

BLO/0907/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003734356

BY BPERFECT LTD

TO REGISTER THE TRADE MARK:

CHROMA

IN CLASSES 3 AND 21

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433736

BY CHROMAVIS SPA

BACKGROUND AND PLEADINGS

1. On 17 December 2021, BPerfect Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 25 February 2022.

2. The applicant seeks registration for the following goods:

Class 3 Cosmetics; make-up; foundation; foundation creams; skin, nail and eye care preparations; skin care preparations; beauty balm creams; blemish balm creams; cosmetic concealers; moisturisers; eye make-up; eye shadows; eyebrow make-up; eyebrow pencils; eye liners; cheek colouring; blush; rouge; lip balm; lipstick; lip gloss; false eyelashes; facial make-up; face powder; face primers; make-up setting sprays; make-up priming cream; multi-functional make-up; toiletries; essential oils; hair care preparations; body care preparations; perfumery; tanning preparations; self-tanning lotions; self-tanning oils; self-tanning mousse; self-tanning gels; sun care products; suntan lotions; suntan oils; suntan creams; suntan gels, sun block lotions, sun block oils, sun block creams, sun block gels; beauty masks; cotton wool for cosmetic purposes; cosmetic kits; adhesives for cosmetic purposes; false nails; nail art stickers.

Class 21 Cosmetic and toilet utensils; cosmetic applicators; applicators for applying foundation; foundation brushes; foundation sponges; applicators for concealers; applicators for skincare preparations; applicators for applying tanning preparations; applicator sticks for applying make-up; mitts for applying tanning preparations; exfoliating mitts; exfoliating pads; cosmetic brushes; make-up brushes; make-up sponges; hair brushes; facial cleansing sponges; facial sponges for applying make-up; cosmetic cases sold filled with cosmetic brushes; parts and fittings for the aforesaid goods.

3. The application was opposed by CHROMAVIS SPA (“the opponent”) on 24 May 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

CHROMAVIS

Comparable UK trade mark (EU) registration no. UK00917874154¹

Filing date 14 March 2018

Registration date 17 July 2018.

Relying upon all of the goods for which the mark is registered, namely:

Class 1 Antimicrobial preservatives for cosmetics; Vitamins for use in the manufacture of cosmetics; Chemicals for use in the manufacture of cosmetics; Chemical substances for use in the manufacture of scented cosmetics; Botanical extracts for use in making cosmetics; Chemical compositions and materials for use in cosmetics; Plant extracts, other than essential oils, for use in the manufacture of cosmetics.

Class 3 Cosmetics; Cosmetics and cosmetic preparations; Natural cosmetics; Functional cosmetics; Organic cosmetics; Mineral oils [cosmetic]; Self tanning lotions [cosmetic]; Toning creams [cosmetic]; Make-up; Moisturising preparations; Beauty care cosmetics; Sun care preparations; Non-medicated cosmetics; Cosmetic preparations for skin firming; Fluid creams [cosmetics]; Cosmetics for the use on the hair; Impregnated cleaning pads impregnated with cosmetics; Nail varnish remover [cosmetics]; Cosmetic kits; Cosmetic preparations for eyelashes; Eyes make-up; Nail tips [cosmetics]; Cosmetics for use on

¹ Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

the skin; Cleaner for cosmetic brushes; Lip cosmetics; Cosmetics containing hyaluronic acid; Colour cosmetics for children; Eyebrow cosmetics; Skin masks [cosmetics]; Body cream; Cosmetics in the form of oils; Facial cleansers [cosmetic]; Cosmetic eye gels; Body paint (cosmetic); Cosmetic preparations for baths; Colour cosmetics for the skin; Facial scrubs [cosmetic]; Body oils [for cosmetic use]; Facial toners [cosmetic]; Cosmetics in the form of milks; Cosmetic products for the shower; Cosmetics in the form of powders; Cosmetics in the form of lotions; Lip coatings [cosmetic]; Skin whitening preparations [cosmetic]; Cosmetic preparations for skin care; Liners [cosmetics] for the eyes; Skin lightening compositions [cosmetic]; Sun blocking lipsticks [cosmetics]; Sun protectors for lips; Cosmetics for use in the treatment of wrinkled skin; Slimming aids [cosmetic], other than for medical use; Refill packs for cosmetics dispensers; Glitter in spray form for use as a cosmetics; Perfume oils for the manufacture of cosmetic preparations; Body and facial gels [cosmetics]; Cosmetic skin enhancers; Cosmetic products in the form of aerosols for skincare.

