

O-388-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2507485  
BY NB LABS LIMITED  
TO REGISTER THE TRADE MARK  
NuBo PERFECTIONIST  
IN CLASSES 3, 5, 29, 30 & 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER Nos. 99338 BY  
ESTEE LAUDER COSMETICS LIMITED**

## BACKGROUND

1) On 29 January 2009 NB Labs Ltd (hereinafter the applicant) applied to register the trade mark “NuBo PERFECTIONIST” in relation to the following goods:

In Class 3: Cosmetics; preparations and treatments for the skin; soaps; perfumery; essential oils; hair lotions; cosmetic products for women and men for various parts of the human body, such as face, eyes, lips, teeth, hair, neck, body, hands, feet, nails; beauty creams; beauty serums; beauty milks; beauty lotions; tonic lotions; beauty masks; beauty gels; beauty oils; make-up removing milks; make-up removing rinses; extracts; toilet soaps; scrubbing and exfoliating products; powders; talcum powders; make-up products; perfuming products; perfumes; eau de toilette; eau-de-Cologne; deodorants; hair care products; hair lotions; shampoos; bath and shower products for cosmetic uses; cosmetic products taken orally; refreshing aerosols for the skin; moisturizing products; hygiene products for beauty purposes.

In Class 5: Pharmaceutical preparations; dietetic substances for medical use; diabetic foodstuffs; herbal preparations for medical purposes; herbal supplements and herbal extracts; herbal beverages; vitamins, vitamin preparations; minerals, mineral preparations; vitamin and mineral food supplements; food supplements; foods and beverages adapted for medical purposes; functional foods and nutraceuticals.

In Class 29: Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; compotes; eggs; milk and milk products; edible oils and fats, margarine.

In Class 30: Confectionery; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread and pastry; ices and ice cream; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

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

2) The application was examined and accepted, and subsequently published for opposition purposes on 17 April 2009 in Trade Marks Journal No.6781.

3) On 17 July 2009 Estee Lauder Cosmetics Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

| Mark                       | Number         | Filing date/<br>registration date | Specification   |
|----------------------------|----------------|-----------------------------------|---|
| ESTEE LAUDER PERFECTIONIST | CTM<br>2919249 | 31.10.2002 /<br>31.01.2005        | Class 3:Cosmetics, skincare,<br>toiletries, hair care and<br>perfumery. |

- b) The opponent states that it has used the above mark in the UK since 2002 in relation to cosmetics and skincare. It states that the word “perfectionist” within the mark is a distinctive and separate element. As a result of this use it contends that it enjoys reputation and goodwill in the word “perfectionist”. It states that the goods in Classes 3 & 5 are identical or similar and that the marks are similar. As a result it contends that the mark in suit offends against Sections 5(2)(b) and 5(4)(a) of the Act.
- 4) On 23 April 2010 the applicant filed a counterstatement which denied the opponent’s claims.
- 5) Both parties filed evidence, and both seek an award of costs in their favour. The matter came to be heard on 21 September 2011. At the hearing, the applicant was represented by Mr Silcock of Counsel instructed by Messrs Harrison Goddard Foote; the opponent was represented by Mr Bartlett of Messrs Beck Greener.

**OPPONENT’S EVIDENCE**

6) The opponent filed a witness statement, dated 30 November 2010, by Lesley Moradian a Vice-President and Senior Trade Mark Counsel employed by the opponent in New York, U.S.A., a position she has held since 1989. She states that the opponent sells its variously branded products worldwide with sales in 2009 of over U.S.\$7billion. She states that her company has sold a range of cosmetics under “Estee Lauder Perfectionist” in the UK since 2002. She also claims that, during the same period in the UK, her company promoted and sold cosmetics simply under the mark “perfectionist”. She states that the goods have been sold via retailers such as John Lewis, Boots and Debenhams and also online via Amazon etc. She provides the following figures for the UK:

| Year                       | Sales £ million | Advertising & promotion £ |
|----------------------------|-----------------|---------------------------|
| 1 July 2006 – 30 June 2007 | 2.0             | 283,173                   |
| 1 July 2007 – 30 June 2008 | 1.42            | 94,499                    |
| 1 July 2008 – 30 June 2009 | 2.72            | 778,745                   |

7) Ms Moradian states that the “perfectionist product has won many awards”. She also points out that the applicant’s product is marketed as an anti-wrinkle cream. She provides the following exhibits:

- LM2: A copy of a page from the opponent’s website which describes the “perfectionist” range as including care and treatment of the skin as well as being cosmetics. The pages show pictures of the product which clearly display the name Estee Lauder, the whole website is also identified as Estee Lauder at the top of each page.

