

O-0159-23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003630150

BY OLGA MORZOVA

TO REGISTER:

GLOWAX

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 427202

BY WAX & GLO LIMITED

Background & Pleadings

1. On 8 October 2020, Olga Morozova (“the applicant”) applied to register the trade mark **GLOWAX** in the European Union. The applicant subsequently applied for the same mark in the United Kingdom on 21 April 2021. In accordance with Article 59 of the Withdrawal Agreement between the UK and the European Union, by filing an application for the EU mark in the UK within nine months of the end of the transition period, the applicant is entitled to rely on the priority date of the EU mark in UK proceedings. The date of the application in these proceedings is therefore considered to be 8 October 2020. The applicant seeks registration for the following class 3 goods:

Depilatory wax; Depilatory wax; Depilatory wax; Depilatory wax; Depilatory lotions; Depilatory preparations; Depilatory preparations; Depilatory creams; Hair removal and shaving preparations; Cosmetics; Depilatory wax with glitter.

The application was published for opposition purposes on 25 June 2021.

2. On 28 September 2021, WAX & GLO Limited (“the opponent”) opposed the application, in its entirety, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). For the purpose of the opposition, the opponent relies upon the following trade mark and all goods and services for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 3369873

WAX & GLO

Filing date: 24 January 2019

Registration date: 12 April 2019

Class 3: *Cosmetics*

Class 44: *Beauty salon services*

3. In its statement of grounds, the opponent contends that the high similarity between the parties' marks and the competing specifications would give rise to a likelihood of confusion on the part of the relevant public.

4. In its counterstatement, whilst the applicant admits that the applied-for goods are identical or similar to the goods in class 3 relied upon by the opponent, it nonetheless maintains that the respective trade marks are sufficiently different so as to avoid a likelihood of confusion.

5. The applicant is represented by Baron Warren Redfern and the opponent by Acuity Law Limited. Neither party filed evidence during the evidential rounds and, on conclusion of the evidence rounds, both parties were given the opportunity to request a hearing or file written submissions in lieu, and both declined to do either.

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

Decision

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

“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.”

8. Under the provisions laid out in section 6 of the Act, the opponent's trade mark clearly qualifies as an earlier mark and, in accordance with section 6A of the Act, as it had not completed its registration procedure more than five years prior to the relevant date, it is not subject to the proof of use requirements. Consequently, the opponent can rely upon its earlier mark and all goods and services for which it is registered without providing evidence of use.

Section 5(2)(b) - Case law

9. The following principles are gleaned from the decisions of the courts of the European Union 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (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 greater 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 will wrongly 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

10. Both parties' specifications include the term *cosmetics*. These goods are literally identical.

11. The applicant also seeks registration for *depilatory wax; depilatory wax; depilatory wax; depilatory wax; depilatory lotions; depilatory preparations; depilatory preparations; depilatory creams; hair removal and shaving preparations and depilatory wax with glitter*. I understand the term 'cosmetics' to refer to goods which are typically applied to the skin for purposes of beautifying or enhancement, be that in terms of quality or appearance. The applicant's goods are intended specifically to remove hair from the skin. If this is to be deemed a beautification process and depilation products would naturally be described as cosmetics, the goods are to be considered identical¹. If that approach is considered incorrect, however, I nonetheless find the goods similar to at least a fairly high degree having considered the factors laid out in *Treat*². Particularly where the applicant's goods are accessed for aesthetic reasons, there is a high similarity in use when considered against the opponent's *cosmetics*. There would also likely be a significant overlap in the goods' respective users. There may be some opportunity for similarity in the goods' physical nature, particularly in the case of the applicant's lotions or creams, for example, though I accept this is fairly limited as the ingredients will be tailored for each individual product. The goods may not reach the market through the same trade channels, though would likely be positioned in relative proximity in the aisles of a beauty retail outlet, supermarket or pharmacy, for example. The goods may also not typically be provided by a single entity. They are not necessarily complementary, but could be used alongside one another as part of the user's wider beauty routine.

The average consumer and the nature of the purchasing act

12. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question³. 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:

¹ *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05

² *Treat*, [1996] R.P.C. 281

³ *Lloyd Schuhfabrik Meyer*, Case C-342/97

“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.”

13. The average consumer of the goods at issue here is likely to be a member of the general public. In my experience, the goods are generally self-selected from the shelves of the relevant retail establishment or an online equivalent. The marks’ visual impression is consequently likely to play a greater role in the selection process, though I do not overlook the opportunity for consumers to seek or share recommendations with peers, for example, so I do not discount the significance of the marks’ aural impressions. Although there will likely be a notable difference between budget ranges and very high-end goods in this field, generally the goods are inexpensive and will be purchased fairly frequently. The consumer will likely be alive to considerations such as suitability, quality and possibly the ingredients used when approaching its selection. Weighing all factors, I find the average consumer likely to apply a medium degree of attention.

Comparison of trade marks

14. 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

“34. ...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.”

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

16. The trade marks to be compared are displayed in the table below:

Opponent's mark	Applicant's mark
WAX & GLO	GLOWAX

17. The opponent's mark comprises two word elements, both three letters in length, positioned either side of an ampersand. I do not consider either word more dominant than the other and instead find the mark's overall impression to reside in the mark as a whole.

18. The applicant's mark comprises a single word of six letters. The mark's overall impression lies solely in the word itself.

19. Visually, both marks feature the letters W-A-X and G-L-O, presented sequentially. In the opponent's mark those letters signify two distinct words which are separated by an ampersand symbol. In the applicant's mark, those letters are conjoined to create a single word with G-L-O preceding W-A-X. Notwithstanding the identity in the marks' letters, keeping in mind the differences I have identified, and that the beginnings of

marks tend to have more of an impact on consumers than their endings⁴, I find the visual similarity to be of no more than a medium degree.