Class 42 Scientific research relating to cosmetics; Laboratory research in the field of cosmetics; Laboratory analysis in the field of cosmetics; Testing of cosmetics.

4. The opponent claims that there is a likelihood of confusion because of the high degree of similarity between the marks and the identity/high degree of similarity between the goods and services.

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

6. The opponent is represented by DLA Piper UK LLP and the applicant is represented by Murgitroyd & Company. Neither party requested a hearing, however, the applicant filed evidence in chief and written submissions, and the opponent filed submissions in reply. The applicant also filed final written submissions. I have taken all of the evidence and submissions into account in reaching this decision.

RELEVANCE OF EU LAW

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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

8. The applicant's evidence consists of the witness statement of Emma Devir dated 3 January 2023. Ms Devir is the Head of Marketing for the applicant. Ms Devir's statement was accompanied by 4 exhibits (ED1-ED4).

9. Whilst I do not propose to summarise it here, I will refer to the applicant's evidence and parties' submissions where necessary below.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) 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.”

11. The earlier mark had not completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

Section 5(2)(b) case law

12. The following principles 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. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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 goods

13. For the purpose of this comparison, the applicant's goods are listed at paragraph 1, and the opponent's goods are listed at paragraph 3 of this decision.

14. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in Canon, Case C-39/97, the court stated at paragraph 23 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.”

15. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

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

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

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

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

Class 3

Cosmetics; Cosmetic kits.

18. These terms appear identically in both specifications.

Make-up; toiletries.

19. The applicant’s above terms are self-evidently identical to “cosmetics” in the opponent’s specification.

Foundation; foundation creams; cosmetic concealers; eye make-up; eye shadows; eyebrow make-up; eyebrow pencils; eye liners; cheek colouring; blush; rouge; lipstick;

lip gloss; facial make-up; face powder; make-up setting sprays; multi-functional make-up.

20. The applicant's above goods fall within the broader category of "cosmetics" in the opponent's specification. They are identical on the principle outlined in *Meric*.

Skin, nail and eye care preparations; skin care preparations; beauty balm creams; blemish balm creams; moisturisers; lip balm; face primers; make-up priming cream; beauty masks.

21. The applicant's above goods falls within the broader categories of "beauty care cosmetics" and "cosmetic preparations for skin care" in the opponent's specification. They are identical on the principle outlined in *Meric*.

False eyelashes.

22. The applicant's above goods fall within the broader category of "cosmetic preparations for eyelashes". They are identical on the principle outlined in *Meric*.

Essential oils.

23. The applicant's above goods fall within the broader category of "cosmetics in the form of oils" in the opponent's specification. They are identical on the principle outlined in *Meric*.

Hair care preparations.

24. The applicant's above goods are self-evidently identical to "cosmetics for the use on the hair" in the opponent's specification.

Self-tanning lotions.

25. The applicant's above goods are self-evidently identical to "tanning lotions [cosmetic]" in the opponent's specification.

Tanning preparations.

26. The opponent's to "tanning lotions [cosmetic]" falls within the applicant's above broader category. They are identical on the principle outlined in *Meric*.

Sun care products; suntan lotions; suntan oils; suntan creams; suntan gels, sun block lotions, sun block oils, sun block creams, sun block gels.

27. The applicant's above goods fall within the broader category of "sun care preparations" in the opponent's specification. They are identical on the principle outlined in *Meric*.

