

**O/477/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3378000**

**IN THE NAME OF EVOIQ LIMITED FOR THE TRADE MARK**



**IN CLASS 3**

**AND**


**THE OPPOSITION THERETO UNDER NUMBER 416810**

**BY LA BROSSE ET DUPONT, SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE**

## Background and pleadings

1. EvoiQ Limited (the applicant) applied to register the trade mark no. 3378000



for  in the UK on 24 February 2019. It was accepted and published in the Trade Marks Journal on 29 March 2019 in respect of the following goods:

*Class 3: Organic & natural toiletries, personal care & hygiene, sanitary preparation, baby care products, creams, lotions, shampoos, washes, soaps, deodorants, dentifrices & balms.*

2. LA BROSSE ET DUPONT, Société par Actions simplifiée (the opponent) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This is on the basis of, amongst one other, its earlier European Union (formerly Community) Trade Mark registration no. 3799939 for MISS DEN. The following goods under this registration are relied upon in this opposition:

*Class 3: Cosmetics*

3. The opponent also based the opposition on Section 5(2)(b) of the Act on a second mark EU Trade Mark registration no. 9028416, also for the word mark MISS DEN. The following goods are relied upon in the opposition:

*Class 3: Make-up preparations; cosmetics.*

4. The opponent argues in respect of both earlier marks that the respective goods are in part identical and in part similar and that the marks are similar.
5. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of its earlier trade marks relied upon. The applicant submits the opponent's mark is related only to

various make-up products, the likes of which are not identical or similar to its products, and that, bearing in mind the differences between the marks, the consumer will not be confused.

6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
7. Only the applicant filed submissions in respect of these proceedings, and these were filed during the evidence rounds. These submissions will not be summarised, but they will be considered in full and referred to where appropriate throughout these proceedings.
8. No hearing was requested and so this decision is taken following a careful perusal of the papers. The opponent is represented by Dolleymores. The applicant is representing itself.

## **Evidence**

### **The opponent's evidence in chief**

9. The opponent filed evidence in the form of a witness statement in the name of François Carayol, the President of the Opponent, and Exhibits FC1-FC8. Mr Carayol states within his witness statement that he has been in his position with the company since 2004.
10. In his witness statement, Mr Carayol submits that the mark MISS DEN has been used by the opponent continuously in the EU for make-up preparations and cosmetics during the Relevant Period, identified by Mr Carayol as 24 February 2014 – 23 February 2019.

### **Exhibit FC1**

11. Mr Carayol has identified that Exhibit FC1 provided shows the opponent's sales figures for MISS DEN products in the EU during the relevant period, and

has offered the translation of the heading of the Exhibit as “Miss Den Sales Achieved In The European Union”. Mr Carayol identifies that the that the table shows “substantial sales throughout the Relevant Period in Belgium, Spain, Italy, Poland and Portugal, with the total figure being over 372,000 Euros for these countries”.

12. Exhibit FC1 shows a table, the language of which appears to be French. This seemingly lists, in French, the total sales figures in Euros for 2014 – 2019 in the EU countries identified by Mr Carayol in his witness statement, namely Belgium, Spain, Italy, Poland and Portugal. The figures shown are as below:

**CHIFFRES D’AFFAIRES MISS DEN  
REALISES EN UNION EUROPEENNE**

Somme de CA	An_Facture							
Pays		2014	2015	2016	2017	2018	2019	Total général
BELGIQUE			4 748,04 €	2 641,50 €	16 108,50 €	19 018,77 €	2 175,66 €	44 692,47 €
ESPAGNE	6 302,92 €	9 364,96 €	7 819,30 €	6 778,80 €	5 813,71 €	655,89 €	36 735,58 €	
ITALIE	719,88 €	1 090,41 €	3 811,74 €	1 281,60 €	1 626,18 €	122,97 €	8 652,78 €	
MONACO			8 164,73 €	6 028,79 €	5 282,81 €	2 970,41 €	22 446,74 €	
POLOGNE			172,71 €	490,74 €	630,00 €		1 293,45 €	
PORTUGAL	20 539,30 €	41 829,53 €	73 619,39 €	67 841,65 €	70 642,93 €	6 309,63 €	280 782,43 €	
<b>Total général</b>	<b>27 562,10 €</b>	<b>57 032,94 €</b>	<b>96 229,37 €</b>	<b>98 530,08 €</b>	<b>103 014,40 €</b>	<b>12 234,56 €</b>	<b>394 603,45 €</b>	

Fait à Hermes, le 28 novembre 2019.

### Exhibit FC2

13. Exhibit FC2 consists of a number of invoices. Mr Carayol states within his witness statement that these invoices all show transfers of MISS DEN make-up preparations and cosmetics from the opponent to its subsidiaries in Belgium, Spain, Italy, Poland and Portugal. The invoices are dated between 31 March 2014 - 8 Feb 2019 and are addressed to various entities in Portugal, Spain, Italy and Poland.

### Exhibit FC3

14. Exhibit FC3 consists of screenshots of the website [www.missden.com](http://www.missden.com) from the internet archiving site the 'Wayback Machine'. The screenshots are dated by the archiving site and show the pages as they were on the following dates:

- 17 May 2014;
- 3 October 2014;
- 6 October 2014;
- 4 July 2015;
- 7 December 2015;
- 23 April 2016;
- 16 November 2016;
- 3 November 2017;
- 18 November 2017

15. The screenshots show the opponent's website, in French and translated into English, offering for sale a variety of make-up and nail varnishes under



variations of the following mark . Mr Carayol confirms in his witness statement that where the webpages appear in English they are translated using Google's website translation facility. The website also shows the mark



on several products including beauty brushes, sponges, make up pencil sharpeners, toe separators and make up bags. MISS DEN is also shown on the site in the following scenarios:



1. The word mark Miss Den is used on the side bar of the 2014

**OPERATION  
COSMOPOLITAN**


3 mois d'abonnement  
à Cosmopolitan  
offerts pour l'achat de  
3 produits Miss Den  
offre valable dans les  
magasins participants.

webpages (the text has not been translated) as ;

2. The screenshot showing the "points of sale" page dated 3 October 2014 states "Miss Den is present in more than 1000 stores";

3. The screenshots show  which has been translated to  next to many of its items for sale, followed by tips for application of the products;



4. The sign  is shown on the website in December 2015;

Copyright © 2012 Miss Den All r

5. All pages show the following notice

16. Where the site is translated into English, the currency is shown in Euros prior to 2017, and dollars in November 2017.

