

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2111766
BY LIDL STIFTUNG & CO. KG**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 50570
BY AVON PRODUCTS INC**

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IN THE MATTER OF Opposition thereto under No 50570
by Avon Products, Inc

Background

1. On 2 October 1996, Lidl Stiftung & Co KG applied under the Trade Marks Act 1994 to register the trade mark CAMORIS for a specification of goods which, following amendment, reads:

Class 03:

Soaps; perfumery, essential oils, cosmetics; make-up; deodorants and anti-perspirants; hair lotions, preparations for cleaning, care, treatments and improvement of hair and scalp.

Class 21:

Brushes, applicators, sponges, powder puffs all for use with make-up.

2. The application was accepted and published. On 29 December 1999, Avon Products, Inc, filed notice of opposition to the application. The statement of grounds accompanying the notice of opposition set out various grounds of opposition but only two were pursued at the hearing. These can be summarised as follows:

- (a) under section 5(2)(b) of the Trade Marks Act 1994 in that the trade mark the subject of the application is similar to the opponents' earlier trade mark AVON COMORES number 2061424 and is to be registered for goods identical or similar to those for which the earlier trade mark is protected; and
- (b) under section 5(4)(a) having regard to the opponents' goodwill and reputation in the earlier trade mark AVON COMORES, the application is liable to be prevented by the law of passing off.

3. The applicants filed a counterstatement denying the grounds of opposition. Both sides seek an award of costs and both parties filed evidence in the proceedings. The case came to be heard on 26 October 2001. The opponents were represented by Mr Colin Birss of Counsel instructed by Frank B Dehn & Co, the applicants were represented by Mr James St Ville of Counsel instructed by Urquart-Dykes & Lord.

Evidence

Opponents' Evidence

4. The opponents' evidence consists of a declaration by Mr John M Bergin, dated 23 August 2000. Mr Bergin is the Chief Trademark Counsel of Avon Products Inc. He has been employed by that company since 1996 and has held his current position since February 2000.
5. Mr Bergin gives evidence of the history of the AVON mark which he says is the 'House' mark of the opponents. He notes that it was registered in 1962. Mr Bergin states that it is the policy of his company to seek registration of their trade marks before commencing use of them. He states that the application to register the trade mark AVON COMORES was filed on 18 March 1996. He states that it was advertised and then registered on 15 November 1996. Mr Bergin states that the COMORES range of products proved to be very popular immediately after its launch in October 1996 and soon became one of the opponents' best selling ranges of products. It should be noted that the relevant date in these proceedings is the date of application, 2 October 1996. Mr Bergin goes on to say that the COMORES range continues to be sold in the United Kingdom.
6. At exhibit AP3, Mr Bergin exhibits pages taken from the 'Campaign 17 1996' brochure in which certain of the COMORES range of goods were first offered for sale in the UK. Mr Bergin states that 3 million copies of this brochure were printed and put into circulation. I note that this brochure has on its front cover the phrase 'The Christmas store that comes to your door', a 'Father Christmas' type soft toy appears on the front cover. The relevant page showing the COMORES range indicates the product is new. It states 'NEW COMORES' and 'NEW FOR CHRISTMAS'. I note also that Mr Bergin does not state when in 1996 this brochure entered circulation.
7. Mr Bergin gives evidence as to the range of products sold under the trade mark and indicates that sales of the product has generated within the United Kingdom approximately £9 million (gross) since October 1996. Mr Bergin comments on the statement made by the applicants in their counter-statement to the effect that the opponents have not used their trade mark AVON COMORES. However, he states that AVON is the 'house' mark of the opponents and that as such, all the products of the opponents are sold as AVON products. Thus, whilst the mark COMORES is not used in combination with the mark AVON as such, the goods would be ordered as AVON COMORES goods.
8. At AP4 he exhibits two further examples of catalogues showing use of the COMORES mark. Mr Bergin goes on to make various comments as to the similarities between the applicants' and opponents' trade marks, I need not summarise these.
9. During the examination process of the application in suit, the registrar raised an ex officio objection to the application under section 5(2)(b) of the Trade Marks Act 1994. This objection was based on opponents' trade mark AVON COMORES. The application proceeded to a hearing and was refused. The applicants' appealed that decision to the Appointed Person. In a decision dated 21 June 1999 (SRIS O/185/99), Mr Simon Thorley, Q.C., sitting as the Appointed Person, overturned the Hearing Officer's decision and allowed

the application to proceed to publication. Mr Bergin refers to the decision of the Appointed Person and a copy of that decision was attached as an exhibit to his declaration.

