

O/318/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2547936
BY DABUR INDIA LIMITED TO REGISTER THE TRADE MARK**

DABUR UVEDA

IN CLASSES 3 AND 5

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 101632
BY AVEDA CORPORATION**

BACKGROUND

1) On 20 May 2010, Dabur India Limited (“Dabur”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark DABUR UVEDA in respect of the following goods:

Class 3

Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.

Class 5

Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; foods and beverages which are adapted for medical purposes; air deodorising preparations.

2) The application was published in the Trade Marks Journal on 26 November 2010 and on 25 February 2011, Aveda Corporation (“Aveda”) filed notice of opposition to the application. The grounds of opposition are in summary:

- a) The application offends under Section 5(2)(b) of the Act because the mark is similar to three earlier marks in the name of Aveda and is in respect of identical or similar goods. The relevant details of these earlier marks are:

Relevant details	List of goods
2218843 AVEDA Filing date: 5 January 2000 Registration date: 7 September 2001	Class 5: <i>Dietary and nutritional supplements and food supplements.</i> Class 30: <i>Dietary and nutritional beverages, non medicated herbal teas.</i> Class 35: <i>The bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and purchase those goods in a department store or high street stand-alone retail store selling lifestyle goods; compilation of mailing lists, direct mail advertising, business advisory and business management services, advertising services, display services for merchandise, publicity services, marketing and promotional services, market analysis and research, import/export services, procurement and buying of goods on behalf of a</i>

	<p><i>business, window dressing, advisory and consultancy relating to the aforesaid.</i></p> <p>Class 41: <i>Arranging and conducting demonstrations, exhibitions, conferences and seminars, all for training or educational purposes; provision of training and educational services; all relating to beauty, perfumery, make-up, skin treatment, hair care, nutritional supplements, home fragrance products and retailing.</i></p> <p>Class 44: <i>Beauty consultation services; beauty salon services, beauty treatment services, make-up services, massage services, hair care services, manicure services, pedicure services, cosmetic treatment services; consultation services in the selection and use of cosmetics, make-up, skin care preparations, hair care preparations and beauty treatment preparations; aromatherapy and reflexology; spa services.</i></p>
<p>CTM* 298117</p> <p>AVEDA</p> <p>Filing date: 14 June 1996</p> <p>Registration date: 7 May 1999</p>	<p>Class 3: <i>Hair care preparations, namely shampoo, cream rinses, hair spray and hair gel, colour rinses, liquids for permanent waves; skin care products, namely moisturising creams, lotions, cleansing lotions; lotions, beauty masks and astringent face creams for cosmetic purposes; cosmetics, namely lipsticks, eye shadow, foundations, rouges, face powder, eye pencils, lip pencils and mascara; toiletries for personal use, namely body cleansing lotions, eau-de-toilette; perfumery and eau de Cologne, massage oils and lotions; soaps; essential oils; skin creams, skin lotions, body oils and body lotions for softening and moisturising the skin; dentifrices; cleaning preparations for household use, namely all-purpose cleaning preparations; bleaching preparations and other substances for laundry use; dish-washing preparations, cleaning preparations for fabrics, window and toilet cleaning preparations; cleaning, polishing, scouring and abrasive preparations.</i></p>
<p>CTM* 4515854</p> <p>AVEDA</p> <p>Filing date: 27 July 2005</p> <p>Registration date: 07 August 2006</p>	<p>Class 4: <i>Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.</i></p> <p>Class 5: <i>Dietary and nutritional supplements, vitamins.</i></p> <p>Class 18: <i>Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags;</i></p>

	<p><i>umbrellas, parasols and walking sticks; whips, harness and saddlery.</i></p> <p>Class 21: <i>Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.</i></p> <p>Class 26: <i>Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.</i></p> <p>Class 30: <i>Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.</i></p> <p>Class 32: <i>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</i></p> <p>Class 41: <i>Educational services, in particular conducting classes, seminars and workshops all relating to cosmetology, esthology, massage therapy, hair care, body and skin care, spa therapy, salon and spa management and client relations.</i></p>
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* Community Trade Mark

