

BL O/971/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3720723

BY

HANGZHOU OXYHYDROGEN E-COMMERCE CO., LTD.

TO REGISTER THE TRADE MARK:

GEMO

IN CLASSES 3, 5 AND 9

-AND-

THE OPPOSITION THERETO UNDER No. 430066

BY

GEMOLOGY

Background and pleadings

1. Hangzhou Oxyhydrogen E-commerce Co., Ltd. (“**the Applicant**”) applied to register the trade mark shown below (“**the Contested Mark**”) in the UK on 12 November 2021:

GEMO

It was accepted and published in the Trade Marks Journal on 26 November 2021 in respect of Classes 3, 5 and 9. The goods for which registration is sought are laid out in their entirety at **Annex 1** to this decision.

2. Gemology (“**the Opponent**”) partially opposes the Contested Mark under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). This is on the basis of its earlier Comparable Trade Mark (IR) ‘GEMOLOGY’ (“**the Earlier Mark**”), details of which are shown below:¹

Trade Mark Number:	810856886
Filing Date :	6 November 2017
Registration Date:	13 June 2018

3. The Earlier Mark is registered in respect of the following goods in Class 3, all of which are relied upon in this opposition:

Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and scouring preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; depilatories; make-up

¹ The Earlier Mark originally enjoyed protection in the UK as an ‘EU Trade Mark (IR)’. The International Registration is based on a trade mark applied for in France on 5 November 2004. The EU was a subsequent designation (which did not claim priority from the base application of the International Registration as the designation was made more than six months after the filing date of the French trade mark application). The date of the subsequent designation is 6 November 2017 i.e. the filing date. Following the end of the transition period of the UK’s withdrawal from the EU, a comparable UK trade mark was created for the ‘EU Trade Mark (IR)’, this is referred to as the ‘Comparable Trade Mark (IR)’ (i.e. the Earlier Mark), which retains the same filing date (i.e. 6 November 2017) and ‘protection conferred date’ (i.e. registration date, which is 13 June 2018) of the ‘EU Trade Mark (IR)’.

removing preparations; lipsticks; beauty masks; shaving products; leather preservatives (polishes); creams for leather.

4. The Opposition is directed solely against the Applicant's Class 3 and 5 goods as follows:

Class 3

Skin toner; Aloe vera gel for cosmetic purposes; Essential oils; Toothpaste; Cosmetics; Beauty masks; Perfume; Shampoos; Cleansing milk; Depilatory preparations; Cleansers for intimate personal hygiene purposes, non medicated; Massage gels, other than for medical purposes; Hair tonic; Air fragrancing preparations; Body milk; Hair conditioner; Teeth whitening strips; Skin care preparations; False eyelashes; Nail varnish.

Class 5

Cooling sprays for medical purposes; Anti-inflammatory gels; Aloe vera gel for therapeutic purposes; Massage gels for medical purposes; Gels for dermatological use; Antibacterial gels; Dressings, medical; Gelatine for medical purposes; Vitamin preparations; Solutions for contact lenses; Food for babies; Deodorants for clothing and textiles; Breast-nursing pads; Eyepatches for medical purposes; Babies' diapers; Diapers for incontinence; Dental abrasives; Medicated shampoos; Dietetic beverages adapted for medical purposes; Dietetic foods adapted for medical purposes.

5. Given the respective filing dates, the Opponent's mark is an earlier trade mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely upon all of the goods for which the Earlier Mark is registered

without having to show any use at all.²

6. The Opponent argues that the marks are similar and that the goods are identical or similar, such that there is a likelihood of confusion of the average consumer.
7. The Applicant filed a counterstatement admitting that some of its Class 3 goods are identical or highly similar to the Opponent's goods in Class 3 (and that the remainder of its Class 3 goods and Class 5 goods are dissimilar to the Opponent's goods).³ However, the Applicant denied the claims made in respect of the similarity between the marks.
8. The parties' submissions will be referred to as and where appropriate during this decision.
9. Neither party elected to file evidence nor made any request to be heard. Only the Opponent elected to file written submissions in lieu of a hearing. This decision has therefore been taken following a careful perusal of the papers.
10. In these proceedings the Opponent is represented by Wilson Gunn and the Applicant is represented by IPEY.
11. 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.

² It is noted that whilst the UK Trade Marks Register records a 'priority date' of 5 November 2004 for the 'Comparable Trade Mark (IR)' (i.e. the Earlier Mark), this is merely a reference to the French Trade Mark application upon which the International Registration is based and it is not a priority claim for the Earlier Mark (which retained the same filing details as the 'EU Trade Mark (IR)'). The registration date of the Earlier Mark is 13 June 2018, which is less than five years before the filing date of the application. It is also noted that the Applicant indicated at question 7 of its Form TM8 that it did not request the opponent to provide proof of use.

