

O/218/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2561122
BY
HERBOSYS LIMITED
TO REGISTER THE TRADE MARK**



• N A T U R A L S •

Luxury you deserve
Enjoy Life

IN CLASSES 3, 4 AND 30

AND

**THE OPPOSITION THERETO
UNDER NO 101374
BY
CBM CREATIVE BRANDS MARKEN GmbH**

Trade Marks Act 1994
In the matter of application no 2561122
by Herbosys Limited
to register the trade mark:



Luxury you deserve
Enjoy Life

in classes 3, 4 and 30
and the opposition thereto
under no. 101374
by CBM Creative Brands Marken GmbH

BACKGROUND

1. On 11 October 2010, Herbosys Limited (the applicant) applied to register the above trade mark in classes 3, 4 and 30 of the Nice Classification system.¹ Only class 3 has been opposed, the specification for which is as follows:

Class 03

Soaps; perfumery, essential oils, cosmetics, hair lotions; cosmetic preparations for the bath; bath salts, not for medicinal use; ethereal essences; cosmetic preparations for skin care; cosmetic preparations for face care; cosmetic creams; lotions for cosmetic purposes, body lotions; beauty masks; oils for cosmetics purposes; potpourris (fragrances); shampoos.

2. Following publication of the application on 5 November 2010, CBM Creative Brands Marken GmbH (the opponent) filed notice of opposition against the application.

3. The ground of opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4. The opponent relies on the following earlier mark:

MARK DETAILS AND RELEVANT DATES	GOODS
CTM: 4265971	Class 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

Mark: HOLY	abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.
Date of application: 1 February 2005	
Date of registration: 7 September 2011	

5. In its notice of opposition the opponent states:

“6. Owing to the dominance in the Applicant’s mark of the word HOLY, being identical to the Opponent’s earlier trade mark, and the identity of the goods, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.”

6. On 17 October 2011, the applicant filed a counterstatement in which it accepts the goods are identical or similar, with the exception of ‘potpourris (fragrances)’. With regard to the marks it states:

“8. The word HOLY in the opposed mark is not the dominant component, but the words HOLY LAMA, which hang together, visually and aurally.

...

9. The opposed mark has additional verbal components, the word ‘NATURALS’ and the phrases ‘Luxury you deserve’ and ‘Enjoy life’, all of which contribute to the differences between the respective marks and which differences heavily outweigh the similarity arising solely from the common element, HOLY.”

7. The opponent's mark is an earlier mark which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.²

8. Neither party filed evidence; only the applicant filed written submissions in lieu of a hearing. I will refer to these as necessary below.

DECISION

9. Section 5(2)(b) of the Trade Marks Act 1994, states:

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

....

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

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

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

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 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 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

11. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

12. The average consumer will be a member of the general public. The purchase is likely to be primarily visual as it is likely to be made from a website or directly from a shelf. However, I do not ignore aural considerations as, in my experience, it is not unusual to find more expensive perfumes and cosmetics kept in cases or behind counters in, for example, department stores.

13. The purchaser will pay a reasonable degree of attention, to the extent that the majority of the goods are to be used on the body and the average consumer of these products is likely to consider, inter alia, the fragrance and particular ingredients. However, in general, these are relatively low value, fairly frequent purchases.

Comparison of goods

14. In comparing the respective specifications, all relevant factors should be considered, as per *Canon* in which the CJEU stated at paragraph 23 of its judgment:

“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. Other factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

16. For ease of reference, the goods are shown below:

The opponent's goods	The applicant's 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: Soaps; perfumery, essential oils, cosmetics, hair lotions; cosmetic preparations for the bath; bath salts, not for medicinal use; ethereal essences; cosmetic preparations for skin care; cosmetic preparations for face care; cosmetic creams; lotions for cosmetic purposes, body lotions; beauty masks; oils for cosmetics purposes; potpourris (fragrances); shampoos.</p>

17. In comparing the goods I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. ‘Soap’, ‘perfumery’, ‘essential oils’, ‘cosmetics’ and ‘hair lotions’ are included in the application and of the opponent’s earlier mark. These are self evidently identical terms.

19. ‘Cosmetic preparations for the bath’, ‘cosmetic preparations for skin care’, ‘cosmetic preparations for face care’, ‘cosmetic creams’, ‘lotions for cosmetic purposes’, ‘body lotions’, ‘beauty masks’ and ‘oils for cosmetics purposes’ can be considered, in this context, to be included within the wider category ‘cosmetics’ in the opponent’s registration. ‘Ethereal essences’ would be included within ‘essential oils’ while ‘bath salts’ and ‘shampoos’ fall into the broader category ‘cleaning

preparations'. Applying the test laid down by the General Court in *Meric*, these goods are also identical.

20. The opponent considers the remaining term, 'potpourris (fragrances)', to be identical to perfumery. In its counterstatement the applicant states:

"6. It is denied that 'potpourris (fragrances)' are identical or similar to 'perfumery'; the former is not for personal use whereas the latter is."

