

**O-531-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3265452  
BY UNICORN MAGIC ENTERPRISES LTD TO REGISTER:**



**AS A TRADE MARK IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600000808 BY UNICORN COSMETICS LTD**

## **BACKGROUND & PLEADINGS**

1. On 23 October 2017, Unicorn Magic Enterprises Ltd (“the applicant”) applied to register the above trade mark for the following goods in Class 3:

Aromatherapy lotions; Aromatherapy oils; Aromatic oils for the bath; Aromatic plant extracts; Aromatics for perfumes; Auto-tanning creams; Balms other than for medical purposes; Base cream; Bath and shower gels, not for medical purposes; Bath lotion; Bath oils for cosmetic purposes; Baths (Cosmetic preparations for - );Beauty creams; Beauty creams for body care; Beauty gels; Beauty lotions; Beauty masks; Beauty serums; Beauty tonics for application to the body; Blush; Body art stickers; Body care cosmetics; Body creams; Body lotions; Body oil [for cosmetic use]; Body polish; Body soufflé; Bubble bath preparations [for cosmetic use]; Cheek colours; Cleansing balm; Cleansing gels; Cleansing lotions; Cleansing milk; Colour cosmetics; Colour cosmetics for the eyes; Colour cosmetics for the skin; Cosmetic body scrubs; Cosmetic creams; Cosmetic creams and lotions; Cosmetic face powders; Cosmetic facial lotions; Cosmetic hair dressing preparations; Cosmetic rouges; Cosmetic sun milk lotions; Cosmetic sun oils; Cosmetics preparations; Day creams; Makeup; Make-up; Make-up for the face; Make-up for the face and body.

The application was published for opposition purposes on 5 January 2018.

2. On 27 February 2018, the application was opposed in full by Unicorn Cosmetics Ltd (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon the following trade marks:

European Union Trade Mark (EUTM) 16073579:

UNICORN COSMETICS

Filing date: 23 November 2016

Registered: 20 March 2017

EUTM 16554628:



Filing date: 4 April 2017

Registered: 20 July 2017

The opponent indicates that it relies upon all goods for which its marks are registered. These are presented in their entirety at paragraph 13.

3. In its statement of grounds, the opponent asserts that the competing goods are identical or highly similar and that the respective marks are highly similar visually, aurally and conceptually, resulting in a likelihood of direct or indirect confusion.

4. The applicant filed a counterstatement in which it denies the basis of opposition, stating specifically that the respective marks cannot be confused.

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions of which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. No such leave was sought in respect of these proceedings.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was not requested nor considered necessary in this case. Only the applicant filed written submissions in lieu of a hearing. This decision is taken following a careful reading of all the papers which I will refer to as necessary.

8. The applicant in these proceedings is currently represented by Fieldfisher LLP and the opponent is represented by Humphreys & Co.

## **DECISION**

9. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(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.”

10. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. Both of the opponent’s trade marks (as detailed at paragraph 2) qualify as earlier trade marks under the provisions outlined above. In accordance with section 6A of the Act, neither is subject to proof of use requirements as they had not been registered for five years or more at the publication date of the applicant’s mark.

### **Section 5(2)(b) - Case law**

12. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### **The principles:**

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect

picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also 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 of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods

13. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p><b>EUTM 16073579</b> Class 3: Cosmetics</p> <p><b>EUTM 16554628</b> Class 3: Cosmetics; false eyelashes. Class 21: Cosmetic brushes.</p>	<p>Class 3: Aromatherapy lotions; Aromatherapy oils; Aromatic oils for the bath; Aromatic plant extracts; Aromatics for perfumes; Auto-tanning creams; Balms other than for medical purposes; Base cream; Bath and shower gels, not for medical purposes; Bath lotion; Bath oils for cosmetic purposes; Baths (Cosmetic preparations for -); Beauty creams; Beauty creams for body care; Beauty gels; Beauty lotions; Beauty masks; Beauty serums; Beauty tonics for application to the body; Blush; Body art stickers; Body care cosmetics; Body creams; Body lotions; Body oil [for cosmetic use]; Body polish; Body soufflé; Bubble bath preparations [for cosmetic use]; Cheek colours; Cleansing balm; Cleansing gels; Cleansing lotions; Cleansing milk; Colour cosmetics; Colour cosmetics for the eyes; Colour cosmetics</p>

