

O-389-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION 2547623  
BY ROBERTA RENZONI IN RESPECT OF THE FOLLOWING MARK IN  
CLASSES 9, 18 & 25:**

**WOMANITY**

**AND**

**OPPOSITION THERETO (NO 101029) BY CLARINS FRAGRANCE GROUP  
S.A.S.**

## **The background and the pleadings**

1) Mrs Roberta Renzoni applied for the trade mark: **WOMANITY** on 17 May 2010. It was published in the Trade Marks Journal on 13 August 2010. The goods for which registration is sought are:

**Class 09:** Spectacles, sunglasses, spectacle cases, spectacle chains.

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

**Class 25:** Clothing, footwear, headgear.

2) Clarins Fragrance Group S.A.S.<sup>1</sup> (“CFG”) opposes the registration of Mrs Renzoni’s mark in respect of all of the above goods. Its opposition was filed on 6 October 2010 and is based on section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). Two earlier marks are relied upon, namely:

i) International Registration (“IR”) 993781 for the mark: **WOMANITY** which designated the European Community for protection on 6 January 2009. It is registered for:

**Class 03:**

Perfumes, scented waters, toilet water, eau-de-Cologne, toiletry products, bath or shower preparations for cosmetic purposes, deodorants for personal use, perfumed soaps, perfumed talcum powder, scented cosmetic creams, scented cosmetic lotions, lotions and gels (non-medical) for skin care, perfumery, cosmetics, hair lotions.

ii) IR 1009004 for the mark: **WOMANITY** which designated the UK for protection on 3 July 2009. It is registered for:

**Class 41:**

Entertainment, cultural activities, production of films, theatrical performances, production and performance of shows

3) Both marks constitute earlier marks as defined by section 6 of the Act. As neither mark had had its protection conferred before the five year period ending on the date of publication of Mrs Renzoni’s mark, the use conditions do not apply to them; there is no dispute about this.

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<sup>1</sup> At the time the opposition was lodged it was called Thierry Mugler Parfums S.A.S.

4) Mrs Renzoni filed a counterstatement denying the grounds of opposition. Only CFG filed evidence. Neither party requested a hearing. Neither party filed written submissions. I will, though, take account of any arguments presented in the papers before me.

### **The request(s) for a stay**

5) It should be noted that the parties jointly requested a stay in June 2011 for the purpose of settlement negotiations. This was granted. I subsequently held a case-management conference with the parties on 10 November 2011 in view of a further request to stay the proceedings. Given the state of play the parties described, I allowed a further stay until 30 April 2012, but indicated that unless there were exceptional circumstances no further stays would be permitted. A further stay was requested but my view was that there were no exceptional circumstances and a preliminary indication was issued to refuse the request for a further stay. Neither party requested a hearing or a case-management conference to discuss this matter. The timetable to conclude matters was then reset, giving, effectively, a further three months to conclude the final steps in the proceedings. I reminded the parties that this time could be used, simultaneously, to conclude settlement negotiations; no settlement has been reached. I am satisfied that ample time has been given to the parties to conclude matters and that in the absence of a settlement agreement, the substantive case should proceed to final determination.

### **The evidence**

6) This comes from Ms Sophie Charpentier Giraud, a lawyer working for CFG. She states that CFG was founded by Thierry Mugler who she describes as “one of the world’s leading and most widely recognized fashion designers”. Exhibit SCG1 contains information about Mr Mugler from the *Wikipedia* website and from other resources on the Internet. He is clearly a designer of some repute, but his true level of repute in the UK is not altogether clear from this evidence. He may be known by those who have an interest in fashion, but beyond this it is not clear. What I do note is that Mr Mugler has branched out into the production of perfumery. Ms Giraud explains that Mr Mugler began with Clarins GMBH in 1990. CFG was then established with the perfumes developed and sold by it being closely associated with Mr Mugler. Prints from the website [www.thierrymugler.com](http://www.thierrymugler.com) are provided in SCG2 showing a range of what are said to be products of CFG, including various perfumes, including WOMANITY. There is no information as to the sales of WOMANITY in the UK or elsewhere. Ms Giraud states that WOMANITY was adopted as a fragrance name in 2008 and first registered in France. Early French registrations included goods in classes 9, 18 & 25.