- b) The application offends under Section 5(3) of the Act because Dabur's mark is similar to Aveda's marks (as detailed above) that are claimed to have a reputation. It claims that Dabur's mark will ride on the coat-tails of the opponent taking advantage of "the enormous reputation" generated by the AVEDA marks in the field of beauty and body care goods and services in the UK.
- c) The application offends under Section 5(4)(a) of the Act because of "an extremely strong and valuable goodwill and reputation under the mark AVEDA in all areas of body and beauty care". It claims that AVEDA products were first sold in the UK as early as 1994 and use has been in respect of hair care, skin care, body care, make-up and perfumery products and services.

3) Aveda's three earlier marks are all registered and all have a filing date that pre-dates the filing date of Dabur's mark. Therefore, they all qualify as earlier marks as defined by Section 6 of the Act. Two of these, namely 2218843 and CTM 298117, completed their registered procedures more than five years before the contested application was published and are, consequently, subject to the proof of use provisions set out in Section 6A of the Act.

4) The applicant subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use in respect of all the goods and services listed in the two earlier marks which are subject to the proof of use provisions.

5) Only Aveda filed evidence in these proceedings, but Dabur filed written submissions that I will take into account. Both sides ask for an award of costs. The matter came to be heard on 26 April 2012 when Aveda was represented by Ian Bartlett for Beck Greener and Dabur represented by Sophie Holcombe, of Counsel, instructed by Cresco Legal Solicitors.

Opponent's Evidence

6) This takes the form of a witness statement by Lesley A. Moradian, Vice President and trade mark Counsel employed by The Estee Lauder Companies Inc. She explains that Aveda is a subsidiary of this group of companies.

7) Ms Moradian explains that Aveda was founded in 1978 and is based in the USA and manufactures and sells skin care, cosmetics, perfume, hair care and lifestyle products. Further, Aveda also maintains a number of partnerships with salons and spas that use and sell its products with many of them offering beauty services under the name AVEDA. There are nearly 7,000 hair salons and spas in 24 countries around the world.

8) Ms Moradian provides evidence of use in response to Dabur's request for proof of use. She understands the relevant period for demonstrating use to be between 26 November 2006 and 26 November 2010 and focuses her evidence on this period. The period is actually 27 November 2006 to 26 November 2010.

9) This evidence is intended to illustrate use of the AVEDA mark in the UK in respect of hair care products, skin care products, cosmetics, oils, perfumes and teas and also in respect of a range of beauty services. These products and services are sold through forty retail stores and 570 salons in the UK. Ms Moradian provides exhibits in the form of order lists, example packaging, invoices and advertisements to support this claim to use.

10) Turnover between £22 million and £26 million is disclosed for each of the financial years 2006 to 2011, with a promotional spend for the same years of between £1.5 million to £2.2 million.

11) For reasons that will become obvious, it is not necessary for me to provide further details of this evidence.

DECISION

Preliminary Point

12) Mr Bartlett sought to admit further evidence in the form of a witness statement and exhibits demonstrating recent use of the applicant's mark in the UK. I rejected this on the grounds that the evidence was of minimal, if any, relevance to my considerations of the case.

Proof of use

13). Section 6A of the Act reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

14) Aveda relies upon three earlier marks. Earlier marks 2218843 and CTM 298117 completed their registered procedures on 7 December 2001 and 7 May 1999 respectively. The contested application was published on 26 November 2010. Therefore, both of these earlier marks, by virtue of completing their registration procedures more than five years before the contested application was published, are subject to the proof of use provisions. The third mark relied upon by Aveda, namely CTM 4515854, completed its registration procedure on 7 August 2006. This is less than five years before the publication of the contested mark and is not subject to the proof of use requirements.