21. It is my understanding that 'potpourris (fragrances)' are the fragrances used to give potpourri an aroma and as such are identical to essential oils (rather than perfumery), which in accordance with the guidance in *Meric* is a broader term within which such fragrances would be included.

22. However, if the phrase 'potpourris (fragrances)' was intended to mean the potpourri itself then in my experience, potpourri is given its fragrance by the use of essential oils which are also sold separately, to refresh the smell at a later date when the initial aroma has faded. As essential oils are included in the opponent's specification it is these which I will compare to the contested goods in the application. The users of both products will be members of the general public who wish to use the goods in order to create a pleasant smelling environment. The nature of potpourri is normally in the form of dried plants and flowers whereas essential oils are generally made available in liquid form. Essential oils may be added to a carrier such as potpourri or may be used in an oil burner to create an attractive smell. In my experience these goods are often sold together to enable the consumer to refresh the potpourri once the initial smell has faded, but even when not sold as a single product, they are often available in the same area of a shop or website.

23. As part of the overall goods comparison I must also consider if the respective goods are complementary. In this respect I am guided by the General Court (GC) judgment in *Boston Scientific Ltd v OHIM (Trade marks and Designs Case)*, Case T-325/06:

"82. *It is true that goods are complementary if 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 (see, to that effect, T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).*"

24. Potpourri and essential oils are clearly related, but in the absence of any evidence before me on this point, not sufficiently so, in my view, for me to conclude that they are complementary goods in the sense mentioned in *Boston Scientific* as neither is indispensable for the use of the other.

25. In conclusion 'potpourris (fragrances)' and 'essential oils' are either identical (on the *Meric* principle), or, at the very least, are highly similar in accordance with the guidance in *Canon* and *Treat*.

Comparison of marks

26. The marks to be compared are:

Opponent's mark	Applicant's mark
HOLY	

27. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components³, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

Distinctive and dominant components

28. In its notice of opposition the opponent states:

"4...the word 'HOLY' is the dominant part of the Applicant's mark and this word is identical to the Opponent's mark."

29. In its counterstatement the applicant states:

"8. The word HOLY in the opposed mark is not the dominant component, but the words HOLY LAMA, which hang together visually and aurally."

30. The opponent's mark, 'HOLY' does not split into separate distinctive and dominant components. It will be viewed as the single word 'HOLY' which is its only constituent part.

31. The applicant's mark consists of the two words 'holy lama' in lower case. These are presented one on top of the other with the initial letters 'h' and 'l' joined and the 'y' of holy joined to the 'm' of lama. They are shown in white on a shaded background in the shape of a stylised rectangle. These combined elements take up more than half of the total mark. In its submissions the applicant states:

³ *Sabel v Puma AG*, para.23

“The dominant and distinctive component is the words ‘holy lama’...”

32. Presented below these elements is the word ‘NATURALS’ in block capitals but considerably smaller than the words ‘holy lama’. It has a circle before and after the word, the approximate size of a bullet point. In the context of the goods this will be seen as nothing more than a reference to a quality of the goods i.e. the goods have a natural origin, contain natural ingredients or respect the environment. Below this are the two phrases ‘Luxury you deserve’ and ‘Enjoy Life’. In my experience the average consumer is used to seeing such non-distinctive combinations used in advertising in relation to these types of goods. Consequently, this and the fact that these words are dominated by the larger element which contains the words ‘holy lama’ mean that they are unlikely to be afforded any origin significance.

33. I agree with the applicant that the average consumer would not separate the words ‘holy’ and ‘lama’. The two words hang together. They are physically joined and presented within a rectangular background.

34. The dominant presentation of the ‘holy lama’ element and the descriptive/non-distinctive nature of the words ‘NATURALS’, ‘Luxury you deserve’ and ‘Enjoy Life’ mean that ‘holy lama’ is the distinctive and dominant element of the applicant’s mark.

Visual similarities

35. Any visual similarity between the marks rests in the word ‘HOLY’ which is the entirety of the opponent’s mark and is presented in plain block capitals. In the applicant’s mark the word is presented in lower case and is physically attached to the word ‘lama’, also presented in lower case, both in an unremarkable font. The two words are presented on what the applicant describes as ‘*a solid curvi-rectilinear shape*’. In respect of any visual similarity the applicant submits:

“2.4 Even if the comparison was confined to the dominant components of the respective marks, holy lama is somewhat visually dissimilar to HOLY alone”.

36. The application includes the additional word ‘NATURALS’, which denotes a quality of the product and the words ‘Luxury you deserve’ and ‘Enjoy Life’ which, I have already concluded, will be seen as mere advertising puff and are common in respect of these goods.