Body care preparations.

28. The opponent's "moisturising preparations", "body cream", "body oils [for cosmetic use]" and "body and facial gels [cosmetics]" fall within the applicant's above broader category. They are identical on the principle outlined in *Meric*.

False nails; Nail art stickers; Adhesives for cosmetic purposes.

29. I consider that the applicant's above goods fall within the broader category of "cosmetics and cosmetic preparations" in the opponent's specification. They are identical on the principle outlined in *Meric*.

Cotton wool for cosmetic purposes.

30. I note that cleaning pads for use in cosmetics are usually made from cotton wool, and therefore the applicant's above term is self-evidently identical to "impregnated cleaning pads impregnated with cosmetics" in the opponent's specification. However, if I am wrong in this finding, the goods will overlap in nature, user, method of use and purpose. Therefore the goods are similar to a high degree.

Self-tanning oils; self-tanning mousse; self-tanning gels.

31. The applicant's above goods are similar to the opponent's "tanning lotions [cosmetic]". The goods all overlap in purpose, method of use and user as they are all directly applied to the users skin for tanning. I consider that there would be an overlap in trade channels as the goods would all be sold by the same undertaking which specialise in tanning goods. They would also be sold in the same aisle of beauty retail outlets. The goods are also in competition because the user could choose any of the goods to achieve the same result. The goods are, therefore, similar to a high degree.

Perfumery.

32. The applicant's above goods are similar to the opponent's "moisturising preparations". I consider that albeit the goods differ in nature, method of use and purpose, and they are neither in competition nor complementarity, there may be an overlap in trade channels as these goods can be sold alongside each other as a set/gift set. Therefore as they are produced by the same undertaking, they overlap in trade channels. The goods can also be fragranced with the same scents, and would be bought by the same user. Therefore, I consider that the goods are similar, but to between a low and medium degree.

Class 21

Cosmetic and toilet utensils; cosmetic applicators; applicators for applying foundation; foundation brushes; foundation sponges; applicators for concealers; applicator sticks for applying make-up; cosmetic brushes; make-up brushes; make-up sponges; facial sponges for applying make-up; cosmetic cases sold filled with cosmetic brushes.

33. The applicant's above goods are similar to the opponent's "cosmetics". I consider that the goods overlap in trade channels and users as it is relatively common practice for cosmetic brands to produce cosmetics and applicators such as brushes and sponges, and cosmetic cases, which as a collective would be sold through beauty retailers. I also note that the utensils are important and indispensable to the use of cosmetics, and therefore they are complementary. I consider that, to the extent all the goods are used to beautify and enhance one's appearance, the goods overlap in purpose. However, the main purpose of the applicant's goods are to apply the

cosmetics to the user's face. Taking all of the above into account, I consider that the goods are similar to between a medium and high degree.

Applicators for skincare preparations; facial cleansing sponges.

34. The applicant's above goods are similar to the opponent's "cosmetic preparations for skin care" and "facial cleansers [cosmetic]". I consider that the goods overlap in trade channels and users as skin care brands can produce both skin care and its applicators, including cleansing sponges, which again, would be sold as a collective through beauty retailers. The use of the applicators is also important and indispensable to the use of the skin care preparations. The goods are therefore complementary and overlap in purpose to the extent they are all used to care for the users skin. However, the applicant's goods are used specifically to apply the skin care goods to the user's face. The goods are therefore similar to between a medium and high degree.

Applicators for applying tanning preparations; mitts for applying tanning preparations.

35. The applicant's above goods are similar to the opponent's "self tanning lotions [cosmetic]". The goods overlap in trade channels and users as tanning brands will produce both the tanning lotions and the applicators/mitts in order for the user to apply it to their body. The goods would also be sold as a collective through beauty retailers. The goods are complementary and overlap in purpose to the extent that they all tan the user's skin. However, I appreciate that the applicant's goods are used specifically to apply the tanning lotion to the skin. I therefore consider that the goods are similar to between a medium and high degree.