20. It seems likely that the earlier mark will be articulated in three syllables; WAX-AND-GLO. The applicant's mark would likely comprise two syllables; GLO-WAX. The marks share two identical syllables, although they are presented in a different order in each mark. There is also a third syllable in the middle of the opponent's mark with no equivalent in the applicant's mark. I find the marks' aural similarity of a medium degree.

21. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁵ Beginning with the opponent's mark, I am satisfied that the word 'GLO' will be seen as a shortened version of well-known dictionary word, GLOW. The mark's first word, WAX, will be readily understood as a reference to a hair removal process or product. Its final word, GLO (GLOW), will also be readily understood and will evoke a suggestion of radiance. Conceptually, the mark therefore suggests that the user will enjoy a radiance or 'glowing' of some description subsequently to waxing. Taken as a whole, the mark could be also seen as somewhat of a play on words, perhaps suggestive of 'WAX and GO', indicating that the process is relatively short or can be done in a hurry. I should make clear that I have considered the opponent's submission insofar as it claims that the words WAX and GLO in the earlier mark could be interchangeable on the part of the relevant public and the mark could therefore be misremembered as 'GLO & WAX'⁶. I consider this unlikely. The order in which the words are presented are indicative of a sequence in which 'glowing' is a consequence of the preceding wax. The words make less sense sequentially, in my view, if considered in the reverse and I do not find it likely the average consumer would be inclined to misremember it as such. In the applicant's mark, as I have already noted, the words are joined together to create a single word but nonetheless it seems likely that the consumer will easily recognise that it comprises two fairly ordinary words, albeit with GLOW having been reduced to GLO. In my view, the impact of merging those words and with GLO being positioned before WAX, would be for GLO to be seen somehow as a qualifier of the WAX itself, effectively suggesting that the WAX referred

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁵ *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29

⁶ See paragraph 7 of the opponent's statement of grounds

to in the mark 'glowed' in some way, the same way a consumer would interpret the word glow-worm, for example. I agree with the applicant insofar as it contends that, due to the makeup of the respective marks, the 'WAX' in the earlier mark would be seen as a verb whereas in the later mark it would be seen as a noun. Notwithstanding the common elements between the marks, for the reasons already provided, I find the conceptual similarity between the marks to be fairly low.

Distinctive character of the earlier trade mark

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

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

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

23. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services for which they are registered, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will typically fall somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; generally, the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

24. Given that the opponent has not made a pleading of enhanced distinctiveness, and in the absence of evidence showing the use made of the earlier mark, I have only its inherent distinctiveness to consider. The opponent relies upon *cosmetics* in class 3 and *beauty salon services* in class 44, though I have found the former most pertinent to these proceedings. I have already considered the relationship between waxing products and cosmetics in my assessment of the respective goods, which I found similar to at least a fairly high degree. When I consider the meaning of the mark against the goods relied upon, there is at least an allusive relationship to be found, with 'WAX' being a well-known hair removal treatment or product, possibly intended to beautify, and 'GLO' understood as an alternative to GLOW, which is likely to be interpreted as an effect which the consumer hopes to create by applying certain cosmetic products. The shortening of 'GLO' is, in my experience, not uncommon, so does little in terms of a contribution of distinctiveness, though I've found that the mark could also be seen as somewhat of a play on words. Still, weighing all factors, I find the earlier mark's inherent distinctiveness fairly low.

Likelihood of confusion

25. In determining whether there is a likelihood of confusion, 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 also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion.

26. 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.

27. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he 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)".

28. 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.

29. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

30. I will begin by considering a likelihood of direct confusion. I have found the marks' visual impressions to carry the greatest weight, although I do not overlook the relevance of their aural impact. In that regard, I have found the marks visually similar to no more than a medium degree and aurally similar to a medium degree. I have further found that the average consumer will typically apply a medium degree of attention to its purchase and that the earlier mark possesses a fairly low degree of inherent distinctiveness which, generally speaking, points against a likelihood of confusion. Even when considered in respect of goods which are identical, I do not find it likely that the average consumer will simply mistake one mark for the other; one comprises three elements and the other a single word. I have also dismissed a likelihood of the average consumer erroneously interchanging the word elements in the earlier mark (recalling it as 'GLO' & 'WAX'). Additionally, the respective concepts evoked by each mark, which are likely to immediately resonate with the average consumer, are similar to only a fairly low degree. Weighing all factors, I do not consider

there to be sufficient similarity between the marks to engage a likelihood of direct confusion.

31. I move now to consider a likelihood of indirect confusion. Whilst the examples provided in *L.A.Sugar* are not intended to be exhaustive, they nonetheless offer a helpful indication of the circumstances in which indirect confusion may arise. Conceptually, I have found the marks to share a fairly low degree of similarity and the differences in the marks are not, in my view, consistent with what the average consumer would identify as a brand extension or sub-brand, for example. Particularly keeping in mind the fairly low distinctiveness awarded to the earlier mark, having recognised the differences between the marks, the average consumer would likely attribute those differences to the marks simply originating from separate undertakings. The marks' common element (or elements) are not sufficiently distinctive, and they are not used in the same way linguistically, for the average consumer to erroneously conclude that the marks must be related. I therefore dismiss a likelihood of indirect confusion.

Conclusion

32. The opposition has failed and, subject to any successful appeal, the application will proceed to registration.

Costs

33. The applicant has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2016. In accordance with that TPN, I award costs as follows:

Considering the Notice of Opposition and
preparing a counterstatement: £250

Total: £250

34. I order WAX & GLO Limited to pay Olga Morozova the sum of £250. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of February 2023

**Laura Stephens
For the Registrar**