³ See the Applicant's Counterstatement included in its TM8, paragraphs 1.1.1 and 1.1.2

DECISION

Legislation and Case Law

12. Section 5(2)(b) and 5A of the Act are as follows:

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

[...]

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

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

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

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

- (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

14. Section 60A of the Act provides:

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

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

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

15. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, (“**Meric**”), the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

16. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:⁴

- (i) the physical nature of the goods;
- (ii) their intended purpose;
- (iii) their method of use / uses;
- (iv) who the users of the goods are;
- (v) the trade channels through which the goods reach the market;

⁴ See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v. James Robertson & Sons Ltd.*, [1996] R.P.C. 281 – the “*Treat*” case

- (vi) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
 - (vii) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors)
- or
- (viii) whether they are complementary to each other. Complementary means “*there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking*”.⁵ I note that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.⁶

17. For the purposes of making my comparison, I have grouped the goods where the same reasoning applies.⁷

18. The goods to be compared are as follows:

Opponent’s goods	Applicant’s goods
<p><u>Class 3</u></p> <p><i>Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and scouring preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; depilatories; make-up removing preparations; lipsticks; beauty masks; shaving products;</i></p>	<p><u>Class 3</u></p> <p><i>Skin toner; Aloe vera gel for cosmetic purposes; Essential oils; Toothpaste; Cosmetics; Beauty masks; Perfume; Shampoos; Cleansing milk; Depilatory preparations; Cleansers for intimate personal hygiene purposes, non medicated; Massage gels, other than for medical purposes; Hair tonic; Air</i></p>

⁵ *Boston Scientific Ltd v OHIM*, Case T-325/06, paragraph 82

⁶ *Kurt Hesse v OHIM*, Case C-50/15 P

⁷ *Separode Trade Mark BL O/399/10*, paragraph 5

<p><i>leather preservatives (polishes); creams for leather.</i></p>	<p><i>fragrancing preparations; Body milk; Hair conditioner; Teeth whitening strips; Skin care preparations; False eyelashes; Nail varnish.</i></p>
	<p><u>Class 5</u></p> <p><i>Cooling sprays for medical purposes; Anti-inflammatory gels; Aloe vera gel for therapeutic purposes; Massage gels for medical purposes; Gels for dermatological use; Antibacterial gels; Dressings, medical; Gelatine for medical purposes; Vitamin preparations; Solutions for contact lenses; Food for babies; Deodorants for clothing and textiles; Breast-nursing pads; Eyepatches for medical purposes; Babies' diapers; Diapers for incontinence; Dental abrasives; Medicated shampoos; Dietetic beverages adapted for medical purposes; Dietetic foods adapted for medical purposes.</i></p>

Identical goods

19. The following goods in the parties' Class 3 specifications are self-evidently identical to each other:

Opponent's goods	Applicant's goods
perfumery	perfume
essential oils	essential oils

cosmetics	cosmetics
dentifrices	toothpaste
depilatories	depilatory preparations
beauty masks	beauty masks

20. 'Cosmetics' are substances and products intended for application on the skin, hair, face and nails, typically to clean, beautify or improve appearances (such as improving the complexion).⁸ They can include beauty preparations such as make-up and face creams, as well as grooming aids and body cleansing products, such as body lotions, hair styling products and shampoos. The following goods in the Applicant's Class 3 specification, namely:

"Skin toner; Cleansing milk; Aloe vera gel for cosmetic purposes; Body milk; Massage gels, other than for medical purposes; Skin care preparations; Shampoos; Hair tonic; Hair conditioner; Nail varnish; False eyelashes"

all fall within the broad category of "cosmetics" in the Opponent's Class 3 specification. The Applicant's goods are therefore identical to the Opponent's goods on the principle outlined in *Meric*.

21. The word 'perfume' (relating to 'perfumery') is defined as "the fragrance or odour emitted by any (usually pleasant-smelling) substance or thing; a fragrance; a fragrant liquid, usually consisting of aromatic ingredients (natural or synthetic) in a base of alcohol, used to impart a pleasant smell to the body, clothes, etc."⁹ "Air fragrancng preparations" in the Applicant's Class 3 specification fall within the broad category of "perfumery" in the Opponent's Class 3 and also within the broad category of "essential oils" in the Opponent's Class 3 specification (since 'essential oils' can be 'air fragrancng preparations'). These goods are identical on the principle outlined in *Meric*.