Exfoliating mitts; exfoliating pads

36. The applicant's above goods are similar to the opponent's "facial scrubs [cosmetic]". The goods overlap in purpose and user as they are all used to exfoliate and remove the dead skin from the user's face and body. To the extent that they are all applied to the face/body and rubbed in using a circular motion, they overlap in method of use. I also consider that the goods overlap in trade channels as the same

skin-care undertakings would sell both scrubs and manual exfoliators, which would all be sold in the same aisle of a beauty retail outlet. The goods may be in competition, as any of them can be used to achieve the same result. Consequently, the goods are similar to between a medium and high degree.

Hair brushes

37. The applicant's above goods are similar to the opponent's "cosmetics for the use on the hair". The goods overlap in method of use and user, as they are all applied to and run through the hair. The goods will overlap in purpose to the extent that they are all used to improve the hairs appearance. They also overlap in trade channels as the same hair care undertakings would produce all of the goods, which would then be distributed in the same aisle of a beauty retail outlet. I therefore consider that the goods are similar to a medium degree.

Parts and fittings for the aforesaid goods.

38. I note that I have found similarity with all of the opponent's and applicant's above goods, and therefore its best comparison would be with the opponent's cosmetics in class 3. However, as set out in *Les Éditions Albert René v OHIM*,² it is clear that just because a particular good is used as a part, element or component of another, it should not result in a finding of identity/similarity between those goods. However, it does not mean that there can never be similarity between such goods where there is overlap in the factors identified in *Treat*.

39. In this instance, I consider that the applicants' parts and fittings of its class 21 goods do not overlap with any of the opponent's cosmetic goods. I do not find that the use, user or nature of the goods overlap. I also consider that there wouldn't be an overlap in trade channels as the applicants' parts and fittings would be purchased wholesale to be used in the production of the finished article, which would then be on sale to the general public. I do not consider that the goods are in competition nor complementary. I therefore consider that the goods are dissimilar.

² Case T-336/03

40. It is a prerequisite of section 5(2)(b) that the goods be identical or at least similar. The opposition will, therefore, fail in respect of the goods that I have found to be dissimilar.³

41. The opposition under section 5(2)(b) fails for the following goods:

Class 21 Parts and fittings for cosmetic and toilet utensils, cosmetic applicators, applicators for applying foundation, foundation brushes, foundation sponges, applicators for concealers, applicators for skincare preparations, applicators for applying tanning preparations, applicator sticks for applying make-up, mitts for applying tanning preparations, exfoliating mitts, exfoliating pads, cosmetic brushes, make-up brushes, make-up sponges, hair brushes, facial cleansing sponges, facial sponges for applying make-up, cosmetic cases sold filled with cosmetic brushes.

The average consumer and the nature of the purchasing act

42. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

43. The average consumer for the goods will be members of the general public. However, I do not discount that a smaller proportion of consumers would be professional users such as a beautician, make-up artist or hairdresser. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, quality, aesthetic, scent and the suitability for their specific needs. Therefore, the level of attention paid during the purchasing process will be medium.

44. The goods are likely to be obtained by self-selection from the shelves of a (beauty) retail outlet, or online equivalent. I also note that cosmetics can be on display with tester products, for the user to test and use in store. Alternatively, the goods may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a sales assistant or representative.

Comparison of the trade marks

45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

46. 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.

47. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
CHROMAVIS	<u>CHROMA</u>

48. The opponent's trade mark consists of the word CHROMAVIS, written in a stylised diagonal-cut capitalised font. I consider that the word CHROMAVIS plays a greater role in the overall impression of the mark, with the stylisation playing a lesser role.

49. The applicant's trade mark consists of the word CHROMA, written in a curved stylised font, with the left-hand side of the letters consisting of a double line, to create a shadow effect. The word is also underlined. I consider that the word CHROMA plays a greater role in the overall impression of the mark, with the stylisation playing a lesser role.

