O/0400/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004207092
BY CLINICA FIORE LTD TO REGISTER:

The Aestheticologist

THE AESTHETICOLOGIST

(Series of 2)

AS A TRADE MARK IN CLASSES 3, 9, 41 & 44

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO OP600003731
BY AESTHETICOLOGY LTD

BACKGROUND AND PLEADINGS

1. On 21 May 2025, Clinica Fiore Ltd ("the applicant") applied to register in the UK the series of trade marks shown on the cover page of this decision. Given the identity of these marks, I will, for ease of reference, refer to the series of marks as "the applicant's mark" throughout this decision, unless it becomes necessary to differentiate between the marks which comprise the series. The application was accepted and published for opposition purposes on 6 June 2025. Registration is sought for the following goods and services:

   Class 3: Cosmetics and cosmetic preparations.

   Class 9: Downloadable courses and educational material.

   Class 41: Educational services relating to beauty therapy; Training in the field of aesthetics and beauty treatments; Providing online courses and workshops in aesthetic treatments; Certification training in cosmetic procedures.

   Class 44: Human hygiene and beauty care; Beauty treatment; Therapeutic treatment of the body Beauty care; Beauty therapy services; Medical and healthcare clinics; Consultation services relating to body hair removal; Therapy services; Therapeutic treatment of the body; Cosmetic treatment services for the body, face and hair; Massage services; Spa services; Information, Cosmetic treatment for the body; Health spa services for health and wellness of the body and spirit; Beauty treatment; Microneedling treatment services; Facial beauty treatment services; Slimming treatment services; Cosmetic laser treatment of skin; Advisory services relating to beauty treatment; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of skin; Cellulite treatment services.

2. On 16 July 2025, AESTHETICOLOGY LTD ("the opponent") filed a fast track opposition opposing the application in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following mark:

AESTHETICOLOGY

UK registration no. UK00004132979
Filing date 4 December 2024; registration date 7 March 2025.
Relying on all services, being:

> Class 41: Education, teaching, instruction and training in respect of cosmetician services; education, teaching, instruction and training in respect of cosmetic, facial, body and hair treatments and services; education, teaching, instruction and training in respect of cosmetic treatments and services for the face, body and hair; provision of information, advice and consultancy in respect of the all the aforementioned services.
>
> Class 44: Provision of cosmetician services; provision of cosmetic facial, body and hair treatment services; provision of cosmetic treatment services for the face, body and hair; provision of injectable filler treatments for cosmetic purposes; provision of skin treatments for cosmetic purposes; provision of anti-wrinkle injections for cosmetic purposes; provision of Polydioxanone (PDO) thread treatments for cosmetic purposes; provision of platelet-rich plasma (PRP) injections for cosmetic purposes; provision of fat-dissolving injections for cosmetic purposes; provision of IV nutrition services for cosmetic purposes; provision of information, advice and consultancy in respect of all the aforementioned services.

3. The opponent's case is that the marks at issue are visually, phonetically and conceptually similar to a very high degree. The opponent submits that given the highly distinctive and invented nature of the earlier mark relied upon, the very high degree of similarity between the signs, and the identical, similar, associated and complementary nature of the goods and services, it is highly likely that consumers would mistake one sign for the other and that direct confusion would arise. In the alternative, the opponent submits indirect confusion would arise.

4. The applicant filed a counterstatement denying that registration of the applicant's mark contravenes section 5(2)(b) of the Act, denying that the marks are identical

or similar to such an extent as to give rise to a likelihood of confusion and denying that the goods and services are identical or similar.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

   "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. On this point, it is noted that neither the applicant nor opponent has filed evidence in these proceedings.

7. The opponent is represented by Sonder & Clay. The applicant is represented by The Trademark Helpline. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. In this case, a hearing was neither requested nor considered necessary. I also note that only the applicant has filed written submissions in lieu of a hearing.

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b): legislation and case law

9. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because-
>
> > (a) …
> >
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

10. Section 5A of the Act states as follows:

> "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."