	<p>for the skin; Cosmetic body scrubs;  Cosmetic creams; Cosmetic creams and lotions; Cosmetic face powders; Cosmetic facial lotions; Cosmetic hair dressing preparations; Cosmetic rouges; Cosmetic sun milk lotions; Cosmetic sun oils;  Cosmetics preparations; Day creams; Makeup; Make-up; Make-up for the face; Make-up for the face and body.</p>
--	--

14. In its statement of grounds, the opponent submits:

*“16. The Opponent’s primary contention is all of the Applicant’s goods are identical to the Opponent’s Cosmetics in the earlier trade marks, on the basis of Meric (i.e. they can all be encompassed within the Opponent’s broader term).*

*17. Alternatively, those goods are unequivocally highly similar.*

*18. The Opponent’s goods and the Applicant’s goods are all sold in the same channels of trade. They will all appear next to, or within close proximity, to each other on the health and beauty shelves of retail outlets. They all share a similar purpose, namely to cleanse and beautify the skin. They are therefore likely to be made in at least partially similar ways and share similar ingredients.”*

15. In its submissions, the applicant states the following in response:

*“22. Whilst we accept this is true for a large portion of the goods covered by the Application, we submit that “Aromatherapy lotions; Aromatherapy oils; Aromatic plant extracts” are not cosmetics. Cosmetics are products intended to be placed in contact with the external parts of the human body with a view to cleaning them,*

*perfuming them, and/or changing their odour or appearance. This is not the case for the products listed above. In any event, the Applicant submits that the similarity of the goods is moot due to the sign subject of the Application not being similar to the Opponent's marks."*

16. I refer, as the opponent does, to *Gérard Meric v OHIM* case T-133/05, in which the General Court ("GC") stated:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

17. The *Merice* approach gives rise to a finding of identical goods when comparing the broad term 'Cosmetics' (for which each of the opponent's earlier marks is registered) against each of the following goods of the opposed application:

Auto-tanning creams; Balms other than for medical purposes; Base cream; Bath oils for cosmetic purposes; Baths (Cosmetic preparations for -); Beauty creams; Beauty creams for body care; Beauty gels; Beauty lotions; Beauty masks; Beauty serums; Beauty tonics for application to the body; Blush; Body care cosmetics; Body creams; Body lotions; Body oil [for cosmetic use]; Body polish; Body soufflé; Bubble bath preparations [for cosmetic use]; Cheek colours; Colour cosmetics; Colour cosmetics for the eyes; Colour cosmetics for the skin; Cosmetic body scrubs; Cosmetic creams; Cosmetic creams and lotions; Cosmetic face powders; Cosmetic facial lotions; Cosmetic hair dressing preparations; Cosmetic rouges; Cosmetic sun milk lotions; Cosmetic sun oils; Cosmetics preparations; Day creams; Makeup; Make-up; Make-up for the face; Make-up for the face and body.

18. When considering the remaining goods, I am guided by the relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity which were as follows:

- (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.

19. In respect of the complementary relationship between the goods, in *Kurt Hesse v OHIM*, Case C-50/15 P, the Court of Justice of the European Union (“CJEU”) stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“...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”.

20. For the purposes of considering the similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

### **Aromatherapy lotions; Aromatherapy oils; Aromatic plant extracts**

21. I agree with the applicant’s assessment that there is a distinction between the goods already rendered identical under *Meric* and those listed above, particularly in light of its definition of ‘Cosmetics’, which I refer to at paragraph 15.

22. My understanding of the term ‘Cosmetics’ differs to the applicant’s insofar as I would not consider cleaning or cleansing products to fall directly within the term which, in my view, refers predominantly to products intended to beautify or enhance one’s appearance. While the applicant has accepted that a “large portion” of its goods can be categorised as ‘Cosmetics’, it has not indicated that the goods recorded above are by any means an exhaustive representation of those that can’t. I will therefore consider each of the remaining goods in turn.

23. In doing so, I bear in mind the comments of L.J. Arden in *esure Insurance Ltd v Direct Line Insurance Plc*, [2008] EWCA Civ 842, restating what Lord Diplock held in *Re GE Trade Mark* at 321:

“56...But where goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the

general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced, but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods.”

