

O/0279/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3693867

IN THE NAME OF LTWHP, LLC

**TO REGISTER THE FOLLOWING TRADE
MARK:**

LIFE'S

IN CLASSES 3, 21 & 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 481108**

BY HENKEL AG & CO. KGAA

Background and pleadings

1. On 13 September 2021, LTWHP, LLC (“the applicant”) applied to register the trade mark “**LIFE’S**” in the UK under application number 3693867. The application, effectively a re-filing of pending European Union trade mark number 016915761, was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union (hereafter referred to as “Article 59”). The EU filing date was 26 June 2017 and so, in accordance with Article 59, the contested application is deemed to have the same filing date as the corresponding pending EU application, which for the purposes of this decision will be taken as the relevant date. The UK application was published for opposition purposes on 24 December 2021 and registration is sought for the goods and services as set out in paragraph 18 of this decision.

2. On 17 February 2022, Henkel AG & Co. KGaA (“the opponent”) opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of the following UK Trade Marks:

Earlier Mark	Registration no.	Registration date	Goods relied upon
LIVE	“the first earlier mark” UK00003204627	07 April 2017	Class 3: Preparations for treating, dyeing, colouring, bleaching, styling hair.
LIVE	“the second earlier mark” UK00900984245 ¹	10 April 2000 (priority date: 05 August 1998)	Class 3: Preparations for treating, dyeing, colouring, bleaching, styling hair.

¹ The second earlier mark was initially registered at the European Union Intellectual Property Office (EUIPO). On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result of the second earlier mark being registered as a EUTM, at the end of the Implementation Period, it was automatically converted to a comparable UK trade mark. The comparable UK mark is now recorded on the UK trade mark register and has the same legal status as if it had been applied for and registered under UK law, and the original filing date remains.

3. By virtue of their earlier filing dates, the above registrations constitute as earlier marks within the meaning of section 6 of the Act.

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

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its second earlier mark.

6. Both parties are professionally represented in these proceedings, the opponent by D. Young & Co. and the applicant by Sipara Limited. Whilst the opponent filed evidence, the applicant did not. Neither party requested a hearing however both parties filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied 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

8. The opponent's evidence was filed in the form of a witness statement dated 16 August 2022 from the company's Corporate Senior Trade Mark Counsel, Joachim Renner and includes 18 exhibits in total. The evidence filed is intended to substantiate the extent of the opponent's use of its earlier marks and to show that the marks have acquired an enhanced degree of distinctive character. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

Proof of use

9. The first earlier mark had been registered for less than five years at the filing date of the application in issue and is therefore not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods it has identified for its first earlier mark. The second earlier mark, however, had completed its registration processes more than five years before the application date of the contested mark and is therefore subject to the proof of use provisions contained in section 6A of the Act.

10. The applicant has requested proof of use in these proceedings in respect of the opponent's second earlier mark, in respect of all of the goods relied upon. However, I note that the opponent's first earlier mark which is not subject to proof of use, is also registered for the word "LIVE" and is registered for identical goods in class 3. As such, I find that both earlier marks provide the opponent with identical protection, and it is not necessary for me to consider proof of use for the second mark as the opponent may instead rely on the protection offered by the first earlier mark. I will therefore focus my assessment on the opponent's first earlier mark.

Decision

11. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

12. Section 5A of the Act is as follows:

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

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components; (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

