

O-127-15

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATION NO 3047002

BY INVICTUS COSMETICS LTD & DESTINY FINANCIAL SERVICES LTD

TO REGISTER THE TRADE MARK

Invictus Cosmetics

IN CLASS 03

AND

**OPPOSITION THERETO (UNDER NO. 402514)
BY PUIG FRANCE, SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE**

BACKGROUND

1) On 15 March 2014 Invictus Cosmetics Ltd and Destiny Financial Services Ltd ('the applicants') applied to register the trade mark **Invictus Cosmetics** in respect of *Cosmetics* in class 03.

2) The application was published on 25 April 2014 in the Trade Marks Journal and notice of opposition was subsequently filed by PUIG FRANCE, Société par Actions Simplifiée ('the opponent').

3) As the applicants are without legal representation, I will explain that opposition proceedings before the Tribunal are governed by the Trade Marks Act 1994 ('the Act'). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks ('the Directive') (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union ('CJEU') and the General Court ('GC'), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously known as the Court of First Instance) and the CJEU can be found at the following url (judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court): <http://curia.europa.eu/juris/recherche.jsf?language=en>

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the following url: <http://www.ipo.gov.uk/t-challenge-decision-results.htm>

The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland). Judgments of courts in the United Kingdom can be found at the following url: <http://www.bailii.org/>

4) The opponent claims that the application offends under Section 5(2)(b) of the Act. It relies on three earlier Community trade mark registrations ('CTM'). Of those three marks, the opponent's strongest case clearly lies with its CTM No 9625682, details of which are shown in the table below:

CTM details	Goods relied upon
No: 009625682 INVICTUS Filing date: 24 December 2010 Date of entry in the register: 06 May 2011	Class 3: <i>Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.</i>

5) The trade mark relied upon by the opponent has a filing date of 24 December 2010 and completed its registration procedure on 06 May 2011. The consequences of these dates, in relation to the applicants' mark, are that the opponent's mark is an earlier mark in accordance with section 6 of the Act and, as it completed its

registration procedure less than five years before the publication date of the applicants' mark, it is not subject to the proof of use conditions, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

6) The applicants filed a counterstatement denying the grounds of opposition. I note that they also draw attention to marks on the register, containing the word INVICTUS, which they state pre-date the opponent's mark. They therefore contend that the opponent should not have been able to register its mark. As the opponent submits, this is not a factor which can have any bearing on the matter before me. The registered status of the opponent's mark is *prima facie* evidence of its validity.¹ In the absence of a successful application to invalidate the opponent's mark, it is a valid earlier right upon which the opponent is entitled to rely in this opposition. Further, the applicants' reference to other marks co-existing on the register containing the same words (such as numerous marks containing the word 'Hollywood') is also of no relevance to the matter before me.

7) Neither party filed evidence; nor did they request a hearing. Only the opponent filed submissions in lieu. Accordingly, I now make this decision on the basis of the papers before me.

DECISION

8) Section 5(2)(b) of the Act provides:

“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.”

9) The leading authorities which guide me are from the CJEU: *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.

The principles

(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

¹ Section 72 of the Act refers.

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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

10) The opponent also draws my attention to the case of *Il Ponte Finanziaria SpA v OHIM* (Case C-234/06 P), and to the following part of the judgment, which reads:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.”

11) The opponent therefore contends that the common presence of the word INVICTUS in its three earlier CTMs “points to the existence of a family of marks” and that this “serves to reinforce the strength of the Opponent’s case”. However, in the same case, the court went on to state:

“64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

12) As I have already stated, the opponent has filed no evidence in these proceedings. Accordingly, there is nothing to show that any of the marks it relies upon have been used in the marketplace. Consequently, its claim to the existence of a family of marks containing the word INVICTUS must be rejected at the outset. The following decision is therefore based solely on the mark which I have already established clearly constitutes the opponent’s best prospect of success i.e. CTM No 009625682.

Comparison of goods

13) The goods to be compared are shown in the table below:

Opponent's goods	Applicants' goods
<p>Class 3: Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.</p>	<p>Class 3: Cosmetics.</p>

14) The opponent's goods include 'cosmetics' which are, self-evidently, identical to the applicants' 'cosmetics'.

Average consumer and the purchasing process

15) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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.”