15) In light of the above, and given that all three earlier marks are for the same word AVEDA, it is only necessary to consider the issue of proof of use in respect of goods and services covered by the first two of Aveda’s marks that are not also covered by its third mark (where it is entitled to rely upon the full list of goods and services). At the hearing Mr Bartlett provided a list of goods and services that Aveda claim proof of use has been shown, namely:

Class 3

Hair care preparations, namely shampoo, cream rinses, hair spray and hair gel, colour rinses, liquids for permanent waves; skin care products, namely moisturising creams, lotions, cleansing lotions; lotions, beauty masks and astringent face creams for cosmetic purposes; cosmetics, namely lipsticks, eye shadow, foundations, rouges, face powder, eye pencils, lip pencils and mascara; toiletries for personal use, namely body cleansing lotions, eau-de-toilette; perfumery and eau de Cologne, massage oils and lotions; soaps; essential oils; skin creams, skin lotions, body oils and body lotions for softening and moisturising the skin; cleaning, polishing, scouring and abrasive preparations for use on the body.

Class 4

Scented candles.

Class 30

Dietary and nutritional beverages and non medicated herbal teas.

Class 35

The bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and purchase those goods in a department store or high street stand-alone retail store selling lifestyle goods and specifically relating to grooming, beauty cosmetics, make-up, skin care and related products.

Class 41

Arranging and conducting of education, demonstrations, exhibitions, conferences and seminars relating to beauty, cosmetology, esthology (skin care and treatments), massage therapy, make-up, hair care, nutritional supplements, home fragrance products and retailing, spa therapy, salon and spa management and client relations.

Class 44

Beauty consultation services; beauty salon services, beauty treatment services, make-up services, massage services, hair care services, manicure services, pedicure services, cosmetic treatment services; consultation services in the selection and use of cosmetics, make-up, skin care preparations, hair care preparations and beauty treatment preparations; aromatherapy and reflexology; spa services.

16) Ms Holcombe conceded that use had been shown in respect of all of these goods and services with one exception, namely *herbal teas* in Class 30. However, *non-medicated herbal teas* are covered by the broad term *teas* in Class 30 of Aveda's third mark CTM 4515854, consequently, the point has no real relevance.

17) There is a potential issue of whether Aveda claims cover for medicated herbal teas by virtue of its Class 5 term *Dietary and nutritional supplements*. However, this is a question that I need not decide as its third mark CTM 451854 includes this same broad term, so if this term covers medicated herbal teas then by virtue of the specification in Aveda's third mark, the point has no real relevance. On the other hand, if medicated herbal teas are not covered by the

broad term then the two earlier marks that are subject to proof of use, do not cover medicated herbal teas. Either way, there is no need to demonstrate use.

Section 5(2)(b)

18) Section 5(2)(b) reads:

“(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.”

19) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH (MEDION)*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods/services

20) In assessing the similarity of goods/services, it is necessary to apply the approach advocated by case-law and all relevant factors relating to the respective goods and services should be taken into account in determining this

issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

„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.’

21) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

22) Taking account of the concessions made by Dabur regarding proof of use and the goods and services that Aveda is entitled to rely upon by virtue of its third earlier mark CTM 451854 (that is not subject to the proof of use provisions), the full lists of goods and services that Aveda may rely upon are as follows:

2218843

Class 30: *Dietary and nutritional beverages* [Use in respect of *non medicated herbal teas* not examined, but covered by *teas* in the Class specification of CTM 4515854, below].

Class 35: *The bringing together, for the benefit of others, of a variety of goods, enabling customers conveniently to view and purchase those goods in a department store or high street stand-alone retail store selling lifestyle goods;* [and limited at the hearing to *and specifically relating to grooming, beauty cosmetics, make-up, skin care and related products*]

Class 41: *Arranging and conducting of education, demonstrations, exhibitions, conferences and seminars; all relating to beauty, make-up, skin treatment, hair care, nutritional supplements, home fragrance products and retailing.*

Class 44: *Beauty consultation services; beauty salon services, beauty treatment services, make-up services, massage services, hair care services, manicure services, pedicure services, cosmetic treatment services; consultation services in the selection and use of cosmetics, make-up, skin care preparations, hair care preparations and beauty treatment preparations; aromatherapy and reflexology; spa services.*