⁸ Also see the entries for 'cosmetic' in the Oxford English Dictionary, www.oed.com

⁹ See the entry for 'perfume' in the Oxford English Dictionary, www.oed.com

22. “Cleansers for intimate personal hygiene purposes, non medicated” in the Applicant’s Class 3 specification fall within the broad category of “soap” in the Opponent’s Class 3 specification. ‘Soap’ being a substance used for washing or cleansing purposes.¹⁰ These goods are identical on the principle outlined in *Meric*.

Similar goods

23. In the alternative, there is a degree of similarity between “*massage gels, other than for medical purposes*” in the Applicant’s Class 3 specification and “*cosmetics*” in the Opponent’s Class 3 specification, because they overlap in nature, purpose, method of use and user (particularly when considering that massage gels could be infused with preparations that improve the appearance of the skin or complexion). There is overlap in trade channels as the same undertakings would likely sell the respective goods. There is also a degree of complementarity between them since a massage gel may be used to supplement a person’s daily regimen. Therefore in the alternative, these goods are similar to a medium degree.
24. In the alternative, “*shampoos; hair tonic; hair conditioner*” in the Applicant’s Class 3 specification are at least highly similar to “*cosmetics*” in the Opponent’s Class 3 specification, because they overlap in nature and purpose since they are used to beautify, cleanse and improve the appearance of a person’s hair. There is also overlap in trade channels as the same undertakings would likely sell the respective goods, for example a company that produces make-up and skincare products may also produce haircare products. There is also a degree of complementarity between them since they would be used as part of a person’s beauty routine.
25. In the alternative, there is a degree of similarity between “*false eyelashes*” in the Applicant’s Class 3 specification and “*cosmetics*” in the Opponent’s Class 3 specification, because they overlap in purpose and method of use and are also complementary, since they would be used to adorn and enhance a person’s eyes

¹⁰ See the entry for ‘soap’ in the Oxford English Dictionary, www.oed.com

as part of their make-up routine, as such they also overlap in user. They are likely to be found on the same shelves/ beauty counters in shops. There is also overlap in trade channels as the same undertakings would likely sell the respective goods, for example a company that produces make-up is also likely to produce false eyelashes. Therefore in the alternative, these goods are similar to a medium degree.

26. In the alternative, there is a degree of similarity between the Applicant's "*Cleansers for intimate personal hygiene purposes, non medicated*" and the Opponent's "*soap*". This is because there is overlap in nature and intended purpose as both are cleansing substances; as such there is overlap in method of use and users. There may also be overlap in trade channels, as the undertaking that sells the one may also sell the other. They may also be found on the same or adjacent shelves in a shop; they may also be in competition with one another, as a consumer may select one above the other; and they may also be complementary to each other. Therefore in the alternative, these goods are highly similar.
27. "*Dental abrasives*" in the Applicant's Class 5 specification would be abrasives used for the purpose of cleaning teeth. They are similar to "*dentifrices*" in the Opponent's Class 3 specification because they overlap in nature and purpose as they are both substances used for cleaning teeth. There is overlap in method of use and users and in trade channels as the same undertakings would likely sell the respective goods. There is also a degree of competition between them as a consumer may select a specific dental abrasive, above a generic dentifrice and vice versa. These goods are highly similar.
28. "*Teeth whitening strips*" in the Applicant's Class 3 specification are similar to "*dentifrices*" in the Opponent's Class 3 specification since there would be an overlap in purpose and user (particularly when considering that dentifrices can whiten teeth). There will also be overlap in trade channels as the same undertakings may sell/produce both. They are also likely to be found on the same display shelves in shops. There may also be a degree of competition between them and a degree of complementarity. These goods are similar to at least a medium degree.

29. I consider the following goods in the Applicant's Class 5 specification, namely:

“gels for dermatological use; aloe vera gel for therapeutic purposes; medicated shampoos”

to be similar to the broad category of “cosmetics” in the Opponent's Class 3 specification; in addition, “medicated shampoos” in the Applicant's Class 5 specification are also similar to “hair lotions” in the Opponent's Class 3 specification.