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

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

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

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

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

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

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

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

Opponent	Applicant
<p>Class 3: Preparations for treating, dyeing, colouring, bleaching, styling hair.</p>	<p>Class 3: Perfume with the exception of hair dye products, essential oils except those for hair dyeing, cosmetics except those for hair dyeing, hair lotions with the exception of those for dyeing; Dentifrices; After-shave preparations; Almond milk for cosmetic purposes; Almond oil; Almond soap; Amber [perfume]; Antiperspirant soap; Antiperspirants [toiletries]; Aromatics; Astringents for cosmetic purposes; Badian essence; Bath salts, not for medical purposes; Baths (Cosmetic preparations for -); Cosmetic masks with the exception of those for hair dyeing; Bergamot oil; Boot cream; Bar soap; Cedarwood (Essential oils of -); Cleansing milk for toilet purposes; Cosmetic kits with the exception of products for hair dyeing; Cotton sticks for cosmetic purposes; Cotton wool for cosmetic purposes; Cosmetic creams; Creams for leather; Degreasers, other than for use in manufacturing processes; Deodorant soap; Deodorants for personal use; Depilatories; Detergents, other than for use in manufacturing operations and for medical purposes; Cologne; Emery; Essential oils except those for hair dyeing; Ethereal essences; Extracts of flowers [perfumes]; Flower perfumes (Bases for -); Gaultheria oil; Geraniol; Incense; Ionone [perfumery]; Jasmine oil; Lavender oil; Lavender water; Essential oils of lemon; Lipstick; Lotions for cosmetic purposes with the exception of those for hair dyeing; Make-up; Make-up powder; Make-up preparations; Make-up removing preparations; Mascara; Mint essence [essential oil]; Mint for perfumery; Mouthwashes, not for medical purposes; Musk [perfumery]; Moustache wax; Nail care preparations; Oils for cosmetic purposes except those for hair dyeing; Oils for perfumes and scents except those for hair dyeing; Oils for toilet purposes; Cosmetic pencils; Eyebrow pencils; Perfume; Petroleum</p>

	<p>jelly for cosmetic purposes; Pomades for cosmetic purposes with the exception of those for hair dyeing; Preservatives for leather [polishes]; Rose oil; Perfume water; Shampoo except those for hair dyeing; Shaving preparations; Shaving soap; Shoe polish; Shoe wax; Shoemakers' wax; Skincare cosmetics; Skin whitening creams; Soaps; Soap for foot perspiration; Sunscreen preparations; Tanning preparations; Talcum powder, for toilet use; Tissues impregnated with cosmetic lotions; Toilet water; Toiletry preparations except those for hair dyeing; Transfers (Decorative -) for cosmetic purposes; Wax (Depilatory -).</p>
	<p>Class 21: Combs and sponges except those for hair dyeing; Brushes, except paint brushes with the exception of those for hair dyeing; Brush goods except those for hair dyeing; Combs for the hair (Large-toothed -) except those for dyeing; Soap boxes; Toilet cases except for hair dyeing.</p>
	<p>Class 35: Retail services, wholesale services, mail order services and online sale services relating to perfumes, cosmetics, soaps with the exception of hair dye products and related accessories.</p>

19. The applicant in its counterstatement accepts that “the opposed goods are at least similar to the goods of the earlier registration.” However, I am still required to determine the level of similarity between the goods and as such, I will continue to carry out a full assessment regarding the level of similarity between the same.

Class 3 Goods

20. I find that the applicant's *shampoo except those for hair dyeing; toiletry preparations except those for hair dyeing; hair lotions with the exception of those for dyeing; cosmetic masks with the exception of those for hair dyeing and lotions for cosmetic purposes with the exception of those for hair dyeing; cosmetic creams and baths (cosmetic preparations for -)* would include shampoos, conditioners, lotions and masks for the use of treating hair. Consequently, I consider these terms to be identical to *preparations for treating hair* on the principle outlined in *Merix*. If I am wrong on this, I find the goods to be highly similar. They would overlap in users and share trade channels as they would be sold on the same shelves as *preparations for treating hair*. Further, I find that they would overlap in physical nature, purpose and method of use. There may also be a degree of competition between the same.

21. I consider that the opponent's *preparations for treating, dyeing, colouring, bleaching, styling hair* would include preparations intended for use on facial hair. I therefore find the applicant's *moustache wax* and *pomades for cosmetic purposes with the exception of those for hair dyeing* to be identical to the opponent's *preparations for treating and styling hair*.

22. The applicant's *depilatories; wax (depilatory -)* and *shaving preparations* are all goods that aid in the removal of hair. I consider the opponent's *preparations for treating hair* would include preparations intended to remove body hair and on that basis, I consider these goods to be identical as outlined in *Meric*. If I am wrong on this, then I find that the goods are highly similar. I make this finding on the basis that the goods would overlap in terms of nature and purpose. There would be an overlap in users and trade channels. Though I do not find there to be a complementary relationship, I consider that there would be a degree of competition between the same.

23. I now consider the applicant's *oils for cosmetic purposes except those for hair dyeing* and *oils for toilet purposes*. I find that these terms would include oils to be used on the hair as a treatment or for the purposes of styling hair. As such, I consider these goods to be identical to *preparations for treating and styling hair* on the principle outlined in *Meric*.