16) The average consumer of *cosmetics* is a member of the general public. The applicants contend that the consumer will be extremely attentive to the purchase of the goods given that careless purchase may result in unwanted side effects or personal injury and that cosmetics are very personal. Whilst I accept that considerations such as compatibility with skin type (whether the goods are suitable for sensitive skin, for example) may sometimes come into play, together with considerations such as the colour or scent of the goods, I consider that, generally speaking, the consumer is unlikely to pay any more than a reasonable level of attention (i.e. neither low nor high). The goods are those which will be bought mainly by the eye but aural considerations are not disregarded given that they may sometimes be requested orally over a counter, for example.

Comparison of marks

17) 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.”

It would therefore be wrong to artificially dissect the 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.

18) In the counterstatement, the applicants refer to the respective logos used by the parties as being very different and provide a copy of the logo used by them. In *L'Oreal SA v Bellure NV* [2008] R.P.C. 9, the Court of Appeal stated:

“The test is, and must be, founded on the mark as registered, not material which forms no part of that. There is simply no warrant in the Directive for taking more than the registered mark into account. The global appreciation test does not amount to the proposition that once a registered mark is used in marketing, anything, extraneous to the mark used in marketing, comes in too—as though it formed part of the registered mark.”

It is clear from the above case law that I am required to make my assessment on the basis of the respective marks as they appear on the register. Any additional logos which may be used by the parties in marketing cannot form part of that assessment. Accordingly, the marks to be compared are:

Opponent's mark	Applicants' mark
INVICTUS	Invictus Cosmetics

19) The opponent's mark consists of the word INVICTUS in plain block capitals; the overall impression of the mark is based solely on that word. The applicants' mark contains the two words 'Invictus Cosmetics'. The word 'Cosmetics', whilst not negligible, is directly descriptive of the nature of the goods covered by the application; it is the distinctive word 'Invictus' which strongly dominates the overall impression of the mark.

20) The applicants' draw my attention to their mark being in title case, whereas the earlier mark is presented all on capitals, thus making the marks, in their view, visually different. This submission does not assist the applicants. Notional and fair use of the respective marks means that both could be used in the same case (including both in title case or both in upper case). There is plainly a very high degree of visual, aural and conceptual similarity between the marks, notwithstanding

the presence of the word 'Cosmetics' in the applicants' mark which is absent from the opponent's mark.

Distinctive character of the earlier mark

21) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* Case T-79/00 [2002] ETMR 91).

22) As there is no evidence before me to show that the opponent's mark has been used in the UK, I can only take into account its inherent level of distinctiveness. The word INVICTUS does not describe or allude to the nature of the goods covered by the earlier mark. I consider the mark to have a good level of distinctiveness.

Likelihood of confusion

23) In deciding whether there is a likelihood of confusion, I must take account of all my earlier findings. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;
- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

24) I have found the respective goods to be identical. There is a very high degree of visual, aural and conceptual similarity between the marks. The average consumer is a member of the general public, who are likely to pay a reasonable degree of attention during the mainly visual purchase (although aural considerations are not disregarded) and the earlier mark has a good degree of inherent distinctiveness. Bearing all of these factors in mind, I have no hesitation in concluding that the average consumer is likely to confuse the marks.

The opposition succeeds. The trade mark application is refused.

COSTS

25) As the opponent has been successful, it is entitled to a contribution towards its costs. In its submissions in lieu of a hearing, the opponent requests costs off the scale on the basis that the applicants "should have realised that a defence of the Opposition was not feasible". I take this to mean that the opponent considers that the applicant should have known it was going to lose and therefore its decision to file a

defence was unreasonable. As is stated in Tribunal Practice Notice 4/2007 ('TPN'), the mere fact that the applicants have lost the opposition is not, of itself, indicative of unreasonable behaviour. In the absence of any other factors pointing towards the applicants having been unreasonable or obstructive in these proceedings, the request for costs off the scale is dismissed. Accordingly, adhering to the standard scale in the aforementioned TPN, I award the opponent a contribution towards its costs on the following basis:

Preparing the notice of opposition and considering the counterstatement	£200
Official opposition fee	£100
Written submissions:	£300
Total:	£600

26) I order Invictus Cosmetics Ltd and Destiny Financial Services Ltd (being jointly and severally liable) to pay PUIG FRANCE, Société par Actions Simplifiée the sum of **£600**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of March 2015

**Beverley Hedley
For the Registrar,
the Comptroller-General**