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "(6)(1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark or international trade mark (UK) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

12. The opponent's mark qualifies as an earlier trade mark under the above provisions. As the opponent's mark had not completed its registration process more than five years before the filing date of the applicant's mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent may rely on the services highlighted in its notice of opposition.

13. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

14. The parties goods and services are as follows:

The opponent's services	**The applicant's goods and services**
	Class 3: Cosmetics and cosmetic preparations.

	Class 9: Downloadable courses and educational material.
Class 41: Education, teaching, instruction and training in respect of cosmetician services; education, teaching, instruction and training in respect of cosmetic, facial, body and hair treatments and services; education, teaching, instruction and training in respect of cosmetic treatments and services for the face, body and hair; provision of information, advice and consultancy in respect of the all the aforementioned services.	Class 41: Educational services relating to beauty therapy; Training in the field of aesthetics and beauty treatments; Providing online courses and workshops in aesthetic treatments; Certification training in cosmetic procedures.
Class 44: Provision of cosmetician services; provision of cosmetic facial, body and hair treatment services; provision of cosmetic treatment services for the face, body and hair; provision of injectable filler treatments for cosmetic purposes; provision of skin treatments for cosmetic purposes; provision of anti-wrinkle injections for cosmetic purposes; provision of Polydioxanone (PDO) thread treatments for cosmetic purposes; provision of platelet-rich plasma (PRP) injections for cosmetic purposes; provision of fat-dissolving injections for cosmetic purposes; provision of IV nutrition services for cosmetic	Class 44: Human hygiene and beauty care; Beauty treatment; Therapeutic treatment of the body Beauty care; Beauty therapy services; Medical and healthcare clinics; Consultation services relating to body hair removal; Therapy services; Therapeutic treatment of the body; Cosmetic treatment services for the body, face and hair; Massage services; Spa services; Information, Cosmetic treatment for the body; Health spa services for health and wellness of the body and spirit; Beauty treatment; Microneedling treatment services; Facial beauty treatment services; Slimming treatment services; Cosmetic

purposes; provision of information, advice and consultancy in respect of all the aforementioned services.	laser treatment of skin; Advisory services relating to beauty treatment; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of skin; Cellulite treatment services.

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account, as per *Canon*, where the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgement:

> "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."

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

18. In *Kurt v Hesse v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

"…there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public is liable to believe that the responsibility for the goods/services lies with the same undertaking or with

economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

20. Whilst on the other hand:

> "…….it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

21. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

> "[…] 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 of 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."

22. I bear in mind that it is permissible to group terms together for the purposes of assessment: *Separode Trade Mark*.[1]

[1] BL O-399-10 (AP)

23. In making the following comparison, I remind myself of Section 60A(1)(b) of the Act which sets out that goods or services are not to be regarded as dissimilar from each other solely on the ground that they appear in different classes under the Nice Classification.

24. In its statement of grounds, the opponent's position is that the applicant's class 41 services are clearly identical with or very closely similar to, or associated with, the opponent's class 41 services. The opponent submits that the applicant's class 44 services are clearly identical with or very closely similar to, or associated with, the opponent's class 44 services. The opponent further submits that it is clear that the applicant's class 3 goods are similar to the opponent's class 44 services to at least a medium degree and are complementary, providing reasons as to how they have concluded this. Finally, the opponent submits that the applicant's class 9 goods are so closely associated with the opponent's class 41 services that it is not possible to distinguish them, they are complementary and similar to at least a medium degree.

