

**O-469-15**

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION No. 3080502 BY SPA SATORI LTD**

**AND**

**FAST TRACK OPPOSITION No. 60000215**

**BY SATORI (UK) LIMITED**

## Background and pleadings

1. This is a fast track opposition by Satori (UK) Limited (“the opponent”) to an application by Spa Satori Ltd (“the applicant”) to register SPA SATORI as a trade mark for the following services in class 44:

Beauty salon services; Providing information about beauty; Services of a hair and beauty salon; Beauty treatment services; Hygienic and beauty care for human beings; Hygienic and beauty care for humans; Hygienic and beauty care services; Beauty care for human beings; Beauty care Advisory services relating to beauty treatment; Beauty consultancy; Beauty consultation; Beauty counselling; Beauty therapy services; Beauty therapy treatments; Beauty treatment Consultation services relating to beauty care; Facial beauty treatment services; Hygienic and beauty care; Beauty salons. Medical services; hygienic and beauty care for human beings; dentistry services; medical analysis for the diagnosis and treatment of persons; pharmacy advice.

2. The application to register the trade mark was filed on 7<sup>th</sup> November 2014 (“the relevant date”).

3. The notice of opposition was originally filed on 9<sup>th</sup> March 2015. However, both this document and the applicant’s counterstatement required amendment. The amended counterstatement was filed on 6<sup>th</sup> July 2015.

4. The single ground of opposition is that the opponent is the proprietor of earlier trade mark 3063329, which consists of this mark:



5. The opponent’s mark was applied for on 8<sup>th</sup> July 2014 and is therefore an ‘earlier trade mark’ for the purposes of sections 5 and 6 of the Act. The earlier trade mark is registered in class 44 for:

Beauty salon services; Providing information about beauty; Services of a hair and beauty salon; Beauty treatment services; Hygienic and beauty care for human beings; Hygienic and beauty care for humans; Hygienic and beauty care services; Beauty care for human beings; Beauty care; Advisory services relating to beauty treatment; Beauty consultancy; Beauty consultation; Beauty counselling; Beauty therapy services; Beauty therapy treatments; Beauty treatment; Consultation services relating to beauty care; Facial beauty treatment services; Hygienic and beauty care; Beauty salons.

6. The opponent contends that these are the same or similar to the services covered by the application, that the marks are similar, and there is a likelihood of confusion

on the part of the public, including the likelihood of association. Consequently, registration of the applicant's mark should be refused under s.5(2)(b) of the Act.

### **Evidence**

7. As this is a fast track opposition, the procedure for filing evidence under Rule 20(1) to (3) of the Trade Mark Rules 2008 does not apply. Neither side made an application under Rule 20(4) for leave to file evidence.

### **Representation**

8. Neither side is legally represented. I have, however, had the benefit of written arguments from the parties.

### **The correct approach**

9. The applicant relies on a number of factors which it says will avoid any likelihood of confusion. These are that:

- i) The applicant and the opponent trade in different parts of the country (Manchester and Plymouth, respectively) and in use their marks have "*distinctly different appearances*".
- ii) The services operated by the applicant are more extensive than those provided by the opponent and include colonic hydrotherapies, aromatherapies and training programmes.
- iii) The parties operate from premises classified as being for different purposes under the Town and Country Planning (Use Classes) order 1987.
- iv) The applicant has traded in Manchester for 4 years without any instances of confusion with the opponent.
- v) Jennie Lawrenson of the applicant called Stuart Dyke of the opponent before the opposed application was filed because she was concerned that the opponent may be passing itself off as the applicant, but Mr Dyke persuaded her otherwise.

10. Some of these are familiar arguments in trade mark oppositions. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

11. A trade mark registration is essentially a claim to a piece of legal property, i.e. the trade mark. The goods and services for which the mark is registered set some limits to the claim, although since marks can be protected against the use of the same or similar marks in relation to goods or services which are only similar to those for which the earlier mark is registered<sup>1</sup>, the limits of the claim are not precise. Every registered mark is therefore entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods/services, if there is a likelihood of confusion.