24. I note that the applicant's specification includes the broad terms *cosmetics except those for hair dyeing* and *cosmetic kits with the exception of products for hair dyeing*. The opponent's specification includes the term *preparations for treating hair* and I find that this term would include hair oils, hair masks and hair lotions. In *La Mer Technology, Inc v OHIM*, Case T-418/03, the GC noted the similarities between hair lotions and 'cosmetics of a marine product base'. The court observed that:

"110. As regards the assessment of the similarity of the goods in question, it must be stated, as the Board of Appeal correctly noted in paragraph 33 of the contested decision, that 'cosmetics' in the Community trade mark application include 'cosmetics of a marine product base', so that they are identical.

111. So far as concerns 'soaps, perfumery, essential oils, hair lotions, dentifrices, toiletries' in the Community trade mark application, it should be stated that they share hygiene and cosmetic properties. The cosmetic products of the earlier mark may also be used for hygiene purposes. As was stated in paragraphs 77 to 84 above, soaps and bath additives are used not only for cleaning the skin but also for making the skin more beautiful and claim therefore to have cosmetic properties. On that point, in paragraph 33 of the contested decision the Board of Appeal correctly noted that beautification is not obtained only by the use of traditional means, such as make-up or other cosmetics, but also through the use of products which, although they may be hygienic, serve beauty purposes as well: for example, soap that is composed in a manner whereby there is only a minimum of skin dehydration, thus leading to a more beautiful skin or dentifrices that, in addition to cleaning teeth, also make them whiter.

112. Moreover, those products may be sold in the same sales outlets and be directed at an identical category of consumers. In addition, quite often the manufacturers of those products are the same.

113. Finally, the applicant itself concedes, in its complaint alleging that the Board of Appeal ought to have made an additional distinction between the goods, that besides the cosmetics which are identical, all the other products are, to differing degrees, similar to those bearing the earlier mark.

114. The Board of Appeal was therefore right to take the view, in paragraph 33 of the contested decision, that 'soaps, perfumery, essential oils, hair lotions, dentifrices, toiletries' under the Community trade mark and 'cosmetics of a marine product base' under the earlier mark are very similar."

25. I agree with the findings above, and for the reasons set out I find that the applicant's *cosmetics except those for hair dyeing and cosmetic kits with the exception of products for hair dyeing* are highly similar to *preparations for treating and styling hair*.

26. Although make-up is a cosmetic, and I have found above that *preparations for treating and styling hair* are highly similar to cosmetics, this does not necessarily mean that make-up and the opponent's goods are similar.² I consider *make-up; make-up powder; make-up preparations; lipstick; mascara; cosmetic pencils* and *eyebrow pencils* all refer to products which are applied to the face to enhance or alter one's appearance. I find that these goods differ in nature and method of use compared to the opponent's earlier goods. There would be an overlap in users and trade channels however, I consider that the goods would be sold on different shelves. Further, I do not consider that the goods enjoy a competitive or complementary relationship. Weighing up these factors, I consider these services to be dissimilar.

27. I find that the applicant's *skincare cosmetics; almond milk for cosmetic purposes; astringents for cosmetic purposes* and *cleansing milk for toilet purposes* would encompass goods such as skin cleansing and moisturising lotions and that the opponent's *preparations for treating hair* would include goods such as hair lotions and shampoos. From this, I consider there would be an overlap in physical nature. There would also be a broad overlap in purpose insofar as both goods would be used to improve one's appearance however, the method of use would differ with the applicant's goods being used on the skin, and the opponent's goods being used on the hair. I do not consider there would be a complementary relationship between the respective goods, nor do I consider there would be a degree of competition between the same. Moreover, I consider that the goods would be found on different shelves of a retail outlet. Overall, I find there is a low degree of similarity between these goods.

