the respective marks to be conceptually dissimilar. I have found the earlier mark to have a low degree of inherent distinctive character. I identified the average consumer to be a member of the general public who will select the goods and services predominantly by visual means, though I do not discount an aural element to the purchase. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods and services to range from a medium degree of similarity to identical.

63. I acknowledge that there are a few elements in the opponent's favour such as the medium level of visual, aural and conceptual similarities between the marks (where the terms "Feme/Femme" are understood to hold the same meaning and pronunciation by consumers) and the fact the some of the goods are identical or highly similar. I note however, that the only element the respective marks share is Feme/Femme, and I found this element to be low in inherent distinctive character in relation to the goods which points away from confusion. There is also a clear difference between the marks in the presence of the wording "the" and "collection" in the opponent's mark which

results in the mark being noticeably longer than the applicant's, in addition to the pink device and stylisation. Furthermore, the wording "luxe" in the applicant's mark adds a further point of difference. In this case I find that these differences will not go unnoticed by the average consumer with a medium level of attentiveness. I do not find that the opponent's mark will be mistaken for the applicant's and as such, I do not consider there to be a likelihood of direct confusion.

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

65. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.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).”

66. These examples are not exhaustive but provide helpful focus.

67. 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.

68. Furthermore, 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.

69. In *Salima Vellani v Dirtybird Restaurants LTD*, Case BL O/413/18, Mr Geoffrey Hobbs K.C. as the Appointed Person stated that:

“18. ... It is axiomatic that the relevant average consumer is to be regarded as reasonably well-informed and reasonably observant and circumspect. However, (s)he is not to be regarded as a person who normally engages in extended thought processes for the purpose of pairing and matching trade marks or actively considering how they might be developed or appropriated for use as siblings of other marks.”

70. As previously stated, I note that the respective marks share a common element and the fact that the similarity of the goods and services ranges from medium to identical is a factor weighing in the opponent's favour. Nonetheless, I have carefully considered if the marks may be perceived as a sub brand or brand extension of one another, or for them to be considered to represent economically linked undertakings and I can see no logical reason for this. Earlier in my decision, I found that the shared element in both marks (Feme/Femme) contributed to the earlier mark possessing a low degree of inherent distinctive character. With this in mind, I find that should the consumer notice the common element shared between the marks, they would regard this as a coincidence. Accordingly, I see no reason why the average consumer would believe that the marks originate from the same or economically linked undertakings, even when I have found the contested goods to be identical. Further, if some consumers are unfamiliar with the term "Feme", this would point even further away from confusion. I therefore do not consider there to be a likelihood of indirect confusion.

CONCLUSION

71. The opposition under section 5(2)(b) of the Act has failed in its entirety. Subject to any successful appeal against my decision, the application will proceed in the UK for the full range of goods and services applied for.

COSTS

72. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Filing submissions:	£300

73. I therefore order Feme Limited to pay the sum of £500 to Noble Trends Limited. 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 26th day of September 2022

**Catrin Williams
For the Registrar**