25. As stated at paragraph 4 above, the applicant filed a counterstatement denying that registration of the applicant's mark contravenes section 5(2)(b) of the Act, denying that the marks are identical or similar to such an extent as to give rise to a likelihood of confusion and denying that the goods and services are identical or similar. The applicant submits that the applicant's class 3 goods and the opponent's class 44 services differ in nature, purpose, method of use and trade channels, and complementarity alone does not create identity or high similarity. The applicant further submits that the applicant's class 9 goods and the opponent's class 41 services are distinct categories and the fact that some providers may supply both does not render them identical or confusingly similar. The applicant states that their class 41 services differ in focus from the opponent's broader wording and to the extent there is overlap, coexistence without confusion is possible. Finally, the applicant acknowledges that in relation to the class 44 services, both parties specifications include beauty and cosmetic treatments. However, the applicant denies this results in a likelihood of confusion due to the

conceptual distinction of the marks, the high degree of consumer attention, market practice and the distinctive impression of the marks.

26. In its written submissions, the applicant describes why the applicant's class 3 goods and the opponent's class 44 services differ, why the applicant's class 9 goods and the opponent's class 41 services are not identical, why the applicant's focus on certification and online training in class 41 differentiates it from the opponent's class 41 services and why the conceptual difference between the marks and the informed nature of consumers in this field prevent confusion between the parties' class 44 services.

27. I do not intend to summarise the opponent's statement of grounds or the applicant's counterstatement or written submissions in any more detail here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent deemed necessary below.

28. When considering the likelihood of confusion under section 5(2)(b) the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods and services based on the specifications before me, not the goods and services actually provided by the parties.[2]

Class 3 - Cosmetics and cosmetic preparations

29. Whilst the opponent's specification does not include any cosmetics and cosmetic preparations in class 3, I remind myself of section 60A of the Act which sets out that where goods and services are in different classes, it does not mean that they are automatically dissimilar.

30. The opponent's services in class 44 being "provision of cosmetician services", "provision of cosmetic facial, body and hair treatment services" and "provision of cosmetic treatment services for the face, body and hair" are those that will include treatments that use cosmetic products and cosmetic preparations. Clearly these

[2] *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

goods and services are different in nature, so too are their methods of use. However, they share the same purpose, namely to beautify the user. The users will often be the same as the goods and the services will be aimed at the same average consumer. The goods and services have a complementary relationship as the applicant's goods are important for the provision of the opponent's cosmetic services, meaning that the consumer may well conclude that the same undertaking is responsible for both the goods and the services. Furthermore, in my experience, providers of these services often recommend products for use at home, including their own ranges of goods, resulting in a coincidence of trade channels for the goods and services. Lastly, I consider that the goods and services may be in competition where a consumer can choose to purchase cosmetic goods for use at home or visit a salon for the same treatment carried out by a beauty professional. Overall, I find that these goods and services are similar to a medium degree.

Class 9 - Downloadable courses and educational material.

31. The above applied for goods are unlimited and I must consider all the circumstances in which the mark applied for might be used if it were registered.[3] Class 41 of the opponent's specification contains the broad terms "education, teaching, instruction and training in respect of cosmetician services", "education, teaching, instruction and training in respect of cosmetic, facial, body and hair treatments and services" and "education, teaching, instruction and training in respect of cosmetic treatments and services for the face, body and hair". Once again, I remind myself of section 60A of the Act which sets out that where goods and services are in different classes, it does not mean that they are automatically dissimilar.

32. The opponent's services in class 41 listed in the preceding paragraph are those that will include downloadable courses and educational material. Clearly these goods and services are different in nature, so too are their methods of use. However, they share the same purpose, namely to educate the user. Where the downloadable courses and educational material are in relation to cosmetician

[3] See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) at [66]

services and cosmetic treatment / services, the users will often be the same as the goods and the services will be aimed at the same average consumer. The goods and services have a complementary relationship as the applicant's goods are important for the provision of the opponent's educational, teaching, instructing and training services, meaning that the consumer may well conclude that the same undertaking is responsible for both the goods and the services when in the field of cosmetics. Furthermore, in my experience, providers of these services often recommend or offer products to download and use at home, resulting in a coincidence of trade channels for the goods and services. Overall, I find that these goods and services are similar to a medium degree.

Class 41

Educational services relating to beauty therapy.