7) Ms Giraud believes that the class 3 goods of CFG’s earlier mark are similar to the goods of Mrs Renzoni’s application. She states that it is widely recognized

that fashion designers (such as Mr Mugler) have extended their trade in clothing to fashion accessories such as perfumery, cosmetics, sunglasses, handbags etc. She says that such goods share the same users, the same general purpose (to enhance the appearance of the user) and are often sold in the same outlets. She also highlights that the class 18 goods of Ms Renzoni is so broad as to cover cases, bags and purses for cosmetics and, as such, will be complementary to CFG's class 3 goods. Provided in Exhibit SCG5 are various website prints showing what Ms Giraud says is this trade expansion. A brief summary of this exhibit is as follows:

- ARMANI – a website (douglas-shop.com) selling Armani Fragrances. Prints from amazon.co.uk show Armani clothing, sunglasses and belts. Armani clothing is shown on the website of Harrods.
- BURBERRY – fragrances shown on douglas-shop.com, then a variety of websites selling clothing, bags and sunglasses.
- BVLGARI - fragrances shown on douglas-shop.com and listed on Bvlgari's website. Then a variety of pages are provided (including Bvlgari's own website) showing sunglasses and bags.
- CALVIN KLIEN - fragrances shown on douglas-shop.com. Then on its own website there are sunglasses, bags and clothing. Sunglasses, clothing, wallets and bags are also shown on amazon.co.uk. Web prints from Harrods are provided showing underwear and a body wash on the same page.
- Chloe – fragrances shown on douglas-shop.com. Sunglasses, bags and jewelry are shown on its own website and on amazon.co.uk. Web prints from Harrods are provided showing bags, shoes and jewelry.
- DIESEL - fragrances shown on douglas-shop.com. Sunglasses, bags and clothing are shown on its own website. Clothing, wallets, watches and sunglasses are shown on amazon.co.uk. Clothing is shown on the website of Harrods.
- DKNY – fragrances shown on douglas-shop.com. Sunglasses, clothing and bags are shown on its own website. Sunglasses, bags and clothing are shown on amazon.co.uk. Watches and purses are shown on the website of Harrods. Bags and purses are shown on the website of Selfridges.
- DOLCE & GABBANA - fragrances shown on douglas-shop.com. Clothing, sunglasses and bags are shown on its own website. Sunglasses and bags are shown on amazon.co.uk. Bags, clothing and shoes are shown on the website of Harrods.

- GUCCI - fragrances shown on douglas-shop.com. Glasses, goggles, bags and clothing are shown on its own website. Sunglasses, belts and clothing are shown on amazon.co.uk.
- HUGO BOSS - fragrances shown on douglas-shop.com. Sunglasses, watches, shoes, bags and what may be a fragrance bottle are shown on its own website. Clothing is shown on amazon.co.uk. Shoes are shown on the website of Harrods. Bags, clothing and wallets are shown on the website of Selfridges.
- LA PERLA - fragrances shown on douglas-shop.com. Clothing is shown on its own website. Clothing is shown on the websites of amazon.co.uk and Selfridges.
- LANVIN - fragrances shown on douglas-shop.com. Fragrances, bags and clothing are shown on its own website. Swimwear and bags are shown on the website of Harrods. Bags, jewelry and shoes are shown on the website of Selfridges.
- PRADA - fragrances shown on douglas-shop.com. Various unclear items are shown on its own website. Clothing, sunglasses and bags are shown on amazon.co.uk.
- TRUE RELIGION – fragrances shown on douglas-shop.com. Fragrance, sunglasses and clothing is shown on its own website. I note that “Fragrance” is listed in the “ACCESSORIES” category, the other sub-categories being “hats”, “belts” and “sunglasses”. The prices on this website are in dollars. Clothing and sunglasses are shown on amazon.co.uk. Bags are shown on the website nurseblog.com. Clothing is shown on the website of Harrods.
- VIKTOR & ROLF - fragrances shown on douglas-shop.com. Fragrances and bags are shown on its own website. Bags are shown on the website foundem.co.uk. Clothing is shown on amazon.co.uk. Shoes are shown on the website of Selfridges.
- THIERRY MUGLER – clothing and fragrances are shown on its own website. Bags and jewelry on a US “boutique” website (possibly part of its own website).

