

BL O/0824/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3863017

BY

ELIZA BEAUTY PROFESSIONAL LTD

TO REGISTER THE TRADE MARK:

AtmaSPA

IN CLASS 44

-AND-

THE OPPOSITION THERETO UNDER No. 600002734

BY

AMAN GROUP S.à.r.l.

Background and pleadings

1. Eliiza Beauty Professional Ltd (“**the Applicant**”) applied to register the trade mark ‘AtmaSPA’ in the UK on 28 December 2022. It was accepted and published in the Trade Marks Journal on 13 January 2023 in respect of the following services:

Class 44:

Spa services; Spas; Beauty spa services; Health spa services; Medical spa services; Beauty care services provided by a health spa; Salon services (Beauty-); Beauty salon services; Beauty salons; Salons (Beauty-); Beauty treatment.

2. On 30 January 2023, Aman Group S.à.r.l. (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opposition is based on the Opponent’s trade mark shown below, which is registered in respect of services in Classes 35, 36, 39 and 44 (the specification is set out in the Annex to this decision).¹ For the purposes of the opposition, the Opponent relies on all the services for which its mark is registered.

Representation of the Earlier Mark:	ATMA
Registration Number:	3825606
Filing date:	1 September 2022
Registration Date:	27 January 2023

3. The Opponent argues that the respective marks are similar and that ‘SPA’ in the applied-for mark is descriptive of the Class 44 services for which registration is sought, as such no weight should be given to that element in the comparison of the marks. It also argues in particular that certain terms contained within its Class 44 services are identical or at least highly similar to the applied-for services, thus giving rise to a likelihood of confusion.

4. The applicant filed a counterstatement denying the claims made.

5. This is an opposition to which the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 applies, deemed a ‘Fast Track’ opposition. As there was no use requirement, the Opponent did not file any evidence with its notice of Opposition.

¹ The Opponent’s mark is an earlier trade mark in accordance with section 6 of the Act.

Neither party sought leave to file evidence nor made any request to be heard. Only the Opponent elected to file submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers.

6. The Opponent is represented by K&L Gates LLP. The Applicant has no professional legal representation in these proceedings.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

DECISION

Legislation and Case Law

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

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

[...]

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

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

9. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.*

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

10. In *Gérard Meric v Office for Harmonisation in the Internal Market*,² (“**Meric**”), the General Court held to the effect that goods and services can be considered as identical when the goods and services designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

11. I have included in the table below those services identified by the Opponent as its best case.³

Opponent’s services	Applied-for services
<p><u>Class 44</u></p> <p>Spa services; health spa services; medical spa services; medical treatment services provided by a health spa; nutritional advisory services; health resort services [medical]; cosmetic facial and body treatment services; sauna; solarium and sun tanning facilities; massage services; health care relating to therapeutic massage; skin care services; beauty treatment services; slimming treatment services; hair care services; pedicure and manicure services; beauty salons; hair dressing salons.</p>	<p><u>Class 44</u></p> <p>Spa services; Spas; Beauty spa services; Health spa services; Medical spa services; Beauty care services provided by a health spa; Salon services (Beauty-); Beauty salon services; Beauty salons; Salons (Beauty-); Beauty treatment.</p>

12. “Spa services; health spa services; medical spa services; beauty salons” appear in in both parties’ specifications and are therefore **identical**.

² Case T- 133/05

³ See the Opponent’s submissions in lieu dated 26 May 2023, paragraphs 21 and 22. Also see the Annex to this decision.

13. “Spas” in the Applicant’s specification is self-evidently **identical** to “spa services” in the Opponent’s specification.

14. “Beauty treatment” in the Applicant’s specification is self-evidently **identical** to “beauty treatment services” in the Opponent’s specification.

15. “Salons (Beauty-); Beauty salon services; Salon services (Beauty-)” in the Applicant’s specification are self-evidently **identical** to “beauty salons” in the Opponent’s specification.

16. “Beauty spa services” in the Applicant’s specification falls within the broader category of “Spa services” in the Opponent’s specification. They are **identical** on the principle outlined in *Meric*.

17. “Beauty care services provided by a health spa” in the Applicant’s specification falls within the broader categories of “Spa services; health spa services; beauty treatment services” in the Opponent’s specification. They are **identical** on the principle outlined in *Meric*.

Conclusion on the services comparison

18. I have found that all the applied-for services in Class 44 are identical to terms contained in the Opponent’s Class 44 services.

The average consumer and the nature of the purchasing act

19. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the services in question. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word “average” merely denotes that the person is typical,⁴ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.⁵ It is therefore necessary to determine who the average

⁴ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

⁵ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

consumer of the respective services is, and how the consumer is likely to select those services.