12. Until a trade mark has been registered for five years (when the proof of use requirements set out in s.6A of the Act kick in), it is entitled to protection in relation to all the goods/services for which it is registered. Consequently, the opponent's earlier UK mark must be protected for the services for which it is registered in class 44 without the opponent needing to prove any use its mark in relation to those services. The opponent's earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the services listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>2</sup> like this:

"22. ....It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

13. So far as the applicant's proposed use of his mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*<sup>3</sup>, the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

14. Therefore matters such as the classification of the parties' existing trading premises under planning law is irrelevant to the assessment I am required to make

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<sup>1</sup> And where the earlier mark has a reputation, potentially even dissimilar goods/services

<sup>2</sup> [2004] RPC 41

<sup>3</sup> Case C-533/06

under trade mark law. Similarly, differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the lists of services they have tendered for the purpose of the registration of their marks. Differences between the parties' marks or trading styles are also irrelevant, again except to the extent that these are apparent from the registered and applied-for marks.

15. Further, as the earlier mark is a national trade mark which is protected against confusion anywhere in the UK, and the applicant also seeks a UK-wide trade mark registration for its mark, the fact that the parties are currently trading in different parts of the UK tells me nothing about the likelihood of confusion in the future<sup>4</sup>. It does, however, mean that little or no significance could be attached to the fact that the opponent is unaware of any instances of confusion to date, even if there was evidence (which there is not) of substantial and established concurrent local trade under the marks limited to the cities of Plymouth and Manchester, respectively.

16. My decision as to whether there is a likelihood of confusion must be based on an objective assessment of the relevant factors. Consequently, the views previously expressed by the parties as to whether or not the opponent would, by using its mark in Plymouth, be passing off as the applicant, are also irrelevant.

17. Finally, section 72 provides that registration shall be taken as *prima facie* evidence of the validity of a registered mark. The applicant has not sought to cancel (or 'invalidate' to use the language of s.47 of the Act) the earlier trade mark on the basis of its claim to an earlier common law earlier right. Consequently, the opponent's trade mark must be regarded as a validly registered mark. In this situation the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority and a likelihood of confusion between the marks based on their notional use throughout the UK will be enough to justify the refusal of the applicant's later filed trade mark.

18. This may seem unfair to an applicant who claims to be the first user of the name at issue. However, apart from providing a procedure to cancel earlier filed marks, if they are invalid, s.11(3) of the Act also provides a defence to a claim of trade mark infringement brought on the basis of a registered mark where, before the first filed trade mark was registered or used, the defendant had acquired an earlier common law right to their mark in a particular locality of the UK and the allegedly infringing use of that mark is in that locality.

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<sup>4</sup> In any event, I note that the opponent's submissions indicate that it intends to extend the geographical scope of its use around the country.

## Decision

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

### Comparison of services

20. The registered and applied-for services of the parties are self evidently the same, except to the extent that the applicant’s services also cover:

Medical services; dentistry services; medical analysis for the diagnosis and treatment of persons; pharmacy advice.

21. In *Canon*<sup>5</sup>, the CJEU stated at paragraph 23 of its judgment 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”.

22. Medical services are different in nature to hygienic and beauty care services, although there is some similarity of purpose between some beauty services, such as Botox treatments, and some anti-ageing cosmetic medical treatments. Generally, the services are not competitive. Further, and with some hesitation, I find that hygienic and beauty care services covers colonic hydrotherapy, which may also be described as a complementary medical service. According to the applicant, certain types of spa provide both beauty care services and complementary medical services, such as colonic hydrotherapy and aromatherapy. Therefore users of such services would not be surprised to find these services being offered by one undertaking. Overall, I find that there is a low degree of similarity between medical services (at large) and hygienic and beauty care services.

23. Dentistry services are generally different in nature to hygienic and beauty care services. However, there is some similarity of purpose to the extent that both descriptions of services may be applied to treatments such as teeth whitening, or at least both services may be provided by same undertaking. Overall, I therefore

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<sup>5</sup> Case C-39/97

consider there to be a low level of similarity between dentistry services and hygienic and beauty services.