8) Ms Giraud also believes that the class 41 services of CFG’s earlier mark cover fashion shows. She states that fashion shows would feature the goods of the opposed application, thus being related and similar.

## **Section 5(2)(a)**

9) Section 5(2)(a) of the Act reads:

“5.-(2) A trade mark shall not be registered if because –

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

(b)....

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

10) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-3/03 Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10). In relation to section 5(2)(a), I particularly bear in mind that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(d) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

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

(f) 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;

(g) 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.

11) As stated above, whether there exists a likelihood of confusion must be appreciated globally, bearing in mind all relevant factors. However, for there to be a likelihood of confusion under section 5(2)(a), not only must the respective marks be identical, but there must also be some similarity between the respective goods/services. The first point (identical marks) is straightforward. Mrs Renzoni seeks to register the word **WOMANITY** which is identical in every respect to CFG's earlier marks which consist of exactly the same word. **The marks are identical.** In terms of the goods/services, I note that in Case C-398/07 P, *Waterford Wedgwood plc v Assembled Investments (Proprietary) Ltd and Office for Harmonisation in the Internal Market* the CJEU stated:

34. However, the interdependence of those different factors does not mean that the complete lack of similarity can be fully offset by the strong distinctive character of the earlier trade mark. For the purposes of applying Article 8(1)(b) of Regulation No 40/94, even where one trade mark is identical to another with a particularly high distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. In contrast to Article 8(5) of Regulation No 40/94, which expressly refers to the situation in which the goods or services are not similar, Article 8(1)(b) of Regulation No 40/94 provides that the likelihood of confusion presupposes that the goods or services covered are identical or similar (see, by way of analogy, Canon , paragraph 22).

35. It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in Canon . However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, Canon , paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.

12) In view of the above, if I find that the goods/services are not similar then there can be no finding of a likelihood of confusion. I will though be cautious in my approach because even if there is a low degree of similarity then there could still be a likelihood of confusion when the other factors, and their interdependency, are considered. I will begin by comparing the goods/services.

## Comparison of goods/services

13) When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

14) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

15) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the

responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product/service is, as a practical matter, regarded for the purposes of the trade”<sup>2</sup> and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>.

17) I will begin by considering the position in respect of CFG’s IR protected in class 3. As can be seen from its evidence, the primary plank of CFG’s evidence and argument rests on the relationship between perfumes on the one hand and clothing on the other. As the evidence suggests, it is not uncommon for fashion designers (and their brands) to extend their businesses by putting their names (and brands) to perfume. However, it cannot be right, simply because businesses expand their product ranges, that the goods so expanded are automatically considered similar to the goods from which they have expanded. It is therefore necessary to fully consider the tests advocated by the jurisprudence.

18) In terms of the nature of the goods, they are like chalk and cheese. Perfume is a liquid sold in small bottles whereas clothing is made from textile materials, being sold in a variety of shapes and sizes. CFG argue that they have the same general purpose of “to enhance the appearance of the user”, however, I consider this to be an assessment made at the wrong level of generality. The purpose of a perfume is for the user to apply a fragrance to themselves whereas the purpose of clothing is to clothe the body. It follows that the methods of use differ vastly. The goods do not compete, one will hardly make a competitive choice between perfume and clothing given the differences in purpose. In terms of being complementary, this requires close connections such that the uses of the goods are important or indispensable. The use of one is neither important nor indispensable for the other, or vice versa. Whilst I am aware that bags and footwear have been held to be complementary<sup>4</sup>, there is a closer link there as such goods may often form part of a co-ordinated look – the same does not apply

