

O/0850/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004114200
BY ELITE OUD LTD
TO REGISTER:

Barakkat

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 451925
BY BACCARAT (SOCIÉTÉ ANONYME)

BACKGROUND AND PLEADINGS

1. On 20 October 2024, Elite Oud Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 22 November 2024 in respect of the following goods:

Class 3: *Perfumes; Eau de toilette; Eau de parfum; Eau de Cologne; Perfumery products; Cosmetics; Perfume oils; Perfumery and fragrances; Cologne; Aromatics for fragrances; Perfumery; Extracts of perfumes; Body deodorants [perfumery]; Eau de cologne [cologne water]; Body fragrances; Perfumeries; Room perfumes in spray form; Room fragrances; Scented body spray; Scented room sprays; Eau de colognes; After-shave; Fragrance for household purposes; Perfumery, essential oils.*

2. On 14 January 2025, the application was opposed in its entirety by BACCARAT (Société Anonyme) (“the opponent”) based upon Sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon, and claiming reputation for, the following mark:

UK00913429361¹

BACCARAT ROUGE 540

Filing date: 04 November 2014

Registration date: 31 March 2015

Class 3: *Perfumery, Cosmetics, Creams, Milks, Lotions; Gels and powders for the face, the body and the hands; Skincare cosmetics, Creams (Cosmetic -), Pomades for cosmetic purposes, Lotions for cosmetic purposes; Facial and body creams and lotions; Non-medicated lotions; Oils for cosmetic purposes, Almond milk for*

¹ This is a comparable mark based on earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTM. This comparable mark enjoys the same filing and registration dates as its European counterpart.

cosmetic purposes; Cosmetic kits, Cotton wool for cosmetic purposes; Sun protection preparations (cosmetic sun tanning preparations), Sun-tanning preparations [cosmetics]; Baths (Cosmetic preparations for -), Cosmetic kits, Bath salts and gels, not for medical purposes; Massage oils and gels, not for medical purposes; Antiperspirants [toilettries]; Deodorant soap, deodorants for personal use (perfumery); Perfumery, Room perfumes, Perfume water, Lotions (perfumery), Flower perfumes (Bases for -); Eau de Cologne, Perfume water, Eau de Cologne, Musk (perfumery), Essential oils, Essential oils, Extracts of flowers (perfumes), Oils for perfumes and scents, Oils for toilet purposes, Almond oils, Jasmine oil, Lavender oil, Rose oil; Cleansing milk for toilet purposes, Cosmetic masks, Skin whitening creams; Make-up, Make-up removing preparations, Face powder, Make-up, Lipstick, Mascara, Eyebrow pencils, Eyebrow pencils; Nail polish, Toilettries, Colorants for toilet purposes, Colorants for toilet purposes; Soaps, Soap, Dentifrices, Talcum powder, for toilet use; Hair lotions, shampoo; Shaving preparations, After-shave preparations; Incense, scented wood; Depilatories; Cleaning, polishing, scouring and abrasive preparations.

Class 4: Bougies, Perfumed candles, Candles, Candles, Night lights (candles), Christmas lights [candles], Illuminating wax, Fuels, Lighting fuel, Wicks for candles.

3. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an earlier mark in accordance with Section 6 of the Act. The opponent's earlier mark had been registered for more than five years at the filing date of the contested mark, and as such, it is caught by the use conditions under Section 6A of the Act.

4. Under Section 5(2)(b), the opponent relies on the goods highlighted in grey, and claims that there is a likelihood of confusion because the marks are highly similar and the goods are identical.

5. Under Section 5(3), the opponent relies on the goods in underline and claims that it has developed a significant reputation in the earlier mark through its extensive use in the UK. The opponent also submits that the marks are closely similar and that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's mark.

6. Under Section 5(4)(a), the opponent relies on a sign which is identical to the earlier mark claiming that it has been used throughout the UK since 2014 in relation to: *Perfumery, Room perfumes, Perfume water, Lotions (perfumery), Flower perfumes (Bases for -); Eau de Cologne, Perfume water, Eau de Cologne, Musk (perfumery), Extracts of flowers (perfumes), Oils for perfumes and scents, After-shave preparations. Perfumed candles, Candles, Candles, Night lights (candles), Christmas lights [candles]*. The opponent claims that registration of the application will be contrary to the law of passing off.

7. The opponent's case under Section 3(6) is essentially that the applicant was aware of the opponent's reputation (with the implication that it copied the earlier mark). It stated:

"The Opponent submits that the Application should not be granted on the basis that, when filed, the Application was made in bad faith. The Opponent enjoys substantial reputation and goodwill in its mark for products sought for protection by the Applicant. In the course of these proceedings, the Opponent will demonstrate that its mark has been in longstanding use and that the Application was made with the clear intention of confusing consumers. The Opponent will also demonstrate during the proceedings that, at the time the Application was filed, the Applicant must have been aware of the Opponent's high degree of recognition and its business. Therefore, the Opponent requests that the Application be refused in its entirety on the basis of Section 3(6) of the Act".

8. The applicant filed a defence and counterstatement denying the claims made and putting the opponent to proof of use.

9. The applicant is represented by Bird & Bird LLP, and the opponent is represented by Venner Shipley LLP.

10. Only the opponent filed evidence. Neither party requested a hearing, but they both filed written submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

11. 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.

EVIDENCE

12. The opponent's evidence came in the form of a witness statement from Laurence Nicolas dated 27 June 2025. Mr Nicolas is the CEO at the opponent's company, and his witness statement is accompanied by ten exhibits, being those labelled Exhibits LN1 – LN10.

13. I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

DECISION

PROOF OF USE

Relevant statutory provision: Section 6A:

“(1) This section applies where

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

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

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

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

14. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

15. I have already set out the proof of use provisions as they relate to oppositions. The relevant period for the purpose of the present opposition is the five years ending with the filing date of the application for the contested mark (21 October 2019 to 20 October 2024).