- (i) This is because they overlap in nature and purpose since “gels for dermatological use” and “aloe vera gel for therapeutic purposes” are a form of skincare and “medicated shampoos” are a form of haircare (albeit they would be targeted at specific skincare and haircare needs). Because of this, it also follows that there would be an overlap in method of use and user. There will also be overlap in trade channels as the same undertakings may sell/produce both. They may also likely be found on the same display shelves in shops, although not always – this would vary depending on the specific ingredients in the products. There may also be a degree of competition between them and a degree of complementarity.
- (ii) For example:
 - (a) a consumer may purchase aloe vera gel (or a gel) to use as after-sun because of its therapeutic properties and dermatological benefits to soothe sunburn. It may even be the same brand as their cosmetic sunscreen lotion and likely to be displayed next to those products. They may use it in conjunction with another cosmetic after-sun lotion or may favour it above the cosmetic product. These goods are similar to a high degree.
 - (b) a medicated shampoo, such as an anti-dandruff shampoo, would have the same purpose as a cosmetic shampoo to cleanse the hair and scalp, and may even be the same brand as a cosmetic shampoo. It is likely to be found on the same shelf as other shampoos and used in conjunction with a cosmetic shampoo or may

indeed be favoured above it. These goods are similar to a high degree.

- (c) a medicated shampoo, such as a shampoo to treat hair thinning or hair loss, may have the same purpose as a hair lotion that is designed to treat the same issues, and they may even be the same brand. The shampoo is likely to be found on the same shelf as the hair lotion and could be used in conjunction with the lotion or indeed may be favoured above it. These goods are similar to a medium degree.

30. *“Deodorants for clothing and textiles”* in the Applicant’s Class 5 specification are similar to *“perfumery”* (taking into account the definition of ‘perfume’) and *“substances for laundry use”* in the Opponent’s Class 3 specification. This is because they overlap in nature and purpose since ‘perfumery’ and ‘substances for laundry use’ can also be intended to give a pleasant smell/ deodorise clothing and textiles. Therefore there may be overlap in method of use and user. There may also be overlap in trade channels and there may also be a degree of competition between them as a consumer may select one above the other and there may also be a degree of complementarity between them. These goods are similar to a medium degree.

Dissimilar goods

31. The Opponent has submitted that *“Whilst the applicant’s goods in class 5 may have medical uses, they also have some cosmetic uses, the goods are at least similar to the opponent’s class 3 goods. The goods will be found in the same retail outlets.”* Whilst I agree with this to a certain extent (insofar as I have found similarity between some of the contested goods in Class 5 and the Opponent’s Class 3 goods), when assessing the remainder of the Applicant’s Class 5 goods, I cannot set the bar for similarity so low that I find similarity merely because the goods may be found in the same retail outlet. This would ignore the principles of assessment of similarity.

32. As such, I do not find any degree of similarity between the following goods in the Applicant's Class 5 specification and the Opponent's Class 3 specification (despite the fact that they could potentially "*be found in the same retail outlets*"):

Preparations for topical application

"Cooling sprays for medical purposes; Anti-inflammatory gels; Massage gels for medical purposes; Antibacterial gels"

Ingestible goods

"Gelatine for medical purposes; Vitamin preparations; Food for babies; Dietetic beverages adapted for medical purposes; Dietetic foods adapted for medical purposes"

Miscellaneous

"Dressings, medical; Solutions for contact lenses; Breast-nursing pads; Eyepatches for medical purposes; Babies' diapers; Diapers for incontinence"

33. I have identified that some of the contested goods are identical and some are similar to the Opponent's goods and that the remainder are dissimilar. My consideration of the opposition will proceed only in relation to the contested goods that are identical and similar to those covered by the Earlier Mark since an opposition under section 5(2)(b) of the Act cannot succeed in respect of the contested goods which are found to be dissimilar to the Opponent's goods.

The average consumer and the nature of the purchasing act

34. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word "average" merely denotes that the person is typical,¹¹

¹¹ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.¹²

35. It is therefore necessary to determine who the average consumer of the respective goods is, and how the consumer is likely to select those goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.¹³
36. I consider the average consumer of the goods at issue will be a member of the general public at large.
37. The goods are likely to be sold through a range of retail outlets (and their online equivalents) such as beauty and health stores, pharmacies, supermarkets and via catalogues. The goods are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply online and with catalogues where the consumer will select the goods having viewed an image displayed on a webpage/page.
38. The selection of the goods is therefore primarily visual, although I do not discount that aural considerations may play a part by way of word-of-mouth recommendations and advice from sales assistants or beauticians. However, it is my view that even where the goods are selected by making requests to staff, the selection process would primarily be visual in nature whereby the goods are displayed on shelves behind a counter and the mark will be shown on the packaging of the goods. Accordingly, visual considerations dominate.
39. The goods will range in price but are, for the most part, likely to be inexpensive. They will generally be purchased on a regular basis, as they are non-durable, and used (mostly) as part of a daily regimen. Although some of the goods may be purchased less frequently than others, and only as and when the need arises.