CTM 298117

Class 3: *Hair care preparations, namely shampoo, cream rinses, hair spray and hair gel, colour rinses, liquids for permanent waves; skin care products, namely moisturising creams, lotions, cleansing lotions; lotions, beauty masks and astringent face creams for cosmetic purposes; cosmetics, namely lipsticks, eye*

shadow, foundations, rouges, face powder, eye pencils, lip pencils and mascara; toiletries for personal use, namely body cleansing lotions, eau-de-toilette; perfumery and eau de Cologne, massage oils and lotions; soaps; essential oils; skin creams, skin lotions, body oils and body lotions for softening and moisturising the skin; cleaning, polishing, scouring and abrasive preparations [limited at the hearing to for use on the body].

CTM 4515854

Class 4: *Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.*

Class 5: *Dietary and nutritional supplements, vitamins.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.*

Class 21: *Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.*

Class 26: *Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.*

Class 30: *Coffee, tea [and as I have stated earlier, including non-medicated herbal tea], cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.*

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 41: *Educational services, in particular conducting classes, seminars and workshops all relating to cosmetology, esthology, massage therapy, hair care, body and skin care, spa therapy, salon and spa management and client relations.*

23) In considering the similarity of the above goods and services with those of Dabur's, I bear in mind the guidance of the General Court ("GC"), in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05* paragraph 29, that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice-versa. I also bear in

mind the guidance of the General Court (“the GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 that to be complimentary, goods must be important and even indispensable to the existence of the goods they are being compared.

24) Guidance has also been provided by the courts when considering the scope of goods/services. This suggests I must take account of the circumstances of the particular trade and how the public would perceive the use (*Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, para 31) and that terms should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities (*Avnet Inc v Isoact Ltd (Avnet)* [1998] FSR 16). Finally, I should not attribute an unnaturally narrow meaning to terms (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [2000] FSR 267).

25) In considering the following similarity of goods and services, I make no distinction between which of Aveda’s three earlier marks its terms are listed, as this has no impact upon the outcome of the proceedings.

Daabur’s Class 3 goods

26) At the hearing, Mr Bartlett conceded that Dabur’s *Bleaching preparations ... for laundry use* are not similar to any of Aveda’s goods or services.

27) In respect of Dabur’s *other substances for laundry use*, Mr Bartlett argued that such goods are similar to *scented candles*. Clearly, the nature, intended purpose, users, method of use are so obviously different that it follows that the respective goods are not in competition or complementary in any way. I conclude there is no similarity.

28) In respect of Dabur’s *cleaning, polishing, scouring and abrasive preparations*, Mr Bartlett submitted that such terms include goods for use on the body and, consequently, the terms are in respect of identical goods to those of Aveda. I remain unconvinced by this submission. The natural meaning attributed to Dabur’s unqualified term is likely to be one of describing household or industrial preparations rather than those for use on the body. This perception is amplified by the use of all four adjectives together in the same term. There is nothing before me to illustrate that the terms *scouring preparations* and *abrasive preparations* are terms used to normally describe preparations for use on the body (even where a preparation may actually work by scouring or abrading part of the body). These terms are more readily associated with preparations that have household or industrial applications. The inclusion of such terms in the overall term *cleaning, polishing, scouring and abrasive preparations* has the consequence of leading the reader (and consumer) to believe that the overall term relates to household and/or industrial preparations and not preparations for use on the body. Such a finding appears to be consistent with the guidance provided in *Beautimatic* and *Thomson Holidays*. The guidance provided in and

Avnet was in respect to services rather than goods, but even if it is considered that the guidance has equal application to the consideration of goods, I do not see my finding as being inconsistent with that guidance. In summary, I find that Dabur's *cleaning, polishing, scouring and abrasive preparations* are not similar to Aveda's goods, as identified by Mr Bartlett.

29) In respect of Dabur's *soaps; perfumery, essential oils, cosmetics* these are also listed in Aveda's Class 3 specification and they are, therefore, self evidently identical.