## Exhibit FC4

17. Exhibit FC4 consists of a screenshot from the opponent's Facebook



homepage displaying the mark . The page shown states that MISS DEN was founded in 1965, and displays a page talking about the origins of the brand. The pages provided also show historic posts from within the relevant timeframe in the following format (examples only):






18. These posts have not been translated.

## Exhibit FC5

19. Exhibit FC5 consists of a variety of press articles referring to Miss Den and Miss Den products. The articles appear to be in French, and reference to Miss

Den is both in word format and colour variations of the following mark  (sometimes this is a white square featuring black text on a white background, sometimes white text on a clear background, and sometimes the text is clear on a white background). The articles range from 2014 to 2019, and some clearly reference make up items, whilst others feature French text, the subject of which I cannot decipher. Mr Carayol has confirmed in his witness statements that these publications were all available within the relevant time period throughout France.

## Exhibit FC6

20. Exhibit FC6 is a screenshot from the webpage 'Wikipedia' identifying various demographics of the EU member states, including details of the population

size and the percentage of the EU. The witness statement of Mr Carayol identifies that this shows the population of the territories France, Belgium, Spain, Italy, Poland and Portugal to be over 233 million and that that number constitutes over 45% of the EU population.

### **Exhibit FC7**

21. Exhibit FC7 consists of a screenshot of pages from Wikipedia, and from a site entitled “port80services”. The Wikipedia page provides an explanation of Toubon Law, and the screenshot from port80services comments on the question “Do I need a French Version of my Website?”.

### **Exhibit FC8**

22. Exhibit FC8 consists of the UK Intellectual Property Office decision no. O-778-18 of opposition no. 411400 in respect of a previous application for the applicant’s mark in the name of the applicant for slightly different goods in class 3, and the opposition filed against it by the opponent in these proceedings. This opposition was also based on “cosmetics” in class 3 only under the earlier EU registration no. 3799939. No proof of use was requested in these opposition proceedings, and the opposition was successful in full.

### **The Applicant’s evidence in chief**

23. The applicant filed evidence in the form of a witness statement in the name of Ehab Sami, and two exhibits GC1 and GC2. The witness statement filed states Mr Sami is vice president of the applicant and has been since 2017.

### **Exhibit GC1**

24. Exhibit GC1 includes a collection screenshots from the opponent’s website, Facebook and Instagram pages, on which the applicant has highlighted the opponent’s references to make-up. The pages provided are undated. Mr Sami states in his witness statement that this exhibit also shows “that Miss Den and



suffix “Paris” is exist together in all products and all social media appearance in addition to French Website language, screenshots also show that all Opponent website articles are directed to Women only not general consumer ...”. I find Mr Sami’s comments in his witness statement to be a mixture of submission and fact, and I will bear this in mind when considering the evidence. These comments have also been mirrored within the applicant’s submissions.

## **Exhibit GC2**

25. Exhibit GC2 consists of several invoices that were filed under the opponent’s Exhibit FC2 with various items circled which are referred to as “make-up products”. Mr Sami states these shows all invoices are for make-up products only. The applicant’s comments in its witness statement referring to Exhibit GC2 also contain submissions on the likelihood of confusion and differences between the goods, and these comments would be more appropriately placed within the applicant’s submissions only, where I note the comments have again been mirrored.

26. The opponent did not file any evidence in reply to the applicant’s evidence in chief.

## **Preliminary issues**

27. The applicant has, within its TM8, requested that the opponent provide proof of use of both its earlier marks in respect of the following goods:

*Class 3: Soaps, cosmetics.*

28. However, the opposition has been based on the following goods only:

*EU003799939 – Class 3: Cosmetics*

*EU9028416 – Class 3: Make-up preparations; Cosmetics*

29. As 'soaps' have not been relied upon by the opponent within these opposition proceedings, proving use of these goods will not be required. Further, I note the applicant has not requested the opponent prove use of its second mark, namely EU9028416, in respect of Make-up preparations. This appears entirely intentional, as the applicant has conceded within its submissions to genuine use of the opponent's mark in respect of various make-up items, and whilst it is not necessary to find both that the applicant did not request proof of use, and that it did not intend to request proof of use of the opponent's goods make-up preparations (only the former is required), I am satisfied that this was indeed the case in this instance. I will consider the applicant's statement further later in this decision.

30. At paragraph 16 of its submissions, the applicant has stated that the marks to be compared are as below:

Comparison of Marks

16. The marks to be compared are:

Applicant trade mark	Opponent trade mark
	

31. The opponent submits that the word PARIS is used "as a slogan in all opponents' products as noticed from their exhibit FC 3,4&5, so suffix "PARIS" considered an integral part of the Opponent trade mark". In *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd L.J. considered the CJEU's judgment in *Specsavers*, Case C-252/12, which was submitted as establishing that matter used with, but extraneous to, the earlier mark should be taken into account in assessing the likelihood of confusion with a later mark. The judge stated:

"46. Mr Silverleaf submitted that, in the light of this guidance, the proposition stated by Jacob LJ in *L'Oreal* can no longer be regarded as representing the law. He starts by recognising that acquired distinctiveness of a trade mark has long been required to be taken into account when considering the likelihood of confusion. He goes on to

submit that *Specsavers* in the CJEU has made it clear that the acquired distinctiveness to which regard may properly be had included not only matter appearing on the register, but also matter which could only be discerned by use. The colour, on which reliance could be placed in *Specsavers*, was matter extraneous to the mark as it appeared on the register. It followed that if something appears routinely and uniformly in immediate association with the mark when used by the proprietor, it should be taken into account as part of the relevant context.