¹² *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

¹³ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

40. When purchasing the goods, the average consumer is likely to consider such things as ingredients, whether the products have been tested on animals, their durability, their properties and benefits and whether the goods meet their specific needs and requirements. The average consumer may also base their considerations solely on the scent of some of the goods. These considerations will apply even where the goods are of low cost.
41. The goods are every day convenience goods therefore the purchasing process is likely to be more casual than careful and will not require an overly considered thought process. The average consumer will tend to pay more attention where the goods are for use on the body, or to be used for beautification, or because of their particular scent, however, they will not typically demonstrate more than a medium level of attention when selecting the goods.

Comparison of marks

42. It is clear from established case law that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.¹⁴ The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks in the mind of the average consumer, bearing in mind the distinctive and dominant components of the marks.¹⁵ Then, in light of the overall impression, and all factors relevant to the circumstances of the case, it is necessary to assess the likelihood of confusion.¹⁶
43. 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.

¹⁴ *Sabel BV v. Puma AG*, Case C-251/95, paragraph 23

¹⁵ *Ibid.*

¹⁶ *Bimbo SA v OHIM*, Case C-591/12P, paragraph 34

44. The respective trade marks are shown below:

Earlier Mark	Contested Mark
GEMOLOGY	GEMO

45. The Applicant submits that:

“Whilst the later mark forms the prefix of the earlier mark (and is thus entirely subsumed therein), [...] the Gemo element of the earlier mark is not by itself the distinctive and dominant component and overall the impression of the [earlier] mark lies in the word “Gemology”, in its totality [...] and the overall impressions created [by the] marks are entirely different.”

46. The Applicant also submits that the word ‘gemology’ means ‘the science of gems’ and that *“the suffix ology is commonly used in the English language to denote a field of study e.g. biology, archaeology, audiology, pathology, sociology and technology.”* In this regard, the Opponent submits that *“GEMO is an invented term whereas GEMOLOGY refers to the study of gems/gemstones”,* and that the *“word GEM and its meaning will be apparent to the average consumer in the mark GEMO”*.¹⁷

Overall impression

47. The Earlier Mark is a word-only mark consisting of the word ‘GEMOLOGY’. The word ‘GEMOLOGY’ is made up of the prefix word ‘GEM’ and the suffix ‘OLOGY’, with the word ‘GEM’ qualifying the meaning of the suffix ‘OLOGY’. In other words, the word ‘GEM’ on its own has a standalone meaning (i.e. a precious stone), however, whilst ‘OLOGY’ has a definable meaning (being a branch of knowledge/

¹⁷ I note that ‘gemology’ can also be spelt with a double ‘m’ i.e. ‘gemmology’. See the Oxford English Dictionary entry for ‘gemmology’, www.oed.com; and the Collins English Dictionary entry for ‘gemology’, www.collinsdictionary.com. The definition and pronunciation remains the same and I do not think it is something that will affect the average consumer’s perception of the Earlier Mark.

a subject of study), it is a suffix,¹⁸ therefore its meaning is qualified by the prefix word that comes before it, in this case, the word 'GEM'.

48. It must be emphasised, however, that whilst the etymology of the word 'GEMOLOGY' derives from the word 'GEM' and the suffix 'OLOGY', the combination of those elements forms an entirely new word that has a separate meaning to the word 'GEM' and therefore the average consumer would perceive the word 'GEMOLOGY' as a word in its own right. Therefore the overall impression of the Earlier Mark rests in the word 'GEMOLOGY' as a whole.
49. The Contested Mark is a figurative mark consisting of the word 'GEMO' written in black, upper-case letters. The font is not dissimilar to a typical typographical font. The stylisation of the font plays a lesser role in the Contested Mark and it is the word element in which the overall impression of the mark lies. The word 'GEM' does not dominate the overall impression of the mark, rather, the overall impression of the mark lies in the invented word 'GEMO', as a whole.