33. The closest comparable term in the opponent's specification is "education, teaching, instruction and training in respect of cosmetic, facial, body and hair treatments and services" in class 41. I find these services to be identical under the principle outlined in *Meric*, given beauty therapy includes cosmetic, facial, body and hair treatments and services.

Training in the field of aesthetics and beauty treatments; Providing online courses and workshops in aesthetic treatments; Certification training in cosmetic procedures.

34. The above applicant's services all provide training in the field of aesthetics or cosmetic procedures. The closest comparable term in the opponent's specification is "education, teaching, instruction and training in respect of cosmetician services". As "cosmetician services" includes aesthetic treatments, beauty treatments and cosmetic procedures, I consider the services to be identical under the principle outlined in *Meric*.

Class 44

Human hygiene and beauty care; Beauty treatment; Therapeutic treatment of the body Beauty care; Beauty treatment; Cosmetic treatment services for the body, face and hair; Information, Cosmetics treatment for the body; Microneedling treatment services; Cosmetic laser treatment of skin; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of skin; Facial beauty treatment services; Cellulite treatment services.

35. I consider that the applicant's above services include a variety of cosmetic and beauty services. The above applicant's terms all fall within the broader opponent's term "provision of cosmetic, facial, body and hair treatment services" in class 44. Consequently, I find these services to be identical under the principle outlined in *Meric*.

Beauty therapy services; Therapy services; Therapeutic treatment of the body.

36. The closest comparable term in the opponent's specification to the above applicant's services is "provision of cosmetician services" in class 44. All of the above applicant's services are types of cosmetician services. This is even the case with the applicant's *therapy services* as they are not limited in any respect so can include cosmetician services. Taking this into account, I find these services to be identical under the principle outlined in *Meric*.

Medical and healthcare clinics.

37. As far as I am aware, the above applicant's services provide diagnosis and treatment of medical issues by qualified medical professionals. All of the opponent's class 44 services are in relation to the provision of cosmetic services. These services clearly differ in nature to the applicant's above services as cosmetic services usually involve beauty and aesthetic services that are non-medical. Additionally, the purpose of the services differ in that the opponent's services are to improve a consumer's appearance whereas medical and healthcare clinics are to improve a person's health. Whilst both services can involve invasive procedures

and may be used by the same public (being the general public at large), I do not consider this level of overlap to be of a sufficient level to result in similarity. The services are not complementary nor in competition with each other. Taking all of these factors into consideration, I find the services to be dissimilar.

Consultation services relating to body hair removal; Advisory services relating to beauty treatment.

38. The above applicant's services refer to consultancy in relation to body hair removal or advice relating to beauty treatment. Both of these services fall within the opponent's broad term in class 44 being "provision of information, advice and consultancy in respect of all the aforementioned services", with the "aforementioned services" including "provision of cosmetic facial, body and hair treatment services". Given this, I find these services to be identical under the principle outlined in *Meric*.

Massage services; Spa services; Health spa services for health and wellness of the body and spirit.

39. The closest comparable term in the opponent's specification to the above applicant's terms is "provision of cosmetician services" in class 44. Cosmetician services can be performed in various locations including a beauty salon or a spa and can include massage services. Whilst I acknowledge massages can be performed by a masseuse in a spa they are also routinely performed in a beauty salon by a practitioner who also provides cosmetic services. Whilst the nature of the services are not identical, health spa services often include beauty treatments. The purpose of the services overlaps with the opponent's service focusing on appearance and the applicant's services focusing on wellness and often appearance. A consumer may consider the services to be complementary as spas often employ cosmeticians and offer cosmetic treatments, resulting in an overlap of trade channels and the services being important or indispensable for each other. Taking all of the above into account, I find the services to be similar to a medium degree.

Slimming treatment services.

40. The closest comparable term in the opponent's specification to the applicant's *slimming treatment services* is "provision of fat-dissolving injections for cosmetic purposes". Fat-dissolving injections are a type of slimming treatment. Taking this into account, I find these services to be identical under the principle outlined in *Meric*.