20. The average consumer of the Class 44 services at issue will be a member of the general public. The services will be selected either online, from brochures or over the phone where visual and aural considerations will both apply. The frequency of use will depend on the particular service, for example, a consumer may likely use beauty salon services more frequently than a spa service (as they may not need to use spa services as frequently). In any event, the frequency depends on individual needs and would also be based on the recommendations from the treatment specialists providing the services. As the services relate to personal care and wellbeing, a medium degree of attention will be taken when selecting the services.

Comparison of marks

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

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

22. 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.

23. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
ATMA	AtmaSPA

Overall impression

24. The overall impression of the earlier mark lies solely in the word 'ATMA'.

25. The overall impression of the contested mark lies in the two conjoined words of which it is comprised – 'Atma' and 'SPA'. 'SPA' is commonly understood to mean a place which offers health and beauty treatments. Accordingly this word has limited relative weight in relation to the services for which protection is sought, as such, the overall impression of the contested mark is dominated by the word 'Atma'. I also do not overlook the possibility that the average consumer of the services may fail to perceive the word 'SPA' as an intentional part of the brand name, and instead may perceive it as a descriptor of the services offered and therefore this word will be accorded less attention than the word 'Atma'.

Visual comparison

26. I note that a word mark protects the word itself and the comparison must be made on the basis of the word, not any particular presentation of the word. The protection of a word mark is not limited by any features such as capitalisation which appear on the Register, as such those features do not provide a point of distinction when comparing two word-only marks.

27. In terms of visual similarity, 'ATMA' forms the first four letters of the contested mark and that sequence of letters is therefore identical to the earlier mark. I note that generally, although just as a rule of thumb, the first parts of a mark normally carry a greater significance.⁶ The visual differences lie in the word 'SPA' which is not present in the earlier mark. Given my earlier comments regarding the limited relative weight of the word 'SPA', I assess the visual similarity as high (this is because, even if the

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, paragraph 81

average consumer perceives the word 'SPA' as descriptive, that does not in itself mean it will be ignored in a visual comparison).⁷

Aural similarity

28. 'ATMA' will be pronounced identically in both marks. Although I note that the contested mark comprises of two conjoined words, there exists a natural break between them, such that the two words of which the contested mark is comprised, are likely to be pronounced separately as 'ATMA – 'SPA' (as opposed to anything else). This is even more so when considering the services to which the mark relates i.e. inter alia, spa services.

29. Whilst 'SPA' is not present in the earlier mark, given my assessment of the relative weight the word plays in the overall impression of the contested mark, this difference is not significant. I assess the aural similarity as high.⁸

Conceptual similarity

30. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁹ The Opponent submits that "*both trade marks are derived from the Sanskrit word 'Ātman', which refers to a sense of self, the soul and consciousness. The marks are therefore also conceptually identical.*"¹⁰ I do not think this meaning would be well known to the average UK consumer of the services at hand, and 'ATMA' is likely to be perceived as an invented word – in which case the concept of the word 'ATMA' is neutral; or in the alternative it may be perceived as a person's name – if it is perceived as such, the concept of 'ATMA' would be identical for both marks.

31. The word 'SPA' in the contested mark has a clear concept, however, this word has very little relative weight. The word 'SPA' does not add or alter the conceptual message (if there is one) provided by the word 'ATMA'. Consequently, I find the marks to be conceptually identical or at least very highly similar. Where the average

⁷ See the recent appeal decision by Philip Harris, sitting as the Appointed Person, in *Purity Wellness Group Ltd v Stockroom (Kent) Ltd*, Case BL-O/115/22, it was determined that "*descriptiveness does not of itself render an element negligible or aurally invisible*".

⁸ Ibid.

⁹ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

¹⁰ See the Opponent's submissions in lieu dated 26 May 2023, paragraph 19.

consumer is not familiar with the meaning of the word 'ATMA' then the earlier mark has no concept, and the contested mark only has the clear concept of a 'SPA' which would be derived from that word alone.

Distinctive character of the earlier trade mark

32. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be, although it is the distinctive character of a component that is similar between the marks that is particularly relevant.

33. 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.

34. The Opponent makes no claim to enhanced distinctiveness through the use made of the earlier mark, and has filed no evidence of use, therefore I only have the inherent distinctiveness of the mark to consider.

35. Despite the Opponent's submission on the meaning of the Sanskrit word from which 'ATMA' is said to derive, it cannot be said that 'ATMA' is an ordinary word that would be readily understood. It is more likely to be viewed as an unusual name or indeed an invented word and it makes no descriptive or allusive reference to the services.

36. I find that the earlier mark is inherently distinctive to a high degree.

Conclusions on Likelihood of Confusion

37. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.¹¹ I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that a lesser degree of similarity between

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.¹²

38. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.¹³ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.¹⁴

39. Confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect, which is where the consumer notices that the marks are different, but the later mark and the earlier mark share common elements that lead the consumer to conclude that it is another brand of the owner of the earlier mark.¹⁵

40. I have found that the applied-for services are identical to terms contained in the Opponent's Class 44 services. I have also found that the marks are similar visually and aurally to a high degree and potentially (depending on perception) are conceptually identical or at least similar to a very high degree.

