

O/0096/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003671675

BY MELISSA GELLATLY AND MICHELLE TRAINOR

TO REGISTER THE TRADE MARK:

Love Willow Wax

IN CLASSES 3 AND 4

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427630

BY WILLOW BEAUTY PRODUCTS LIMITED

BACKGROUND AND PLEADINGS

1. On 21 July 2021, Melissa Gellatly and Michelle Trainor (“the applicants”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 10 September 2021. The applicant seeks registration for the following goods:

Class 3 Reed diffusers; Hand washes; Hand soap; Hand cream; Scented wax melts; Scented room sprays; Scented body lotions.

Class 4 Perfumed candles; Scented candles.

2. The application was opposed by Willow Beauty Products Limited (“the opponent”) on 19 October 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:



UK registration no. UK0090908799

Filing date 12 May 2010.

Registration date 26 October 2010.

Relying upon some of the goods for which the earlier mark is registered, namely:

Class 3 Cosmetics; beauty products; perfumes; skincare lotions and creams; essential oils; pot pourri; room fragrances; perfumed oils.

Class 4 Wax; unscented candles; scented candles.

3. The opponent claims that there is a likelihood of confusion because of the identity/similarity of the marks and the goods.

4. The applicants filed a counterstatement denying the claims made.

5. Both parties are unrepresented. Neither party requested a hearing, however, the applicants filed evidence in chief. This decision is taken following a careful perusal of the papers.

6. 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.

EVIDENCE AND PRELIMINARY ISSUES

7. The applicants' evidence consists of the witness statement of Melissa Gellatly dated 13 July 2022. Together with the other applicant, Ms Gellatly has been selling soy candles and melts via Facebook and Instagram for five years. Ms Gellatly's statement was accompanied by 7 exhibits (E1-E4, F1 and G1-G2).

8. **Exhibits E1** is a screenshot from Google searching the opponent's "WILLOW BEAUTY PRODUCTS". I note that the first search result is the opponent's website which sells "organic beauty products, organic face and skincare", "organic baby lotions" and "organic bath and shower". The opponent's website is also split into 3 categories, "luxury organic skin care", "bath & body" and "gifts".

9. **Exhibits E2** and **E3** contains screenshots of the opponent's Facebook and Instagram pages. I note that its Facebook page is labelled as a "skincare service" and its Instagram bio states that the opponent is "natural & organic beauty, targeted for 30yr+ skin, anti-ageing & sustainable". **Exhibit E4** is a screenshot from the applicant's Facebook page which is labelled as a "home décor" page which sells "SOY CANDLES, MELTS & GIFTS". **Exhibit F1** is a screenshot from the applicant's Instagram page

which again highlights that they sell soy candles, melts and gifts. Ms Gellatly states that its “gifts” are the “candles, melts, reed diffusers or hand wash and lotion sets”, and that they do not sell any “organic or skin care products” that the opponent sells. Ms Gellatly states that the parties therefore operate in different categories; the opponent in skincare and beauty and the applicants in home décor. Therefore, she submits that there would be “no confusion between the two businesses”.

10. **Exhibit G1** shows the colours that the applicants use for their business, which are “only black and white”. **Exhibit G2** shows the colours which the opponent uses, which shows an “array of colours”. Ms Gellatly therefore submits that “it would be difficult to confuse the two businesses as Willow Beauty uses a range of colours for all products”.

11. I note that the applicants’ above evidence has been provided to show how both parties’ marks are being used within the marketplace, including the different types of goods that the marks are being used on. However, I note that my comparison must be of the marks as registered. Therefore, the evidence about how the parties’ marks are used in practice, or even how the parties’ overall branding (colour palettes etc.) is different, does not assist the applicant. I also note that in question 7 of its Form TM8, the applicants had ticked ‘no’ to the opponent providing proof of use of its mark. Consequently, the opponent is entitled to rely upon its full specification without demonstrating use of its mark or how it has marketed and sold its goods.

12. Therefore, as the applicants have not requested proof of use, I must make my comparison between the marks on the basis of how they could fairly be used.

DECISION

13. Section 5(2)(b) reads as follows:

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

(a)...

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

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

14. The earlier mark has completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do apply. However, as highlighted above, the applicants did not request that the opponent prove use of its mark, and therefore it is entitled to rely upon all of the goods without demonstrating that it has used the mark.