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<sup>2</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

<sup>3</sup> See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>4</sup> See *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-443/05)

to perfume and clothing. There is no evidence to suggest that clothing and perfume are matched in any way. The channels of trade also differ. Perfumes will normally be purchased in a specialist perfume shop or from the perfume/cosmetics area of a larger retail store (or the online equivalents). Clothing is normally purchased from a specialist clothing store or from the clothing area of a larger retail store (or the online equivalent). When it comes to the areas within a larger store, clothing and perfume areas do not, in my experience, coincide. One level of similarity could be that the users are the same, but given that the users are the general public, a point of similarity which could apply to a huge variety of vastly different goods, then this point has no material relevance. As I have said, the fact that a manufacturer or designer may produce the same goods does not make those goods similar.

19) On all the standard tests laid down to assist in determining whether goods are similar, I have found nothing meaningful. The evidence does not establish anything more than that some fashion designers/brands also offer perfumes. Whilst I note that one exhibit listed fragrance as an accessory (other examples being hats and belts), this is just one exhibit which, in any event, does not appear to be a UK based website. I note that my views, certainly at least in relation to whether there exists a complementary relationship, accord with the judgment of the CFI in *Mühlens GmbH & Co KG v OHIM* Case T-150/04, where the comparison was between class 3 goods (perfumery and toiletries) and goods in classes 18 and 25 (bags and clothing). The court stated:

“34 In this regard, it is clear from Article 8(1)(b) of Regulation No 40/94 that a likelihood of confusion between two identical or similar marks can exist only within the limits of the principle of speciality, that is to say, where, as has been pointed out at paragraph 27, regardless of the distinctive character which the earlier mark enjoys as a result of the awareness which the relevant public may have of it, the goods or services at issue are identical or similar in the eyes of that relevant public.

35 Nevertheless, it cannot be ruled out, particularly in the fashion and body and facial care sectors, that goods whose nature, purpose and method of use are different, quite apart from being functionally complementary, may be aesthetically complementary in the eyes of the relevant public.

36 In order to give rise to a degree of similarity for the purposes of Article 8(1)(b) of Regulation No 40/94, this aesthetically complementary nature must involve a genuine aesthetic necessity, in that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use these products together (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraphs 60 and 62).

37 However, the existence of an aesthetically complementary nature between the goods at issue, such as that referred to in the previous paragraph, is not enough to establish similarity between those goods. For that, the consumers must consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers or distributors of these products are the same (*S/SSI ROSSI*, paragraph 63).

38 In the current proceedings, the applicant claims only that the public is accustomed to fashion industry products being marketed under perfume trade marks owing to the practice of granting licences. Yet, if proved, that point alone would not be sufficient to compensate for the absence of similarity between the goods at issue. Such a point does not, in particular, establish the existence of an aesthetically complementary connection between perfumery goods on the one hand and the leather goods and clothing, referred to at paragraph 3 above, on the other hand, so as to mean that one is indispensable or important for the use of the other and that consumers consider it ordinary and natural to use those goods together.

39 The applicant nevertheless claims that the goods at issue have in common their importance for a person's image and appear together in fashion magazines. In this respect, it should be pointed out that, apart from the fact that this argument, which was not pleaded in the hearings before OHIM, has been submitted out of time, the point does not suffice, in any event, to establish the existence of an aesthetically complementary nature, such as that referred to above in paragraph 36."