28. I now turn to the applicant's *essential oils except those for hair dyeing, mint essence [essential oil]; bergamot oil; almond oil; cedarwood (essential oils of -); gaultheria oil; geraniol; jasmine oil; lavender oil; essential oils of lemon; and rose oil*. I consider these terms to all be essential oils which are used for *inter alia* natural remedies, stress relief and perfume scents. I also acknowledge that essential oils are often used as an ingredient in *preparations for treating and styling hair*. However I note that the fact that a particular good is used as a part of another good does show that

² See *Novartis AG v OHIM*, Case T-444/12, GC, in which the court stated that specific goods within broad categories may be not similar to one another.

the finished goods containing those products are similar since in particular, their nature, intended purpose and the customers for those goods may be completely different.³ I consider that there is an overlap in terms of physical nature as I find that the opponent's *preparations for treating and styling hair* could be available in the form of a hair oil however I find there to be a difference in method of use as essential oils are typically diluted in water or a carrier oil as they are heavily concentrated goods. There is a broad overlap in purpose insofar as the goods may be used to improve the condition of one's hair and an overlap in user. I do not consider that the goods would be sold within close proximity to one another, nor do I consider there to be a complementary relationship between the same. There may be a degree of competition between the goods. Considering these factors, I find there is a medium degree of similarity between these goods.

29. *Perfume with the exception of hair dye products, amber [perfume]; ethereal essences; aromatics; extracts of flowers [perfumes]; flower perfumes (bases for -); Ionone [perfumery]; cologne; toilet water; badian essence; mint for perfumery; lavender water; perfume; musk [perfumery]; oils for perfumes and scents except those for hair dyeing and perfume water* are all various perfumes and fragrances. I begin by acknowledging that these goods may be used as ingredients in the opponent's goods, however, this does not necessarily render the goods as similar as there may be differences in the respective goods nature, intended purpose and users. I find that these goods and the opponent's goods differ in terms of physical nature. Though the goods would both be used as part of a personal care or beauty regime, I consider they differ in terms of method of use and purpose as the opponent's goods are used to colour, style and treat the hair whereas the applicant's goods are used to give the body a desirable scent. There would be an overlap in users insofar as they would be purchased by members of the general public, and I consider that these goods would be found in the personal care section of supermarkets or in retailers such as Boots and Superdrug however, the respective goods would have their own discrete areas within such stores. I do not find that these goods enjoy a competitive relationship, nor are they complementary. Overall, I consider these goods to be dissimilar.

³ See *Les Éditions Albert René v OHIM*, Case T-336/03

30. I now consider the applicant's *bar soap; soaps; soap for foot perspiration; shaving soap* and *almond soap*. These goods along with the opponent's goods would be used as part of a personal care or beauty regime so there is a shared purpose however, they differ in terms of method of use and their physical nature differs. I consider there would be an overlap in users and trade channels however, the goods would be sold on different shelves. I do not find that these goods would be complementary, and I do not consider that they would be in any competition with each other. Consequently, I find there is a low degree of similarity between these goods.

31. *Antiperspirant soap; antiperspirants [toiletries]; deodorant soap* and *deodorants for personal use* are all used to prevent perspiration. I consider that they differ in nature, purpose and method of use compared to the opponent's *preparations for treating, dyeing, colouring, bleaching, styling hair*. Again, there would be an overlap in users being the general public and the goods would share trade channels albeit, they would be sold on different shelves. I do not find that these goods would share a complementary or competitive relationship. I do not consider there to be any similarity between these goods.

32. I consider *detergents, other than for use in manufacturing operations and for medical purposes* and *degreasers, other than for use in manufacturing processes* to be substances for cleaning and laundry use. Comparing these goods to that of the opponent's I find that they differ in nature, method of use and purpose. Though the goods would be sold in a supermarket, they would not be sold within close proximity of one another. Further, I do not consider there to be a competitive or complementary relationship between the same. I do not consider these goods to be similar.

33. *Boot cream; creams for leather; shoe polish; shoe wax; shoemakers' wax; preservatives for leather [polishes]* are all products used for polishing or treating shoes and leather. Their purpose, method of use and physical nature differs from the opponent's goods. I do not consider that the goods would be sold close to one another in a supermarket, and I do not find there to be a competitive or complementary relationship between the same. Consequently, I do not find there to be any similarity between these goods.

34. *Incense* is a substance that is burned to release a fragrant scent. I consider that it differs in terms of nature, purpose and method of use compared to the opponent's goods. I do not consider there to be an overlap in trade channels and the goods do not enjoy a competitive nor a complementary relationship. These goods are dissimilar.

35. I consider *dentifrices* and *mouthwashes, not for medical purposes* to be dental hygiene goods used to clean the teeth and mouth. I therefore consider that these goods differ in terms of purpose, physical nature and method of use compared to the opponent's goods. The goods would not be found close to one another in a retail outlet, and I do not find there to be a competitive not a complementary relationship between the same. Consequently, I do not consider there to be any similarity between these goods.