10. Commenting on the decision, Mr Bergin states that in his view, the decision to reject the application was overturned primarily because of the geographical significance that was said to attach to the word Comores. He states that it was also said in the decision that it is the geographical significance which distinguishes the word Comores from Camoris and that the respective words would not be confused.

11. Mr Bergin acknowledges that the word Comores is indicative of geographical location. He states that it would appear however, that the word is used as a term for the group of islands that is collectively known as the Comoro Islands from which various goods including, inter alia,, essential oils are exported. He refers to the decision of the Appointed Person and notes that in it, the words Comores and Camoris have been incorrectly referred to and he refers to Paragraph 6, line eight. I note that the mark is also incorrectly referred to as AVON CAMORIS in the last sentence of paragraph 8. Mr Bergin states that when the application was filed to register the trade mark AVON COMORES, no objection was taken to it on the ground that the word COMORES had any geographical significance. He submits that this is because the correct name for the geographical location is the Comoro Islands and not Comores.

12. In concluding, Mr Bergin comments that regardless of the geographical significance that is alleged to attach to the work 'Comores', having regard to the fact that the marks COMORES and CAMORIS are almost identical, if identical or closely similar goods were seen to be on sale bearing those marks, there would exist a strong likelihood of confusion arising in the minds of the purchasing public as to the origin of the goods.

Applicants' Evidence

13. The applicants' evidence consists of a statutory declaration by Ms Alison Simpson, a trade mark attorney with Urquart-Dykes & Lord, the applicants' representatives in this matter.

14. Ms Simpson states that the applicants have in excess of 230 'Lidl' supermarkets throughout the United Kingdom selling primarily their own branded products. Their own branded products are only sold through their own 'Lidl' retail outlets.

15. Ms Simpson states that she has reviewed the evidence of Mr Bergin and that he acknowledges that the word COMORES is indicative of geographical origin. Whilst the applicants accept that the islands may sometimes be referred to as the 'Comoros Islands' she states that this usage is primarily in the United States. Ms Simpson states that the main island in the archipelago is called Grande Comore. Ms Simpson states that in the United Kingdom, the islands are generally referred to as 'The Comores'. Ms Simpson does not give any indication of how she formed these views but she does exhibit a copy of a SUNSET 1998 brochure and a Hayes & Jarvis brochure from May 97 - April 98 and a copy of the Hayes & Jarvis brochure from December 1998. These are exhibited at AEFS1 and all advertise holidays in 'The Comores'. The SUNSET '98 brochure states:

‘The Comores

Nestled in the warm Moçambique Channel midway between the east coast of Africa and the island of Madagascar - just over three hours away by air - are the magical, mystical islands of the Comores.....You will not find better all-inclusive holiday value anywhere than these rustic, undiscovered and uncommercialised islands can offer you. Known as ‘The Perfume Isles’ because of the rich heady fragrance of ylang-ylang, vanilla and nutmeg, which pervade the air.....’

16. Both the Hayes & Jarvis brochures refer to the Comores as follows:

‘With two thirds of the words perfume essence coming from these volcanic islands, it’s not surprising that the Comores are known as “the Perfume Islands”.

17. Ms Simpson at AEFS 2 exhibits a copy of a web page from the Department of Trade & Industry listing beneficiary countries and territories enjoying generalised tariff preferences in the European Union; ‘The Comores’ appears in list A. At AEFS 2, Ms Simpson exhibits a copy of web pages relating to ‘The Comores’, in particular the home page of Action Comores, a page from Partnership Travel and pages from Tana Travel.

Opponents’ Evidence in reply

18. The opponents’ evidence in reply consists of a further declaration dated 5 March 2001 by John Bergin. Mr Bergin notes the evidence of the applicants intended to prove that COMORES/THE COMORES is indicative of geographical location. He states that it is claimed on behalf of the applicants that whilst the group of islands that has been referred to may sometime be referred to as the ‘Comoros’ Islands, this usage is mainly in the United States. In Mr Bergin’s view this is debatable and he points out that one of the references at AEFS3 to Ms Simpson’s declaration, Action Comoros, refers to itself as a voluntary conservation organisation working in the Comoros Islands (Comores).

19. That concludes my review of the evidence.

Decision

20. The grounds of opposition refer to sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994. The relevant provisions read as follows:

“5.- (1)

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

- (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."

(3).....