30) Dabur's *deodorants for personal use* are not replicated in Aveda's specifications. However, deodorants are toiletry items of which various items are listed in Aveda's specification. In particular, Aveda's specification includes *eau-de-toilette; and eau de Cologne*. Whilst such goods are not identical, they have a similar intended purpose, namely to mask body odour on the one hand, and imparting a pleasing fragrance upon the wearer on the other hand. The nature of these goods is also similar, even though they may be applied to the body in various (and in some cases different) ways. There may be significant overlap in trade channels with such respective goods often being sold in close proximity to each other (and even both appearing together in gift packs etc). Taking all of this into account, I conclude that these respective goods share a reasonably high level of similarity.

31) Dabur's *hair lotions* are not obviously identical to Aveda's *shampoo, cream rinses, hair spray and hair gel, colour rinses, liquids for permanent waves*, I do not rule out that a cream hair rinse, for example, may not be classified as a hair lotion. Nevertheless, even if not identical, there is clearly a very high level of similarity, with the respective goods having a very similar or identical purpose, method of use and user. Further, these respective goods will appear in close proximity to each other in shops.

32) Finally, I consider the similarity of Dabur's *dentifrices* with Aveda's goods and services. These are pastes or powders for cleaning the teeth¹. Whilst such goods can, therefore, strictly be described as "cleaning preparations", I nonetheless find that there is no similarity with Aveda's *cleaning ... preparations* in Class 3. The reason for this is the same as set out in my paragraph 28 above.

Dabur's Class 5 goods

33) Mr Bartlett submitted that Dabur's *Pharmaceutical [...] preparations* includes medicated skin care preparations and that these share a high similarity with Aveda's *skin care products* in Class 3. I concur with this submission. These

¹ "dentifrice". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 19 July 2012 <<http://oxforddictionaries.com/definition/english/dentifrice>>.

respective goods may share the same nature (for example, being a cream for application directly to the skin), and may also have an overlap of trade channels with these respective goods being sold in the same type of retail outlet and if not on the same, then at least in closely adjacent parts of the outlet. Their intended purpose of improving the condition of the skin, is also the same, even though, they may act in a different way. Consequently, I conclude that these goods share a reasonably high level of similarity.

34) Mr Bartlett argued further that Dabur's *preparations for destroying fungicides* could be in the form of *medicated skin preparations* and, as such, they are also very similar to Aveda's *skin care products*. I am not convinced by this rationale. I do not believe that such an interpretation should be given to the term *preparations for destroying fungicides*. Rather, the term will ordinarily be understood as referring to products not designed for use on the body. Consequently, and for the same reasons as set out in paragraph 28 above, I conclude there is no similarity with Aveda's goods.

35) In respect of Dabur's *veterinary preparations; sanitary preparations for medical purposes* it is not obvious to me that these share similarity with any of Aveda's goods and services. Their nature and intended purpose are clearly different and they are not in competition with, or complimentary (in the sense identified in *Boston Scientific*) to any of Aveda's goods and services.

36) Despite Mr Bartlett's claim that all of Dabur's goods have a connection to the goods and services of Aveda, in respect of Dabur's *food for babies, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, preparations for destroying vermin and herbicides*, I see no similarity. These goods are different to those of Aveda in that they differ in their purpose, nature, method of use and trade channels. Neither can they be said to be in competition, or complementary to Aveda's goods and services. Consequently, I find that the respect goods and services are not similar.

37) Next, I consider the similarity between Dabur's *dietetic substances adapted for medical use* and *foods and beverages which are adapted for medical purposes* and Aveda's *dietary and nutritional supplements*. Here, there may be an overlap of intended purpose, namely to treat a medical condition and they may be similar in nature, all being in a form that can be consumed. Consequently, they may appear on the same, or closely adjacent, parts of a retail outlet. Further, they may be in competition if the respective goods are perceived as being beneficial in the treatment of a particular condition. Taking all of this into account, I conclude that these goods share a high level of similarity.