47. I am unable to accept these submissions. The CJEU's ruling does not go far enough for Mr Silverleaf's purposes. The matter not discernible from the register in *Specsavers* was the colour in which a mark registered in black and white was used. It is true that in one sense the colour in which a mark is used can be described as "extraneous matter", given that the mark is registered in black and white. But at [37] of its judgment the court speaks of colour as affecting "*how the average consumer of the goods at issue perceives that trade mark*" and in [38] of "*the use which has been made of it [i.e. the trade mark] in that colour or combination of colours*". By contrast Mr Silverleaf's submission asks us to take into account matter which has been routinely and uniformly used "*in association with the mark*". Nothing in the court's ruling requires one to go that far. The matters on which Mr Silverleaf wishes to rely are not matters which affect the average consumer's perception of the mark itself."

32. It is clear from the comments set out within the case law above that I cannot accept the applicant's submissions that PARIS should be considered as part of the opponent's mark for the comparison on likelihood of confusion, despite the applicant's claim it has been used routinely and uniformly in association of the mark. It is my view that it is the trade mark as registered by the opponent, namely the word mark MISS DEN that I should consider within my assessment of a likelihood of confusion. The ways in which the opponent is

using the earlier marks is relevant to these proceedings, to the extent that the use of the opponent's mark in the forms used may be an acceptable variant of the earlier mark, for the purpose of showing genuine use. Whether this is found to be the case will be addressed later in this decision. However, for clarification, even if it is the case that the opponent's mark, as used in the manner identified by the applicant above, is found to be the only acceptable use opponent's mark for the purpose of these proceedings, the comparison of the marks will still be carried out between the opponent's mark as registered, and the applicant's mark as applied for.

33. One final point that I wish to address before moving on to the decision is the wording of the applicant's specification. The applicant's goods are split up using commas, rather than by use of the more common (in trade mark specifications) semicolon. This makes it more difficult to determine where one term ends and the next begins, and further, some of the wording used does not clearly define the goods as a standalone term. I reference particularly those highlighted below:

*Class 3: Organic & natural toiletries, **personal care & hygiene, sanitary preparation**, baby care products, creams, lotions, shampoos, washes, soaps, deodorants, dentifrices & balms.*

34. For clarity, it is my view that these goods are to be interpreted as being followed by the word "preparations", so personal care & hygiene **preparations**, sanitary preparationss. The comparison of goods will be carried out on this basis.

## **DECISION**

### **Section 5(2)(b)**

35. 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”.

## Section 5A

36. 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.”

## The Principles

37. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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.

### **Proof of use**

38. The registration procedure for the opponent's earlier marks was completed on 7 September 2005 (3799939) and 12 October 2010 (9028416). In the case of both the earlier marks, this is over five years prior to the date the application was filed on 24 February 2019. Both registrations are therefore subject to proof of use provisions under 6A of the Act, to the extent that this is requested by the applicant. The relevant timeframe for proving genuine use within this opposition is between **25 February 2014 – 24 February 2019**. As the earlier marks are both EU trade mark registrations, the relevant territory for showing genuine use has been made is within the European Union. Proof of use was requested in respect of the following goods:

<b>Earlier mark</b>	<b>Proof of use requested</b>	<b>Proof of use not requested</b>
EU003799939	Class 3: Cosmetics	-
EU009028416	Class 3: Cosmetics	Class 3: Make-up preparations.

39. Following the genuine use request made by the applicant, and as mentioned within the preliminary issues, the applicant has conceded to the opponent's genuine use of the mark in respect of a number of make-up products. There

are many references to the opponent being in the field of make-up throughout its evidence and submissions, and the applicant states at paragraph 9:

“9. ... Therefore, it is satisfied that there has been genuine use of the opponent mark in the European Union during the relevant period on the following products:

“Eyes; Mascara, Eye liner, Eye shadow, Kohl pencil, Powder, Foundation, Concealer, Bronzer, BB cream, Blush, Lip coloring products and Nail coloring products”

10. As shown above, the goods on which the opposition is based are not either identical nor similar to the goods in the Application.”

40. The above goods for which the applicant has stated it is satisfied there has been genuine use of the earlier mark fall within the category of ‘Cosmetics’, which had previously been challenged by the applicant within its TM8 and counterstatement. However, within its submissions, the applicant continues to challenge the opponent’s use to the extent that it satisfies the full category of cosmetics, submitting that a narrowing of the specification to subcategories would be appropriate within this opposition. I will therefore consider the opponent’s proof of use of ‘cosmetics’ to the extent that the goods fall outside of the items to which the applicant is satisfied genuine use has been shown, but which remain within the broader category of ‘cosmetics’. As both earlier marks are identical, this will be done in respect of both marks.

### **Relevant statutory provision**

41. Section 6A:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,



(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

42. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

43. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form

of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial

justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

44. The burden is on the proprietor to show genuine use of its mark within the European Union, within the relevant time frame, in respect of the services as registered.

### **Form of the mark**

45. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use of the registered marks, it is necessary to review the instances where the proprietor has used the mark in conjunction with additional elements, or in a varying form to the mark as shown on the register, in order to determine if these instances should be classed as use ‘of the mark’ for the purpose of the assessment. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally

encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

46. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

47. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

48. Where MISS DEN is used as a trade mark on its own in word format within the opponent's evidence, it is clear this will be acceptable use of the marks as registered. However, the opponent also shows use of the mark in various stylisations and combinations. Within the evidence filed, the proprietor's mark appears in the following variants:

#### **Variant 1**



49. This variant appears most frequently in the evidence of the opponent. This mark is used in this colour combination, as well as in white writing on the clear

plastic containers of the opponent's make up products, with the omission of the black square. On occasion this mark is shown in colour, including red, blue, orange, yellow and green.