24. I see no similarity at all between medical analysis for the diagnosis and treatment of persons or pharmacy advice and any of the services covered by the earlier mark.

25. As some similarity between the services is essential in order for an opposition under s.5(2)(b) to succeed<sup>6</sup>, the opposition against the registration of the applicant's mark for the services listed in the previous paragraph is bound to fail.

### Comparison of marks

26. It is clear from *Sabel BV v. Puma AG*<sup>7</sup> (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. 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.

The respective trade marks are shown below:

	SPA SATORI
Earlier trade mark	Contested trade mark

27. The earlier mark has certain visual aspects which make a more-than-negligible impact. However, the dominant element of the earlier mark is plainly the word SATORI.

28. The first word in the applicant's mark – SPA – is self evidently a word of little or no distinctive character in relation to the remaining services at issue<sup>8</sup>. The dominant and distinctive element of the contested mark is therefore also the word SATORI.

<sup>6</sup> *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

<sup>7</sup> CJEU: Case C-251/95

<sup>8</sup> See paragraphs 24 and 25 above.

29. Consequently, even after taking account of the visual aspects of the earlier mark (and their absence from the contested mark) and the presence of the word SPA as the first element of the contested mark (and its absence from the earlier mark), I find that there is a high degree of visual similarity between the marks.

30. The visual aspects of the earlier mark do not come into the aural comparison. It follows that I find that there is also a high degree of aural similarity between the marks.

31. Neither mark (as a whole) has a meaning. The word SPA has no capacity to distinguish between providers of the remaining services at issue. Therefore there is no conceptual similarity or distinctive dissimilarity between the marks.

32. Overall, I find that the marks are highly similar.

#### Distinctive character of the earlier mark

33. The element that is common to both marks – the word SATORI - would appear to have no meaning to the relevant public. Consequently, there is nothing about the earlier mark which is descriptive, or even allusive, of any characteristics of the services covered by the earlier mark. It follows that the earlier trade mark, including the word SATORI, is well suited to distinguishing the services of a particular undertaking. I find that it is a mark with an above average level of distinctive character for the services concerned.

#### Average consumer

34. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 or services in question: *Lloyd Schuhfabrik Meyer*<sup>9</sup>.

35. I see no reason to believe that the services of the parties will be selected with anything other than a normal degree of attention. I would expect the services concerned to be selected mainly by eye, via advertisements and visual signs, but word of mouth recommendations may also play a part so aural similarity is also relevant.

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<sup>9</sup> CJEU: Case C-342/97



## Likelihood of confusion

36. 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.

37. Given the identity or similarity between the services (other than those listed in paragraph 24), the high degree of similarity between the respective marks, the above average level of distinctiveness of the common element – SATORI – and the normal level of attention that consumers of the services concerned are likely to pay when selecting the services, I have no hesitation in finding that there is a likelihood of confusion.

38. Because the word SPA is so lacking in distinctive character for the services at issue, the average consumer is likely to attach most weight to the most dominant and distinctive element of the marks – the word SATORI. There is therefore a likelihood of direct confusion as a result of the consumer imperfectly recollecting one of these marks and approximating it to the other.

39. Further, even amongst those consumers who recognise that the applicant's mark is different to the opponent's mark, it is likely that average consumers will take the presence of the common element – SATORI – as indicating that these are variant marks used by the same undertaking, or by economically connected undertakings. Therefore there is also a likelihood of indirect confusion, or (mis) "association" to use the word in the Act.

## **Outcome**

40. The opposition is successful, except in relation to:

Medical analysis for the diagnosis and treatment of persons; pharmacy advice.

41. Subject to appeal, the trade mark will be registered for these services and refused for all the rest.

## **Costs**

42. The opponent has been mostly successful and is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £350 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£200 to cover the official filing fee for the notice of opposition

£100 to cover the time taken to complete the notice and consider the applicant's counterstatement

£50 to cover the time taken to provide written submissions on the merits of the opposition.

43. I therefore order Spa Satori Ltd to pay Satori (UK) Limited the sum of £350. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 7th day of October 2015**

**Allan James  
For the Registrar**