- LM3: Copies of web pages from retailers which shows use of “Estee Lauder Perfectionist”. It also shows that if a search is carried out using “Perfectionist [CP+] Targeted Deep Wrinkle Filler” the search will find the opponent’s product. There are a few instances of “perfectionist wrinkle lifting serum by Estee Lauder”.
- LM5: Samples of advertising in the UK all of which have “Estee Lauder” clearly displayed in addition to the words “perfectionist [CP+]”.
- LM6: Copies of editorial mentions of both “Estee Lauder Perfectionist” and “perfectionist [CP+] by Estee Lauder” in the UK.
- LM7: Copies of internet pages which show the opponent’s product and its packaging. The words “Estee Lauder” are in a different script and somewhat remote from the word “Perfectionist”, although always visible.
- LM 8 & 9: Copies of advertisements for the applicant’s product which it is claimed shows that the word “NuBo” is distanced from the word “perfectionist”. These are similar to the opponent’s website pages in that once on the NuBo site which is clearly identified at the top of the page, the word “perfectionist” is somewhat isolated.

## **APPLICANT’S EVIDENCE**

8) The applicant filed a witness statement, dated 2 March 2011, by Marina Shcherbinina a director of the applicant company. She states that prior to launching their NuBo Perfectionist range of products in late 2008 her company researched the market. She provides at exhibit MS1 an excerpt from the Mintel report entitled “Facial Skincare Intelligence, June 2008”. This shows that the UK skincare market was worth £275 million in 2008, which means that the opponent’s market share was 0.19%. In the analysis of major companies, Estee Lauder is included but there is no mention of their “perfectionist” range. She states that the Mintel report makes it clear that there are different market’s for men’s and women’s products. She provides, at exhibit MS1A, a screen shot of a list of recent reports from Mintel which suggests that men’s products are reported upon separately from women’s products. She states that she is unaware of any crossover skincare products. She states that when she chose the mark she “had in mind a particular male character, being a perfectionist”. She provides the following definition of the word from the Collins English dictionary (10<sup>th</sup> edition):

“Noun: 1. A person who strives for or demands the highest standards of excellence in work etc. 2. A person who believes the doctrine of perfectionism. – Adjective:3. Of or relating to perfectionism.”

## **OPPONENT’S EVIDENCE IN REPLY**

9) The opponent filed a second witness statement by Ms Moradian, dated 19 April 2011. She provides considerable detail to show that the applicant's product is not simply a "cosmetic make-up product" but a product which moisturises and fills or blurs wrinkles, just like the product of the opponent. At exhibit LM14 she provides copies of web pages from a number of manufacturers showing that they use the same trade mark such as "DNAage", "Q10", "Age fitness" etc, albeit in slightly different packaging for men and women. She repeats that her company's "perfectionist" range is ranked number 4 in the UK for firming products.

10) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

11) I first consider the ground under Section 5(2)(b) which reads:

"5.-(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."

12) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

13) In these proceedings the opponent is relying upon its earlier mark which has an application date of 31 October 2002, and a registration date of 31 January 2005. It is clearly an earlier trade mark and as it had not been registered for five years at the point at which the application in suit was published, 17 April 2009, it is not subject to The Trade Marks (Proof of Use, etc) Regulations 2004.

14) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) 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] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 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)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(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/ 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; 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;

(e) 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;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) 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;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) 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;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

15) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods in their specifications.

16) In the instant case the opponent has provided evidence regarding use of its mark. However, whilst the opponent has shown turnover and marketing figures which in themselves are reasonably substantial, it would appear that they have only a 0.2% share of the UK skincare market. It cannot therefore benefit from an enhanced reputation. To my mind, the opponent's mark has an average degree of inherent distinctiveness given that it consists of a name and also the word "perfectionist" which describes the individual purchasing or using the product.

17) I must determine who the average consumer would be for the goods of both parties in Classes 3 & 5 (the opposed goods). Broadly speaking the relevant goods are cosmetics, perfumes, personal hygiene products, vitamins, health supplements and pharmaceuticals. It was accepted at the hearing that the average consumer would be the general public who would be reasonably circumspect.

18) In its' skeleton argument the applicant accepted that the goods in classes 3 and 5 of its application must be regarded as identical or similar to the opponent's goods in Class 3.

19) I now turn to consider the marks of the two parties. For ease of reference these are reproduced below:

|                    |                            |
|--------------------|----------------------------|
| Applicant's mark   | Opponent's mark            |
| NuBo PERFECTIONIST | ESTEE LAUDER PERFECTIONIST |

20) In its skeleton argument the applicant contended that there was no similarity at all between the marks. It said:

“13. Firstly, the ECJ's decisions in Sabèl and Lloyd emphasise that the comparison of marks must be based on the overall impression given by the marks, bearing in mind in particular their dominant and distinctive components, on the basis that the average consumer normally perceives the mark as a whole without proceeding to analyse its various details.