38) Finally, in respect of Dabur's *air deodorising preparations*, Mr Bartlett submitted that these are similar to Aveda's *scented candles*. Both goods may impart a fragrance even if, in the case of air deodorisers, such a fragrance is intended to remove or conceal an unpleasant smell. It is not usual that

deodorising preparations are in the form of candles. It is not usual for these respective goods to share the same trade channels and there may be an element of competition where scented candles may be purchased to act as a deodoriser despite this not necessarily be their intended purpose. Taking all of this into account, I find that these goods are reasonably similar..

The average consumer

39) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

40) Both parties' specifications include Class 3 goods such as cosmetics and cleaning preparations. Such goods are relatively regular purchases, with the latter purchased as part of regular shopping for grocery and general provisions. Consequently, such goods are not bought with the greatest of care, but nonetheless, for goods such as cosmetics, more consideration may be involved than in respect of everyday purchases. The purchases are likely to involve mainly visual considerations, but I do not discount that aural considerations may also be relevant.

41) In respect of the parties' Class 5 goods, some goods (such as disinfectants) are likely to involve a very similar purchasing process to that discussed in the above paragraph. Both parties' marks include food supplements or foods adapted for medical purposes. Here, consideration is likely to be higher than in respect of ordinary grocery products, but nevertheless it will not be of the highest order. Others, such as pharmaceutical and veterinary preparations may also be purchased in a more considered way.

Comparison of marks

42) For ease of reference, the respective marks are:

Aveda's mark	Dabur's mark
AVEDA	DABUR UVEDA

43) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). It is self evident that the dominant and distinctive part of Aveda's mark is the word AVEDA itself, being the only element of the mark. Dabur's mark consists of the words DABUR and UVEDA. Neither appear to have any meaning and will

both be perceived as made up words. Consequently, as made up words, I conclude that DABUR and AVEDA share equal dominance within the mark.

44) I now turn to consider the visual similarity between the marks. Aveda's mark consists of a single, five letter word and Dabur's mark consists of two five letter words. Consequently, Dabur's mark is twice the length as Aveda's mark. However, the last four letters VEDA that appear in the second word of Dabur's mark are the same as the last four letters of the word comprising Aveda's mark. Taking account of these differences and similarities, I conclude that the respective marks share a low degree of visual similarity.

45) From an aural perspective, Mr Bartlett submitted that AVEDA and UVEDA are virtually indistinguishable. I concur that they are very similar, with both consisting of the identical second and third syllables. Whilst the first syllable is different, when considering the words as a whole the pronunciation U-VE-DA and A-VE-DA is still very similar. Of course, Dabur's mark also has the two syllable word DABUR as the first part of its mark and is a significant point of aural difference. Taking all of this into account I conclude that the respective marks share a moderate level of aural similarity.

46) It is common ground between the parties that neither mark has any conceptual meaning. Consequently, they are neither conceptually similar nor dissimilar.

47) In summary, I have found that the respective marks share a low level of visual similarity, a moderate level of aural similarity but that they are neither conceptually similar nor dissimilar. This combines to give the marks a moderate level of similarity overall.

Distinctive character of the earlier trade mark

48) I must consider the distinctive character of the earlier mark because the more distinctive it is, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier trade mark must be assessed by reference to the goods for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91).

49) The word AVEDA has no obvious meaning and as such, being perceived as a made-up word, endows the mark with a high level of inherent distinctive character.

50) Whilst the evidence illustrates significant use of the mark AVEDA in respect of various beauty products and services, the resultant enhancement to the marks distinctive character is not decisive in these proceedings, in light of the inherently high level of distinctive character that is already endowed in the mark.

Likelihood of confusion

51) I must adopt the global approach advocated by case-law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

52) At the hearing, Ms Holcombe submitted that the parties' respective goods and services could be differentiated because the range of goods listed in Dabur's specifications reflected that it is in the field of health, cleaning and hygiene whereas Aveda is focussed upon high-end cosmetics. It is not clear to me that such a distinction can be perceived, but even if it can, the guidance provided by Richard Arnold QC in *Oska's Ltd's trade mark* [2005] RPC 20 indicates that this is not relevant when assessing likelihood of confusion because "a likelihood of confusion must be assessed on the basis of normal and fair use of the mark in relation to the goods specified in the application, which is not limited in any particular types [...] nor to any particular market" and "even if it is assumed that the target market of the applicant's goods would not be confused, that does not negate the existence of a likelihood of confusion if the applicant's mark were to be used in other ways falling within the scope of normal and fair use [...]"

