

O-358-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2563418
IN THE NAME OF NEW WORLD HOTEL MANAGEMENT (BVI) LIMITED TO
REGISTER THE TRADE MARK**

SENSE

IN CLASS 44

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 102122
BY GREENCLOSE LIMITED**

BACKGROUND AND PLEADINGS

1) On 5 November 2010, Rosewood Hotels and Resorts, L.L.C. applied under the Trade Marks Act 1994 for registration of the mark SENSE in respect of *Spa services; health spa services; beauty spa services* in Class 44. The application was published in the Trade Marks Journal on 11 February 2011. It was subsequently assigned to New World Hotel Management (BVI) Limited. For the purposes of this decision, it is not necessary for me to differentiate between the two companies and, consequently, my use of the term “the applicant” is used to describe either of these enterprises.

2) On 11 May 2011, Greenclose Limited (“the opponent”) 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 it is in respect of a mark that is visually, phonetically and conceptually similar to an earlier mark in the name of the opponent and is in respect of identical services. The mark relied upon is registered and therefore qualifies as an earlier mark as defined by Section 6 of the Act. The relevant details of the opponent’s mark are as follows:

Mark and relevant details	List of services
<p>2359129</p> <p>SenSpa</p> <p>Filing date: 23 March 2004</p> <p>Registration date: 17 September 2004</p>	<p>Class 3: <i>Soaps, perfumery, essential oils, cosmetics, massage oils, aromatherapy oils, anti-perspirants; aromatics; bath salts; creams; beauty masks; cleansing preparations; cotton wool; lotions for cosmetic purposes; oils for cosmetic and cleansing purposes; shampoos; all included in Class 3.</i></p> <p>Class 41: <i>Healthclub services; leisure services; provision of healthclub services; provision of bathing and swimming facilities; provision of sporting facilities; provision of keep-fit and recreational facilities; personal training and development services.</i></p> <p>Class 44: <i>Provision of hygienic and beauty care; information and advisory services relating to health, diet and exercise; beauty treatments; heat treatments and wet treatments; provision of facial treatments, body treatments, hydrotherapy and spa and water treatments; pedicure and manicure services; physiotherapy; day spas; health resort services; beauty salons; aromatherapy; provision of saunas, steam rooms, hot tubs, spa pools and Turkish baths; massages; provision of spa services.</i></p>

- b) the application offends under Section 5(4)(a) of the Act because use of the applicant’s mark would be contrary to the law of passing off. The opponent has operated an upmarket spa and health facility in Hampshire since 2004 and has built up a considerable and valuable goodwill in the mark SENSPA in respect of spa and beauty services and related goods.

3) In respect of both grounds, the opponent also draws attention to the applicant’s practice outside the UK (it is stated that they are currently not trading

in the UK) of adding the word SPA to the mark applied for i.e. "SenseSpa" and it has a website sensespa.com.

4) The applicant subsequently filed a counterstatement denying the opponent's claims and put it to proof of use.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side requested to be heard and I make my decision based upon a careful consideration of the papers on file.

Opponent's Evidence

6) This takes the form of a witness statement, dated 31 October 2011 by Ms Lina Lotto, Spa Director for the opponent's "SenSpa" spa facility in Hampshire, since its opening in 2004. Ms Lotto states that the spa and health club has been widely advertised and publicised throughout the UK since 2004. All of Ms Lotto's documentary evidence is grouped together in a single exhibit, Exhibit LL1. This includes examples of such advertising. Most of the 35 pages are undated, but the third page has the typed date "7/2/06" appearing at the top of the page and refers to massage, hydrotherapy and mud treatment services. Another makes references to yoga and relaxation classes, spa facilities and spa treatments and refers to further services being available in 2008.

7) Ms Lotto states that pages 8 to 35 are copies of pages from SenSpa's current brochure. One of these pages lists industry awards won by the facility. These awards variously relate to the years 2007 to 2011. The brochure identifies a wide range of facilities available including swimming pool, gymnasium, hydrotherapy pool, herbal sauna, steam room, thermal room, relaxation room, ice room, mud room, and 17 treatment rooms. Services include the provision of "over 40 treatments" including "wet treatments", hydrotherapy, mind body classes, facials, relaxation massage, deep body cleanse, body polish and body wraps, mud treatments, manicures, pedicures and hand and foot grooming. Various marks are shown including numerous occurrences of the word only SenSpa that corresponds to the earlier marks relied upon. Other examples include quotes about the facility that appeared in publications such as Vogue.com, Closer online, The Guardian, The Independent, Top Sante, Cosmopolitan and the Daily Express.