50. I find the distinctive character of the earlier mark is held in the words MISS DEN. I find that the use of these elements alongside the addition of the small 'PARIS', which in my view holds at best a low level of distinctive character for the products in question, does not prevent the consumer using the MISS DEN element to identify the commercial origin of the products themselves. I do not find the use of the PARIS within the mark is enough, on its own, to make this variant unacceptable for the purpose of maintaining the protection of the MISS DEN word mark.

51. However, it is not just the addition of PARIS that makes variant 1 differ from the mark as registered in this instance. Variant 1 also shows MISS DEN in a stylised form. I remind myself of the factors as set out in *Nirvana* above. I have identified already that the distinctive character of the mark is held in the words MISS DEN. I find here that the differences to the mark as registered are (most noticeably) the 'stacking' of the words on top of each other, and the inversion of the second 'S', which is in turn connected to the first 'S' to form a heart shape. I find that whilst the stacking of the words will be noticed by the average consumer, it does not impact on the distinctive character of the mark. However, I find that the stylisation of the 'SS' in the word 'MISS', creating the heart shaped element within the mark *does* alter the distinctive character of the mark. I therefore find this stylisation falls outside what I consider to be fair and notional use of the mark, and I do not find variant 1 to be an acceptable variant of the opponent's earlier word marks for MISS DEN.

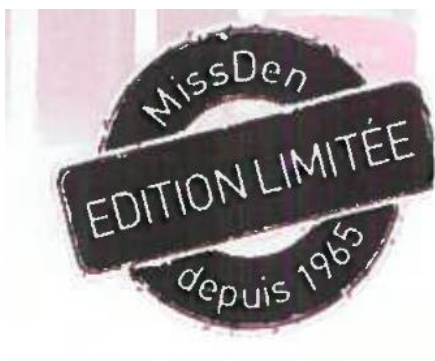
#### **Variant 2**





52. This version of the opponent's mark is shown in relation to the opponent's beauty tools such as eye pencil sharpeners, sponges, brushes and toe separators. I find that the addition of the dot between the words, and the minimal stylisation do not have an impact on the distinctive character of the MISS DEN mark. I find the use of PARIS to have the same effect on this mark as noted in my comments under variant 1. I find this to be an acceptable variant of the opponent's mark.

### Variant 3



53. This variant of the mark looks to be use of the Miss Den wording alongside elements that appear, even to the consumer that does not speak French, to be simply promotional messages. I find the circle and rectangle within which the wording is placed to be merely banal surroundings for the wording itself. Further, even if the additional wording is not understood as promotional messages by the relevant consumer, I find the opponent's mark Miss Den maintains an independent distinctive role within this mark, and it would be used by the consumer as an indicator of commercial origin within the same. I therefore find the use of this mark in this format to be an acceptable variant of the opponent's mark, in line with *Colloseum*.

### Variant 4



54. I find the stacking of this mark, and the addition of the banal white circle does not alter the distinctive character of the opponent's mark as registered. In addition, I find the addition of PARIS in this variant to have the same impact as it does within variant 1. I find this to be an acceptable variant of the opponent's mark as registered.

#### **Variant 5**

MISS DEN PARIS

55. I find that the PARIS element of this mark does not hang together with MISS DEN to create a new meaning. It is my view that MISS DEN maintains an independent distinctive role within this mark when used in this format, separate to the element PARIS which I find to be of little (if any) distinctiveness in respect of the goods. I find this mark to be an acceptable variant of the opponent's mark as registered, in line with *Colloseum*.

#### **Genuine use**

56. Now that I have established which of the variants displayed in the opponent's evidence I find to be acceptable for maintaining protection under the earlier marks for the purpose of this opposition (variants 2, 3, 4 & 5), I will consider the use made of these variants in relation to the goods relied upon, within the relevant territory of the EU, and within the relevant timeframe, in order to establish if this satisfies the requirements for genuine use of the mark within the parameters set out within the case law.

57. The opponent has provided turnover figures within Exhibit FC1, but has not provided further details that I may use to put these figures into context. It is not clear from the figures what proportion of the total turnover under the MISS DEN mark relate to each of the products sold, which, as I will address shortly, from the evidence provided clearly do not all fall within the category of 'cosmetics'. Further, there is no context as to how the figures relate to a total market share, and there is no indication of market size, but I find it is likely the EU market for cosmetics will be large. Mr Carayol refers to the table as showing "substantial sales throughout the Relevant Period in Belgium, Spain, Italy, Poland and Portugal, with the total figure being over 372,000 Euros for these countries. I find it unlikely that these sales are particularly 'substantial' in relation to the size of the cosmetic market in these five countries, and I cannot with any certainty attribute the full value of the figures shown only to cosmetics. I do consider however, that the goods shown in the exhibits appear to be fairly low value items, with the figures shown between the 5-10 euro mark, and so the turn over figures will relate to a higher number of sales than if these were high value items. On balance, and taking into account the surrounding evidence including the website images provided, it is my view that it is reasonable to assume that a percentage of the figures given can be allocated to items falling within the meaning of 'cosmetics', such as the make-up items as identified by the applicant. However, I can make no informed estimate of the turnover for each of the goods for which there have been sales within the relevant period. For some products, these may be minimal.

58. Exhibit 2 includes the invoices which are described by Mr Carayol in his witness statement as "a selection of invoices showing transfers of MISS DEN make-up preparations and cosmetics from My Company to its subsidiaries in the countries mentioned in paragraph 4". From reviewing the invoices, I find that they relate to addresses in Portugal, Spain, Italy and Poland (rather than Portugal, Spain, Italy, Poland and Belgium as was mentioned by Mr Carayol in paragraph 4). The invoices do appear to relate to make-up products under the MISS DEN mark which features on the invoices, and are dated throughout the relevant timeframe. The invoices directly reference items such as "Rouge

Brilliance” and “Crayon Khol Intense” and “Mascara Pin Up” which are easily matched with products shown for sale on the website.