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others

which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

17. Proven use of a mark which fails to establish *that “the commercial exploitation of the mark is real”* because the use would not be *“viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”* is, therefore, not genuine use.

18. I take the following from the opponent’ evidence:

19. The opponent is a French company founded in 1764. While the opponent’s activities first involved the manufacture and sale of crystal and of a variety of glasswork (vases, mirrors, stemware, glass, chandeliers, perfume bottles), the opponent later broadened its activities to, amongst other things, the sale of perfumes and candles.

20. In 2014, to celebrate its 250th anniversary, the opponent, in collaboration with Maison Francis Kurkdjian, introduced a fragrance under the brand name “Baccarat Rouge 540”. In the same year, the opponent commenced the sale of candles under the mark. The mark has been continuously used in the UK for these products since 2014.

21. In the UK, the opponent conducts its trading activities via a UK company called “Baccarat UK Limited” (company number 03226955), which is a 100% subsidiary of the opponent. Baccarat UK Limited trades under the name “Baccarat” (or sometimes “Baccarat Harrods” since it mainly trades inside Harrods) and uses the mark under a licence.

22. In addition, the opponent sells its goods in the UK through its website baccarat.com/en_gb/ and a third-party company called “Maison Francis Kurkdjian” which uses the opponent’s earlier mark under a licence. The opponent’s goods are then sold to, and distributed by, re-sellers including well-known UK retailers such as Superdrug, House of Fraser, Tesco, Selfridges & Co., Harvey Nichols, John Lewis, and Fenwick.

23. In terms of marketing spend, Mr Nicolas provides the following table outlining the opponent’s and its licensees’ marketing spend:

Period	Spend in the UK
19 November 2018 – 22 December 2018 Christmas holiday theme	€19,914
20 January 2020 – 3 February 2020 Winter theme	€7,578
01 June 2022 to 31 July 2022	€239,309

24. In terms of turnover, Mr Nicolas provides the following table outlining the revenue generated in the UK in the six-year period 2019-2024:

Year	Revenue in the UK
2019	In excess of € 24,000
2020	In excess of €24,000
2021	In excess of € 25,000
2022	In excess of € 21,000
2023	In excess of € 23,000
2024	In excess of € 26,000
Total	In excess of € 124,000

25. These figures are not broken down by products. However, since Mr Nicolas refers to both perfumes and candles, the turnover must include revenue generated by the sale of both types of goods. He states:

“ the Goods and the Reputed Goods are placed in the luxury end, if not beyond the luxury end, of the fragrance market. As shown in page 13 of Exhibit

LN1, as by way of example, a 200ml bottle of the Opponent's perfume is advertised for sale at £675 and at page 15, the Opponent's candle is advertised for sale at £480"

26. The rest of the evidence includes sample invoices,² as well as copies of press articles mentioning the opponent's goods sold under the earlier mark. As noted by Mr Nicolas in his witness statement, some of these magazines and newspapers have high circulation numbers and are well known in the UK, including Marie Claire, Elle, Glamour, Vogue and the Independent.

Assessment of Genuine use

27. Admittedly, the opponent's evidence contains a number of deficiencies and inconsistencies; before I turn to them, I will address the applicant's criticisms.

28. The applicant's three main criticisms of the opponent's evidence are that (1) it is either undated or dated outside the relevant period; (2) it shows another mark, i.e. 'MAISON FRANCIS KURDJIAN' used prominently and (3) the earlier mark will not be perceived as indicative of the origin of the goods.

29. In addition, the applicant pointed out that there are a number of issues with the way the evidence ties together with the statements made in Mr Nicolas' witness statement. In particular, the applicant noted that:

- a) The size of the marketing spend is negligible, save for one alleged campaign in 2022. However, there is nothing in the exhibits to the witness statement that relates or connects to a campaign within that period, so the alleged marketing has not been proven.
- b) The relevant period being 21 October 2019 to 20 October 2024, the expenditures for the 2018 Christmas holiday theme should be disregarded because they fall prior to the relevant period.

² LN8

- c) The spend is listed in € rather than £, which casts doubt on whether it has actually been made in the UK.
- d) The alleged large-scale advertising referred to in the witness statement does not tie in with the very small figures given for marketing expenditure.
- e) It is stated that a bottle of perfume costs £675, but the total revenue for any one year does not exceed €26,000 (for 2024). Converting this to GBP gives a 2024 revenue figure of around £22,500. If a bottle of perfume costs £675, that means a maximum of 33 bottles of perfume were sold in 2024 - and that is the year with the highest purported revenue.
- f) Looking at 2020, the sales were stated to be €24,000, which at current exchange rates is under £21,000 - and at £675 a bottle would mean maximum sales of 31 bottles. This does not tie in with the invoices included at exhibit LN8. For example, the invoice at page 13 of exhibit LN8 (from 2022) shows sales of a total of well over 600,000 products. I reproduce the invoice below:

INVOICE

Date	Invoice Number	Customer	Reference	Order Num
12/10/2020	7519	CORANGES	11432	50

Reference	Description	Quantity	Uni
BACCARAT ROUGE 540 EdP Travel refills 3*11ml			
1042305	BACCARAT ROUGE 540 EXTRAIT Refills 3*11ML	60,000	
BACCARAT ROUGE 540 Extrait Travel refills 3*11ml			
1CM23002	BACCARAT ROUGE 540 Extrait Travel set 5*11ML	192,000	
BACCARAT ROUGE 540 Extrait Travel set 5*11ml			
1042306	BACCARAT ROUGE 540 EXdP 11ML	90,000	
BACCARAT ROUGE 540 Extrait Travel refill 11ml			

021202	BACCARAT ROUGE 540 Scented body cream 250ML	210,000
BACCARAT ROUGE 540 Scented body cream 250ml		
041203	Baccarat Rouge 540 - Scented hair mist 70ml	222,000
BACCARAT ROUGE 540 Scented hair mist 70ml		
031203	Baccarat Rouge 540 - Scented body oil 70ml	192,000

The applicant argues that as a consequence of these discrepancies, the use shown in the exhibits cannot relate to sales by or with the permission of the opponent - the differences between the sales shown in the statement and the material in the exhibits mean that use has not been shown.

