

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF APPLICATION NO. 2135416**  
**BY LANCOME PARFUMS ET BEAUTE & CIE**  
**TO REGISTER A TRADE MARK IN CLASS 3**

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 2135416  
BY LANCOME PARFUMS ET BEAUTE & CIE  
TO REGISTER A TRADE MARK IN CLASS 3**

5

**DECISION AND GROUNDS OF DECISION**

10 On 10 June 1997, Lancome Parfums et Beaute & Cie, 29 Rue du Faubourg Saint-Honoré, 75008,  
Paris, France, applied under the Trade Marks Act 1994 to register the mark TEINT VITALITE  
in Class 3 in respect of “Perfume, toilet preparations; toilet water; gels and salts for the bath and  
the shower; toilet soaps; body deodorants; cosmetics; creams, milks, lotions, gels and powders  
for the face, the body and the hands; sun care preparations; make-up preparations; shampoos; hair  
15 conditioners; gels, sprays, mousses and balms for hair styling and hair care; hair lacquers; hair  
colouring and hair decolorant preparations; permanent waving and curling preparations; essential  
oils for personal use; dentifrices.”

20 Objection was taken to the mark under Section 5(2) of the Act in respect of the following  
registered mark:

<u>Number</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>
25 2017481	VITALITE	3	Perfumes; soaps; cosmetics; non-medicated toilet preparations; bubble baths; bath and shower gels; preparations for personal and beauty care; body, face, eye, hand, moisturizing and cleansing creams, lotions, gels, scrubs, oils, 30 powders, splashes and balms; body and face powder; rouge; eyebrow pencils, eyeliners; eyeshadow; mascara; lash enhancers; lipstick; lip liners; facial and body cleansing and moisturizing masks; 35 preparations for hair care; shampoos; conditioners; hair tonics; creme rinses; styling glaze, spray, mousse and gel; shaving cream, foam and gel; aftershave lotion; skin cleansing cream and foam; 40 nail enamel and varnish; nail lacquer; sunscreens; suntanning preparations; topical skin balms, creams, lotions and moisturisers; body shampoo; dentifrices and toothpastes; mouth washes and sprays; 45 skin-whitening gels and creams; lip balms;

cellulite creams, gels and lotions; contour  
creams, gels and lotions; deodorants and  
antiperspirants.

5 At a hearing at which the applicants were represented by Mr D W J Castle of Castles, their trade  
mark agents, the objections under Section 5(2) were maintained. Following refusal of the  
application under Section 37(4) of the Act I am now asked under Section 76 of the Act and Rule  
56(2) of the Trade Mark Rules 1994 to state in writing the grounds of decision and the materials  
used in arriving at it.

10

No evidence of use has been put before me. I have, therefore, only the prima facie case to  
consider.

Section 5(2) of the Act reads as follows:

15

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

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

20

or

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

25

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

30 The mark applied for and the earlier mark raised as an objection are not identical and  
consequently Section 5(2)(a) does not apply.

Dealing first with the question of whether the goods of the application are the same or similar to  
those covered by the earlier mark. There cannot be any doubt that the goods of the cited mark  
are contained within the applicant's specification of goods.

35

Turning to the respective marks, since these are not identical, I must decide whether the mark of  
this application so nearly resembles the cited mark as to be likely to cause confusion on the part  
of the public, which includes the likelihood of association with the earlier mark. In doing so, I  
take account of the comments in the Sabel v Puma trade mark case in the European Court of  
Justice (C-251/95), 1998 RPC 199 at page 223 lines 52-54 and page 224 lines 1-23 which stated:

40

“..... In that respect, it is clear from the tenth recital in the preamble to the Directive that  
the appreciation of the likelihood of confusion “depends on numerous elements and, in  
particular, on the recognition of the trade mark on the market, of the association which  
can be made with the used or registered sign, of the degree of similarity between the trade

45

mark and the sign and between the goods or services identified”. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

5 The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive-” ..... there exists a likelihood of confusion on the part of the public .....” - shows that the perception of marks in the minds of the average consumer of the type of  
10 goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

