

O-263-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2653879
BY
MK PHARMA
TO REGISTER THE TRADE MARK**



elaverta

IN CLASS 03

AND

**THE OPPOSITION THERETO
UNDER NO 400724
BY
LAVERANA GMBH & CO. KG**

Background and pleadings

1. MK Pharma (“the applicant”) has applied to register the trade mark shown below in class 3 for *Skincare, cosmetics, creams, gels, lotions, hair products, hair cosmetics, perfumes, cleansers, soaps, face masks, make up, make up tools, make up accessories, cosmetics accessories*:



elaverta

2. The application was filed on 28 February 2013 and published for opposition purposes on 17 May 2013. Laverana GmbH & Co. KG (“the opponent”) objects to the application achieving registration because it claims there would be a likelihood of confusion with two of its own earlier trade mark registrations (a UK mark and a Community Trade Mark (“CTM”)) and an earlier application it has made for a CTM, which is itself opposed. It is sufficient at this point to note the details of the registered CTM (in so far as they are relevant to the opposition):

CTM 4098679

Lavera

Class 3: Perfumery goods; cosmetics, decorative cosmetics; face creams and lotions; skin-cleansing lotions and creams, hand and body lotions and creams; tinted moisturising creams, make-up, foundation, face powder and rouge; blemish stick, lipstick, lip pencils, eyeliner pens and mascara, eyeshadow; sun care preparations; foot creams and lotions; exfoliants; abrasive implements in the form of pumice stones; non-medicated powders and lotions for foot spas; body care products, shower gels, hair care products; shampoos and hair lotions, conditioning rinses (conditioners), combined shampoo and conditioner, hair sprays, styling mousse and gels; hair dyes; bath oils, shampoos, skin oils and creams; anti-wrinkle creams; massage oils; grooming products for men; shaving cream, after-shave balms; deodorants; antiperspirants.

Filed 29 October 2004; registration procedure completed 25 February 2008.

3. The section of the Trade Marks Act 1994 (“the Act”) under which the opponent makes its opposition is section 5(2)(b). This states:

“(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.”

4. The opponent claims that the distinctive and dominant elements in the respective marks are “LAVERA” and “LAVERTA”, and that they are similar. The opponent claims that the goods are identical or highly similar, and that there would be a likelihood of confusion as a consequence.

5. The applicant filed a counterstatement in which it denies the opponent’s claims. It made a positive choice on the statutory form of defence¹ not to ask the opponent to prove use of its registrations². I will bear in mind the applicant’s comments and treat them as submissions, rather than listing them all here. Likewise, I will treat the opponent’s fully expressed statement of its opposition as submissions. Neither side filed evidence. Both sides filed written submissions which will not be summarised but will be borne in mind and referred to as and when appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.

Decision

Comparison of goods

6. In the judgement of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, Case C-39/97, the court stated at paragraph 23 of its judgment that:

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

7. The relevant factors identified by Jacob J. in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

¹ Box 7 of the TM8 form.

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.

- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

8. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

9. The parties’ competing specifications are:

Opponent	Applicant
<i>Perfumery goods; cosmetics, decorative cosmetics; face creams and lotions; skin-cleansing lotions and creams, hand and body lotions and creams; tinted moisturising creams, make-up, foundation, face powder and rouge; blemish stick, lipstick, lip pencils, eyeliner pens and mascara, eyeshadow; sun care preparations; foot creams and lotions; exfoliants; abrasive implements in the form of pumice stones; non-medicated powders and lotions for foot spas; body care products, shower gels, hair care products; shampoos and hair lotions, conditioning rinses (conditioners), combined shampoo and conditioner, hair sprays, styling mousse and gels; hair dyes; bath oils, shampoos, skin oils and creams; anti-wrinkle creams; massage oils; grooming products for men; shaving cream, after-shave balms; deodorants; antiperspirants.</i>	<i>Skincare, cosmetics, creams, gels, lotions, hair products, hair cosmetics, perfumes, cleansers, soaps, face masks, make up, make up tools, make up accessories, cosmetics accessories.</i>

10. As per the judgment of the GC in *Gérard Meric v Office for Harmonisation in the Internal Market (“OHIM”) Case T-133/05*, goods and services can be considered as identical when the goods and services of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical. Applying this to the parties’ specifications,

- the applicant’s *skincare* covers, for example, the opponent’s face creams and lotions;
- the applicant’s *cosmetics* covers, for example, the opponent’s make-up, lipstick and eyeshadow;
- the applicant’s *creams, gels and lotions* covers, for example, the opponent’s skin-cleansing lotions and creams and shower gels;
- the applicant’s *hair products* covers, for example, the opponent’s shampoos and conditioners;
- the applicant’s *hair cosmetics* covers, for example, the opponent’s hair dyes, hair sprays, styling mousse and gels;
- the applicant’s *perfumes* covers the opponent’s perfumery goods;
- the applicant’s *cleansers* covers the opponent’s skin-cleansing lotions and creams;
- the applicant’s *face masks* is covered by the opponent’s exfoliants;
- the applicant’s *make up* is identical to the opponent’s make-up.

11. This leaves the applicant’s *soaps, make up tools, make up accessories* and *cosmetics accessories*. *Soaps* are highly similar to the opponent’s body care products and shower gels, all of which are used to clean the skin, are similar in nature (soap can be in liquid form), share the same users, are often sold nearby to one another, and are in competition (e.g. the choice being to use soap instead of shower gel).

12. The applicant’s *make up tools, make up accessories* and *cosmetics accessories* can be considered together. It is debateable whether these terms are proper to class 3 (as opposed to class 21). Leaving that aside, the users of the opponent’s make-up will be the users of the applicant’s make-up/cosmetic tools and accessories. The nature of the goods differs, as does the purpose (except to the extent that both assist in beautification). Make-up and make-up/cosmetic tools and accessories will be sold side by side. In *Boston Scientific Ltd v OHIM, Case T-325/06*, the General Court (“GC”) stated that “complementary” means that:

“...there is a close connection between them [the goods/services], 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”.

13. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

14. In the present case, the goods in question are sold together. Eyeshadows are frequently sold in a compact which includes an applicator sponge/brush combination. Face and blusher powders are applied with a make-up brush. Lip gloss, if it does not include a built-in applicator, is applied with a lip brush. The parties’ goods are complementary, are sold nearby to one another, and share the same users. There is a reasonable degree of similarity between them.

Comparison of marks

15. The respective trade marks are shown below:

Opponent’s mark	Applicant’s mark
Lavera	

16. It is clear from *Sabel BV v. Puma AG* [1998] RPC 199 (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. It would be wrong, therefore, to artificially dissect the trade

marks, although it is necessary to take into account any distinctive and dominant components and give due weight to any other features which are not negligible.

17. The opponent's mark consists of a single word, Lavera. A similar looking word appears as one of the elements of the applicant's mark. The sole difference is the additional letter 't' in the applicant's Laverta element. The other element in the applicant's mark is the letter 'e', which is offset and elevated to the left of Laverta. I think the slash or slanting line is negligible; it is unlikely to be noticed by the average consumer. The applicant submits that its mark would be read as elaverta, which matches a word mark it has registered in Australia. Firstly, how another, different, registered mark (registered in another country) will be perceived by the UK average consumer has no bearing on the perception of the mark in the form in which it has been applied for: it is the application the subject of these proceedings which is being considered, and no other. Secondly, the degree of offset and elevation of the 'e' component means that it appears as a separate entity to the Laverta component. The dominant element of the application is Laverta because (i) it is the largest element and (ii) its presentation in the mark means that it is Laverta, rather than the 'e', to which the eye will be drawn. There is a good deal of visual similarity between the marks.

18. The 'e' in the applicant's mark may be pronounced but, even if it is not, the emphasis given to the three syllables in the words in each mark will alter depending on the attempts to articulate the parties' invented words. For example, the opponent's mark might be pronounced with a long or short 'e', whilst the emphasis in the applicant's word might be on any one of its three syllables. However, the initial syllable in each word is identical (Lav) and the words both end in an 'a' sound'. On balance, there is an average degree of aural similarity between the marks.

19. The parties' marks both contain invented words, with no meaning. As the applicant itself says, in its counterstatement, "trademarks with no meanings will have no conceptual differences". The marks are neither similar nor different conceptually, because neither has a concept.

Average consumer and purchasing process

20. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97). Although I bear in mind that there may be an aural aspect to the purchasing process, the goods will be purchased primarily visually after examination on shelves, on websites and from brochures. On a notional view, these are goods of ordinary cost which will cause some degree of care to be used, but not the highest level of care.

Distinctiveness of the earlier mark

21. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

22. The opponent has not filed any evidence to show that it has used its mark, so I have only the inherent position to consider. Lavera is an invented word; invented words have a high degree of distinctive character. The earlier mark has a high degree of inherent distinctive character.

Likelihood of confusion

23. In *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2012] EWCA Civ 24 para 51 et seq, the Court of Appeal approved the following principles from the decisions of the CJEU in *Sabel BV v Puma AG*, Case C-251/95 [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97 [1999] RPC 117, *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 [2000] E.T.M.R. 723, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Case C-334/05P.

(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 in 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.

24. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison, because the average consumer perceives trade marks as wholes and rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind. It also includes the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). In these proceedings, I have found that the parties' goods are identical, highly similar, and reasonably similar.

25. The applicant's mark contains a dominant and distinctive element which is visually very similar to the sole (dominant and distinctive) element in the opponent's mark. Of course, I bear in mind that the assessment means that I should not simply

take just this component of the applicant's mark and compare it with the opponent's mark. It is an assessment of the whole mark, including the 'e'. In my view, the impact of the 'e' on the average consumer, who will pay no more than an average level of attention to the purchase of the parties' relatively low cost goods, will not sufficiently mitigate the effects of imperfectly recalling the dominant Lavera/Laverta elements. Bearing in mind the interdependency principle, referred to above in paragraph 24, this is particularly so in relation to the goods which I have found to be identical and highly similar, but is also the case in relation to the goods which are reasonably similar (make-up/cosmetic tools and accessories).

26. The marks are visually similar to a good degree. Owing to my finding that the parties' goods are primarily purchased visually, this means the level of visual similarity is more important than the lesser level of aural similarity, as per *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, in which the GC stated:

"49. However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs."

27. There is also no differing concept between the marks which might offset the visual similarity and so help to militate against imperfect recollection³. For this to work, at least one of the marks must possess a clear meaning which the average consumer will grasp immediately. As Lavera and Laverta are invented words, this counteraction cannot apply. The combination of all the factors which I have assessed throughout this decision lead me to find that there is a likelihood of confusion between the parties' marks, in relation to all of the goods for which the application has been made. The opposition succeeds in full.

28. As this earlier trade mark leads to the opposition being successful in its entirety, there is no need to consider the remaining trade marks upon which the opposition is based (UK registration 4098679 and CTM application 11493426).

³ *The Picasso Estate v OHIM*, Case C-361/04 P: "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

Outcome

29. The opposition succeeds in full. The application is refused.

Costs

30. The opponent has been successful and is entitled to the following contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007:

Preparing a statement and considering the counterstatement	£300
Opposition fee	£200
Written submissions	£250
Total:	£750

31. I order MK Pharma to pay Laverana GmbH & Co. KG the sum of £750. 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 11th day of June 2014

**Judi Pike
For the Registrar,
the Comptroller-General**