8) Ms Lotto provides photographs of various goods bearing the mark SenSpa or with references under the picture referring to SenSpa products. Such goods include room sprays, body oils, face mist, essential oils and body polish.

9) Ms Lotto states that SenSpa has a wide and varied customer base with both individuals and businesses using its facilities. To illustrate this, numerous customer reviews are provided as part of the exhibit.

10) Ms Lotto discloses that SenSpa's turnover has grown from £1 million in 2004/5 to about £2.2 million in 2010/11. Annual marketing spend for the same period has averaged £87,807. Marketing is undertaken both in print and online and includes SenSpa's own magazine called "Escape", a copy of the Winter 2010 addition is also provided in the exhibit with many pages showing use of the mark *SenSpa*.

11) The SenSpa facility has also received "considerable" press coverage and Ms Lotto provides a compilation of quotes where SenSpa has been commented upon favourably. These include comments that appeared in magazines such as Natural Health, Marie Claire, Top Sante and Health and Fitness and newspapers such as The Independent, The Telegraph, Surrey Advertiser, Daily Express, The Guardian as well as numerous online publications. Articles from such magazines and newspapers are also exhibited.

12) SenSpa has also won numerous industry awards and Ms Lotto also exhibits a list of these.

13) Ms Lotto states that 90% of SenSpa's business is booked by telephone, with the other 10% being booked via the Internet.

14) The exhibit includes copies of pages from the applicant's website entitled "Rosewood Hotels & Resorts" and illustrates the applicant referring to its facilities as "Sense® spa".

15) Ms Lotto also makes a number of submissions that I will not detail here, but I will bear in mind when making my decision.

Applicant's Evidence

16) This takes the form of a witness statement by Mr Nicholas Christopher Alwyn Bolter, of Edwards Wildman Palmer UK LLP, the applicant's representatives in these proceedings.

17) At Exhibit NCB2, Mr Bolter provides copies of printouts of three websites obtained on 29 February 2012 showing use of the word SENSES to identify businesses operating in the spa services field. The first is from the web site www.sensesspa.co.uk promoting the SENSES Face and Body Spa near Crieff in Perthshire. The second is an extract from the Marriott Hotels website promoting "Sense at the London Marriott Hotel, Regent's Park" offering facials, manicures and massages. The third is from the website www.senses-skincare.co.uk. Whilst the text is not clear, it appears to be promoting Senses Skin Care Beauty Salon in Derbyshire.

18) The remainder of Mr Bolter’s statement is in the form of submissions and criticisms of the applicant’s evidence. I will bear these in mind, but I will not detail them here.

Opponent’s Evidence in reply

19) This takes the form of a witness statement by Abigail Louise Stevens, Solicitor at Thrings LLP, the representative for the opponent in these proceedings. At pages 1 to 7 of the single Exhibit ALS1, Ms Stevens provides a further selection of customer reviews obtained from the website www.tripadvisor.co.uk in response to criticism that the opponent’s original evidence failed to demonstrate a customer base (and therefore, reputation) throughout the UK. The first five are all dated in 2008, and two further are dated in August and September 2010 respectively. The reviewers are based in Wiltshire, Kent, Wales and Bath, as well as one from a customer based overseas.

20) In response to criticism that readership figures were unknown in relation to exhibits in the original evidence illustrating press coverage of the SenseSpa facility, Ms Stevens provides information regarding the Mail on Sunday, The Daily Mail, The Times, The Independent, The Observer and The Daily Telegraph newspapers. Unsurprisingly, for UK national newspapers, these all reflect significant readership figures ranging from about 600,000 to nearly 5 million. Similarly large readership figures are also provided for the magazines Red, Vogue, Country Homes & Interiors, Hello and Marie Claire.

21) Ms Stevens states that the marketing spend for the opponent’s Careys Manor Hotel (that includes the SenSpa facility) is approximately £96,000. Ms Stevens does not specify what period of time that this figure relates to.

DECISION

Proof of use

22) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision 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...”

23) Consideration has to be taken, also, of section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit, or that there are proper reasons for non-use.