Conclusion on the goods and services comparison

41. Where there is no similarity of goods or services, there can be no likelihood of confusion in respect of oppositions brought under s5(2)(b) grounds.[4] As a result, my findings above mean that the opposition fails in respect of the following services, being those that I have found dissimilar:

Class 44: Medical and healthcare clinics.

The average consumer and the nature of the purchasing act

42. 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.

43. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

[4] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

44. The goods at issue are ordinary consumer goods that will be selected by the general public at large. However, I acknowledge that the average consumer might also include professional users (such as beauticians and make-up artists) and students. The goods will be available via general or specialist retailers (such as

beauticians, make-up shops or supermarkets) and their online equivalents (where available). In physical stores, the goods will be displayed on shelves where they will be self-selected by the consumer. When the selection takes place online, the goods will be selected after viewing an image of it on a webpage. Clearly, the visual component will dominate such selection processes, though I do not discount the aural component entirely as suggestions may come from word-of-mouth recommendations or advice from sales assistants, especially in beauticians or make-up shops where the goods may be selected after a discussion with the beautician or make-up artist, or from education providers such as teachers and lecturers. Regardless of the importance of the aural component, the consumer will still view the goods. As for the services, these are likely to be selected having considered, for example, promotional material (in hard copy or online) or signage appearing on the high street. I consider that the selection process will be primarily visual but I do not discount an aural component playing a role by way of word of mouth recommendations or advice from sales assistants.

45. The goods are likely to be selected on a fairly frequent basis and at a relatively low cost. In respect of the level of attention paid, I am of the view that when selecting the class 3 goods, the consumer is likely to consider factors such as the colour, ingredients used, the desired effects on the skin/hair, ease of application, scent and whether the goods have been tested on animals. When selecting the class 9 goods, I am of the view that the consumer is likely to consider what information they need to learn, the format of the material and possible timeframes of the courses. As for the services, these will be selected after the consumer gives consideration to factors such as the type of treatments offered, location and qualifications of the provider, quality of the training provided and/or the certification obtained. As some cosmetic treatment services can be more invasive than some beauty treatments and may be selected on a less regular basis, the consumer may pay a higher level of attention. Generally speaking, the average consumer will pay either a medium or relatively high degree of attention.

Comparison of marks

46. 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.

47. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

48. It would be wrong, therefore, to dissect the trade marks artificially, 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.

49. The respective trade marks are shown below:

The opponent's mark	The applicant's marks
AESTHETICOLOGY	The Aestheticologist THE AESTHETICOLOGIST (Series of 2)

50. In its notice of opposition and statement of grounds, the opponent submits that the marks are visually, phonetically and conceptually similar to a very high degree. The opponent submits that “THE” in the applicant’s mark can be dismissed for comparison purposes given that it holds no distinctive quality at all and it is so negligible that is it permissible to make the comparison based solely on the basis of the dominant element, namely the word “AESTHETICOLOGIST”.

51. In its counterstatement, the applicant states that the marks are not identical and the similarities are limited to the presence of the prefix “aesthetic” which is descriptive of beauty or appearance in the relevant field. The applicant states that the remaining elements are materially different as the opponent’s mark ends in ‘ology’ which denotes a branch of study and the applicant’s mark ends in ‘ologist’ which denotes a practitioner. The applicant also states that its mark contains the definite article ‘THE’ which alters its overall impression. As a result, the applicant states that the marks differ visually (longer/shorter word endings), aurally (different syllable count and rhythm) and conceptually (abstract study vs identifiable professional).

52. In the applicant’s written submissions, the applicant reiterates some of their reasoning stated in their counterstatement and states that the opponent’s claim that “AESTHETICOLOGY” is a highly distinctive invented word is overstated. The applicant states that this term combines the descriptive element ‘aesthetic’ with the ordinary English suffix ‘ology’ and within the aesthetics and beauty sector ‘aesthetic’ directly describes the nature or purpose of the goods and services. Consequently, the opponent’s mark enjoys at best a modest level of inherent distinctiveness, limiting the scope of protection to its precise form.