50. Visually, both marks are presented in capital letters, and the word CHROMA in the applicant's mark is fully replicated at the beginning of the opponent's mark. These act as visual points of similarity, and I bear in mind that the average consumer tends to pay more attention to the beginning of the marks.⁴ However, the opponent's mark ends in the letters "VIS" and the marks differ in the stylisation of the typefaces. Nonetheless, I consider that the marks are visually similar to between a medium and high degree.

51. Aurally, the opponent's mark will likely be pronounced as CROME-AH-VIS and the applicant's mark will likely be pronounced as CROME-AH. Therefore the pronunciation

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

of the applicant's mark is wholly contained at the beginning of the opponent's mark. I consider that they are aurally similar to a high degree.

52. Conceptually, Ms Devir states that CHROMA is a common English word which is known and related to the word "chromatic" which is defined as "the attribute of colour that enables an observer to judge how much chromatic colour it contains". At **exhibit ED1**, Ms Devir provides the following definitions of CHROMA from the Collins Dictionary:

- A purity of colour.
- Intensity of distinctive hue; saturation of colour.

53. Following this argument, Ms Devir has attached evidence in **exhibit ED2** of 11 different cosmetic and beauty products using the word "CHROMA", which she states is used to indicate that a "particular type of product is of a particular colour", and "has the purpose of giving skin, hair or nails a particular colour". I note that this evidence is dated 16 December 2022, and therefore is dated a year after the relevant date.

54. Ms Devir states that she is "aware of the fact that a number of beauty and cosmetic businesses include the word *chroma* in their business or trading name, and has provided 2 examples of business websites which are called Chroma Cosmetics and Chroma Skincare contained in **ED2**. I note that these screenshots are also dated 16 December 2022.

55. Taking all of the above into account, Ms Devir states that the word CHROMA by itself is so "banal, common and descriptive that it would be impossible for consumers to differentiate between cosmetic products from various businesses. It is tantamount to using the word "colour" or "colouring" on cosmetic products".

56. If I am correct in understanding the applicant's submissions, they believe that the word CHROMA, based on the above definitions is, on its own, descriptive and lacks distinctive character, especially in regard to the parties' (cosmetic) goods. However, I do not find that the evidence is strong nor compelling enough to draw the same

conclusion. There are not enough examples, nor any that fall before the relevant date, that convince me that firstly the word CHROMA would be known to the average consumer, and secondly, that it is so commonly used in trade that it has become descriptive. Even if I were to accept that these meanings were known to some consumers at the relevant date, I consider that a significant proportion of average consumers would not know the above meanings of the word CHROMA, but would instead, see it as an invented term with no meaning.

57. Both parties submit that the opponent's mark, CHROMAVIS, has no conceptual meaning. The applicant in its submissions states that "even allowing for the average consumer identifying the components CHROMA and VIS, it is not liable of ascribing any particular meaning to the mark as a whole". Overall, the opponent's mark will be seen as an invented word with no meaning. Therefore, based on all of the above, the marks are conceptually neutral.

Distinctive character of the earlier trade mark

58. 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 C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

59. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

60. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

61. As highlighted above, the opponent’s mark as a whole is an invented word with no meaning, presented in a stylised diagonal-cut capitalised font. As the mark is an invented word, this contributes significantly to the overall distinctiveness of the mark, with the stylisation contributing to a lesser extent. Overall, the mark is inherently distinctive to a high degree.

Likelihood of confusion

62. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. This includes the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing

so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

63. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a medium and high degree, aurally similar to a high degree and conceptually neutral.
- I have found the opponent's mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods to be the general public and professional users such as beauticians, make-up artists, and hairdressers, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods vary from being identical to similar to between a low and medium degree.

64. I bear in mind that in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ stated that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

65. This was, of course, in the context of infringement. However, the same approach is appropriate under section 5(2).⁵ It is not, therefore, necessary for me to find that the majority of consumers will be confused. The question is whether there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer.