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

21. The term 'earlier trade mark' is defined in section 6 of the Act as follows:

- "6.- (1) In this Act an "earlier trade mark" means -
- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,"

Section 5(4)(a)

22. I questioned Mr Birss at the outset of the hearing on his clients' objection under section 5(4)(a). Whilst not shirking from the fact that section 5(2)(b) was the main issue, he maintained his clients' objection on this ground and made submissions.

23. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

- (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.

24. In order to succeed under this head of opposition, the opponents must show that as at the date of the application, 2 October 1996, they could have prevented use of the applicants' trade mark under the law of passing off. In the majority of cases, the opponents' product or services will be on the market or advertised as available to the relevant market and in order to satisfy the first of the elements listed above, the opponents will file evidence showing use of their trade mark in the market place. The evidence will be dependent on the facts of the individual case but will usually show the period of use before the date of application, invoices will be exhibited together with turnover figures, advertising figures and examples of advertising will also be included. Of course, that will not always be the case and actions for passing off have been successful where the claimant has not commenced trading in the market place. Mr Birss referred me to two such cases. In *The British Broadcasting Corporation v. Talbot Motor Company Ltd* [1981] F.S.R. 228 the mark was CARFAX and in *W.H. Allen & Co v. Brown Watson Limited* [1965] R.P.C. 191, it was the name of a book.

25. Mr Birss submitted that as at the relevant date, 2 October 1996, it was evident from the fact that the opponents' mark had been advertised, in the Trade Marks Official Journal, that they intended to launch a product under the name AVON COMORES. Thus, Mr Birss submitted, that if they had been aware of a competitor's intention to launch a product AVON COMORES, they could have gone to the Motions Court and obtained an injunction. In my view, if a third party had intended to launch a product called AVON COMORES on the 2 October 1996, then the opponents may well have succeeded in obtaining an injunction, but that would have been based on any reputation and goodwill they may have had in the mark AVON. It does not follow that they could have prevented use of the trade mark CAMORIS. That is the question that is before me.

26. After hearing Mr Birss' submissions on this point I did not invite Mr St Ville to reply. In my view it is fallacious to suggest that an advertisement appearing in the Trade Marks Journal would be sufficient to obtain the necessary goodwill and reputation which could prevent another from using the same or similar mark under the law of passing off. In both the cases to which I was referred, there had been extensive pre-launch press publicity. There was evidence before the court in both *Talbot* and *Brown Watson* that the public were aware of the intended launch of a traffic information system and a book. The evidence was sufficient for the court to find the necessary goodwill and reputation. In this case, the opponents' evidence states that the product was launched in October 1996, I am given no date. The application was filed on 2 October 1996. I am given no figures of sales prior to the relevant date, no evidence of advanced publicity concerning the launch of the opponents' 'new' product or indeed any pre-launch activity. Without such evidence I cannot find that at the relevant date the opponents' possessed the goodwill or reputation necessary to found an action under section 5(4)(a) and this ground of opposition fails at the first hurdle and is dismissed.

Section 5(2)(b)

27. Under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, 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; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

28. Under section 5(2), the test is a composite one, involving a global appreciation taking into account a number of factors. With these comments in mind I proceed to consider the opponents' case under section 5(2)(b).

29. The opponents' trade mark AVON COMORES registration number 2061424 is an earlier trade mark within the definition of section 6 of the Act. The applicants' and opponents' trade marks and their respective specifications are set out below:

Applicants' trade mark

CAMORIS

Class 3

Soaps; perfumery; essential oils; cosmetics; make-up; deodorants and anti-perspirants; hair lotions, preparations for cleaning, care treatment and improvement of hair and scalp.

Class 21

Brushes, applicators, sponges, powder puffs all for use with make-up.

Decision of the Appointed Person

30. This case has several unusual aspects. As noted above, in my summary of the evidence, the opponents' earlier trade mark was raised as a citation against this application by the registrar ex officio. The objection was maintained but the applicants appealed to the Appointed Person and in a decision dated 21 June 1999 (SRIS O/185/99), Mr Simon Thorley Q.C. sitting as the Appointed Person overturned the registrar's decision to refuse registration and allowed the application to proceed to publication.

31. Mr Birss argued that the decision of the Appointed Person had no relevance to the case that was before me. Mr St Ville did not go quite that far but accepted, I think, that it was of limited value. That must be right, the decision of the Appointed Person was taken ex parte without the opportunity for the opponents to file evidence or make submissions and as such, it can have no bearing on this opposition.