14. This principle was expanded upon by the then CFI in the case of Matratzen Concord GmbH v. OHIM 120021 ECR II-4335, where it was held that the mere fact that both marks contained the same element was not in itself a sufficient basis for holding that the two marks in question, when compared as a whole, were similar. Instead, regard had to be had to the dominant and distinctive components of the marks (and so in that particular case the marks were held to be similar by the CFI essentially by reason of the fact that the element MATRATZEN was the dominant and distinctive element in both marks).

15. Consequently, against the background of the evidence filed in this case, it is submitted that there is no similarity between the Opponent's CTM and the Applicant's Mark, for the following reasons:

15.1 visually and aurally the marks are clearly different, when taken as a whole, since each mark is prefixed by its owner's "house mark" (ESTEE LAUDER for the Opponent, and NuBo for the Applicant), which constitutes the dominant and distinctive part of each respective mark as a whole, yet which is not shared between the parties' respective marks, with their shared suffix PERFECTIONIST constituting the weaker, generally laudatory, and less distinctive element in each case;

15.2 in the case of the Opponent's CTM, the house mark comprises not only the first part of the mark, but also the first two of its three component words, and half of its syllables;

15.3 furthermore, the initial house mark prefixes are in any event completely different from one another, and it is well established that the start of a mark is generally more significant than the end of a mark;

15.4 further, the Opponent's CTM comprises three words, whereas the applicant's mark comprises two;

15.5 even if the dominant and distinctive characteristics of both marks are not principally the "house marks", but derive from the combination of the house marks with the shared suffix PERFECTIONIST, then the distinctive character of each mark derives from the combination of that suffix with the house mark in question, with the result that the fact that the house mark is not shared means that the marks cannot realistically be regarded as being similar;



15.6 conceptually the marks are also clearly different, as a result of the fact that the marks first elements comprise the parties' different house marks.

16. The Opponent's difficulties are compounded by the fact that the suffix PERFECTIONIST is essentially a "limping" mark of the kind identified by Jacob J. in *British Sugar plc v. James Robertson & Sons Ltd* 11996I RPC 281 (Ch), being an essentially laudatory epithet, used as a product range name or identifier, but possessing relatively low distinctive character on its own, and requiring the assistance of the main house mark, with which it has to be used in combination, in order for the public to be able to discern the origin of the goods. In "7' [2000] ETMR 14, at 23 and 22, the OHIM Board of Appeal stated that "... where a claimed mark appears together with the name of the supplier for specific products, there is a prima facie presumption that the mark functions as a mere identifier sign." "... [A] mere identifier sign will not function as a trade mark, but rather as a means of distinguishing the appellant's various products from one another". It is submitted that whilst it is not strictly binding upon the Registry as a principle of law, the same presumption ought nevertheless to be applied here as a matter of fact.

17. It is presumably by reason of these very difficulties that the Opponent sought to register the mere identifier PERFECTIONIST in combination with its house mark in the first place. The evidence, it is submitted, simply does not rebut this presumption, and does not establish that the mark PERFECTIONIST has achieved distinctive character independently of the house mark.

18. For all of the above reasons it is submitted that there is no similarity between the parties respective marks, and it is therefore unnecessary to consider whether or not there could be any resulting likelihood of confusion.

19. Furthermore, on all the facts of this case, applying the global appreciation test, there is in fact no realistic likelihood of confusion on the part of the average consumer in any event, for all of the reasons given above.

20. In the circumstances, therefore, it is unsurprising that the Opponent has been unable to furnish any examples of confusion actually having taken place on the part of real consumers, despite the fact that the Applicant's Mark has been in use for some time now."

21) The applicant has also sought to rely upon the decision with regard to the digit "7" in the *Caterham* case. However, I do not believe that this case is on all fours with the instant issue. In the *Caterham* case there was evidence that a number of other car manufacturers also had the digit "7" registered as part of short trade marks such as "A7" and "S7". It was also found that the digit "7" had never been used, *solus*, to identify the products of Caterham. It had always been used with the word "Lotus" or "Caterham". Unsurprising it was found that the digit "7" did not serve as an identifier of origin.

22) The opponent referred me to the case of *Bulova Accutron* [1968] F.S.R. 336 where Stamp J. adopted the following wording of the Hearing Officer:

“The present issue is not simply a comparison of two words; but the comparison of one word with a composite mark the second component of which has been held to be 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.”

23) The opponent contends that the average consumer will focus on the word “perfectionist” rather than the house mark and will assume that the PERFECTIONIST range is now made by NuBo, or that NuBo is controlled or associated with Estee Lauder, or that NuBo is a sub brand of Estee Lauder i.e. for men’s products. At the hearing it was contended:

“The word PERFECTIONIST is perfectly distinctive in itself. It does not have any reference to the products at all. It may have reference to a person, an “ist”, but it doesn’t have any reference to the products. It is instructive but there is no evidence of the use of the mark by any other party.”