36. *Bath salts, not for medical purposes* are different in nature, purpose and method of use compared to the opponent's goods. Although there would be an overlap in trade channels with the opponent's goods, I consider that these goods would be sold on different shelves. There would be no competitive relationship between the goods, nor would they enjoy a complementary relationship. Overall, I do not consider these goods to be similar.

37. I now consider the applicant's *make-up removing preparations; petroleum jelly for cosmetic purposes; skin whitening creams; tanning preparations; talcum powder, for toilet use; tissues impregnated with cosmetic lotions; transfers (Decorative -) for cosmetic purposes* and *sunscreen preparations* and *after-shave preparations*. I consider these terms include preparations to be used on the skin for various purposes. I find that their nature, purpose and method of use differs to the opponent's goods. Although the respective goods would share trade channels, the goods would be sold on different shelves. Further, I do not consider there to be a competitive or a complementary relationship between these goods. Consequently, I consider these goods to be dissimilar.

38. I find that the applicant's *cotton sticks for cosmetic purposes* and *cotton wool for cosmetic purposes* would differ in terms of nature, purpose and method of use compared to the opponent's goods. There would be an overlap in trade channels

however, I consider that the respective goods would be sold on different shelves. I do not consider the goods to be complementary, nor do I consider them to have a competitive relationship. I consider these goods to be dissimilar.

39. I consider that *emery* and *nail care preparations* to have a different purpose, method of use and nature compared to the opponent's goods. Although the goods would overlap in trade channels, they would not be sold on the same shelves. Further, I do not consider the goods to enjoy a competitive nor a complementary relationship. Overall, I do not find these goods to be similar.

Class 21 Goods

40. The applicant's terms *combs except those for hair dyeing; brushes, except paint brushes with the exception of those for hair dyeing; brush goods except those for hair dyeing* and *combs for the hair (large-toothed -) except those for dyeing* are all goods used to style and detangle hair. Although these goods differ in terms of nature and method of use compared to the opponent's *preparations for styling hair*, I find there is a general overlap in terms of purpose as the respective goods are both used to style the hair. I also consider that these goods would be sold within close proximity to one another in a retail outlet and there would be an overlap in users. I find that the applicant's goods may be used to apply *preparations for styling hair*, and I consider this relationship between the goods would result in the average consumer believing that the goods are derived from the same undertaking. I do not consider that these goods would enjoy a competitive relationship. Overall, I find there is a low degree of similarity between these goods.

41. I now turn to the remaining goods in class 21 of the application, being *sponges except those for hair dyeing; soap boxes and toilet cases except for hair dyeing*. I find that these goods differ in nature, purpose and method of use compared to the opponent's goods. There would be no competitive nor a complementary relationship between the same. I consider that there would be an overlap in users insofar as they would be the general public and though there would be an overlap in trade channels,

I do not consider that these goods would be sold on the same shelves in a retail outlet. Consequently, I do not consider these goods to be similar.

Class 35 Services

42. I first note that the applicant's specification in relation to its services in class 35 includes the limitation "*with the exception of hair dye products and related accessories*", I will take this into account when conducting my comparison of these services in class 35 in relation to the opponent's earlier goods *preparations for treating, and styling hair*. I note that the applicant's services in class 35 includes retail and wholesale of goods in relation to cosmetics and I consider that this would encompass goods covered by the opponent's specification, namely *preparations for treating, and styling hair* to the extent that these are not for dyeing the hair, as per the limitation. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

43. Accordingly, although the respective goods and services have different natures, purposes and methods of use, I find the applicant's retail and wholesale services to be complementary to the opponent's *preparations for treating, and styling hair*. The opponent's goods are important to the operation of the applicant's services to the extent that consumers may believe that the responsibility for them lies with the same undertaking⁴. Further, the respective goods and services will be offered through shared trade channels and to the same users. Overall, I consider the respective goods and services to be similar to a medium degree.

44. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition must fail against the goods of the application that I have found to be dissimilar⁵, namely:

⁴ *Boston Scientific Ltd v OHIM*, Case T-325/06

⁵ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

Class 3: Make-up; Make-up powder; Make-up preparations; Lipstick; Mascara; Cosmetic pencils; Eyebrow pencils; Perfume with the exception of hair dye products, Amber [perfume]; Ethereal essences; Extracts of flowers [perfumes]; Flower perfumes (Bases for -); Ionone [perfumery]; Cologne; Toilet water; Badian essence; Mint for perfumery; Lavender water; Perfume; Musk [perfumery]; Perfume water; Antiperspirant soap; Antiperspirants [toiletries]; Deodorant soap; Deodorants for personal use; Detergents, other than for use in manufacturing operations and for medical purposes; Degreasers, other than for use in manufacturing processes; Incense; Boot cream; Creams for leather; Shoe polish; Shoe wax; Shoemakers' wax; Preservatives for leather [polishes]; Bath salts, not for medical purposes; Dentifrices; Mouthwashes, not for medical purposes; Make-up removing preparations; Petroleum jelly for cosmetic purposes; Skin whitening creams; Tanning preparations; Talcum powder, for toilet use; Tissues impregnated with cosmetic lotions; Transfers (Decorative -) for cosmetic purposes; Sunscreen preparations; After-shave preparations; Cotton sticks for cosmetic purposes; Cotton wool for cosmetic purposes; Emery; Nail care preparations aromatics; Aromatics; Oils for perfumes and scents except those for hair dyeing.

Class 21: Sponges except those for hair dyeing; Soap boxes; Toilet cases except for hair dyeing.

The average consumer and the nature of the purchasing act

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46. The average consumer for the contested goods and services will be a member of the general public or a professional such as a hair stylist purchasing on behalf of a business undertaking. The goods and services will be purchased reasonably frequently and may be relatively expensive or relatively inexpensive. The general public selecting the goods will take into account individual taste and suitability of the product. Taking this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process by these consumers. The professional public are likely to pay a higher degree of attention due to the added responsibility and liability they will face in their position, and the fact that the product used may directly impact the success of their business. These consumers will be likely to pay an above medium degree of attention to the goods.

47. The goods are likely to be self-selected by the general public from a pharmacy, department store, supermarket or a website. Visual considerations are, therefore, likely to dominate the selection process. However, given that advice may be sought from sale assistants, and orders may be placed over the phone, I do not discount an aural component to the purchase.

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

Comparison of marks

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

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

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

51. The marks to be compared are as follows:

Opponent's mark	Applicant's mark
LIVE	LIFE'S

Overall impression

52. The opponent's mark consists solely of the word “LIVE”. There are no other elements to contribute to the overall impression which lies in the word itself.

53. The applicant's mark consists of the word "LIFE'S". In the absence of any additional components, the mark's overall impression resides solely in the wording itself.

Visual comparison

54. Both parties' marks begin with the letters "LI", and there is a further overlap as "E" is the fourth letter in both marks. Visual points of difference lie in the use of the letter "V" in the opponent's mark, this has no counterpart in the applicants mark. Further, the applicant's mark also contains the letter "F", an apostrophe and the letter "S", these elements are not present in the opponent's mark. I bear in mind that greater attention is normally paid to the beginning of the marks⁶ however, I also note that the marks are short in length. There is no special test which applies to the comparison of short marks, the visual similarities must be assessed in the normal way.⁷ However, it is clear that the differences between the marks, namely the addition of an apostrophe and a further letter in the later mark and the differences between the letters "V" and "F" are clearly more significant than such additions to a longer mark. Therefore, I consider that the differences I have identified between the marks will not just be noticed but will have more of an impact. Taking all of the above into account, I consider that the marks are visually similar to a medium degree.

Aural comparison

55. In their submissions in lieu, the opponent submits that both marks begin with the letters "LI", and these will be pronounced in the same way, creating a "LIE" sound. I agree that a significant proportion of consumers would pronounce the opponent's mark as "LIE-V", however, I accept that in some cases, consumers will pronounce the "I" sound as a short vowel and subsequently, the opponent's mark will be pronounced as "LIV". I consider that the applicant's mark will be pronounced in one syllable as "LIE-FS". In circumstances where both marks are pronounced with a "LIE" sound, I

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

⁷ *Bosco Brands UK Limited v Robert Bosch GmbH*, Case BL- O/301/20, paragraph 44

consider the marks to be aurally similar to a medium to high degree. In cases where the earlier mark is articulated as “LIV”, the marks are aurally similar to a low to medium degree.