- Even if the revenue figures shown in the witness statement are accepted, they do not show sufficient use to demonstrate that the opponent has made genuine use in the UK in the relevant period - 33 bottles of perfume being sold in their best year (and lower numbers in each other year of the relevant period) is not an acceptable level of sales for the perfume industry.

Form of the mark

30. The first point I need to address is about the use of the earlier mark 'BACCARAT ROUGE 540', in conjunction with the mark 'MAISON FRANCIS KURDJIAN'.

31. The applicant says that such use is not acceptable because 'BACCARAT ROUGE 540' will not be given any trade mark significance due to the prominent use of 'MAISON FRANCIS KURDJIAN'. I disagree. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("CJEU") found that:

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

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

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

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

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

32. In the present case, whilst the opponent's earlier mark is used on the goods along with another mark, it is displayed prominently and independently as the name of the perfume (see below), the other mark indicating co-branding. Further, there are plenty of examples of the mark 'BACCARAT ROUGE 540' being used on its own both in a word or slightly stylised format (which is an acceptable variant) on invoices, online and instore as shown by the two examples I have reproduced below:



BACCARAT ROUGE 540 EAU DE PARFUM 35 ML
Price on demand

Hence, the way the opponent's mark is used means that it will continue to be perceived as indicative of the origin of the goods and it is acceptable use of the registration.

Assessment of genuine use

33. I bear in mind the applicant's submission that the figures provided in the witness statement are not substantiated in documentary evidence by way of exhibits and do not tally with the number of units sold as shown by the invoices. However, Mr Nicolas' statement is signed with a statement of truth, and the applicant did not challenge the truthfulness or reliability of this evidence during the evidence rounds, nor has it requested cross examination. Consequently, it is not now appropriate for the applicant to invite me to disregard this evidence.

34. Having said that, I have to concede to the applicant that there are a number of inconsistencies and deficiencies that jump out from the evidence. The first issue is that the opponent failed to produce a breakdown of sales, so it is impossible to allocate any portion of the €124,000 turnover to any product. In this connection, the disparate nature of the evidence and the lack of breakdown for the turnover are a significant hurdle when it comes to determining the issue of genuine use. In *Eros Bodyglide* (BL O/0984/25), Professor Phillip Johnson, sitting as the Appointed Person, stated as follows:

“26. Where global sales figures are provided for multiple goods sold under one trade mark this is not going to be evidence of use for any of those goods. The sales could all be in relation to good A or all in relation to good B or a split between the two. This is why particularisation is so important as without it the figures provide no evidence of use for either good A or good B. The same applies where the same good is sold under trade mark A and trade mark B.

27. Evidence of sales is only useful for establishing genuine use where it sets out the sales revenue for a particular and identified good (or service) and it is clear that that good or service is sold under the trade mark. Only where there is only one good being sold and it is sold under only one trade mark can global figures be sufficient.

28. In this case, Mr Sternoff makes it clear that the sales figures are “across the full range of Body Glide products” (Witness Statement, [51]). This evidence in itself means that the global figures do not establish use”.

35. In the present case, although the evidence indicates that the opponent sells various types of goods under the earlier mark, the range of goods shown by the exhibits is very limited, being restricted to perfumes, candles, body lotions, oils and hair mists. Further, the marketing material exhibited in evidence clearly indicates that the focus of the opponent’s use is overwhelmingly in relation to perfumes. This is shown, for example, by the following:

- a) Printouts from the opponent's website as well as from third party websites showing the opponent's goods available for sale under the mark 'BACCARAT ROUGE 540'; most of the goods on offer are perfumes.³
- b) A report outlining the licensee's activities for the third quarter of the year 2022.⁴ The document provides evidence of the opponent's perfumes being sold under the mark 'BACCARAT ROUGE 540' in all major shopping centres across the UK, including Harrods, Harvey Nichols, John Lewis and Selfridge. Locations include London, Birmingham, Newcastle, Bristol, Milton Keynes, Edinburgh, Leeds, Liverpool, Stratford, and Newcastle. I reproduce below an image showing the way the goods are advertised, as well as images showing how the goods are prominently displayed instore and on Harrods shop windows and grand staircase:

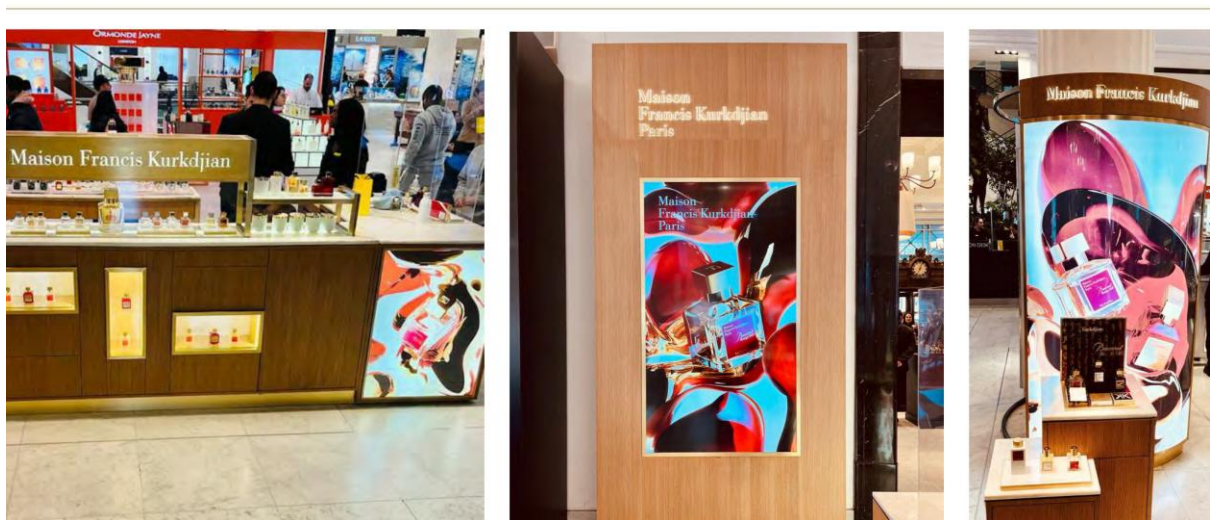
rkdjian

Baccarat
Rouge 540



³ LN1-4

⁴ LN4



Selfridges, London



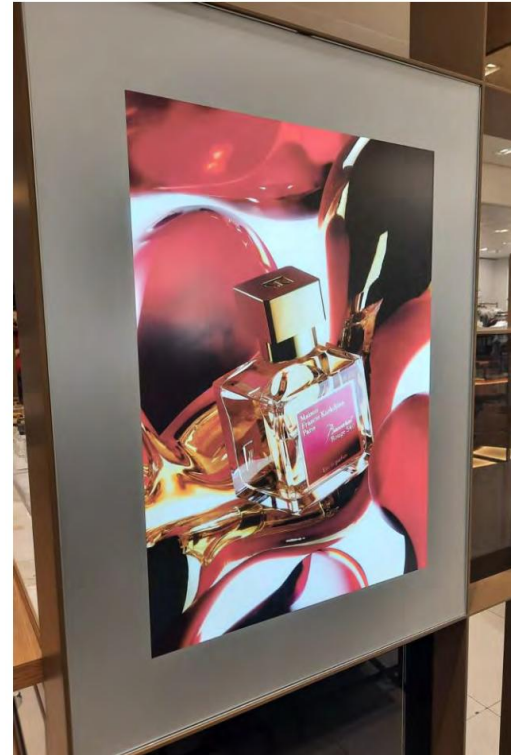
Selfridges, Birmingham



H Beauty, Newcastle



Harvey Nichols, Bristol



John Lewis, Liverpool

HARRODS DOOR 3 SITE

Harrods M
F
P

Chris to send photo with window lighted



Harrods shop windows



Harrods grand staircase

Although the document is undated, Mr Nicolas says that it reports on the licensee's activities for the third quarter of the year 2022 (which falls within the relevant period) and I have no reason to disbelieve him. Significantly, this evidence shows a huge marketing effort to promote the opponent's goods in many leading luxury department stores across the country. Indeed, such marketing effort must have attracted significant marketing investment which is at odds with the low marketing figures for 2018 and 2020. However, bearing in mind that this promotional activity took place in the third quarter of 2022 (July, August and September), it is consistent with the big increase in marketing spend recorded for the period 1 June 2022 to 31 July 2022 which amounted to just over 239,000 euros.

- c) Copies of printed and online articles from magazines promoting the opponent's goods dated within the relevant period including the following: Arcadia (summer 2022, circulation figure 100,000), Net-a-Porter (June 2022, circulation figure 350,000), Marie Claire (June 2022, circulation figure 1,2 million), Get the Gloss (June 2022, circulation figure 500,000), Bazaar (July 2022, circulation figure 390,000), Glamour (July 2022, circulation figure 2.5million), Harrods (July 2022, circulation figure 2.8 million), Grazia (July 2022, circulation figure 400,000), the Independent (July 2022, circulation figure nearly 800,000).⁵ Significantly, those articles are dated June and July 2022 which, once again, tallies with the big marketing campaign launched in that period. Similar evidence showing social media posts from influencers dated within the same period (ie. June/August 2022) relates mostly to perfumes.⁶

Admittedly, there a few articles and social media posts promoting the opponent's scented candles, scented oils, and scented body creams under the mark 'BACCARAT ROUGE 540'. However, these goods are all scented with the perfume 'BACCARAT ROUGE 540' which is the key product; this leads to the conclusion that they are scented-based products deriving from the perfume. The same goes for other marketing material, which is also dated within the relevant period, and confirms that the scent-related goods are part of a marketing strategy centered around the 'BACCARAT ROUGE 540' perfume. Whilst this shows use of the mark in relation to the scented goods, it also corroborates the conclusion that the main product is the perfume.

- d) Sample invoices; most of the goods sold are perfumes.

36. Given the above, I am of the view that the lack of specific sales figures for each type of product sold is not fatal, and it can reasonably be concluded that most of the sales that took place during the relevant period relate to perfumes.

37. As for the low level of sales, admittedly it is at odds with the evidence about promotional activities which is quite strong, both in terms of the marketing campaign

⁵ LN4

⁶ LN4

run in the summer 2022, and of the offering of the goods through major UK retailers and/or luxury department stores. However, even ignoring the discrepancies with the invoices which show a much higher level of sales, I consider that a turnover of £124,000 would be sufficient in this case to establish genuine use because:

- Whilst Mr Nicolas says that, by way of example, the opponent's perfume is advertised for sale at £675, the evidence clearly shows perfume goods sold at a lower price, from £16, to £42, to £55, to £75 to £95, to £155, to £355, £485, etc. Hence, I reject the applicant's conclusion that all the products sold were priced at £675 which would translate into a low level of units sold.
- Whilst the relatively low level of sales indicated in the evidence does not tally with the invoices, or with the picture painted by the evidence of a luxury brand of perfumes sold by major UK department stores and acknowledged by major UK magazines, the marketing efforts are clearly there. Further, since the point about the level of sales was not raised by the applicant until its final submissions, the opponent was not given the chance to explain these inconsistencies, and neither can I conclude that the sales figures given by Mr Nicolas are incorrect. Indeed, the invoices suggest that they are, because they show a much higher level of sales. Further, an article from www.whowhatwear.co.uk (circulation figure 27million) dated 26 January 2022 describes BACCARAT ROUGE 540 as *"the most covetable perfume of 2021 after going viral on TikTok"* and reviews it as one of the UK's 25 bestselling beauty products saying that it is many celebrities' favorite.⁷

38. Bearing in mind all of the above, I conclude that the following factors (i) the intensity and geographical spread of the use made, (ii) the marketing spend, (iii) the promotional activities, (iv) the availability of the goods through major UK retailers, (v) the acknowledgment of the goods by well-known UK magazines, (vi) the review of the goods as one of *"the UK's 25 bestselling beauty products"* and *"the most covetable perfume of 2021"*, are sufficient to counterbalance the relatively low sales figures, and there has been genuine use in relation to *perfumes* (which are covered by the

⁷ LN7 page 34

registered term *perfumery*). I also consider that the other goods marketed by the opponent warrant a finding of genuine use in relation to *scented oils*, *scented body creams*, *scented hair mists*, *extraits de perfume* and *perfumed candles* as shown by another article from www.whowhatwear.co.uk dated 7 January 2022⁸ which reproduces the line of goods marketed under the mark as those I have listed above:

WHO WHAT WEAR

Everyone I Know Asks Me Whether This £215 Perfume Is Worth the Money

by SHANNON LAWLER

Throughout my many years as a beauty editor, I have asked hundreds, if not thousands, of people what *perfume* they are wearing. I pride myself on being able to sniff out specific perfumes from across the room. The first time I ever stepped foot in the Who What Wear offices, the aroma of Chanel Chance Eau Fraîche filled the air. The person who sat next to me in a restaurant last week wore Jo Malone Wood Sage and Sea Salt. The mum of two that I sit opposite on the train most days is a big fan of both Marc Jacobs Daisy and Yves Saint Laurent Black Opium.

It is because of this slightly odd talent we beauty editors have that our perfume collections comprise mostly of under-the-radar scents. We all get a quiet kick out of knowing that our fragrance choices could stump even the most in-the-know of perfume buffs. For the most part, our taste in perfume is expensive. We get sent perfumes from all over the world, and it just so happens that the ones we tend to keep for ourselves are unique and different and therefore come with unique and different price tags.

So imagine my surprise when, a few months ago, someone stopped me in the street to ask if I was wearing Maison Francis Kurkdjian Baccarat Rouge 540. I spluttered my coffee, pulled myself together and politely replied that yes, indeed I was. After some casual chit-chat on its beauty, I swallowed my pride and asked her how she was so familiar with it. "I saw it on TikTok and just had to buy a bottle," she said.

From that moment on, I have smelled Baccarat Rouge 540 often. And while I am over the moon that this previously under-the-radar, but very much coveted, perfume is getting the praise it finally deserves, my overwhelming emotion is one of surprise. Maison Francis Kurkdjian is not your standard perfume brand. It's luxe. *Really* luxe. In fact, a 70-millilitre bottle of Baccarat Rouge 540 will set you back a cool £215. Discovering its new-found fame came courtesy of TikTok, an app that is considered one of the best ways to discover *affordable* beauty dupes.

Now, I can barely go a day without receiving a DM or having a friend ask me whether Baccarat Rouge 540 is worth the money, so I thought I'd share my advice here. In short: Yes, this perfume is worth every penny of its price tag. It smells unlike anything you will have ever smelled before. It's warm, comforting and a little bit sweet. With a blend of jasmine, saffron, cedarwood and fir resin, it's difficult to pull out any individual note. Instead, they all blend together to create one of the most beautiful perfumes I have ever smelled.

It's inoffensive enough to be worn in the day with a cosy jumper or white shirt yet unique and powerful enough to finish off any evening look. In my opinion, there is no individual who wouldn't be absolutely smitten with it. And as for the price, yes, it's eye-wateringly expensive, but artisanal perfumery like this should be. It smells as expensive as it is and makes you feel indescribably wonderful. Honestly, if I were going to recommend spending £215 on any beauty product, it would hands down be this one.



Maison Francis Kurkdjian Baccarat Rouge 540 Eau de Parfum (£215)

Shop More Maison Francis Kurkdjian Baccarat Rouge 540 Products



Maison Francis Kurkdjian Baccarat Rouge 540 Eau de Parfum (£215)



Maison Francis Kurkdjian Baccarat Rouge 540 Scented Candle (£76)



Maison Francis Kurkdjian Baccarat Rouge 540 Body Cream (£70)

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Maison Francis Kurkdjian Baccarat Rouge 540 Hair Mist (£75)



Maison Francis Kurkdjian Baccarat Rouge 540 Body Oil (£90)



Maison Francis Kurkdjian Baccarat Rouge 540 Extrait de Parfum (£320)



Maison Francis Kurkdjian Baccarat Rouge 540 Extrait de Parfum (£320)

The terms *perfumes*, *scented oils*, *scented body creams*, *scented hair mists*, *extraits de perfume* are all covered by the registered term *perfumery* which covers not just perfumes but also perfumed goods (this is relevant for both Section 5(2)(b) and Section 5(3)). However, the term *perfumed candles* is only relevant for the claim under

⁸ LN7 page 32

Section 5(3) ground). Accordingly, the opponent can rely on the following fair specification:

Class 3: *perfumery, namely perfumes, scented oils, scented body creams, scented hair mists, extraits de perfume.*

Class 4: *Perfumed candles*

Section 5(2)(b)

39. 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.”

40. 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 greater 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

41. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

42. 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.