### **Aromatherapy lotions;**

24. When considered against ‘Cosmetics’, the average consumer of the respective goods is likely to be identical. As I understand it, and without any evidence to guide me, aromatherapy products at large are understood to possess medicinal or ‘healing’ properties, in contrast to cosmetics which seek to obtain primarily superficial results. The nature of the goods will be similar, as will the way they are applied; presumably directly to the body. Both can be appropriately classified as health and beauty products and, as a result, are likely to occupy some of the same trade channels. The goods are not directly competitive, neither do I consider them to be complementary as each meets an independent purpose. I do accept, however, that consumers could be inclined to select an aromatherapy lotion as an alternative to a ‘regular’ cosmetic lotion, prompting the goods to occupy competitive roles. On balance, I find the goods to be similar to a medium degree.

### **Aromatherapy oils**

25. In the case of the above, the average consumer will, again, be identical. While I acknowledge that oils will *sometimes* be applied directly to the skin, it is my understanding that aromatherapy oils may also be burned or infused. There is a degree of similarity in their physical nature, which, to my knowledge, is often in liquid form, and

they may share the same trade channels to the extent that both can be considered 'health and beauty' products. Where the method of use for the respective goods is wholly different, as I have suggested, they are unlikely to be sold alongside one another. They are not complementary nor are they competitive. I find the goods to be similar to a low degree.

### **Aromatic plant extracts**

26. Cosmetics, by nature, are, in my experience, ready-to-apply products which often comprise more than a single ingredient, whereas the above are likely to act, at least usually, as a component of a finished article. Consequently, their respective users are dissimilar; the consumer selecting a cosmetic for personal use differing significantly from the consumer selecting plant extracts with the intention of *producing* a cosmetic. To my knowledge, plant extracts are often available as a liquid, resulting in a shared physical attribute with some cosmetic products. In their role as a 'component', they are likely to be sold in more specialised establishments than typical cosmetics. That said, aromatic plant extracts are often indispensable as an ingredient of cosmetic goods, particularly those which are scented, giving rise to a finding of complementarity according to *Boston Scientific Ltd*. I accept that this is not sufficient, in itself, to necessitate a conclusion of similarity<sup>1</sup>. I do not consider the goods to be competitive as the average consumer is unlikely to be burdened by a choice between the two. Having said all of this, I am aware that a number of undertakings provide natural and organic cosmetics which contain little more than the plant extracts themselves and I would find goods of this type to share a higher degree of similarity with cosmetics at large. Considering all factors, I conclude that the goods are similar to a low degree.

### **Aromatics for perfumes**

27. Although it is not unusual for cosmetic products to be scented, they are generally intended to modify one's appearance, whereas the function of a perfume is strictly to

---

<sup>1</sup> Les Éditions Albert René v OHIM, Case T-336/03

alter one's scent. Despite this contrast, each essentially seeks to achieve superficial enhancement. Aromatics for perfumes share the same similarities and differences to cosmetics as aromatic plant extracts, i.e. their use and users will differ, their physical nature will sometimes be similar, they are unlikely to be sold in proximity and they are not competitive. I find the goods to be similar to a very low degree.

### **Cleansing balm; Cleansing gels; Cleansing lotions; Cleansing milk**

28. As already indicated, the above goods cannot be considered identical as their purpose (to cleanse) is different to that of a typical cosmetic. That being said, the goods share the same average consumer and their physical nature will, in some cases, be highly similar. They will also progress through the same trade channels. In light of their differing purpose, the above goods are unlikely to be sold immediately alongside cosmetics in the relevant establishment and, for the same reason, the goods cannot be considered to be competitive, i.e. you could not substitute one for the other. While the respective goods are not indispensable for one another, in my experience it would not be unusual for them to be applied in conjunction with one another as part of a daily routine (e.g. using a cleansing product as a preparatory measure for cosmetic application). On the whole, I find the goods to be similar to a medium degree.

### **Aromatic oils for the bath; Bath and shower gels, not for medical purposes; Bath lotion;**

29. While the purpose of the above goods will primarily be to cleanse (or at least they will be utilised during a cleansing process), they are unlikely to constitute part of an individual's routine in preparation for cosmetic application. They will be purchased by the same average consumer and there will, at times, be some similarity in their physical nature. They will be subject to the same trade channels. The goods cannot be considered directly complementary. They are not competitive, neither will they be sold in the same immediate vicinity. On balance, I find that the goods are similar to a degree which is low to medium.