59. In order for genuine use of a mark to be shown, the evidence need not show use in relation to the end consumer. Sales to a third party such as a wholesaler may suffice. In *Laboratoire de la Mer Trade Mark* [2006] FSR 5, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use.

60. Neuberger L.J. (as he then was) stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul* , it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

61. I note the comments set out in *Laboratoire de la Mer* above and consider these comments in relation to the invoices provided by the opponent. Whilst I note the invoices shown do not have to relate directly to the sale of the goods to end users, I find it an important distinction that in this instance, Mr Carayol has stated within his witness statement that the invoices all relate to subsidiaries of his company (the opponent). It is my view that these subsidiaries do not constitute the 'third parties', and so the exchanging invoices and goods between the opponent and its subsidiaries, will not result in the mark being "communicated to a third party in such a way as can be said to be "consistent with the essential function of a trademark" as referenced in *Ansul* as well as the decision in *Laboratoire de la Mer* as set out above. I find therefore find these invoices, as standalone evidence, offer little to show the opponent's genuine use of the mark in the EU. However, I note that it is the full picture created by all the evidence that I must use to determine if genuine use has been made.

62. Having reviewed Exhibits FC3, FC4 and FC5, and FC7, I have made a number of observations. The opponent's website was displaying products including many which fall under the category of cosmetics throughout the relevant time period. These include BB cream, nail varnish, eyeshadow, eyeliner, blush, foundation (power and cream), mascara, bronzer, lipstick, lip gloss, lip pencil. Much of the use of MISS DEN shown on the products and elsewhere on the website is shown using variant 1 which I have found to be an unacceptable variant of the mark, but there is also limited use of MISS DEN either as a word mark or in an alternative acceptable variant. Use of the mark in variant 2 appears only in relation to goods which do not fall within the meaning of cosmetics, and so use of this variant is not relevant. In 2014, the website claimed that MISS DEN products were available in more than 1000 stores, but there is no confirmation of where these stores are located.

63. My initial view was that the website appeared to be aimed at the French consumer, with the language of the website appearing in French, and the price of the products in Euros. I note the Mr Carayol has explained at paragraph 11 of his witness statement that Exhibits FC7 refers to 'Toubon

Law', stating that it is a legal requirement for his company's website to be in French, but that it is advertised throughout the European Union. It is my view however, that the fact it is a legal requirement for the website to be written in French only makes the consumer to which the .com website is aimed at less certain from the evidence provided. However, on balance, considering the language and the use of Euros, it appears most likely that the French consumer will consider themselves the target of the site, despite the apparent language requirement. In order to be convinced that the site is aimed at other consumers in addition to the French consumer, I would require additional evidence of the consumers to which the site is targeted throughout the EU.

64. There is no evidence that the Facebook pages shown were taken from the site inside of the relevant period. However, the evidence provided shows 'posts' which are dated within this relevant period. The site shows the use of variant 4 at the top of the page and beside each post. However, as this image will be updated besides each of the posts at the time that the 'profile picture' was last updated, which may have fallen outside of the relevant timeframe, I cannot consider this use. There is some use of MISS DEN as a word mark next to various posts about make-up items, but no translation is provided. There is reference to the intention to sell make up under MISS DEN, and what appear to be advertisements of make-up items through posts within the relevant period, but as mentioned, the wording of these posts are unclear. I find this may add context in conjunction with the rest of the evidence filed, but it is of limited assistance.

65. The opponent has featured many items including mascara, nail varnish, powder foundation, eyeliner and lipstick in various French publications throughout the relevant time period. The opponent's goods often feature the mark under variant 1 which I have found to be an unacceptable variant, but the goods are often referred to in the text via the MISS DEN word mark. I find these publications add to a picture of use by the opponent in France in respect of various items of make-up.

66. Exhibit FC8 is a previous decision of the tribunal on a case between the opponent and the applicant that is similar to the one in question. This case did not include the requirement for the opponent to prove use of its mark. Whilst I have noted the previous assessment of the Hearing Officer, I am not bound by the decision issued in that case, not least because the case at hand does not include an identical set of facts to the current case.

67. Exhibit FC6 filed by the opponent goes to show that the proportion of the EU covered by the sales figures relating to MISS DEN products is substantial, with the countries referenced making up 45% of the EU population. I find this shows that use from within these territories only may constitute genuine use throughout the EU, provided this use is sufficiently demonstrated.

68. As mentioned, it is important to consider the full picture created by the opponent's evidence, and weigh up all the relevant facts and circumstances in order to determine whether there has been real commercial exploitation of the mark in relation to the goods protected. I consider Exhibit FC1-FC7 above. With consideration of the goods for which the applicant has already conceded there has been genuine use, from the sum of the opponent's evidence I cannot find any genuine use of the opponent's earlier marks in respect of items that fall outside of these make-up and nail items listed, but within the meaning of 'cosmetics'.

### **Fair specification**

69. I must now consider the extent to which the opponent's use justifies the enforcement of the earlier marks within these opposition proceedings in relation to the goods covered by the registration.

70. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or

services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

71. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by



the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

72. The applicant has made detailed submissions on the extent to which it believes the opponent's specification relied upon should be reduced within these opposition proceedings, stating:

“Regarding ‘cosmetics’; it is considered a broad term and not achieve Fair specification as the opponent has proved genuine use for Make-up preparation only and this is considered just description for subcategory and not fair to describe their genuine use in general as “cosmetics” term refer to wide range of subcategories and wide range of products. From comparison goods and global assessment, Applicant has found genuine use can be grouped into three categories: make-up, nail colours and make-up applicators.”

73. As set out above, the case law explains that a fair specification should be considered from the perception of the average consumer. Where categories are broad, subcategories may be used to replace the broad categories, but I must be careful not to narrow down the opponent's specification to the extent that it becomes more precise than the average consumers perception of the category to which the goods belong.