Inherent Distinctiveness of the Opponents' Earlier Trade Mark

32. The opponents' trade mark is made up of two words AVON COMORES. One of the key issues in dispute between the parties concerns the inherent distinctiveness of the element COMORES in the opponents' trade mark. The applicants contend that it has inherently, a low level of distinctive character. In their view, the average consumer will be aware that it is indicative of a geographical location, the Comores, and that the average consumer will be

aware that the Comores are known as the 'Perfume Iles' or know that they produce two thirds of the worlds essential oils for perfume. It seems to me that this factor will be an important one in making a determination under section 5(2)(b).

33. If the applicants' case is correct and the average consumer is aware of the geographical significance of the word COMORES and its reputation for perfume oils, then they will see that element in the opponents' mark as an indication of the geographical origin of the goods. As such, that element of the mark would be less distinctive. The case law of the ECJ tells us that the more distinctive the mark per se the greater the likelihood of confusion.

34. If however, as the opponents contend, the relevant public are unaware that there is a place called the Comores, then the public will be unaware of any geographical significance. Mr Birss in his submissions, argued that in order for the relevant consumer to give the word COMORES geographical significance, the applicants must show:

- (a) that the average consumer is aware that there is an island or island group called the Comores; and
- (b) that the average consumer is aware that the island group produce essential oils for perfumes.

35. Thus, even if the applicants can show that the average consumer is aware of the islands called the Comores, he or she will not give any geographical significance to the mark unless they are also aware of the island's reputation for production of essential oils. If as Mr Birss' submits the applicants have failed to show either of these two factors listed above then the opponents' mark would be considered by the average consumer as an invented word and as such, it would be highly distinctive per se for the goods for which it is registered.

36. The onus in opposition proceedings rests on the opponent. It is for them to show that the ground of opposition is made out; *Oasis Stores* [1998] RPC 631. However, the opponents' registration of its earlier trade mark is prima facie evidence of its validity; section 72 of the Act. If the applicant contends, as is the case here, that the opponents' mark contains an element which is descriptive of the geographical origin of the goods, is it for the applicant to show that this is so or is it for the opponents to show that their mark is not descriptive? It seems to me that absence any evidence to the contrary, the registrar should assume that an opponents' earlier trade mark is prima facie distinctive of the goods or services for which it is registered. If an applicant in opposition proceedings wished to show that the mark contains a descriptive element which will be seen as such by the average consumer, then it is for them to show that this is the case.

The Comores or The Comoros Islands

37. There was much dispute between the parties over whether the islands were called the COMOROS ISLANDS or THE COMORES. Mr St Ville filed the relevant pages of 'The Reader's Digest Great World Atlas 2nd Edition revised 1969'. He stated that this was to enlighten me as to the location of the island group. The relevant page shows the islands as 'Archipel des Comores'. They are located in the Mozambique channel between that country and Madagascar. Mr Birss was suspicious of the reason given by Mr St Ville for submitting this particular atlas. He found it surprising that the very atlas chosen by Mr St Ville described

the island as Comores; although he noted that it actually described is as Archipel des Comores (Fr)'. The 'Fr' presumably indicates that the islands were once part of the French Empire or within their sphere of influence at sometime. Whatever the reason for putting this atlas before me, Mr Birss criticised it as being out-of-date. He noted that the atlas was revised in 1969 and still showed Zimbabwe as Rhodesia.

38. To counter Mr St Ville, Mr Birss filed extracts from two other atlases, firstly, 'The Times Atlas of the World 9th Edition reprinted 1997,' the relevant islands are shown as Comoros; and 'Lloyd's Maritime Atlas 14th Edition 1983' where they are shown as Comoro Is. on the map and Comoros in the key. Mr Birss also noted that the island historically called Grande Comore (as shown in Mr St Ville's atlas), was now shown as Njazidja.

39. Mr Birss also suggested that I should discount the evidence of Ms Simpson to the effect that the name Comoros is primarily used in the United States. I think that he is right; Ms Simpson does not give any basis for her assertion. The atlases seem to me to suggest that the islands may well have been called the Comores at one time but certainly the appropriate name for them now appears to be Comoros. That said, the holiday brochures, travel websites and the European Communities list of beneficiary countries and territories seem to suggest that the name Comores is still in use to some extent at least.

Public Knowledge

40. Are the public aware of the islands known as the Comores or indeed Comoros and even if they are, are they aware of their role in production of essential oils for perfumes?