53. I do not intend to repeat the parties’ submissions in any further detail here. For the avoidance of doubt, however, I can confirm that I have taken these submissions into account in making the following comparison.

Overall impression

54. The applicant's mark is a word only mark, comprising of two words "THE AESTHETICOLOGIST". There are no additional elements to the applicant's mark and therefore the overall impression lies in the words themselves.[5] Whilst I bear in mind that the beginning of a mark tends to make more of an impact than the end, as the word, "THE", will simply be seen as an identifier of that which succeeds it, the overall impression will be dominated by the word "AESTHETICOLOGIST".[6]

55. As for the opponent's mark, this is a word only mark which consists of the word "AESTHETICOLOGY" in uppercase. The overall impression lies in the word itself.

Visual comparison

56. Visually, the second word of the applicant's mark consists of 16 letters and the opponent's mark consists of 14 letters, both marks overlapping through the use of the first 13 letters of that word being "AESTHETICOLOG". The points of visual difference are the letter "Y" at the end of the opponent's mark, the letters "IST" at the end of the applicant's mark and the use of the word "THE" at the start of the applicant's mark. Regardless of the various roles these elements play in their respective marks, they all contribute as points of visual difference between the marks. For the reasons set out above, I have found the dominant part of the applicant's mark to be "AESTHETICOLOGIST". Overall, bearing in mind the overall impressions of the marks and the shared use of the letters "AESTHETICOLOG", I find that the marks are visually similar to between a medium and high degree.

Aural comparison

57. The opponent's mark consists of six syllables and is likely to be pronounced as "ASS-THET-I-COL-OH-JEE". The applicant's mark consists of seven syllables and is likely to be pronounced as "THE-ASS-THET-I-COL-OH-JIST". Five out of seven

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[5] A word only mark protects the word itself, irrespective of font, capitalisation or otherwise. Given this, as stated in paragraph 1, I have referred to "the applicant's mark" throughout, despite this being a series of two marks.
[6] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

syllables are identical with just the first and last syllable acting as points of aural difference (although I bear in mind that there is some similarity in the pronunciation of the last syllable). Taking all of this into account, I find the marks are aurally similar to between a medium and high degree.

Conceptual comparison

58. Conceptually, the opponent submits that the marks are similar to a very high degree. The opponent states that both marks comprise an invented word, however it is clear that both are derived from a clever combination of the same two words, namely *aesthetic* which means "concerned with beauty" and *ology* which means "a subject of study or a branch of knowledge". The opponent submits that consumers in the relevant sectors would understand both marks to be clever, invented words meaning relating to the study of beauty or a branch of knowledge relating to beauty. The opponent also submits that members of the English speaking public are very used to seeing an "ology" word converted into a gist word, for example, archaeology to archaeologist, ornithology to ornithologist and pharmacology to pharmacologist. The opponent submits that the "ist" version of the word is commonly understood to be a person who practices the "ology" version of the word and as such the applicant's mark would be seen as a logical brand extension of the opponent's mark. On this basis, the opponent states there is no real conceptual distinction between the marks and they are virtually identical overall.

59. The applicant submits that the marks differ conceptually (abstract study vs identifiable professional). The applicant submits that the conceptual distinction reinforces that the marks designate different ideas. The applicant submits that the suffix "-ology" denotes a field of study whereas "-ologist" denotes a practitioner, and the opponent's mark therefore evokes an abstract discipline while the applicant's evokes an individual professional. The applicant states that this difference is conceptually decisive, particularly in sectors where consumers differentiate between academic, training and service-providing contexts. In relation to class 44 services, the applicant states that "AESTHETICOLOGY" refers conceptually to a field of study, whereas "THE AESTHETICOLOGIST" refers to a practitioner and that this distinction is especially important in class 44, where

consumers choose between different service providers and will identify the applicant's mark as denoting a professional person or clinic, not an abstract concept.