74. In this instance, the opposition is based on the category of goods ‘cosmetics’ (alongside ‘make-up preparations’ which were not put to proof of use by the applicant). I agree with the applicant’s submissions that the category of ‘cosmetics’ is broad, and capable of being split into various subcategories. For example, cosmetics will include subcategories such as make-up preparations, hair-care preparations, skin-care preparations, shaving preparations and tanning preparations. Having reviewed the opponent’s evidence, and considered the applicant’s submissions, in particular those relating to the goods for which it has been agreed that genuine use of the mark has been made, it is my view that the perception of the average consumer would be that the opponent uses the mark in relation to the following subcategories of cosmetics:

*Make-up; Nail varnishes*

75. I note the applicant’s comments regarding a third subcategory relating to “make-up applicators”, but it is my view that these items do not fall within the meaning of “cosmetics” and so these items will not be considered within the scope of this opposition.

76. Considering my findings above, the goods which I consider the opponent to have enforceable protection for within these proceedings are as follows:

<b>Earlier mark</b>	<b>Fair specification</b>
EU003799939	Class 3: Make-up; Nail varnishes
EU009028416	Class 3: Make-up; Nail varnishes; Make-up preparations.

### **Comparison of goods and services**

77. Now that a fair specification has been established, I may continue with the comparison of the opponent’s fair specification with the goods of the applicant

## Similarity of goods and services – Nice Classification

78. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

79. Similarity between goods and services is to be considered based on the criteria set out by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, as well as the factors in *Canon*<sup>1</sup>. These cases references factors including the nature, intended purpose, method of use, and whether they are complimentary or in competition, alongside other factors namely the trade channels, users, and in the case of self-serve consumer goods, where these are likely to be found. In respect of identity of goods, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

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<sup>1</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97

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”.

80. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

81. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*“...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded.”*

82. With the above factors in mind, the goods for comparison are as follows:

<b>Opponent's goods</b>	<b>Contested goods</b>
Class 3: Make-up; Nail varnishes (EU003799939)	Class 3: Organic & natural toiletries, personal care & hygiene, sanitary preparation, baby care products, creams, lotions, shampoos, washes, soaps, deodorants, dentifrices & balms.
Class 3: Make-up; Nail varnishes; Make-up preparations (EU009028416)	

83. The applicant submits that the opponent's goods, particularly those goods remaining after a narrowing to a fair specification for the opponent, are not similar or identical to the its goods. Within its counterstatement, the applicant focuses its arguments in this respect on the fact the goods are not in competition with one another. The applicant elaborates in its submissions, stating that make-up is applied to “accentuate or conceal facial features and this has a special nature and purpose differ from Applicant trade mark”. The applicant offers in its submissions to add the term ‘not make-up’ to its description of the goods, in order to distinguish its goods from those covered by the opponent. The applicant appears to submit that as the goods are not the same, will not be purchased instead of one another, they are therefore not similar. However, it is well established that it is not only where goods are identical or where they are in competition that they may be found to be similar

to one another, and a full assessment of the level of similarity shared by the opponent's and applicant's goods will therefore be considered.

**Personal care [preparations], creams, lotions, & balms.**

84. The application covers *lotions, creams and balms* within its specification of goods, as well as *personal care [preparations]*. I find these all either to be, or to include items that are to be applied to the face and body. Generally, these items, when appearing in class 3, are for the purpose of improving the appearance of the skin or complexion, although it is acknowledged these items may also be used for the purpose of gently soothing the body or skin within this class. The opponent's specification includes make-up, which will cover items such as tinted and coloured liquids, creams, and powders for the lips and face. Items included within the opponent's 'make-up' will often be of a very similar nature to these goods, being sold in a cream or balm consistency. I do not find that the ordinary and natural meaning of creams, balms, lotions or personal care preparations fall within the meaning of the opponent's goods, or vice versa, but I find that there may be will be a direct cross over with the intended purpose, with items such as lip balms being used for making the lips feel moist and appear smoother or glossier, as well as make-up items such as lipstick and lip gloss. Items including creams and lotions such as moisturisers are intended to make the face and complexion appear smoother, as are make-up items such as foundations and tinted moisturisers. I find the intended user of the goods will often be the same. I agree with the applicant that often these items are not in direct competition with each other, and they are not complementary on more than a superficial level, but I do not find this is always the case. It is my view the consumer may consider an SPF moisturiser vs an SPF tinted moisturiser or all in one SPF moisturising foundation for example, or a lip balm or tinted lip balm compared to a gloss or moisturising lipstick, and so these goods are in direct competition with one another. The goods will likely share trade channels, often found within the same section of larger multi-product retailers, and within the same more specialised stores.

85. Overall, I find the opponent's goods 'make-up' and 'make-up preparations' to be similar to the applicant's creams, lotions and balms to a high degree. I find that the applicant's *personal care [preparations]* include goods such as creams, lotions and balms, and are therefore also similar to a high degree to the opponent's 'make-up' and 'make-up preparations'.

**organic and natural toiletries, hygiene [preparations], sanitary preparation, shampoos, washes, soaps, dentifrices**

86. The applicant's goods listed above will generally have a different nature to opponent's make-up and make-up preparations, and they serve a different primary purpose, namely for cleaning of the face and body, although it is true that these items may also be for the purposes of hydrating and clearing the skin or hair, or whitening teeth and thus are also improving one's complexion or appearance. These items will often share trade channels with the opponent's make-up items, and whilst they are unlikely to be found on the same shelves in supermarkets, they are likely to at least be placed within the same section of larger stores. These terms (outside of shampoos and dentifrices) will include goods such as soaps and washes designed specifically for make-up removal, and these items are complementary in the sense that the opponent's goods are essential to at least some of the items falling within the meaning of the applicant's goods. I find these goods to be similar to the opponent's goods to a medium degree.

**Deodorants**

87. Deodorants are primarily for the purpose of maintaining personal hygiene. These goods may share trade channels and be near each other within larger stores within a general grooming and hygiene section, and share intended users, but will often not be found in the same more targeted shops focused on make-up and beauty. I find the method of use to differ, and I do not find them to be in competition or complimentary to one another. Overall, I find these goods to be dissimilar to the opponent's goods.