43. In *Kurt Hesse v 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 General Court (“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.”

44. 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. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that the responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/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.”

45. 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.”

46. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the 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 für 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.”

47. The competing goods are as follows:

The applicant's for goods	The opponent's goods
Class 3: <i>Perfumes; Eau de toilette; Eau de parfum; Eau de Cologne; Perfumery products; Cosmetics; Perfume oils; Perfumery and fragrances; Cologne; Aromatics for fragrances; Perfumery; Extracts of perfumes; Body deodorants [perfumery]; Eau de cologne [cologne water]; Body fragrances; Perfumeries; Room perfumes in spray form; Room fragrances; Scented body spray; Scented room sprays; Eau de colognes; After-shave; Fragrance for household purposes; Perfumery, essential oils.</i>	Class 3: <i>perfumery, namely perfumes, scented oils, scented body creams, scented hair mists, extraits de perfume.</i>

48. The following goods in the applicant's specification are self-evidently identical or identical on the *Meric* principle to the opponent's *perfumery, namely perfumes, scented oils, scented body creams, scented hair mists, extraits de perfume*:

Perfumes; Eau de toilette; Eau de parfum; Eau de Cologne; Perfumery products; Cosmetics; Perfume oils; Perfumery and fragrances; Cologne;

Perfumery; Extracts of perfumes; Eau de cologne [cologne water]; Body fragrances; Perfumeries; Eau de colognes; Perfumery, essential oils.

In particular, I consider that the contested term *cosmetics* would include body creams which can have beautification properties as well as being scented. These goods are identical.

49. Body deodorants [perfumery]; Scented body spray; Aromatics for fragrances.

These are goods that come in a liquid, concentrated or spray form and people put on their bodies to make themselves smell pleasant. Although the goods have a different nature and method of use (aromatics for fragrances also being used as ingredients as well as perfumes in the same manners as extracts of perfumes) they have the same uses and purpose, target the same users, are distributed through the same trade channels and can be found in close proximity, and are competitive, though they are not complementary. I consider these goods to be similar to a high degree.

50. After-shave. These goods include scented goods which contain the same scent as a perfume. In addition, the evidence filed by the opponent is consistent with my experience that producers of perfumes normally sell additional scented goods as part of a marketing strategy centred around the perfume as the key product, i.e. scented body creams (which I have found fall within the broad term *cosmetics*). The same would apply in my view to *after-shaves*, which can be scented. Although aftershaves and perfumes have a different nature, purpose, use and method of use, they are normally produced by the same undertaking, target the same users, are distributed through the same trade channels and are found in close proximity (or are sold in gift sets); in addition, whilst the goods are not complementary, they are competitive to a degree. I consider these goods to be similar to a medium degree.

51. Room perfumes in spray form; Room fragrances; Scented room sprays; Fragrance for household purposes.

The listed goods can be described generally as household products, room fragrances and sprays used to fragrance the home or linen. They are all products which enhance the scent of a room or soft furnishings by emitting perfume from various sources be it dispensed via reeds, sachets, wicks or an atomiser of some sort or used when washing. Whilst the nature and methods of use of these goods differ

to the opponent's perfumes where one is worn on the body as opposed to being used in the home, they overlap in general overall purpose to enhance the fragrance of something or someone. Consequently, the respective goods overlap in users and channels of trade although they would not necessarily be sold in close proximity to each other – the one sold at the cosmetic counter of retail outlets, for example, where the other in the household section. I accept however that consumers would purchase a signature scent across an array of products to include scented candles (like in the opponent's evidence), diffusers and home fragrances, to enhance the scent of the home as well as the individual. I consider that the goods are similar to a low degree.

Average consumer

52. 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.

53. In *Iconix Luxembourg Holdings* (cited above), 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:

- (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 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.

54. The average consumer of the competing goods in class 3 is a member of the general public. The goods are most likely to be the subject of self-selection from retail outlets, websites or catalogues. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount an aural component to the purchase, particularly when advice is sought from a sales representative, or a purchase is made further to word-of-mouth recommendations.

55. The cost of the purchase is likely to vary, but, overall, they will be relatively inexpensive, perfumery and cosmetic goods covering both high-priced goods and cheaper versions that offer the same experience. I find that consideration will be given to the smell of the goods, as well as to their ingredients. Taking the above factors into account, I find that the average consumer will demonstrate a medium level of attention in respect of these goods.

Comparison of marks

56. 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 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.”

57. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applied-for mark	The opponent's mark
	BACCARAT ROUGE 540

The applicant's mark

58. The applicant's mark is a figurative mark consisting of the word 'BARAKKAT' presented in a slightly stylised cursive font. Whilst the font used has a visual impact, it is minimal, and the dominant and distinctive element of the mark is the word 'BARAKKAT'.

The opponent's mark

59. The opponent's mark is a word mark consisting of the two words 'BACCARAT ROUGE' and the number '540'. The opponent states that the most distinctive element of its mark is the word 'Baccarat' because consumers tend to focus on the beginning of marks and 'BACCARAT' will be noticed first. It also states that while the registration contains additional elements, such as "Rouge" and "540", these elements are clearly secondary because (a) the word 'ROUGE' will be understood by most UK consumers as meaning "red" in French and will be seen as a descriptive reference to the red used by the opponent for its products (as shown in the evidence) and (b) the number '540' is placed at the end of the mark and will thus receive far less attention.