41. The only evidence that I have before me of the name being brought to the attention of the public is found in the holiday brochures and website pages submitted in the evidence of Ms Simpson. From the evidence before me, it seems to me that the islands are certainly not a popular tourist destination. Only one hotel is offered in the three brochures, and some bungalows are offered in the second Hayes brochure January - December 1998. The holidays on offer are also relatively expensive. Mention was made during the hearing of the fact that a holiday on the Comores was offered as a first prize in the TV show Gladiators and that this had been brought before the Appointed Person during the appeal. I can only base my decision on the evidence that has been filed by the parties in these proceedings and that evidence is not before me.

42. The matter in question must be judged through the eyes of the average consumer of the goods in question. This will be ordinary members of the public. On the basis of the evidence that is before me, I am not convinced the average consumer will be aware of the existence of a group of islands called the Comores or indeed, the Comoros Islands. The islands do not appear, on the basis of the evidence, to have any profile. It follows that the public cannot be aware of the islands reputation as a source of perfume oils. Even if I am wrong in so finding and the public are aware of the islands, it seems to me that I have no evidence to show that those members of the public who might be aware of the islands' existence will know that it is a source of essential oils. The references in the holiday brochures where this information is conveyed, and where the islands are called the 'Perfume Islands', is insufficient in my view for me to reach such a conclusion.

43. I would agree with Mr Birss' submission that this second point is important. Even if consumers are aware of the place, the Comores, in order for them to give it significance as an indication of geographical origin, they must be aware that the islands are a source of essential oils for perfumes. If, as I have found, they are not, then the use of the mark on, for example, perfume, will merely bring to mind images of tropical beaches and clear azure waters; pleasing images which will make an association with the perfume but which will not impart descriptiveness and detract from the distinctiveness of the mark.

44. Therefore, on the basis of the evidence before me, I reach the view that to the average consumer of the goods in question, the mark AVON COMORES will appear to include an invented element COMORES, to some it may bring to mind pleasing images of sun drenched beaches but nothing more. Thus, I conclude the mark AVON COMORES as a whole is distinctive for the goods for which it is registered as is each element within the mark.

Identity/Similarity of Goods

45. The applicants seek registrations for goods falling in classes 3 and 21. To the extent that the application in suit covers goods in class 3, I think that it was conceded that these goods are either identical or very similar to the goods for which the opponents' earlier mark is registered. The application also covers goods in class 21; 'Brushes, applicators, sponges, powder puffs all for use with make-up.' The opponents' mark covers; 'Non-medicated toilet preparations; cosmetics; soaps; preparations for the hair; preparations for cleaning teeth; perfumes, toilet waters, eau de colognes; deodorants for personal use; toilet articles; essential oils.' The applicants' specification in class 21 all relate to products for use with make-up. Make-up is not covered specifically by the opponents' specification but it does include cosmetics, and it seems to me that this term would include make-up. There will be some similarities in the users of both the opponents' product falling within the term cosmetics and the goods for which the applicants' seek protection, products for use with make-up. The products will also be sold in similar establishments; chemists or department stores, in close proximity to one another. Indeed, both cosmetics and products for use with make-up appear in the opponents' catalogues at exhibit AP4. Examples include mascara and a brush on page 49 and "Mosaic Powder" and a "Frosted Dusting Brush" on pages 41 and 27. It seems to me that they are all linked to beauty products and although not in direct competition, they are complementary. An applicator for make-up could be used to apply cosmetics. As such, I find that there is a similarity of goods.

46. As noted above, the likelihood of confusion must be assessed globally. In *Canon*, the ECJ indicated that this implied some interdependence between the relevant factors. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks (and vice versa); *Canon* paragraph 17, page 132.

47. Mr Hobbs Q.C., sitting as the Appointed Person in *Raleigh International* [2001] R.P.C. 11 has stated:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between

marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences.”

Comparison of the Trade Marks

48. I will now consider the visual, aural and conceptual similarities between the trade marks by reference to the overall impression created by the marks but taking into account their distinctive and dominant components. The question must be assessed through the eyes of the average consumer taking into account the fact that the average consumer rarely has an opportunity to make a direct comparison between the trade marks; so called imperfect recollection.

49. Visually, the opponents’ earlier trade mark is AVON COMORES, the applicants’ is CAMORIS. Clearly, on first impression, there is a marked visual difference between the two marks in that the opponents’ is made up of two words, whilst the applicants’ consists of only one word. However, as noted above, I must have regard to the dominant and distinctive elements within the two marks and the perception of the average consumer. It seems to reasonable to infer, on the basis of the opponents’ evidence, that the word AVON appearing in the trade mark is their house mark and that the public at large would perceive it as such. Thus, whilst not discounting the AVON element in the overall impression created by the marks, it seems to me that I should take this factor into account when assessing the visual similarities between the two marks.