Conceptual comparison

56. The opponent argues in their submissions in lieu that “To “live” or have “life/life’s” used in relation to personal care and beauty products could be construed as similar, conjuring feelings of vivacity, vitality and such like, in the average consumer, thus resulting in conceptual overlap to a medium degree.” The applicant contests in their submissions in lieu that both marks have similar derivations from the English noun “life” however, they consider the words to have two different meanings and they are not synonymous with one another and as a result, would be used and understood by the consumer in different ways. I consider that the opponent’s mark “LIVE” has several different dictionary meanings such as an adjective to describe something as showing the characteristics of life or a verb meaning to be alive or to reside or dwell in a certain place⁸. Turning to the applicant’s mark, I find that the apostrophe will convey to the consumer that the term “LIFE’S” is either an abbreviation of “life is” or it will be indicative of a possessive noun for example someone’s life’s work. In both cases, I consider the term “LIFE” will be perceived as meaning the period between birth and death or a living person or being.⁹ Whilst I agree that both marks are derived from the same etymology, I do not find that this renders them conceptually identical. I find that consumers will also recognise the different definitions as already outlined and the addition of the apostrophe and “S” in the applicant’s mark will add a further point of conceptual difference. As such, I consider the marks to have a low degree of conceptual similarity.

Distinctive character of the earlier mark

57. 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

⁸ <https://www.collinsdictionary.com/dictionary/english/live> [accessed on 27/02/23]

⁹ <https://www.collinsdictionary.com/dictionary/english/life> [accessed on 27/02/23]

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

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

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

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

59. I will begin by initially assessing the inherent distinctiveness of the opponent's mark.

60. The applicant submits that the earlier mark "LIVE", being an ordinary dictionary word, is of a relatively weak inherent distinctive character. They further state that for hair products the word "LIVE" would be taken as an allusive reference to the vibrancy of colour or condition of the hair as a result of using the opponent's products. I respectfully disagree with the applicant's assertions and I find that the earlier mark will be considered as a standard English word with one of the meanings as outlined in my conceptual comparison. I do not find the word "LIVE" to be descriptive nor allusive to the goods for which it is registered therefore I find the mark to be inherently distinctive to a medium degree.

61. I now turn to consider whether the distinctiveness of the opponent's mark has been enhanced through use. When considering whether the distinctiveness of a trade mark has been enhanced through use, it is the perception of the UK consumer at the relevant date that is key, that being the EU filing date of 26 June 2017.

62. In his witness statement, Mr Renner states that the opponent has used their trade mark "LIVE" in the UK since 2000.¹⁰ Website screenshots are provided in exhibit JR2 display images of various hair dye kits available within the UK from 2016 to 2021. Although some of the screenshots are dated after the relevant date, I note the list of stockists from the screenshot dated 6 June 2017 include large UK retailing brands such as Boots, Superdrug, Tesco, Amazon, ASDA and Waitrose.

63. Sales figures and marketing expenses from the UK (advertising, promotion and market research) have been provided in Euros from the years 2015 to 2021 and are as outlined below (I note the figures for 2022 are "plan" figures projected for that year). The majority of these figures fall after the relevant date however, I still consider the figures prior to the relevant date to be substantial.

¹⁰ See para 3 of the Witness Statement of Joachim Renner

	GB		2018	€30,120,000	€8,778,000
	Gross External Sales (GES)	Marketing Expenses (L17)			
2015	€23,824,000	€7,943,000	2019	€33,002,000	€7,162,000
2016	€27,040,000	€12,162,000	2020	€34,835,409	€8,756,000
2017	€25,101,000	€8,936,000	2021	€32,643,159	€8,179,000
			2022 (Plan)	€32,902,421	€13,045,000

64. The evidence also establishes the opponent's value share and unit share held by "LIVE" products in the UK between 2013 and 2018¹¹. The figures remain consistent and range between 6.4% to 9.5% for value share and 7.4% to 10.2% for unit share. When considering these figures in relation to the scope of the hair colourant market in the UK, I find it would be reasonable to assume that the opponent holds a fairly significant proportion of the relevant market share.