24) The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Anna Carboni, sitting as the Appointed Person in BL O-371-09 SANT AMBROEUS:

42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the

goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

25) The application being challenged was published on 11 February 2011, consequently the five year period when the opponent is required to demonstrate use is between 12 February 2006 and 11 February 2011.

26) Taking account of this guidance from the courts it is clear that genuine use does not need to be quantitatively significant and that, when asking if the use is genuine, it is necessary to assess all surrounding circumstances.

27) I will begin my consideration of proof of use in relation to the opponent's class 44 services because they provide it with its best chance of success in these proceedings.

28) The range of facilities and services provided at the opponent's spa facility are comprehensively detailed in the brochure exhibited by Ms Lotto who states, in her witness statement of 31 October 2011, that it is the "current brochure". Therefore, the brochure was "current" some eight months after the end of the relevant period. However, this is a relatively short period of time after the end of the relevant period, and I take the view that the facilities and services provided by the opponent are unlikely to have changed to any significant extent in the interim period. Therefore, I accept that the facilities and services promoted in this brochure accurately reflect what was available at least at the end of the relevant period. Such a view is further supported by a number of the other exhibits that do illustrate a number of these facilities and services were available during the relevant period. In particular, the page dated "7/2/06" that refers to massage, hydrotherapy and mud treatment services and the page that appears to be from 2007 (as it refers to further services being available in 2008) that makes references to yoga and relaxation classes, spa facilities and spa treatments.

29) The October 2011 brochure lists the following facilities: swimming pool, gymnasium, hydrotherapy pool, herbal sauna, steam room, thermal room, relaxation room, ice room, mud room, and 17 treatment rooms. Further, it also identifies the following services being available: wet treatments, hydrotherapy, mind body classes, facials, relaxation massage, deep body cleanse, body polish and body wraps, mud treatments, manicures, pedicures and hand and foot grooming.

30) Taking all of this into account, together with the fact that the exhibits consistently show that these facilities and services are identified by the mark “SenSpa”, I conclude that use has been shown in respect of all the services listed in the opponent’s Class 44 specification, with the exception of *physiotherapy*. None of the exhibits appear to illustrate any services that would be described as, or be covered by this term.

31) Consequently, I find that for the purposes of considering the similarity of services, the opponent is able to rely upon the following list of Class 44 services:

Provision of hygienic and beauty care; information and advisory services relating to health, diet and exercise; beauty treatments; heat treatments and wet treatments; provision of facial treatments, body treatments, hydrotherapy and spa and water treatments; pedicure and manicure services; day spas; health resort services; beauty salons; aromatherapy; provision of saunas, steam rooms, hot tubs, spa pools and Turkish baths; massages; provision of spa services.

Section 5(2)(b)

32) 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.”

33) 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 (LIMONCELLO). 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 trade 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*

(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 (LIMONCELLO)*

Comparison of services

34) In line with my approach when considering the issue of proof of use, I will restrict my considerations to the similarity between the respective Class 44 services. The opponent's best case rests with its services in this class.

35) In assessing the similarity of 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.’

36) 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).

37) Finally, I also bear in mind the guidance of the General Court (“the 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. The same is also

true where the application contains a general category that includes goods listed in the earlier mark.

38) The respective lists of services are as follows:

Opponent's Class 44 services	Applicant's services
<i>Provision of hygienic and beauty care; information and advisory services relating to health, diet and exercise; beauty treatments; heat treatments and wet treatments; provision of facial treatments, body treatments, hydrotherapy and spa and water treatments; pedicure and manicure services; day spas; health resort services; beauty salons; aromatherapy; provision of saunas, steam rooms, hot tubs, spa pools and Turkish baths; massages; provision of spa services</i>	<i>Spa services; health spa services; beauty spa services</i>

39) Taking account of the guidance of the courts and, in particular, the guidance of the GC in *MERIC*, it is self evident that all of the opponent's services are either included in the applicant's broader terms or are, for all intent and purposes, identical to the applicant's services. I conclude that all of the applicant's services are identical to the opponent's Class 44 services.

The average consumer

40) As matters must be judged through the eyes of the average consumer (*Sabel BV v.Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the services at issue. As I have found that the parties' respective services are identical it follows that the respective average consumer will also be the same.