15 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

20 The judgement links the question of a likelihood of confusion to two factors; the conceptual similarity and whether the earlier mark has a particularly distinctive character, either *per se*, or by reputation. The earlier mark comprises the word “VITALITE” alone while the applicant’s mark consists of the identical word prefixed by the word “TEINTE” which is the French word for “tint” or “shade” (see HARRAPS FRENCH/ENGLISH DICTIONARY). I should also  
25 mention that the word VITALITE is the French word for “vitality” according to the same dictionary. So far as I am aware the combination has no meaning beyond that of the individual elements e.g. “Shade vitality”. Therefore, I am comparing a registered mark “VITALITE” with a later mark comprising their mark and prefixed by a French word which is non-distinctive and descriptive for many of the goods at issue - cosmetics which impart a “tint” or “shade” of a  
30 particular colour. French is, of course, a language well-known in the United Kingdom and is commonly used on the goods under consideration.

I have no reason to assume that the cited mark was wrongly accepted and must be considered to have a distinctive character. Therefore, I must take the view that if “VITALITE” is distinctive  
35 and “TEINTE” merely descriptive or non-distinctive, the public when seeing the applicant’s mark would associate it with the mark already known to them. I am fortified in this view by the comments made in the RHEINLIEBLING case 1966 RPC 68 at page 73, lines 36-40.

40 “It seems to me that in determining whether there is such a distinction that the registration proposed will not be likely to cause deception and confusion to a substantial number of persons I must have regard to the fact that the only element of distinction is, as Maugham L.J. put it, a descriptive element.”

45 Therefore, I consider that there is a likelihood of confusion between the applicant’s mark and the cited mark, which includes the likelihood of association with the earlier mark.

5 The agent, in his submissions, argued that the marks are not visually or phonetically similar and that the prefix “TEINTE” was the most significant element of the mark. For the reasons given above I do not accept this. Although the word “TEINTE” appears first in the applicant’s mark it is a non-distinctive word and therefore I would consider “VITALITE” to be the “essential feature” and the element which will fix itself in the mind of the public.

10 He also argued that I should consider the state of the register in that there are many other marks he considers equally similar to the cited mark which co-exist. He referred to the following registrations, all covering the same or very similar goods to those of the cited registration and this application:

- 1231105 - DULCIA VITALITY
- 1487160 - LES SOINS VITALITE d’YVES SAINT LAURENT
- 1509694 - SURE VITALITY
- 1558137 - HORSE VITALITY
- 1564145 - HELENE CURTIS VITALITY
- 2057801 - LANCASTER NATURAL VITALITY
- 2137245 - GARNIER VITALITY C
- 2137261 - SYNERGIE VITALITY C

20 It seems to me that the comments by R. Jacob QC, as he was then, in the TERBULINE case, 1990 RPC 21, which drew attention to the co-existence of apparently similar marks, are apt:

25 “What I have to consider is whether the registration of the present mark is prevented by Section 12(1). That involves the consideration of whether or not it is confusingly similar to either of the earlier cited marks. In my view there must be some risk of confusing similarity within the section. At least I am not prepared to say there is not. Mr Morcom’s argument based on the two prior marks involves too much supposition. Not all members of the relevant public and trade will necessarily be aware of both cited marks and confusion between the mark applied for and one of the cited marks seems not unlikely.”

35 Although this was determined under the 1938 Trade Marks Act I consider the comments are equally valid under the present Act.

40 Nevertheless, I would observe that in all the precedents quoted, except 1487160, the marks do not contain the identical mark. In the case of 1487160 the mark consists of a long string of words including a strong housemark where the identical word might be considered to be “lost” in the totality. Clearly, I cannot be aware of all the circumstances surrounding the earlier acceptances. In the present case we are considering a clash between marks where the only difference is the presence of one non-distinctive word. For these reasons I discount the state of the register as a reason to waive the cited mark.

45 Having concluded that there is a likelihood of confusion, I determine that the application is debarred from registration by Section 5(2) of the Act.

In this decision I have considered all the documents filed by the applicant and all arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 5(2) of the Act.

5

Dated this 10 day of December 1998.

10

R A JONES

15 For the Registrar  
The Comptroller General