53) Consequently, I shall approach this analysis based on normal and fair use of the services listed in the respective specifications.

54) At the hearing, Mr Bartlett submitted that the similarity of the UVEDA element of Dabur's mark with the word AVEDA leads to a finding of confusion. In support of this he referred me to the decision *BULOVA ACCUTRON* [1969] RPC 102, where it was stated:

"The present issue is not simply a comparison of two words; but the comparison is one word with a composite mark the second component of which has been held confusingly similar to ACCURIST. Can this component be said to be rendered innocuous now that it appears with and is preceded by BULOVA? I do not think that I can hold that it is and that there is any less risk of deception or confusion. I think that a person having, for example, an imperfect recollection of ACCURIST is just as likely to confuse it with ACCUTRON in the composite mark. As BULOVA and ACCUTRON do not hold together as a phrase or present a wholly different meaning from the separate components, I think that their combination will be taken by many persons on first impression as an indication that the manufacturer of the watches is using two separate trade marks in connection with his products. A person meeting BULOVA ACCUTRON and confusing the latter word with ACCURIST is, I think, likely to consider that BULOVA is another mark which he had previously not observed or which had not been drawn to his attention before."

55) Mr Bartlett also referred to paragraphs 30 and 31 of *MEDION* where the CJEU concluded that it is possible for an element of a mark to have an independent distinctive role without being the dominant element of the mark and that, in such a case, the similarity of that element to that of the other party's mark may create an overall impression that the respective goods and services derive from an economically linked undertaking.

56) On the other hand, Ms Holcombe submitted that Aveda uses its mark with other words such as LOVE and ELEMENTS and that such use is analogous with how Dabur use its mark, namely with DABUR as a house mark. I dismiss this approach for two reasons. Firstly, Aveda's use of its mark, with an additional element, is not a consideration when deciding upon a likelihood of confusion under Section 5(2)(b) of the Act. Secondly, even if it was, I do not find that such use is on all fours with Dabur's mark that consists of two invented words rather than an invented mark followed by a (possibly allusive) ordinary English word.

57) Nevertheless, I am not convinced by Mr Bartlett's approach. I have already found that the DABUR and UVEDA elements of Dabur's mark share equal prominence in its mark. I have particular regard for the guidance in *MEDION* (as referred to by Mr Bartlett) and also in *Matratzen Concord GmbH v OHIM Case T-6/01 [2002] ECR II-4335* and *Matratzen Concord GmbH v OHIM Case C-3/03P*. However, in the current case, it is my view that the word UVEDA does not have a dominant role as referred to in these cases. It has no more than an equal dominance with the word DABUR. When considering the marks as a whole, it is my view that the addition of the word DABUR and the different first letter in the words UVEDA/AVEDA are sufficient to avoid a likelihood of confusion, even where identical goods are involved.

58) In light of the above, the opposition based upon the grounds under Section 5(2)(b) of the Act, fails in its entirety.

Section 5(3) and Section 5(4)(a)

59) At the hearing, Mr Bartlett made it clear that both these grounds were secondary to those based upon Section 5(2)(b) and that he was of the view that both grounds should follow my Section 5(2) findings. Consequently, I will not comment further, other than to concur with Mr Bartlett that Aveda is unlikely to achieve greater success than that already achieved under Section 5(2)(b) of the Act.

COSTS

60) The opposition having failed, Dabur India Limited is entitled to a contribution towards its costs. I take account that a hearing has taken place and that only Aveda filed evidence. I award costs on the following basis:

Considering Notice of Opposition and statement and preparing own statement:	£300
Considering other side's evidence:	£500
Preparing for, and attending hearing	£750
TOTAL	£1550

61) I order Aveda Corporation to pay Dabur India Limited the sum of £1550. 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 22nd of August 2012

**Mark Bryant
For the Registrar,
the Comptroller-General**