41. I have found that the word 'SPA' in the contested mark is non-distinctive and descriptive in relation to the services at hand, and that very little weight will be attributed to that word by the average consumer, as such the overall impression of the mark is dominated by the word 'ATMA' which is identical to the earlier mark.

42. The distinctiveness of the earlier mark lies solely in the word 'ATMA' which I have found to be distinctive to a high degree on an inherent basis.

43. Taking all the above factors into consideration, and allowing for imperfect recollection, whilst bearing in mind the principle of interdependency, I find that the

¹² *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

¹³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

¹⁴ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

¹⁵ See *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16 to 17 wherein Mr Iain Purvis QC, sitting as the Appointed Person, dealt with the distinction between direct and indirect confusion

average consumer – or at least a significant proportion thereof – will mistake one mark for the other and be directly confused as to the origin of the services.

OUTCOME

44. The opposition under section 5(2)(b) of the Act is successful. Subject to any appeal, contested trade mark application number 3863017 shall be refused registration.

COSTS

45. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £500 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee for filing Form TM7F	£100
Preparing the Statement of Grounds and considering the Counterstatement	£200
Preparing written submissions	£200
TOTAL	£500

46. I therefore order Eliiza Beauty Professional Ltd to pay Aman Group S.à.r.l. the sum of **£500**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of August 2023

Daniela Ferrari

For the Registrar

Annex

Opponent's services

I note that the Class 44 services emphasised in emboldened font, are the services the Opponent put forward as its best case comparison between the respective services.

Class 35
Advertising; retail purposes (presentation of goods on communication media, for -); retail services namely services provided within the framework of a retail business (in a shop or by mail order, including online retailing on the Internet) of items of cosmetics, perfumery, essential oils, skin care products and preparations [non-medicated], bath salts, body care products and preparations [non-medicated], hair care products and preparations [non-medicated], incense, electronic publications [downloadable], printed publications in electronically readable form, sound and video recordings, decorative magnets, digital photo frames, sunglasses, camera straps, cases for electronic devices, printed matter, printed publications, books, magazines [printed publications], guide books, guide leaflets, guide magazines, stationery, writing Instruments, wrapping paper for gifts, paper napkins, passport holders, boxes of paper or cardboard, paper or plastic packaging materials, table decorations, paintings, photographs and photograph albums, jewellery, articles of clothing, underwear, footwear, headgear and fashion accessories, home furnishings, interior decor for the home, furniture for both interior and exterior design, kitchen utensils, gardening items, textiles; retail services in relation to furniture; business management of hotels; hotel management service [for others]; business management of resort club; organisation and management of customer loyalty programmes; commercial administration of licensing the goods and services of others; organisation of exhibitions for commercial or advertising purposes; personnel management agencies; office functions.
Class 36
Real estate services; provision of housing accommodation; provision of information relating to real estate property; real estate property leasing; real estate property management; real estate property consultancy services; real estate agency services; real estate property brokerage services; real estate development services; real estate management services.
Class 39
Arranging of cruises; cruise reservation services; cruise ship services [travel]; provision of cruises in yachts and other types of boats; travel guide services; booking of seats for travel; travel reservation; transport of travellers; chauffeur services; car rental; car parking; travel booking agency services; arranging tours and transportation; arranging of travel and sightseeing tours; agency services for arranging travel.

Class 44

Healthcare services; medical clinic services; medical and healthcare clinics; medical services; physician's services; medical x-ray services; arranging medical treatment; diagnostic imaging services and ultrasonography; clinical diagnostic services; emergency medical assistance; medical treatment services provided by clinics and hospitals; medical counselling; medical analysis services; medical health assessment services; medical and physical examination of individuals; preparation of reports relating to health care matters and medical matters; providing information in the field of prevention, diagnosis and management of diseases; medical services in the nature of pre-travel advisory services and post travel health care; complementary medical services; lifestyle counselling for medical purposes; medical screening; health screening services; pharmacy dispensary services; **spa services; health spa services; medical spa services; medical treatment services provided by a health spa; nutritional advisory services; health resort services [medical]**; weight management programmes; dietetic counselling services [medical]; acupuncture; acupressure therapy; alternative medicine services; chiropractic services; physiotherapy services; **cosmetic facial and body treatment services**; cosmetic surgery; dentist services; massage services; nursing services; provision of exercise facilities for health rehabilitation purposes; rental of equipment for medical purposes; **sauna; solarium and sun tanning facilities; massage services; health care relating to therapeutic massage; skin care services; beauty treatment services; slimming treatment services; hair care services; pedicure and manicure services; beauty salons; hair dressing salons**; dietary and nutritional guidance for health; information, advisory and consultancy services related to all of the aforementioned.