Visual comparison

50. The Contested Mark comprises of the word 'GEMO' which is identical to the first four letters of the Earlier Mark. The stylisation of the word 'GEMO' does not alter this finding.¹⁹
51. In making the visual comparison between the marks, with the overall impression of the respective marks in mind, I find that notwithstanding the shared identity of the letters 'GEMO', the presence of the letters 'LOGY' in the Earlier Mark offsets any potential of a finding of strong visual similarity between the marks overall (this is despite the general rule of thumb indicated in *El Corte Inglés, SA v*

¹⁸ I note that 'suffix' is defined by the Oxford English Dictionary as "A verbal element attached to the end of a word to form an entirely new word (e.g. *short, short-age, short-en, short-er, short-est, short-ish, short-ly, short-ness*) or as an inflectional formative (e.g. *ox, ox-en*)", see www.oed.com

¹⁹ See the comments of Mr Iain Purvis, sitting as the Appointed Person, in relation to 'word marks' - Case BL O/281/14, *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, paragraph 21

OHIM,²⁰ with regards to the importance a consumer may attach to the first part of words, since similar beginnings of the marks being compared is not necessarily decisive²¹), particularly since the Contested Mark does not share any other letters in common with the Earlier Mark, as it is a four letter word and the Earlier Mark is an eight letter word.

52. Indeed, the presence of the letters ‘LOGY’ in the Earlier Mark gives rise to a different visual perception between the two signs thus the overall impression created by the marks at issue shows clear visual differences.²² As such, the marks are visually similar overall to a lower than medium degree.

Aural comparison

53. The Opponent submits that the marks are aurally similar “*because of the identity of the first four letters*”, whereas the Applicant submits that:

“The earlier mark comprises 4 syllables. The later mark consists of two syllables. The major difference between the marks is that the later mark lacks the last two syllables of the earlier mark, i.e. “ology” and thus we submit that the earlier and later marks are aurally different.”

54. The presence of the suffix ‘OLOGY’ in the Earlier Mark makes a difference to the way the first four letters i.e. ‘GEMO’ are pronounced in the Earlier Mark. The ‘O’ is tied to ‘OLOGY’ rather than to the word ‘GEM’ when it comes to pronunciation. The word ‘GEMOLOGY’ is therefore pronounced as ‘JEM-OLUHJEE’, as opposed to ‘JEMOWE-LOGY’. In other words, the first letter ‘O’ in ‘GEMOLOGY’

²⁰ Cases T-183/02 and T-184/02, paragraphs 81 to 83. It is important to recall that in *El Corte Inglés*, the marks being compared i.e. the ten letter word ‘MUNDICOLOR’ and the eight letter word ‘MUNDICOR’, not only had identity owing to the same seven letters at the beginning, they also shared identity with regards to the last letter (and the only visual difference between the signs was the letters ‘LO’). Indeed, the General Court recognised that the identity of the first seven letters gave rise to a strong visual similarity which was, moreover, reinforced by the presence of the letter ‘R’ at the end of the two signs.

²¹ I note the findings of the General Court in *CureVac GmbH v OHIM*, T-80/08, paragraph 41, where, in reference to the comparison between the signs ‘RNAActive’ and ‘RNAiFect’ the Court stated that: “*even assuming that, as the applicant claims, the signs were both written in upper case or lower case letters, it must be pointed out that, in any event, the visual similarity would not be more pronounced, since the difference owing to the positioning of the last five letters would always offset the similarity owing to the identity of the first three letters.*”

²² See words to that effect, *Ibid.* paragraph 39

is pronounced as the 'O' in 'dog', as opposed to being pronounced as the word 'owe'.

55. As 'GEMO' is an invented word,²³ it is not possible to say with certainty how it would be pronounced but it is likely to be pronounced as either:

- (i) 'JEE-MOW' (where the 'MO' would be pronounced as 'mow' as in, to 'mow' a lawn);
- (ii) 'JEM-OWE' (where the 'O' would be pronounced as the word 'owe', as in to 'owe' someone something); or
- (iii) I also do not discount that it may be pronounced with a hard 'G' (as in the word 'get') and therefore may be pronounced as 'GHE-MOW', although I think this is less likely.

56. It cannot be said therefore that just because the Contested Mark is subsumed in the first four letters of the Earlier Mark that it follows that there is phonetic identity between the way that sequence of letters is pronounced in both marks. As there are no letters following the letter 'O' in 'GEMO', this changes the way the word is pronounced overall and it reduces the aural similarity between the Contested Mark and the letter sequence 'GEMO' in the Earlier Mark.

57. The most likely pronunciation for the Contested Mark is 'JEM-OWE'. Therefore, there would be an overlap in the way the three letters 'GEM' are pronounced in 'GEMO' and the way they are pronounced in the word 'GEMOLOGY', but that only leads to, at most, a very low level of aural similarity when the Contested Mark is compared to the Earlier Mark as a whole.