41) The respective services may attract individual consumers or corporate groups, as reflected in SenSpa's brochure put in evidence by Ms Lotto. Such services are generally considered to be luxury services and whilst they may not be very expensive, they are more so than everyday purchases such as groceries and toiletries. Consequently, the level of attention of the consumer will be higher than in respect to such everyday products. Nevertheless, the level of attention will not be of the highest level that may be involved in, for example, purchasing a car or property.

42) Ms Lotto contends that enquiries to, and bookings for SenSpa's services are predominantly taken over the telephone. The implication is that the purchasing process is predominantly an aural one. It is argued on behalf of the applicant that this is not relevant because potential customers will have already identified the business before making telephone contact. Neither side has presented evidence

to support their argument, but I favour the applicant's position because anyone contacting a spa is likely to have obtained the number from a source (brochure, website, phone book etc) where the name of the spa will be presented. Consequently, I consider that the purchasing process will rely, to a great degree, on visual contact with the respective marks. However, I do not ignore that aural consideration may play a part where, for example, a customer hears of facilities by word of mouth or aural advertising (such as on the radio).

Comparison of marks

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

Opponent's mark	Applicant's mark
SenSpa	SENSE

44) 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). The opponent's mark consists of two conjoined elements SEN and SPA. The first letter of both the SEN and the SPA elements are in a capitals serving to identify the two groups of three letters as separate elements within the mark. However, the distinctive character resides in the totality with the SEN element being allusive of an adjective acting upon the SPA element.

45) Turning to the comparison of the marks, from a visual perspective, both marks begin with the same four letters SENS. They differ in that the opponent's mark consists of six letters, whereas the applicant's mark consists of five letters. The fifth (and sixth) letters are different. Finally, the opponent's mark is presented with the two occurrences of the letter "S" in the mark are presented in capitals, in contrast to the remaining letters that are presented in lower case. Taking account of these similarities and differences, I conclude that the respective marks share a moderate degree of visual similarity.

46) From an aural perspective, the opponent's mark is likely to be pronounced as the two syllables SEN-SPAA. The applicant's mark is likely to be pronounced as SEN-SS. The first sound is identical. In respect of the second sound, the applicant's mark comprises a sound as when pronouncing the sound of the letter "s". This same sound forms the start of the second syllable of the opponent's mark, but that is the only similarity between these respective elements. A point of difference is that the opponent's mark is presented as two distinct syllables, whereas, in the applicant's mark the sounds are pronounced together as a single syllable. Taking account of all of this, I conclude that the respective marks share a moderate degree of aural similarity.

47) Conceptually, Ms Lotto contends that "SenSpa" alludes to the sensory nature of the services offered and, consequently, the marks are similar. The applicant

submits that “SenSpa” has no meaning and consequently, any conceptual comparison is irrelevant. I reject Ms Lotto’s contention. There is nothing before me to illustrate that “Sen” is recognised or understood as an abbreviation for “sensory” or any other similar word. Any allusive quality attached to “SenSpa” is only of the very vaguest of nature, and it is far from obvious to me that the average consumer will make such a link. Even if I am wrong on this point and the “Sen” element does allude to the sensory element of the services, the highest point of the opponent’s case is that the word SENSE may also allude to the same sensory nature. It cannot and has not been said that “Sen” will be seen as an abbreviation for, or allusive of the word SENSE. To my mind, it is more likely that the “Sen” element of the mark is likely to be perceived as an invented word with the descriptive word “spa” attached. Consequently, there will be some concept of a spa perceived in the mark, but it is my view that this will be the limit of the conceptual impression created. The applicant’s mark consists of the word “sense”, one of its meanings being “a faculty by which the body perceives an external stimulus; one of the faculties of sight, smell, hearing, taste, and touch”¹. This is an ordinary English word that will be readily understood by the average consumer of the goods and services at issue. Taking account of all of the above, I conclude that there is no conceptual similarity between the respective marks.

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 (nurture) 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) I have already concluded that the opponent’s mark will not have any conceptual meaning beyond that identified by the “Spa” element of the mark, consequently, the mark as a whole will be perceived as invented. As a result, it is endowed with a reasonably high level of inherent distinctive character, however, this is not of the highest level because of the “Spa” element giving the impression that the invented mark is related to spa goods and services.

50) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act is that an inherent level of distinctive character may be enhanced through use. In this case, Ms Lotto indicates that the opponent’s spa facility identified by the mark SenSpa has a turnover of about £2.2 million, but no indication is provided as to the market share that this represents. It has received coverage in the national press, however, I take account that it is operated from a single location. Taking all of this into account, I

¹ "sense". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 18 September 2012 <<http://oxforddictionaries.com/definition/english/sense>>.

conclude that the distinctive character of the opponent's mark may be enhanced to a small degree because of this use. However, as the mark is already endowed with a reasonably high level of inherent distinctive character, this slight enhancement as a result of its use is unlikely to be a major factor in the global approach considered below.

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) The applicant relies upon evidence of numerous other similar marks being present on the trade marks register, contending that if the opponent's mark is able to co-exist with these without confusion, it can also co-exist with the applicant. I note this argument, but such "state of the register" evidence is not relevant. I draw support for this from the judgement of Jacob J in *British Sugar* [1996] R.P.C. 281 at 305 where he stated:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence."

53) Whilst the applicant is not currently trading in the UK, Ms Lotto provides evidence to show that the applicant refers to itself, on its website, as "Sense spa" and contends that when used in this way, the mark is aurally very similar to the opponent's mark. Mr Bolter contends that such overseas use is not relevant. I concur that such use is not relevant. The mark I am considering is SENSE and not SENSE SPA. Any action against use of the latter would be subject to different proceedings. Consequently, I find that evidence of such use is not persuasive in these proceedings.

54) Ms Lotto also contends that because 90% of enquiries and bookings in respect of the opponent's SenSpa facility are received by telephone, then aural considerations dominate during the purchasing process. I have already found, in paragraph 42 above, that this is not the case and it is likely that potential

customers will first identify the facility from marketing material, the Internet or phone book. I concluded that the purchasing process is predominantly visual.

55) Taking account of all my comments above, I find that the moderate degree of aural and visual similarity and the lack of conceptual similarity combined with a reasonably high degree of care and attention during the purchasing act, is such as to result in there being no likelihood of confusion, even recognising that identical services are involved.

56) The opposition, insofar as it relies upon Section 5(2)(b) of the Act, fails in its entirety.

Section 5(4)(a)

57) The opponent's case relies upon factors that mirror its case pleaded under Section 5(2)(b) and as exemplified by Ms Lotto's comments at paragraph 28 and 29 of her witness statement where, when discussing the opponent's passing-off case, she offers the following view:

“28. The Applicant's Sign is confusingly similar to the Opponent's SENSPA brand for the reasons set out above. The Applicant's use is therefore likely to lead the average consumer to believe that the services offered by the Applicant are part of the Opponent's business or vice versa and/or are in some way associated with the Opponent.

29. Use of the Sign is therefore likely to damage the valuable reputation and goodwill of the Opponent in its SENSPA brand.”

58) I do not detect a passing-off case pleaded by the opponent that goes beyond its claim of the marks being confusingly similar. I have already given my findings of no likelihood of confusion. Consequently, it follows that the opponent's case based upon Section 5(4)(a) must also fail.

COSTS

59) The applicant seeks costs not only in respect to the proceedings relating to the substantive issues, but also in respect of the late filing of the opposition. The issue was determined by the Registry and communicated to the parties in the Registry letter of 30 June 2011. It was acknowledged that the issue arose, in part, because of an error on the part of the Registry. Under such circumstances, it is not appropriate to make an award of costs against the opponent insofar as this issue is concerned. Consequently, I decline to include this factor in the award of costs.

60) Further, the applicant also argues that if the opponent persists (as it has) with its Section 5(4)(a) claim, it will seek off-scale costs because it is obvious that the

opponent does not have the required significant reputation. I dismiss this submission also. Goodwill, for the purposes of establishing a passing-off claim, does not have to be extensive (see for example *Stacey v 2020 Communications* [1991] FSR 49 (HC)). Consequently, the opponent was not required to demonstrate a “significant reputation”. Whilst it has not been necessary to consider the claim based upon Section 5(4)(a), I am satisfied that the opponent’s failure on these grounds was for reasons other than demonstrating that it has the requisite goodwill.

61) Nevertheless, the opposition having failed, the applicant is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place, that both sides filed evidence (but that both of which were of little value) and also that both sides filed submissions. I award costs on the following basis:

Considering Notice of Opposition and preparing statement in reply	£300
Preparing evidence and considering other side’s evidence	£500
TOTAL	£800

62) I order Greenclose Limited to pay New World Hotel Management (BVI) Limited the sum of £800. 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 26th day of September 2012

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