## **baby care products**

88. The applicant's baby care products in class 3 will include a variety of items such as baby moisturisers, baby lotions and baby wipes. Generally, the focus of these items will be soothing and/or hygiene, but they will also include items for the purpose of improving the appearance of a baby's complexion. The products will generally be sold to parents or guardians for use on their dependents, rather than for use on themselves, whereas the opponent's goods are generally aimed at teenagers and adults for their own use. There may in some instances be a cross over in trade channels, but goods are neither complementary nor in competition with one another. Further, it is unlikely the goods will be sold on the same shelves or within the same section of stores, with baby care generally located in a different area to regular hygiene and grooming items. Overall, I find these goods to be dissimilar to the opponent's goods.

## **Comparison of marks**

89. 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 Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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



90. 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.

91. The respective trade marks are shown below:

	<p style="text-align: center;">MISS DEN</p>
<p style="text-align: center;">Applicant's trade mark</p>	<p style="text-align: center;">Earlier trade marks</p>

92. The opponent has based the opposition on two separate earlier marks. However, as the opponent's two earlier marks are identical to each other, I will, for the purpose of the mark comparison, refer to the opponent's earlier mark in singular form.

93. The dominant elements of the earlier mark are MISS DEN. I find that 'MISS', being a common prefix used to denote a female name, is less distinctive in its own right than the element DEN, however, the overall impression of the mark resides in its entirety, and neither element will be ignored by the consumer.

94. On the contrary, the word DEN clearly dominates the applicant's mark, and it is also the most distinctive element of the same. The stylisation of the mark, and the green leaf device will not be ignored within the overall impression of the mark, but it takes a subordinate role to the word itself. The wording

“ORGANIC & NATURAL PERSONAL CARE” is entirely descriptive, as well as being in a comparatively small typeface, and makes little impact in the overall impression of the mark.

95. The applicant has made submissions regarding the visual similarity of the marks. Within these submissions, the applicant states the opponent’s mark “consist of the word “Paris” together with the logo “MISS DEN””, and makes further submissions regarding the inclusion of PARIS within the earlier mark within the its aural and conceptual comparison. I have already discussed within the preliminary issues why the mark to be compared does not include the element PARIS, and I will not repeat this here, other than to state the earlier mark for consideration visually, aurally and conceptually is the word mark MISS DEN.

#### Visual comparison

96. Visually, the marks both include the same three letter word ‘DEN’. This word is the most dominant and distinctive element of the applicant’s mark, and it is one of the dominant elements within the opponent’s mark. The marks visually differ with the inclusion of the first, four letter word MISS of the opponent’s mark, which is not present in the applicant’s mark, and the less dominant elements of the applicant’s mark such as the stylisation, the leaf device and the small and descriptive additional wording. Considering both the visual similarities and the visual differences, I find the marks to be visually similar to a medium degree.

#### Aural comparison

97. The applicant submits that its mark “consists of one word “Den” in addition to adding “ORGANIC AND NATURAL CARE” under the Applicant logo”. Whilst it is true that the words ORGANIC AND NATURAL CARE feature on the

applicant's mark, it is my view that the elements that will be verbalised by the consumer when referencing the two marks will be DEN in the applicant's mark, and MISS DEN in the earlier mark. I find it highly unlikely the consumer will pronounce the wording "ORGANIC NATURAL AND PERSONAL CARE" when referring to the former, due to the highly descriptive and subordinate nature of the same. Due to the identical pronunciation of DEN in each of the marks, but with consideration to the aural differences that will be caused by the pronunciation of MISS within the earlier mark, I find the marks to be aurally similar to a medium degree. However, on the occasion that the applicant's mark is pronounced in full (which in my view will be rare), I find there will only be a low degree of aural similarity between the marks.

#### Conceptual comparison

98. Within its TM7, the opponent submits that the marks are conceptually similar.

99. Within its submissions, the applicant has stated "Consideration must be given that the marks are found to be conceptually similar to a medium degree not high degree, however, during the selection process the visual impact of the marks will carry the most weight in the mind of the consumer".

100. It appears both parties are in agreement that the marks are conceptually similar to at least a medium degree. The applicant has conceded that the marks are conceptually similar to a medium degree, in which case it is not open to me to lower that level of conceptual similarity. However, it is open to me to decide whether there is a higher than medium level of conceptual similarity. I find that there is not, given the addition of MISS in the earlier mark which creates the impression of a female individual, a concept which is absent from the applicant's mark.

#### **Average consumer and the purchasing act**

101. 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*, Case C-342/97.

102. 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.”

103. Before making a decision on the likelihood of confusion, I must first identify the relevant consumer of the goods.

104. The applicant has made submissions in respect of the average consumer of the goods, stating:

“From Opponent exhibits, you noticed that he just used Make-up preparation, therefore the average consumer of the opponent’s goods would be predominantly female, as female only who would use makeup and nail colors products not male, so the opponent’s consumer would be high and brand loyalty would ensure that the average consumer would readily distinguish between the marks and as such confusion would be unlikely to arise.”

105. I agree with the applicant that it remains more popular for females to purchase make-up over males in the UK. However, I find a claim that the end user would only be female to be a little antiquated, at least in my experience. Further, although I am not entirely sure, it appears the applicant may be stating that having a female audience would result in a higher level of attention being paid to the goods, and increased brand loyalty. I do not agree that gender will play any part in the level attention paid by the consumer, or the loyalty to the brand, and either way it is well established that brand loyalty is not relevant to the assessment I must make regardless<sup>2</sup>.

106. The applicant goes on to state that its own goods are aimed at the general public, and so the relevant public will not mistake one of these marks for another. The applicant seems to distinguish between goods aimed at females and goods aimed at the general public. However, (and although I disagree that the consumer of the opponent's goods will be *only* females), the female population clearly form part of the general public. It is my view that the general public will be the relevant consumer in respect of both the opponent's and the applicant's goods.