⁵ *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch), Mann J.

66. Therefore, taking all of the above into account, bearing in mind that the average consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind, I find that there is direct confusion for a significant proportion of average consumers. The applicant's word CHROMA is wholly replicated at the beginning of the opponent's mark, and the respective words only differ in the letters VIS at the end of the opponent's mark. As the beginning of the marks tend to make more of an impact than the ends, the inclusion of the additional letters may be misremembered. Furthermore, for the significant proportion of consumers who do not attribute any meaning to the word CHROMA, both parties' marks are invented words with no conceptual meanings. Consequently, there is no conceptual hook in order to differentiate the marks, and the opponent's mark is inherently distinctive to a high degree. Therefore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the overall levels of visual and aural similarity between the marks, and the identity and the similarity of the goods will lead the average consumer to mistake one mark for the other.

67. For the sake of completeness, in its submissions the applicant has attributed significant weight to the stylisation of its mark, which includes its shadow capitalised typeface and underline. As highlighted by paragraphs 48 and 49 above, the stylisation plays a lesser role in the overall impression of both marks. Nonetheless, both of the parties' marks use a capitalised typeface, and therefore I consider that this is another factor which points towards the average consumer imperfectly recalling the marks, and the particular stylisations of their capitalised typefaces. Therefore, taking all of the above into account, I consider there to be a likelihood of direct confusion.

CONCLUSION

68. The opposition is partially successful in respect of the following goods, for which the application is refused:

Class 3 Cosmetics; make-up; foundation; foundation creams; skin, nail and eye care preparations; skin care preparations; beauty balm creams; blemish

balm creams; cosmetic concealers; moisturisers; eye make-up; eye shadows; eyebrow make-up; eyebrow pencils; eye liners; cheek colouring; blush; rouge; lip balm; lipstick; lip gloss; false eyelashes; facial make-up; face powder; face primers; make-up setting sprays; make-up priming cream; multi-functional make-up; toiletries; essential oils; hair care preparations; body care preparations; perfumery; tanning preparations; self-tanning lotions; self-tanning oils; self-tanning mousse; self-tanning gels; sun care products; suntan lotions; suntan oils; suntan creams; suntan gels, sun block lotions, sun block oils, sun block creams, sun block gels; beauty masks; cotton wool for cosmetic purposes; cosmetic kits; adhesives for cosmetic purposes; false nails; nail art stickers.

Class 21 Cosmetic and toilet utensils; cosmetic applicators; applicators for applying foundation; foundation brushes; foundation sponges; applicators for concealers; applicators for skincare preparations; applicators for applying tanning preparations; applicator sticks for applying make-up; mitts for applying tanning preparations; exfoliating mitts; exfoliating pads; cosmetic brushes; make-up brushes; make-up sponges; hair brushes; facial cleansing sponges; facial sponges for applying make-up; cosmetic cases sold filled with cosmetic brushes.

69. The application can proceed to registration in respect of the following goods, for which the opposition has been unsuccessful:

Class 21 Parts and fittings for cosmetic and toilet utensils, cosmetic applicators, applicators for applying foundation, foundation brushes, foundation sponges, applicators for concealers, applicators for skincare preparations, applicators for applying tanning preparations, applicator sticks for applying make-up, mitts for applying tanning preparations, exfoliating mitts, exfoliating pads, cosmetic brushes, make-up brushes, make-up sponges, hair brushes, facial cleansing sponges, facial sponges for applying make-up, cosmetic cases sold filled with cosmetic brushes.

COSTS

70. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the opponent's only partial success. In the circumstances, I award the opponent the sum of **£600** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing and filling written submissions In reply	£300
Official Fee	£100
Total	£600

71. I therefore order BPerfect Ltd to pay CHROMAVIS SPA the sum of £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 25th day of September 2023

L FAYTER
For the Registrar