And:

“If you look at the way in which the marks are used, you will see that there is a considerable distance, generally speaking, on the packaging and the labelling on the Opponent’s products, as there is on the Applicant’s products. So the word PERFECTIONIST is not intimately tied on these products with the house marks NuBo or Estee Lauder.”

24) I do not believe that the Bulova case is on all fours with the instant case as the comparison was between “BULOVA ACCUTRON” and “ACCURIST”. In the instant case both marks have house marks which serve as badges of origin. It was also contended that the word “perfectionist” is not used by any other companies in the cosmetics field apart from the two protagonists. The evidence filed by the opponent does not show that the word “perfectionist” is used as an identifier either by the opponent or by others such as retailers or in magazines. The applicant categorises the word “perfectionist” as a “limping trade mark”, and states that the word is laudatory. I agree with this contention. To my mind, the word could be said to describe the individual purchasing or using the

product in that if they are a perfectionist then this is the product for them. It can also be said to be descriptive of the product as offering perfection in skin tone or look.

25) Clearly there are visual and aural differences between the marks as they each contain an entirely different house mark. However, they do both share the word “perfectionist”. To my mind the word “perfectionist” does not possess a distinctive character independent of the house mark in both parties’ marks. The visual and aural differences outweigh any similarities.

26) Conceptually, the average consumer is provided with the idea that if they are a perfectionist then this is the product for them. The house marks inform as the originator of the product.

27) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. In this case the goods will not be purchased without some consideration. However, the applicant accepts that all the goods in Class 3 are identical whilst the applicant’s goods in Class 5 are similar to the opponent’s goods in Class 3. Although both marks contain the same laudatory word this does not perform an independent distinctive role. There are very obvious differences between the marks of the parties as they contain house marks which are very different. I therefore conclude that there is no likelihood of confusion with the earlier trade mark, nor is there a likelihood of association with the earlier trade mark. The ground of opposition under Section 5(2)(b) fails.

28) I now turn to the ground under Section 5(4)(a) which reads:

“5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

29) In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the grounds of opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the applicant from those of other undertakings (see section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Article 4(4)(b) of the Directive and section 40 of the Act) by enforcement of rights

which the opponent could then have asserted against the applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731 is (with footnotes omitted) as follows:

'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.'

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

'To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

30) I also note the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation;

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

31) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

32) First I must determine the date at which the opponent's claim is to be assessed; this is known as the material date. In this regard, I note the judgment of the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM) Joined Cases T-114/07 and T-115/07. In that judgment the GC said:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non registered national mark before the date of filing, in this case 11 March 2000.”

33) In its evidence the opponent claims to have first used their “Estee Lauder perfectionist” mark in 2002, whereas the applicant states that it first used its mark in “late 2008” prior to applying for registration on 29 January 2009. The relevant date must be “late 2008”.

34) it is clear from the evidence, which is mostly unchallenged, that the opponent enjoyed reputation in its mark “Estee Lauder Perfectionist” for cosmetics as at the

relevant date. Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent's mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act on this basis must fail.

35) I now turn to consider the second strand of opposition under Section 5(4)(a), that the opponent also enjoyed a reputation under the mark "perfectionist" *solus*, for cosmetics and skincare. At paragraph seven above I have summarised the evidence filed by the opponent on this point. I note that in the main the word "perfectionist" is used just after the house mark "Estee Lauder" or is closely followed by the words "by Estee Lauder". There are a few instances where the term "perfectionist [CP+]" is used without the house mark "Estee Lauder" being present in the surrounding wording. However, these instances tend to be on the Estee Lauder website and so the house mark is always visible. Even on the examples of packaging shown the house mark is always easily visible and acts as a reminder of the trade origin. There is no independent evidence regarding the opponent's reputation in the word "perfectionist". All of the sales figures would appear to relate to products which have the house mark "Estee Lauder" clearly visible. To my mind the opponent has not managed to get over the first hurdle regarding goodwill. The opposition under Section 5(4)(a) in relation to the mark "perfectionist" *solus*, therefore fails.

#### COSTS

36) The applicant has been successful and as such it is entitled to a contribution towards its costs.

|  |        |
|--|--------|
| Preparing a statement and considering the other side's statement               | £200   |
| Preparing evidence and considering and commenting on the other side's evidence | £700   |
| Preparing for and attending a hearing  | £1,000 |
| TOTAL  | £1,900 |

37) I order the opponent to pay the applicant the sum of £1,900. This sum 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 10<sup>th</sup> day of November 2011**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**