107. The goods themselves are all items that may be purchased fairly frequently. Whilst it might be true that some consumers will pay a higher than average level of attention to the goods on the basis of having particular skin conditions or allergies, for the most part the consumer will have no reason to pay a particularly high level of attention to the goods in question. That being said, the consumer will likely consider factors such as shade, consistency, durability, suitability for their requirements and skin type. I find the level of attention paid in respect of the opponent's goods to be average. I find that little attention will be paid in respect of some of the applicant's more everyday items such as soaps and certain toiletries, and that the degree of attention paid to the applicant's goods will range from low to average.

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<sup>2</sup> See the comments of Iain Purvis QC as the appointed person in *Bonjourno Cafe*, BL O/382/10

108. I find the goods will be primarily purchased following visual inspection, on the shelves in shops or online. However, aural considerations cannot be discounted as the goods may be purchased with the assistance of retail staff and may be the subject of word of mouth recommendations.

### **Distinctive character of the earlier trade mark**

109. 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).”

110. The earlier mark is neither descriptive nor allusive of the goods covered by the mark. The mark appears to be an uncommon female name, and it is my view it would be understood by the consumers as such. Whilst the opponent

has filed evidence in these proceedings, I do not find this evidence sufficient to show that the distinctive character of the mark has been enhanced above its inherent level within the UK because there is no evidence of use in the UK. It is the perception of the UK average consumer which is key to whether there will be a likelihood of confusion in the UK. I therefore find the earlier mark distinctive to an average degree.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

111. Prior to reaching a decision on this matter, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 37 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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. I must consider the level of attention paid by the consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that a likelihood of confusion may be increased where the earlier mark holds a high degree of distinctive character, either inherently, or due to the use made of the same, and that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I must also consider that both the degree of attention paid by the consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

112. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. Direct occurs where the consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the consumer notices the differences between the marks, but due to the similarities between the common elements,

they believe that both products derive from the same or economically linked undertakings<sup>3</sup>.

113. I found the earlier to be inherently distinctive to an average degree, and for the overall impression of the mark to reside in the mark as a whole, namely MISS DEN. I found the dominant and distinctive element of the applicant's mark to be DEN, and I found this to be present in the opponent's earlier mark in its entirety. I found the marks to be visually and aurally similar to a medium degree, except for instances where the applicant's mark is pronounced in full, which I find to be rare, where the aural similarity is low. The marks are conceptually similar to a medium degree. I found the relevant consumer to be members of the general public who will pay between a low to average degree of attention to the goods in question.

114. I found the opponent may rely upon the goods "make-up; nail varnishes" as a fair specification under both earlier marks, in addition to the goods "make-up preparations" under its second earlier mark no. EU009028416. I found these goods to be similar to a high degree to the applicant's *personal care preparation, creams, lotions, & balms*. I found them to be similar to a medium degree to *organic & natural toiletries, hygiene, sanitary preparation, shampoos, washes, soaps, dentifrices* and I found these goods to be dissimilar to *deodorants*. and to *baby care products*.

115. Considering all of the factors set out above, and with consideration to the notional and fair use of the opponent's word marks, I find even where the consumer will pay a low degree of attention in respect of the goods, the differences between the marks themselves will not go unnoticed. I therefore find there is no likelihood of direct confusion.

116. In respect of the likelihood of indirect confusion, I consider that the shared common element, namely DEN, features as the most dominant and distinctive element of the applicant's mark. The use of MISS in the opponent's mark does make the mark, when viewed in isolation, appear to be a female name.

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<sup>3</sup> L.A. *Sugar Limited v Back Beat Inc*, BL O/375/10,



However, I also find that the common element, DEN is fairly notable, and it would be possible for the consumer to make the connection between the marks, and to view the element 'MISS' as an indicator of a sub-brand of the opponent aimed at females. I find this is exacerbated by the fact that the opponent's mark is protected in respect of make-up and nail varnish, which, as the applicant has submitted are predominantly (although not solely) aimed at and used by females, whereas the applicant's goods may be targeted to both genders equally. It is my view that how likely the consumer is to make this connection and be confused in this way will depend on the similarity between the goods, and the consumers expectation of a natural brand extension into that area. I find that making this connection will be more likely where the goods are more similar, and I find there to be a likelihood of indirect confusion in respect of the following goods covered by the applicant's mark:

*Organic & natural toiletries, personal care preparation, creams, lotions, & balms, hygiene, sanitary preparation, shampoos, washes, soaps, dentifrices.*

117. Where the goods have been found to be dissimilar, no there will be no likelihood of confusion.

## **Final Remarks**

118. The applicant has offered to add the limitation "not make-up" to its goods in the form of Organic & natural 'not make-up' toiletries. I find this addition would make no material difference to my findings on a likelihood of confusion in this instance. No identity has been found between make-up and the applicant's goods Organic & natural toiletries, and so it is self-evident from the applicant's current specification that the goods are already "not make-up". Further, I have found, a likelihood of confusion between these goods and the opponent's goods, despite the lack of identity found.

119. The opposition has successful in part, and the application will be refused in respect of the following goods:

*Organic & natural toiletries, personal care preparation, creams, lotions, & balms, hygiene, sanitary preparation, shampoos, washes, soaps, dentifrices.*

120. The application may proceed to registration in respect of the remaining goods, namely:

*Baby care products and deodorants*

## **COSTS**

121. Both parties have achieved partial success in this opposition, but the results are weighted in favour of the opponent. As the opponent has achieved more success, it is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £840 as a contribution towards the cost of the proceedings. I have reduced to total award by 20% on account of the applicant's partial success. The sum is calculated as follows:

Official fee	£100
Preparing and filing the opposition and considering the applicant's defence	£300
Preparing and filing the evidence of use	£650
20% reduction for the applicant's partial success	-£210
Total	£840

122. I therefore order Evoiq Limited to pay LA BROSSE ET DUPONT, SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE the sum of £840. 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 28 day of September 2020**

**Rosie Le Breton  
For the Registrar**