60. The opponent's mark consists solely of the word "AESTHETICOLOGY". Whilst this is an invented word, it is my view that consumers will recognise the word "AESTHETIC" within the mark. I say this because "AESTHETIC" is clearly a well-known word and, as such, the consumer will view it as such. I consider that "aesthetic" is allusive of the services at issue, i.e. it alludes to the services the mark is registered for as opposed to describing them as submitted by the applicant. I have given consideration as to the meaning of "ology" and agree with the applicant that it denotes a branch of study such as biology. Given how many words there are in the English language which end with "ology", I consider the majority of average consumers will be aware that "ology" refers to a field of study. Whilst there may be some consumers that are not aware of the meaning of "ology", they would not make up a significant proportion of consumers. Taking all of the factors into consideration, the opponent's mark will be viewed as an invented word which will evoke the concept of the study of appearance and beauty.

61. The applicant's mark consists of the words "THE AESTHETICOLOGIST". The same reasoning applies as per the preceding paragraph. Whilst "AESTHETICOLOGIST" will be seen as an invented word, the word "AESTHETIC" will be recognised within the invented word. I have given consideration as to the meaning associated with 'ologist' and agree with the applicant that it denotes a practitioner such as a gynaecologist or an oncologist. Given how many words there are in the English language which end with "ologist", I consider the majority of average consumers will be aware that "ologist" refers to a practitioner. Whilst there may be some consumers that are not aware of the meaning of "ologist", they would not make up a significant proportion of consumers. The applicant's mark will be viewed as an invented word which will evoke the concept of a practitioner that specialises in appearance and beauty. As stated previously, the word "THE" will be regarded as an identifier of that which succeeds it and will make little impact as a point of conceptual difference (if at all).

62. I acknowledge that the majority of consumers will understand the different meanings of "ology" and "ologist". However, I also acknowledge that both "ology" and "ologist" relate to science in some way which results in some shared concept. "Aesthetic" is identical in both marks and has an identical conceptual meaning. As a whole, each mark is allusive. Taking all of the above factors into account, I find the marks to be conceptually similar to a high degree as both are invented words which evoke a concept of aesthetic-based science, albeit in slightly different ways.

Distinctive character of the opponent's mark

63. 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)."

64. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a

characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not pleaded that its mark has obtained an enhanced level of distinctiveness and no evidence has been filed to that effect. The opponent's position is that it's mark is a clever, invented word and has a highly distinctive character. As the opponent did not file any evidence, I only have the inherent position to consider.

65. The opponent's mark comprises the word "AESTHETICOLOGY". The word "aesthetic" is of low distinctiveness for the services in issue. As previously outlined in my comparison of the marks, despite the opponent's mark being an invented word, the majority of consumers will recognise the word "AESTHETIC" within the mark and will be aware that "OLOGY" denotes a branch of study. I consider the opponent's mark is allusive as a whole, although the combination of these elements is somewhat usual. Therefore, I am of the view that the opponent's mark is inherently distinctive to between a low and medium degree.

Likelihood of confusion

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

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

67. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods and services at issue are marketed, and in which type of store/platform they are made available.

68. Throughout the course of this decision, I have found the respective goods and services to range from being identical to similar to a medium degree (except where I have found them to be dissimilar). The average consumer for the goods and services are members of the general public, professional users (such as beauticians and make-up artists) and students. I found that the visual component will dominate the selection process for the goods and services, though I do not discount the aural component entirely. I have concluded that, depending on what goods and services are being selected and by who, the average consumer will pay either a medium or relatively high degree of attention during the selection process. I have found the marks to be visually and aurally similar to between a medium and high degree and conceptually similar to a high degree. I have found the opponent's mark to possess between a low and medium degree of inherent distinctive character.