60. I agree with the opponent that 'BACCARAT' is the most distinctive element because it is placed at the beginning of the mark, it is longer than the other elements, and it is inherently high in distinctiveness. Whilst the word 'BACCARAT' appears in Collins online dictionary as having the meaning of "*a card game in which two or more punters gamble against the banker*", this definition shows the lowest frequency band; further, 'BACCARAT' does not appear in Cambridge online dictionary, confirming my impression that it is not a popular word used in the UK. In this connection, whilst 'BACCARAT' might be a card game, there is no evidence as to how popular it is in the UK; in particular, there is no information about when the game was launched, if it is still available for sale, by whom it is played (for example in casinos or house parties). No doubt, some people are aware that 'BACCARAT' is the name of a card game, but that is not sufficient to impute such knowledge to the average consumer of perfumes in the UK. Accordingly, based on the absence of a dictionary definition of 'BACCARAT' in Cambridge online dictionary (which is one of the most popular English dictionaries), and the low frequency band indicated by Collins online dictionary, I consider that most average consumers of perfumes will perceive 'BACCARAT' as an invented word, or a word of foreign origin with a high degree of distinctiveness.

61. If I am wrong, and a significant proportion of the relevant public will understand 'BACCARAT' as the name of a card game, an equally significant proportion of the relevant public will not. Since in circumstances where there are more than one group of consumers, for likelihood of confusion to arise, it is sufficient that a group of consumers (who represent a significant proportion of the relevant public) is confused, and I found that at least a significant proportion of the relevant public will perceive

'BACCARAT' as invented, I will proceed on this basis which is the best case scenario for the opponent (as in this case 'BACCARAT' will convey no concept- see below).

62. As regards the opponent's submission that 'ROUGE' will be perceived as referring to the colour red used by the opponent in the marketing of the relevant goods, this is a factor which is extraneous to the registration and cannot be considered. Nevertheless, I agree with the opponent that a significant proportion of the relevant public will understand 'ROUGE' as meaning red in French, assisted by knowledge of the iconic Parisian 'Moulin Rouge' which is a cabaret near Montmartre in Paris, famed for its cancan show (Collins online dictionary) as well as by the use the word in the cosmetic field to denote *"a red powder or cream which you can put on your cheeks in order to give them more colour"* (Collins online dictionary). Furthermore, the reference to the colour red in relation to perfumes will be perceived as both evocative and laudatory because it is associated with emotions such as passion, intensity, love, romance and luxury; hence, it will have less weight in the overall impression, due to its laudatory connotations, length and positioning. However, for both groups of consumers the elements 'BACCARAT' and 'ROUGE' do not form a unit and will be perceived independently. Lastly, the number '540' will be perceived as a sample number (i.e. like in Chanel no. 5), and whilst it is not negligible, it will have less weight in the overall impression.

Visual similarity

63. The applicant argues that visually the marks are dissimilar because the applicant's mark consists of only one word and eight letters, whereas the opponent's mark consists of three elements and sixteen characters. In support of its argument, the applicant relies on the decision BL O/0450/23, whereby the Hearing Officer compared the marks 'HEALISTIC' and 'HEALY' commenting that the former contained a higher number of letters that were not included in the latter than it actually shared in common, giving rise to very different overall impressions. Lastly, the applicant argues that consumers would definitely notice the differences in the visual comparison, not least the stylised double 'KK' that appears in the applicant's mark. Conversely, the opponent argues that the marks are highly similar and that the simplistic stylisation of the

application is not sufficient to override the high level of similarity between "BACCARAT" and "Barakkat".

64. First of all, the reference to the decision BL O/0450/23 is wholly unhelpful as each case must be considered on its own facts and the marks 'HEALISTIC' and 'HEALY' have nothing in common with the marks 'Barakkat' and 'BACCARAT ROUGE 540'. The same goes for other submissions the applicant has made in relation to other decisions which relate to entirely different marks. I shall say no more about this.

65. Second, I do not think that the change of the double consonant makes a striking impression because: (a) both the double 'CC' and the double 'KK' are placed in the middle of the words 'Barakkat' and 'BACCARAT' which are eight-letter words beginning with 'BA' and ending with 'AT' so the change is less noticeable; (b) the letters 'KK' and 'CC' produce the same sound in 'Barakkat' and 'BACCARAT' and in both words they are placed within two vowels 'A' – this increases the perception of their similarity; (c) whilst the three letters 'ARA' are placed before the double 'KK' in the application and after the double 'CC' in the opponent's mark, this increases (rather than reducing) the overall similarity between 'Barakkat' and 'BACCARAT' because they create similar sounds and rhythms. Lastly, being the opponent's mark a word-only mark, it can be presented in a similar font as that used in the application (as shown in the opponent's evidence), or at least in title case.

66. Overall, I consider that the elements 'Barakkat' and 'BACCARAT' are similar to a high degree. Bearing in mind that the word 'ROUGE' and the number '540' in the opponent's mark have no counterpart in the application but taking into account that these elements have less weight, I consider that the overall similarity between the marks is low to medium.

Aural similarity

67. Aurally, similar considerations apply, the level of similarity between the elements 'Barakkat' and 'BACCARAT' being high, the overall similarity between the marks being low to medium.

Conceptual similarity

68. The applicant states that conceptually, the marks are dissimilar because the opponent's mark conveys three concepts, namely 'BACCARAT' conveys the concept of a card game, 'ROUGE' conveys the concept of a blush or lipstick, and '540' conveys the concept of a number.

69. I have already found that both 'Barakkat' and 'BACCARAT' will be perceived as invented, consequently a conceptual comparison between these elements is not possible.

70. As regards, the word 'ROUGE' it can either conveys the concept of a blush or lipstick, or that of a French word meaning red; either way this concept will be perceived as laudatory because if the consumer knows the meaning of rouge as a blush or lipstick (as the applicant concedes), they will also know that it is red, so the evocative force of the colour red in the context of perfumes is something that the average consumer will be aware of - as a result, they will attribute laudatory connotations to the word. Lastly, the concept of a number has little trade mark significance – this means that the conceptual differences between the marks are created by elements (a colour and a number) that are low in distinctiveness.

Distinctive character of the earlier mark

71. 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).”