Section 5(2)(b) case law

15. 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:

- (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

16. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 3</u> Cosmetics; beauty products; perfumes; skincare lotions and creams; essential oils; pot pourri; room fragrances; perfumed oils.	<u>Class 3</u> Reed diffusers; Hand washes; Hand soap; Hand cream; Scented wax melts; Scented room sprays; Scented body lotions.
<u>Class 4</u> Wax; unscented candles; scented candles.	<u>Class 4</u> Perfumed candles; Scented candles.

17. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in Canon, Case C-39/97, the court stated at paragraph 23 that:

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

18. Guidance on this issue has 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

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

19. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

Class 3

20. The applicants’ “hand cream” and “scented body lotions” fall within the broader category of “skincare lotions and creams” in the opponent’s specification. The goods are therefore identical on the principle outlined in *Meric*.

21. The applicants’ “reed diffusers”, “scented wax melts” and “scented room sprays” fall within the broader category of “room fragrances” in the opponent’s specification. The goods are therefore identical on the principle outlined in *Meric*.

22. I consider that the applicant's "hand washes" and "hand soap" are items which are used to clean the users skin on their hands, and therefore their primary purpose is to clean. However, I note that they can also have secondary purposes, such as moisturising functions. Therefore, I consider that the applicants' goods overlap, to some extent, with the opponent's "skincare lotions and creams", which are used for moisturising purposes. I also consider that there may be an overlap in trade channels as the same hygiene and beauty undertakings are likely to produce all of the above goods. The goods would also be sold within the same aisle of supermarkets, and retail outlets, and would be brought by the same users. However, I note that their nature is different, as soaps can be in either a liquid or solid form, whereas the applicant's goods come in a cream form. The goods are not in competition nor complementary. Therefore, I consider that the goods are similar to a medium degree.

Class 4

23. "Scented candles" appears identically in both specifications.

24. Although "perfumed candles" in the applicants' specification is worded differently to the opponent's "scented candles" they are self-evidently identical goods.

The average consumer and the nature of the purchasing act

25. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. 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 (as he then was) 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 word

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26. The average consumer for the goods will be members of the general public. The cost of the goods in question is likely to be relatively low and they will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, ingredients and fragrance. Therefore, the level of attention paid during the purchasing process will be medium.

27. The goods are likely to be obtained by self-selection from the shelves of a supermarket, (beauty) retail outlet, or online equivalent. I note that the candles, melts and diffusers will be sold in a wider variety of stores, including the aforesaid mentioned stores as well as gift shops, home stores and their online equivalents. Alternatively, the goods may be purchased following perusal of advertisements. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

Comparison of the trade marks

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

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

30. The respective trade marks are shown below:

Opponent's trade mark	Applicants' trade mark
	<p data-bbox="837 831 1362 891">Love Willow Wax</p>

31. The opponent's mark consists of the word WILLOW, presented in a light grey colour, apart from the letter "O" which is presented in a light pink colour. On the left hand side of the word WILLOW, is a device of a willow tree branch. Although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the willow tree branch device at the beginning of a mark, I consider that it plays a roughly equal role in the overall impression with the word WILLOW.

32. The applicants' mark consists of the words LOVE WILLOW WAX. For some of the applicant's goods, the word WAX will be descriptive, and therefore will play a lesser role in the overall impression. Consequently, I consider that the words LOVE, and WILLOW will play an equal and greater role in the overall impression of the mark. For those goods where the word WAX is not descriptive, I consider that the overall impression of the mark lies in the combination of the words LOVE, WILLOW and WAX.

33. Visually, the marks coincide in the word WILLOW. This acts as a visual point of similarity. However, the opponent's mark is presented in the colours grey and pink,

with the willow tree branch device present at the beginning of the mark. The applicants' mark also begins with the word LOVE and ends in the word WAX. These act as visual points of difference. I also bear in mind that the average consumer tends to pay more attention to the beginning of the marks. Consequently, I consider that the marks are visually similar to between a low and medium degree.

34. Aurally, the opponent's mark will be pronounced as WILL-OH (the device will not be articulated). The applicants' mark will be pronounced as L-UV WILL-OH W-AXE. Therefore, the beginning of the marks differ aurally. However, as the marks overlap in the pronunciation of WILLOW, they are aurally similar to between a low and medium degree.