69. In light of the above, it is my view that the dominant part of the applicant's mark (being "AESTHETICOLOGIST") and the entirety of the opponent's mark (being "AESTHETICOLOGY"), are likely to be mistakenly recalled or misremembered as each other. They share the same 13 thirteen letters being "AESTHETICOLOG" (which makes up thirteen out of the fourteen letters in the opponent's mark and thirteen out of sixteen letters dominant part of the applicant's mark). The applicant's mark includes the additional word "THE" at the start of the mark, although, I have found that it will simply be seen as an identifier of that which succeeds it and therefore contribute to a lesser extent to the overall impression of the mark. Consequently, factoring in the principle of imperfect recollection, it may be overlooked by the average consumer (even where a relatively high degree of

attention is being paid). The fact that both marks are likely to be seen as a reference to science in the field of beauty and appearance (albeit in slightly different ways), in addition to the visual and aural similarities, will result in the average consumer imperfectly recalling one for the other. Further, given that the differences in the dominant elements (Y vs IST) appear at the end of the marks, there will be a significant proportion of average consumers who overlook this altogether and so any conceptual differences will not assist in differentiating between them. Given the higher level of similarity between the dominant parts of the marks (being that which the consumer will pin their recollection on), I am of the view that this finding applies in circumstances where the marks are viewed on goods and services that are similar to a medium degree or higher and where the consumer will pay either a medium or relatively high degree of attention when selecting the goods and services. In reaching this conclusion, I have borne in mind that the earlier mark is distinctive to only between a low and medium degree. However, the weak distinctive character of the earlier mark does not preclude a likelihood of confusion.[7] In this case, I find that the weak distinctiveness of the mark is outweighed by the visual, aural and conceptual similarities. Consequently, I consider there exists a likelihood of direct confusion between the marks at issue.

CONCLUSION

70. The opposition succeeds in respect of all the goods and services that have found to be identical or similar. Therefore, the applicant's mark is, subject to any successful appeal of my decision, refused registration for the following goods and services:

Class 3: Cosmetics and cosmetic preparations.

Class 9: Downloadable courses and educational material.

Class 41: Educational services relating to beauty therapy; Training in the field of aesthetics and beauty treatments; Providing online

[7] *L'Oréal SA v OHIM*, Case C-235/05 P

courses and workshops in aesthetics treatments; Certification training in cosmetics procedures.

Class 44: Human hygiene and beauty care; Beauty treatment; Therapeutic treatment of the body Beauty care; Beauty treatment; Cosmetic treatment services for the body, face and hair; Information, Cosmetics treatment for the body; Microneedling treatment services; Cosmetic laser treatment of skin; Cosmetic laser treatment for hair growth; Cosmetic laser treatment of spider veins; Cosmetic laser treatment of skin; Facial beauty treatment services; Cellulite treatment services; Beauty therapy services; Therapy services; Therapeutic treatment of the body; Consultation services relating to body hair removal; Advisory services relating to beauty treatment; Massage services; Spa services; Health spa services for health and wellness of the body and spirit; Slimming treatment services.

71. That being said, the applicant's mark may proceed (again, subject to any successful appeal of my decision) for the following service, which I have found to be dissimilar:

Class 44: Medical and healthcare clinics.

COSTS

72. On balance, I consider that the opponent has enjoyed the greater degree of success in these proceedings. Therefore, I consider that the opponent is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. Given the applicant has succeeded in registering one of the applicant's services, I consider it appropriate to reduce the costs award to a degree in order to reflect the applicant's partial success.

73. In the circumstances, I hereby award the opponent the sum of £300 as a contribution towards its costs. The sum is calculated as follows:

Filing a notice of opposition and considering the counterstatement:	£200
Official fee:	£100
Total:	**£300**

74. I therefore order Clinica Fiore Ltd to pay AESTHETICOLOGY LTD the sum of £300. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 8th day of May 2026

N Barratt
For the Registrar