65. In respect of social media coverage, Mr Renner outlines that the opponent's company operates various social media pages specifically for the "LIVE" brand which has garnered a large global following.¹² Printouts from the various platforms are included in exhibit JR16 and figures provided by the opponent state that on 12 November 2020, the opponent's "LIVE" Facebook page had 215,544 likes and 211,012 followers. Their "LIVE" Instagram page had 26,200 followers and the YouTube page had 8760 followers. By way of example, the opponent highlights that its "How to get silver hair tutorial" YouTube video provided in Exhibit JR16 had amassed 55,697 views, although I note this video is after the relevant date. I recognise at this point that this evidence relating to social media followers is not without its limitations. Whilst I do not deny that the "LIVE" brand had a presence on these platforms at the relevant date, it is unclear as to what proportion of the opponent's followers and interactions are from the relevant UK public.

¹¹ See Exhibit JR9

¹² See para 21 of the Witness Statement of Joachim Renner

66. Further, there are several national magazine articles provided at Exhibits JR13 and JR17 including adverts, promotional features and articles demonstrating celebrities using the “LIVE” brand hair dyes. The publications include Mail Online (articles dated 8 February 2019 and 22 December 2019), Glamour Magazine (articles dated 11 September 2019, 1 December 2018 and 12 March 2019), Refinery 29 (articles dated 8 July 2020 and 1 December 2018) and Good Housekeeping (articles dated 23 August 2019, 29 August 2019 and 20 December 2018). Although these articles are from UK publications, they are all dated after the relevant date.

67. Notwithstanding the evidence dated after the relevant date, it is clear that the mark “LIVE” has been used throughout the UK prior to the relevant date. From the UK turnover and marketing figures before the relevant date and the UK market share figures provided, I conclude that the distinctive character of the earlier mark has been enhanced through use to a high degree.

Likelihood of confusion

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

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

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by

use, the greater the likelihood of confusion'. This is indeed what was said in Sabel. However, it is a far from complete statement which can lead to error if applied simplistically.

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

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

71. 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.

72. I have found the marks to be visually similar to a medium degree. In circumstances where both marks are pronounced with a “LIE” sound, I considered the marks to be aurally similar to a medium to high degree. In cases where the earlier mark is articulated as “LIV”, I found the marks to be aurally similar to a low to medium degree. I found the marks to be conceptually similar to a low degree. I have found the earlier mark to have a medium degree of inherent distinctive character which has been enhanced to a high degree through use. I identified the average consumer to be a member of the general public or a professional who will select the goods and services predominantly by visual means, though I do not discount an aural element to the purchase. I have concluded that a medium degree of attention will be paid during the purchasing process by the general public whereas the professional consumer would pay at least a medium degree during the purchasing process. I have found the goods and services to range from being dissimilar to identical.

73. I acknowledge that the competing marks share the first two letters and as already outlined, as a general rule, the beginning of marks are considered to have more impact. I remind myself however, that differences may be more apparent in shorter marks and there are differences between the marks which are not negligible. To my mind, when the marks are considered as a whole, the differences previously identified would not be overlooked by consumers during the purchasing process, even when paying a medium level of attention. Although I found the earlier mark to have a high degree of enhanced distinctiveness, the distinctiveness lies in the word “LIVE” itself, which is a distinct from the alternative word “LIFE’S” used by the applicant. Further, whilst I noted there is a low level of conceptual similarity between the marks by virtue of the etymology of the words, I found that the consumer will recognise their distinct meanings. In addition, it is my view that the fact each of these words has a distinct meaning and concept will assist the consumer with their recollection of the same, meaning it will be less likely to mistake one for the other. Consequently, notwithstanding the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion.

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

75. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis K.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

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

77. 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.

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

79. I first note that this situation is not one that appears to fall into the categories set out in *L.A Sugar*, however, I remind myself that they were not intended to be exhaustive. I have carefully considered if the marks may be perceived as a sub brand or brand extension of one another, or for them to be considered to represent economically linked undertakings and I can see no logical reason for this. I do not consider that “LIFE’S” would be indicative of a brand extension of “LIVE” or represent economically linked undertakings. Accordingly, I see no reason why the average consumer would believe that the marks originate from the same or economically linked undertakings, even when I have found the contested goods to be identical. Accordingly, I do not consider there to be a likelihood of indirect confusion.

CONCLUSION

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

COSTS

81. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (‘TPN’) 2 of 2016. Using that TPN as a guide, I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side’s statement:	£200
Considering the other side’s evidence:	£500
Filing submissions:	£300

82. I therefore order Henkel AG & Co. KgaA to pay the sum of £1000 to LTWHP, LLC. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 15th day of March 2023

Catrin Williams
For the Registrar