72. Registered trade marks possess various 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 made of it.

73. The earlier mark is ‘BACCARAT ROUGE 540’. I have already found that ‘BACCARAT’ is the dominant and distinctive element of the mark and that it will be perceived as invented; as such it is inherently high in distinctiveness. Whilst the mark also includes the two additional elements ‘ROUGE 540’ it is the distinctiveness of the common element that is the key.

74. This is the inherent position. In addition, the opponent has filed evidence of use of the earlier mark, which I have reviewed above.

75. By the relevant date of 20 October 2024, the opponent had sold in excess of £124,000 worth of goods in the UK, most of which, I have concluded, were perfumes. As it will be recalled, whilst the invoices show a much higher level of sales, it was the opponent’s responsibility to ensure that accurate sales figures were supplied. In this connection, I am not prepared to resolve the inconsistency between the sales figures and the invoices in favour of the opponent, because the opponent failed to explain the inconsistency, redacted the price from the invoices, and failed to provide a total sum

calculated from the invoices – this is not a job that I am prepared to do in the absence of clarity about the discrepancy.

76. Even considering that the opponent's perfumes is a niche product due to the high cost of the goods, a total turnover of £124,000 over 6 years is low in the context of the goods concerned which are luxury perfumes. Whilst the evidence filed was enough to justify a finding of genuine use, the marketing efforts being concentrated in a single campaign, I find that the evidence is far from demonstrating a level of use which warrants a finding of enhanced distinctiveness mainly because the sales figures are low, and there is no indication of market share.

Likelihood of confusion

77. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods (and services if applicable) and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

78. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms,

is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

79. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must

be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

80. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

81. Earlier in this decision I found that:

- The marks are visually and aurally similar to a low to medium degree, and any conceptual differences between the marks derive from elements that are low in distinctiveness. However, the elements ‘Barakkat’ and ‘BACCARAT’ are visually and aurally similar to a high degree, whilst conceptually neutral.
- The parties’ goods range from being identical to being similar to a low degree.
- The average consumer is a member of the general public who will select the goods mainly visually, with a medium degree of attention, but who may also rely on oral recommendations.
- The earlier mark is inherently distinctive to a high degree. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

82. Bearing in mind the interdependency principle, and in particular, the similarity between the marks, the high degree of distinctive character of the earlier mark, and the identity or similarity between the goods, I consider that due to their high degree of similarity, the dominant and distinctive elements of the marks, namely the words ‘Barakkat’ and ‘BACCARAT’, would easily become tangled up with one another in the perceptions and recollections of consumers exposed to concurrent use of them for the class 3 goods of the kind listed in the earlier registration and the contested application for registration.

83. This is all of the more so, since the aural identity between the double consonant and the absence of any conceptual hook which would assist consumers in distinguishing between the marks, make it most likely that the average consumer would elide the 'KK' with the 'CC' and overlook or misremember the different positioning of the sequence 'RA'. In those circumstances, the presence of the additional elements 'ROUGE 540' in the opponent's mark will be seen as indicating a brand extension, for example, 'rouge' will be seen as evoking the mood of the goods (i.e. passion and sensuality) and '540' will be seen as denoting a fragrance formula/sample (i.e. sample no. 540).

84. There is a likelihood of indirect confusion.

85. The opposition is successful under Section 5(2)(b).

Section 5(3)

86. Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

87. I can deal with this ground very briefly. I have already commented on the evidence filed by the opponent and I found that it does not establish enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use. Whilst reputation and enhanced distinctiveness are different concepts, they are closely related and their assessment is based on the same factors.⁹

⁹ *General Motors*, Case C-375/97

For the same reasons as those I have outlined above, I find that the opponent's evidence does not establish that the earlier mark benefits from reputation and the ground under Section 5(3) fails at the first hurdle.

Section 5(4)(a)

88. Section 5(4)(a) states:

“(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, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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.”

89. Likewise, I can deal with this ground very briefly. Insofar as the applicant's evidence establishes a protectable goodwill at the relevant date,¹⁰ it would more or less relate to the same goods for which I have found genuine use, which means that the outcome of the Section 5(4)(a) would be the same as that of the Section 5(2)(b).¹¹

Section 3(6)

90. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

¹⁰ *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC

¹¹ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41

91. In its submissions in lieu, the opponent withdrew its claim under Section 3(6) saying that whilst he found evidence of lookalike products online incorporating the applicant's mark (see below), its investigation is not complete. Accordingly, having the claim of bad faith been withdrawn, I should say no more about it.

Final remarks

93. The opponent's submissions in lieu include pictures of lookalike products incorporating the applicant's mark. The opponent states that he found these images online and argues as follows:

"Irrespective of who the manufacturer of the products found online is, the example below shows how use of the mark "Barrakat" could lead to a high number of consumers believing that the products affixed with the mark "Barrakat" are products of the Opponent, or connected with the Opponent."

94. I reproduce the example below:



95. The opponent relies on these images to support its claim about the likelihood of confusion. For the sake of completeness I should say that I have disregarded these

submissions because: (a) this material represents evidence and should have been filed in a proper evidential format which has not been done and (2) whilst such evidence might be relevant in infringement proceedings, the assessment under Section 5(2)(b) must be based on the marks as they are registered and applied for so any matter which is extraneous to the application must be disregarded.

OUTCOME

96. The opposition succeeds under Section 5(2)(b) and the application will be refused registration.

COSTS

97. The opponent has been successful and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the sum of £1,600, calculated as follows:

Preparing opposition and considering the counterstatement:	£350
Filing evidence:	£700
Submissions in lieu of an oral hearing:	£350
Official fees:	£200
 Total:	 £1,600

98. I therefore order Elite Oud Ltd to pay BACCARAT (Société Anonyme) the sum of £1,600. This sum is to 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 22nd day of September 2026

TERESA PINTO

For the Registrar