50. It is always dangerous to seek to over analyse trade marks, we are told that the average consumer considers marks as a whole. Nevertheless, given the above it seems to me reasonable to assume that the word AVON may not always bear upon the public’s perception when purchasing COMORES products. With that in mind I look at the visual impact of the marks CAMORIS and COMORES. I am of the view that the visual similarities between these two marks are there for all to see. The words are the same length and have a similar impression on the eye differing only in the second and sixth letters. Taking into account imperfect recollection, the visual similarities are all the more marked.

51. Aurally, there was some debate as to how each of the marks would be pronounced. I have no evidence of how either mark has been used orally and so I must assess this matter myself. The first element in the opponents’ mark will be pronounced AVON. However, Mr Birss argued that the second element might well be pronounced COM MOR RES. In contrast Mr St Ville argued that the second element in the opponents’ mark would be pronounced COM ORES. There was I think less debate on the pronunciation to be given to the applicants’ mark but even here versions ranged from CAM OR IS to CAM MORRIS.

52. Initially, I viewed Mr Birss’ submission on the pronunciation of COMORES with some scepticism. As I was aware of the existence of the islands called the Comores, it seemed to me self evident that this element in the opponents’ mark would be given that pronunciation. However, on putting myself in the shoes of someone who is unaware of the islands, I do not think that his submission is so far fetched. Someone who is unaware of the islands on seeing the word COMORES might well split it into three syllables and pronounce it COM MOR RES. In my view, there is a greater degree of aural similarity between Mr Birss’ COM MOR

RES and the applicants' trade mark CAM OR IS. However, it seems to me that even if I take Mr St Ville's line and pronounce the opponents' trade mark COM ORES, there is still a degree of aural similarity between the two marks.

53. Conceptually, my finding in relation to the knowledge of the average consumer in relation to the islands called the Comoros Islands or Comores, leads to the conclusion that conceptually, the opponents' trade mark will be meaningless to the average consumers and will appear to be a made up word, to others, it may allude to tropical beaches etc. The applicants' mark also appears to be a made up word.

Conclusions under section 5(2)(b)

54. Together with my finding in relation to the inherent distinctiveness of the opponents' mark, how do my findings in respect of the similarities of the marks and the identity/similarity of the goods come together under section 5(2)(b). As noted above, the ECJ has stated that a lesser degree of similarity between the goods or services can be offset by a greater degree of similarity between the marks (or visa versa).

55. Mr Hobbs, Q.C., sitting as the Appointed Person *Balmoral Trade Mark* [1998] R.P.C. 297 at page 301, he found that section 5(2) raised a single composite question. Adapted to this case it can be stated as follows:

Are there similarities (in terms of marks and goods or services) which would combine to create a likelihood of confusion if the "earlier trade mark", AVON COMORES and the sign subsequently presented for registration, CAMORIS, were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?

56. Having considered the various factors, I reach the view that this question must be answered in the affirmative. In so finding, I have taken account of the distinctiveness of the opponents' mark, the fact that the applicants seek protection for goods which are identical or similar to those for which the opponents' marks are protected.

57. It seems to me that, whilst noting the AVON element in the opponents' trade mark, and its role as a house mark, the overall visual and oral similarities between the second element of the opponents' trade mark and the applicants' trade mark, are sufficient for me to find that a likelihood of confusion as defined in section 5(2)(b) of the Trade Marks Act 1994 exists. Even if I am wrong on that point, it seems to me reasonable to assume that, even if the mark AVON is sufficient to avoid the likelihood of direct confusion, the average consumer on seeing the mark CAMORIS used on identical or similar products to those for which the mark AVON COMORES is registered, would wrongly believe that the goods came from the opponents or some economically linked undertaking. As such, there is a likelihood of confusion with the meaning of section 5(2)(b) and I find that the opponents' ground of opposition succeeds and the application should be refused in its entirety.

Conclusions

58. I have found that the opponents' ground of objection under section 5(2)(b) has succeeded and the application is refused; the ground of opposition under section 5(4)(a) is dismissed.

Costs

58. The opponents have been successful and are entitled to a contribution towards their costs. I order that the applicants should pay the sum of £1235-00 as a contribution towards their costs. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13 day of February 2002

**S P Rowan
For the Registrar
the Comptroller General**