20) **I conclude that perfumes and clothing are not similar.** CFG is in no better position to argue that the other goods Mrs Renzoni seeks to register are similar to perfumes, nor are the other goods CFG have protection for in class 3 any closer to Ms Renzoni's goods. There is one exception to this, at least in terms of the arguments put forward. The argument is based on the Class 18 goods Mrs Renzoni seeks to register, namely:

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

21) CFG argues that the above goods would include within their ambit bags, cases and purses for carrying cosmetics which should be considered as being similar to cosmetics themselves. Some of the goods clearly have potential to carry cosmetics and make-up (e.g. goods made of leather and imitations of leather materials; purses; bags) and could be sold on this basis. I agree with CFG that the terms are broad enough to cover goods such as make-up/cosmetic

bags/cases/purses. The question is whether they are similar to cosmetic products. They obviously differ in nature and methods of use, but although the exact purpose is not the same (one to beautify the other to carry items for beautification), there is a low level similarity of purpose as they are all goods that someone would purchase for their make-up needs. The goods do not compete but there is nevertheless a complementary relationship between them. The goods will be purchased by a cosmetic buying member of the general public and they are likely to be in fairly close proximity through the same or similar channels of trade. **I consider the goods to have a low to moderate degree of similarity.**

22) I will now consider CFG's other IR, which is protected in class 41 for services including "entertainment". The primary argument made by CFG is that entertainment services would include fashion shows, which it argues are similar to clothing. Whilst I have reservations that fashion shows would naturally fall within the term entertainment, I consider the point academic because the goods and this service are not similar. The nature and the methods of use of the goods and the service will, for obvious reasons, be quite different. The purpose of the two also differs, clothing is to clothe, a fashion show is to display clothes to people. The goods do not compete with the services. The goods are not complementary in the sense described in the case-law; there is no evidence to establish a complementary relationship. **The goods and the service are not similar.**

**23) In view of the above findings on goods/services similarity, I will only assess the remaining factors, and whether there exists a likelihood of confusion, on the basis of the type of goods identified in paragraph 21.**

#### **The average consumer**

24) The case-law informs me that the average consumer 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 or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The respective goods will be purchased by a member of the general public wishing to acquire cosmetics/cosmetic bags (etc). The cost of the goods will vary product to product, but they are not, generally speaking, the most expensive of products. I consider a normal (no higher or lower than the norm) level of care and consideration will be adopted in purchasing the goods.

#### **The distinctiveness of the earlier mark**

25) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see

*Sabel BV v. Puma AG*, paragraph 24). There is no evidence as to the level (or location) of any sales of the earlier WOMANITY mark. In view of this, only the inherent characteristics of the mark are pertinent. In relation to this, there is a mildly allusive quality to the word WOMANITY relating to the word “woman”. However, it has been carved into an invented word which will strike the consumer as unusual. I consider it to possess a reasonably high level of inherent distinctive character.

### **Likelihood of confusion**

26) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

27) The marks are identical and the earlier mark is reasonably high in distinctive character. In my view, these factors are sufficient to counteract the low to moderate degree of goods similarity. In my view, the use of the identical mark WOMANITY in relation to the respective goods will signal to the average consumer that the goods are being provided by the same economic undertaking. **There is a likelihood of confusion.**

### **Overall conclusion**

28) The opposition fails in respect of Mrs Renzoni’s application in classes 9 & 25, but succeeds, partially, in class 18. In respect of class 18, I hereby invite the parties to say in writing what they consider an appropriate limitation should be to reflect the scope of my decision. Such written submissions should be made within 14 days of the date of this decision. My suggestion would be something along the lines of:

**Class 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; purses, bags, wallets, trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; but not including cosmetic bags, cosmetic cases, cosmetic purses, make-up bags, make-up cases or make-up purses.

### **Costs**

29) Although CFG has achieved a measure of success, it is a relatively limited one. I consider that Mrs Renzoni is entitled to a contribution towards her costs. I have made a slight reduction from what I may otherwise have awarded to reflect

CFG's small measure of success. I hereby order Clarins Fragrance Group S.A.S. to pay Mrs Roberta Renzoni the sum of £500. This sum is calculated as follows:

*Preparing a statement and considering the other side's statement*  
£300

*Considering the evidence of CFG*  
£200

30) The above sum should 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. I will not, however, commence the appeal period until I issue a supplementary decision indicating what I consider an appropriate class 18 specification to be.

**Dated this 9th day of October 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**