Conceptual comparison

58. The Opponent has submitted that the *“word GEM and its meaning will be apparent to the average consumer in the mark GEMO and therefore there is arguably some degree of conceptual similarity between the marks”* and that

²³ I note that both parties are in agreement that 'GEMO' is an invented word/term and I am not aware of a recognised English dictionary definition for the word 'GEMO'.

“GEMOLOGY is an English word meaning the study of gems. The average consumer will recognise the GEM part of the applicant’s mark and this therefore results in at least some conceptual similarity between the marks”.

59. In addition to its submissions about the meaning of the word ‘gemology’, the Applicant submits that:

“although the term Gemology has no direct reference to the goods, the word is nevertheless a relatively well known / recognisable word and consumers would immediately bring this to mind and may be led into believing that goods had some bearing to the science of gemology, perhaps because the goods were produced by or for people involved in the science of gemology. [...] The later mark would be seen by the average consumer as a meaningless invented word. The word Gemo is not a recognised abbreviation of the word Gemology and as such, we submit that the earlier and later marks are conceptually different.”

60. The presence of the same letter sequence ‘GEM’ in the Contested Mark is not sufficient to conclude that there is a conceptual similarity between the respective marks. The overall impression of the Contested Mark lies in the invented word ‘GEMO’ as a whole which is not dominated by the word ‘GEM’ or its concept.
61. I agree with the Applicant, ‘GEMO’ would not be viewed as an abbreviation for the word ‘GEMOLOGY’.
62. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²⁴ The conceptual message of the word ‘GEMOLOGY’ would be immediately apparent. That said, I also do not discount that the average consumer may not be aware of the definition of ‘gemology’, in which case the concept of the Earlier Mark is neutral.
63. The same cannot be said for the word ‘GEMO’. Being an invented word, its meaning is not immediately apparent and therefore it has no concept that can be immediately grasped by the average consumer. Whilst the average consumer

²⁴ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

would recognise that it begins with the letters 'G', 'E' and 'M', the presence of the letter 'O' impacts the meaning of the word 'GEMO' when viewed as a whole. In essence, the average consumer will not immediately think that the word 'GEMO' relates to precious stones, despite there being only one letter difference between 'GEMO' and 'GEM'.

64. Furthermore, being an invented word which has no immediately apparent meaning, it is inherently distinctive, which distances it from the dictionary-definable word 'gemology' which has an immediately apparent concept (at least for some).
65. As such, whilst there would be some conceptual overlap between the words 'GEMOLOGY' and 'GEM' (the former deriving its root meaning from the latter i.e. one means the study of the other), the same cannot be said for 'GEMOLOGY' and 'GEMO' (particularly in light of their overall impressions). Therefore I do not consider there to be conceptual similarity between the two marks. Indeed, to the extent that the average consumer will immediately understand the meaning of the word 'gemology', there is a conceptual difference between the marks.

Distinctive character of the Earlier Mark

66. The degree of distinctiveness of the Earlier Mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the Earlier Mark, the greater the likelihood of confusion may be, although it is always important to bear in mind what it is about the earlier mark which gives it distinctive character.²⁵
67. 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.
68. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a

²⁵ *Kurt Geiger v A-List Corporate Limited*, Case O-075-13, paragraph 39

characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.

69. The Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier Mark, therefore I only have the inherent distinctiveness of the mark to consider.
70. There being no dominant components, or any elements that retain an independent distinctive role in the Earlier Mark, the distinctive character of the mark lies solely in the word 'GEMOLOGY', seen as a whole.
71. The word 'GEMOLOGY' appears in a standard English dictionary, it is not an invented word and it will be given its plain and ordinary meaning. 'GEMOLOGY' makes no descriptive or allusive reference to the Opponent's goods.
72. The overall impression created in the mind of the average consumer would be dominated by the ordinary meaning of that word and its use in relation to the goods is odd and unusual. Consequently, the Earlier Mark possesses at least a medium degree of inherent distinctive character. For a consumer who does not know the meaning of the word 'gemology', the distinctiveness of the mark is only likely to increase.

Conclusions on Likelihood of Confusion

73. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.²⁶ I must also keep in mind the average consumer of the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.²⁷

²⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

²⁷ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

74. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether there is a potential that they might believe that the goods come from the same or an economically linked undertaking, and therefore are likely to be confused as to the origin of those goods.
75. The relative weight of the factors is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case.²⁸ The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.²⁹
76. There are three sets of circumstances where a consumer may associate a later mark with an earlier mark because of the identity and/ or similarity between them, the one leads to direct confusion, the second leads to indirect confusion, and in the third circumstance, there is no confusion, merely association.³⁰ Direct confusion is a simple matter of the consumer mistaking one mark for the other. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods bearing the later mark come from the same undertaking or from an economically linked undertaking.³¹ For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.³²
77. The comments of the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*³³ provide “a helpful explanation of the concept of indirect confusion, which

²⁸ See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O/049/17, (*Rochester Trade Mark*).

²⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

³⁰ See to that effect *Sabel BV v Puma AG*, Case C-251/95, paragraph 16

³¹ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

³² *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

³³ *Ibid.*

has frequently been cited subsequently, but as the [Appointed Person] made clear it was not intended to be an exhaustive definition."³⁴

78. If on the other hand, the later mark merely brings the earlier mark to mind, there is no confusion. This is because, notwithstanding the consumer's perception of the similarities between the marks, they do not believe that the marks are from the same or economically linked undertaking and therefore are not confused.
79. Taking into account all my findings and all the relevant factors, I do not consider there is any likelihood of confusion. In reaching this conclusion, I have kept in mind that: (i) the overall impression of the Earlier Mark rests in the word 'GEMOLOGY' as a whole, and that 'GEMOLOGY' has a definable meaning which is capable of immediate grasp by the average consumer;³⁵ (ii) the overall impression of the Contested Mark lies in the word 'GEMO' as a whole, which is an invented word which has no immediately apparent meaning and that 'GEMO' would not be viewed as an abbreviation for the word 'GEMOLOGY'; (iii) the average consumer would perceive both marks as wholes (there being no dominant components or any elements that retain an independent distinctive role in the marks); (iv) the Earlier Mark contains the additional letters 'LOGY' (which form part of the suffix 'OLOGY') which have no counterpart in the Contested Mark and affect the average consumer's visual, aural and conceptual perception of the Earlier Mark when compared with the Contested Mark; (v) the purchasing process is dominated by visual considerations and the visual difference between the two marks, owing to the last four letters of the Earlier Mark (which makes it twice as long as the Contested Mark), offsets the similarity.
80. Any perceived similarity between the marks (owing to the shared letters 'GEMO'), will merely lead to one mark calling the other to mind. This is mere association in the strict sense, as such, the average consumer would not be confused as to the origin of the goods (even where the marks would be seen on identical and similar goods).

³⁴ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 12

³⁵ I note that I have not discounted that a proportion of the average consumer may not be aware of the definition of 'gemology'

OUTCOME

81. The opposition fails under section 5(2)(b) of the Act. Subject to any appeal, the Contested Mark, trade mark application number 3720723, shall proceed to registration for all the goods applied for in Classes 3, 5 and 9.³⁶

COSTS

82. The Applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Applicant the sum of £200 as a contribution towards the cost of the proceedings (for the preparation of the Notice of Defence and Counterstatement).

83. I therefore order Gemology to pay Hangzhou Oxyhydrogen E-commerce Co., Ltd. the sum of **£200**. This 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 7th day of November 2022

Daniela Ferrari

For the Registrar

³⁶ As set out in Annex 1 to this decision.

Annex 1

Class 3

Skin toner; Aloe vera gel for cosmetic purposes; Essential oils; Toothpaste; Cosmetics; Beauty masks; Perfume; Shampoos; Cleansing milk; Depilatory preparations; Cleansers for intimate personal hygiene purposes, non medicated; Massage gels, other than for medical purposes; Hair tonic; Air fragrancing preparations; Body milk; Hair conditioner; Teeth whitening strips; Skin care preparations; False eyelashes; Nail varnish.

Class 5

Cooling sprays for medical purposes; Anti-inflammatory gels; Aloe vera gel for therapeutic purposes; Massage gels for medical purposes; Gels for dermatological use; Antibacterial gels; Dressings, medical; Gelatine for medical purposes; Vitamin preparations; Solutions for contact lenses; Food for babies; Deodorants for clothing and textiles; Breast-nursing pads; Eyepatches for medical purposes; Babies' diapers; Diapers for incontinence; Dental abrasives; Medicated shampoos; Dietetic beverages adapted for medical purposes; Dietetic foods adapted for medical purposes.

Class 9

Interactive touch screen terminals; Computer network server; Downloadable software applications for mobile phones; USB cables; Hand scanner; Headphones; Computer peripheral devices; Computer programs [downloadable software]; Computers; Data processing apparatus; Battery adapters; Battery chargers; Mobile phone battery chargers; Battery chargers for tablet computers; Scales; Weighbridges; Loudspeakers; Weighing apparatus and instruments; Spectacles; Sunglasses.