37. Taking all of these factors into account I find the visual similarity of the marks to be low.

Aural Similarities

38. The only point of aural similarity between the marks rests in the word ‘HOLY’, which is present in both marks and will be heard first. This is a fairly common word with which the average consumer will be familiar. In the applicant’s mark the word ‘holy’ is followed by the word ‘lama’. The words are linked and hang together in the mark and form a natural break from the remainder of the mark. The remainder consists of the words ‘NATURALS’, which denotes a quality of the goods and the

words 'Luxury you deserve' and 'Enjoy Life', which I have commented on above. I have already concluded above that in my view these words are not distinctive or dominant elements within the mark. The applicant submits:

"2.5 Again, even if the comparison was confined to the dominant components of the respective marks, holy lama is somewhat aurally dissimilar to HOLY alone".

39. Taking all of these factors into consideration I find a moderate degree of aural similarity between the marks.

Conceptual similarities

40. For a conceptual meaning to be relevant it must be capable of being immediately grasped by the average consumer.⁴ I must consider the conceptual message which each mark, in its totality, would convey to the average consumer.

41. The applicant submits:

"2.6. Conceptually, the respective marks are quite different on account of their different meanings. The word 'holy' is usually used as an adjective and it is such use that will be familiar to the average consumer. According to The Chambers Dictionary (published 2003) the meanings attributed to the word 'holy' include "perfect in a moral sense; pure in heart; religious; associated with God or gods; set apart for a sacred use; regarded with awe; saintly; sanctimonious, simulating holiness". From the same reference source the meaning attributed to the word 'lama' is "a Buddhist priest or monk in Tibet". The addition of the adjective 'holy' is a mere qualifier of the subject noun 'lama', cf Dalai Lama."

42. While I note the definitions provided by the applicant, I must consider how the marks will be perceived by the average consumer. In respect of the opponent's mark the word 'HOLY' is well known and is a word with which the average consumer will be familiar. In my view the immediate conceptual message that the word HOLY will convey to the average consumer will be one of something sacred, religious or awe inspiring, in a broad sense.

43. Turning to the words 'holy lama' in the applicant's mark in my view the meaning is ambiguous. While I accept that the average consumer may well be aware of the Dalai Lama, I cannot conclude that as a consequence the average consumer will know that the word 'lama' alone refers to a Buddhist monk or priest. In addition I must also consider the fact that the word 'lama' may be seen, by some, to refer to the 'camel-like' animal, the llama, despite the difference in spelling. However, in either case, the term lama is qualified by the adjective 'holy'. Consequently, the words holy lama will, in my view, be seen as a reference to a specific holy being, whether that is an animal or a person.

⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r. -I-643; [2006] E.T.M.R. 29.

44. In my view the word 'HOLY' gives a broad impression of something sacred or awe inspiring and does not share a high degree of conceptual similarity with the immediate conceptual message provided by the words 'holy lama', which will be that of a holy being.

45. In conclusion, while there is a broad reference to something sacred in both marks, any conceptual similarity is at a fairly low level.

Distinctive character of the earlier mark

46. I must now assess the distinctive character of the opponent's earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

47. I have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. As the opponent has filed no evidence in these proceedings I have only the earlier mark's inherent distinctiveness to consider.

48. The word 'HOLY' is neither descriptive of nor non-distinctive for the goods at issue. I find it to be a trade mark with a normal level of distinctiveness.

Likelihood of confusion

49. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁵ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

50. I have found that the marks share a low degree of visual similarity, a moderate degree of aural similarity and a fairly low level of conceptual similarity. I have also identified a normal level of distinctive character in the opponent's earlier mark. In respect of the goods, I have concluded that the parties' goods are identical or highly similar. I have identified the average consumer, namely a member of the general public who buys soap, cosmetics and perfume. I have concluded that the purchasing act will, generally, be visual but may also include an aural element. The purchase will involve a reasonable degree of care and attention, given that the goods will be used on the body and the average consumer will consider fragrance, ingredients, etc.

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

51. In its submissions the applicant draws to my attention several decisions of the Registrar, Appointed Person and UK Courts and concludes the following:

“In comparing the respective marks we submit that the fact that the word holy lies at the beginning of the Applicant’s Mark will not divert the consumer’s attention away from the word lama. The dominant and distinctive component of the Applicant’s Mark is holy lama which will be perceived as a reference to a person whereas the Opponent’s Mark is simply an adjective.”

52. I agree. Taking all the above factors into account, considering the marks as a whole, and the nature of the purchasing process, I conclude that the differences between the marks outweigh the similarities. The visual differences and the distinct conceptual messages are such that the average consumer will not, in my view, (either directly or indirectly) confuse the mark of one of these undertakings for that of the other and there will be no likelihood of confusion.

CONCLUSION

53. The opposition fails.

Costs

54. The opposition having failed, the applicant, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that the applicant filed written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side’s statement:	£200
Written submissions:	£400
Total:	£600

55. I order CBM Creative Brands Marken GmbH to pay Herbosys Limited 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 31st day of May 2012

**Ms Al Skilton
For the Registrar,**