35. Conceptually, the word WILLOW will be recognised in both marks as a type of tree which typically has long branches and long narrow leaves. I note that this description is mirrored by the device at the beginning of the opponent's mark, which will be recognised by the average consumer as depicting the branch of a willow tree, and therefore reinforcing this conceptual message. I note that as fragrances usually derive from plants, the average consumer may recognise the word WILLOW as an indication of scent, however, I consider that as this is not a typical fragrance, the word WILLOW is only mildly allusive.

36. The applicants' mark begins with the word LOVE and ends in the word WAX, both of which will be assigned their ordinary dictionary meanings. As highlighted above, the word WAX will be descriptive of some of the applicant's goods.

37. I consider that, conceptually, the applicants' mark as a whole will be understood as a love for willow, scented, wax. I also consider that there may be a proportion of average consumers who will conceptually recognise the word 'LOVE' as a house mark, with the words 'WILLOW WAX' being an indicator of a sub-brand focussed on willow scented wax.

38. Regardless, as the marks share the concept WILLOW, I consider that the goods are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

40. 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 the use that has been made of it.

41. As highlighted above, the opponent’s mark consists of the word *WILLOW*, which has an ordinary recognisable dictionary meaning of a type of tree. I note that this may be mildly allusive of the fragrance of the opponent’s goods because fragrances usually

derive from plants. At the beginning of the mark is the visual representation of the willow tree branch. Therefore, taking all of the above into account, I consider that the mark as a whole is inherently distinctive to a medium degree.

Likelihood of confusion

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

43. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's mark consists of the willow branch device and the word WILLOW. Although the eye is naturally drawn to the element of the mark that can be read, given the size and positioning of the willow tree branch device at the beginning of a mark, I consider that it plays a roughly equal role in the overall impression with the word WILLOW.
- The applicants' mark consists of the words LOVE WILLOW WAX. For some of the applicant's goods, the word WAX will be descriptive, and therefore will play a lesser role in the overall impression. Consequently, I consider that the words LOVE, and WILLOW will play an equal and greater role in the overall

impression of the mark. For those goods where the word WAX is not descriptive, I consider that the overall impression of the mark lies in the combination of the words LOVE, WILLOW and WAX.

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to between a low and medium degree.
- I have found the marks to be conceptually similar to a medium degree.
- I have found the opponent's mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical or similar to a medium degree.

44. Therefore, taking all of the factors listed in paragraph 43 into account, particularly the visual and aural differences between the marks, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the lower visual similarity (to below a low and medium degree) between the marks, and the predominantly visual purchasing process.

45. As established above, the beginning of marks tend to make more of an impact than the ends. I, therefore, do not consider that the average consumer would overlook the willow branch device at the beginning of the opponent's mark, nor will the word LOVE be overlooked at the beginning of the applicant's mark. Furthermore, although the word WAX is descriptive of some of the applicant's goods, I consider that for those goods for which the word is not descriptive (its class reed diffuser, hand washes, hand soap, hand cream, scented room sprays and scented body lotions) the average consumer would not overlook the word WAX. For all of the above reasons, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as

each other, even when used on identical class 3 and 4 goods. Taking the above into account, I do not consider there to be a likelihood of direct confusion.

46. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

47. 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.

48. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they came from the same or economically linked undertakings. I do not consider that the average consumer would think that the applicants’ trade mark was connected with the opponent or vice versa on the basis that they both contain the word WILLOW, especially, and as highlighted above, the average consumer does not dissect the mark. It is more likely to be viewed as a

coincidence, especially as all of the opponent's and applicants' goods will most likely be fragranced, and therefore the word WILLOW could be indicative of the smell of the goods (as fragrances frequently derive from plants). I also do not consider that the addition of the word LOVE at the beginning of the applicant's mark is indicative of a logical brand extension. As highlighted above, I consider that the average consumer may recognise the word 'LOVE' as a house mark, with the words 'WILLOW WAX' being an indicator of a sub-brand focussed on willow scented wax. Furthermore, I also do not consider that the addition of the word WAX, especially for the applicant's non-wax goods, would be seen as a logical brand extension when none of the goods are 'wax' related. Therefore, I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

49. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

50. Award of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. The applicant has been successful and would normally be entitled to a contribution towards its costs.

51. However, as the applicants are unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicants and invited them to indicate whether they intended to make a request for an award of costs. The applicants were informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with the proceedings. They were informed that "if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded".

52. The applicants did not file a completed Pro Forma and paid no official fees. That being the case, I make no award of costs in this matter.

Dated this 1st day of February 2023

L FAYTER

For the Registrar