## **Body art stickers**

30. Body art stickers will share the same average consumer and use to the extent that they will be purchased for the purposes of personal adornment or beautification, but are likely to differ fairly significantly in their physical nature to the majority of cosmetic goods. It would not however, in my experience, be unusual for these goods to be sold alongside cosmetics, particularly those which are selected primarily for their ability to alter or enhance the appearance of the skin. I do not consider the goods to be immediately competitive nor are they complementary in respect of the relevant case law. All things considered, I find the goods to be similar to a low degree.

## **The average consumer and the nature of the purchasing act**

31. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

32. The average consumer for the goods under consideration in these proceedings is a member of the general public, with the goods most likely to be the subject of self-

selection from traditional bricks and mortar retail outlets, catalogues and websites. This suggests that the selection of such goods will predominantly be made on a visual basis, though aural considerations cannot be ignored as, in my experience, it would not be unusual for sales assistants and specialist advisors to provide oral recommendations.

33. When selecting cosmetics, consumers may consider factors including ingredients, compatibility, colour and so on. The goods in dispute are available in a relatively broad range of prices, from very expensive designer goods to budget goods. Overall, I find them to be of fairly low value and purchased on a fairly frequent basis. The average consumer is likely to pay at least an average degree of attention, necessary to determine, inter alia, colour, ingredients, and so on. While I appreciate that the degree of attention paid is likely to increase when the purchase is approached by a practitioner acting in an intermediary capacity, I do not believe this to be indicative of the average consumer and will not consider it further.

### **Comparison of trade marks**

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*, Case C-591/12P, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

35. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are:

Opponent's trade marks	Applicant's trade mark
<p data-bbox="367 564 618 596">EUTM 16073579:</p> <p data-bbox="321 627 667 659">UNICORN COSMETICS</p> <p data-bbox="367 739 618 770">EUTM 16554628:</p> 	 <p data-bbox="1045 753 1192 787">UNICORN MAGIC COSMETICS</p>

36. In light of the case law referred to above, it is important to recall that the average consumer will rarely have the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them it has retained in its mind. In reaching a conclusion, I must compare the marks from a visual, aural and conceptual perspective and identify what I consider to be the distinctive and/or dominant elements present within each trade mark.

37. The opponent's word mark consists exclusively of the dictionary words 'UNICORN' and 'COSMETICS', presented in upper case. Given that 'COSMETICS' will be considered directly descriptive or highly allusive of the goods at issue, it is the word 'UNICORN' that will play the dominant and most distinctive role in the mark's overall impression.

38. The opponent's device mark consists of one single element and, consequently, relies wholly on this for its distinctiveness. The device comprises the neck and head of what will be easily be identified as a representation of a unicorn. The unicorn is primarily

black, though its features are contrasted and well-distinguished in white. It is presented in side profile facing left with its head tilted downwards and its spiralled horn protruding beyond its mane. The unicorn rests upon a thin, slightly curved black line. This 'underlining' is an insignificant component of the device and will have little impact on the mark's overall impression or distinctive character which is entirely dominated by the unicorn.

39. The applicant's mark consists of a device element and word element, both of which appear on a pale grey background. The device element sits at the top of the mark and is approximately the same size as the words which sit below it. The device is wholly black in colour and takes the form of two unicorn heads presented symmetrically in side profile, one facing left and one facing right, bound to each other at the neck creating an impression of what the applicant describes in its submissions as a heart shaped device. I agree that this is how it will be interpreted and recalled by the average consumer. The words 'UNICORN MAGIC' are presented directly below the device with the words displayed in upper case in a standard black font. Underneath the words 'UNICORN MAGIC' is the word 'COSMETICS', in the same presentation. The word 'COSMETICS' will be considered directly descriptive or highly allusive of the goods at issue. 'UNICORN MAGIC' is distinctive and non-descriptive and will, as a result, make a significant contribution to the overall impression. I find that the words 'UNICORN MAGIC' and the device element contribute equally to the overall impression of the mark.

### **Visual comparison**

40. Of the visual similarity between the opponent's word mark and the applicant's, the opponent submits the following:

*"24. Visually, there is a high similarity between the marks. As regards the word elements of each mark, both marks begin with the same 7-letter word "unicorn". This is important because the average UK consumer reads from left to right and*

*accordingly the beginnings of marks are widely considered to register most with the consumer.”*

41. Of the same comparison, the applicant states:

*“9. ...The Application is dominated by its device element which will draw the eye of consumers. There are quite clearly visual differences between a word mark and a mark which predominantly consists of a device element.*

*10. There are also visual differences between the Opponent’s Word Mark and the word mark element of the application. The Opponent’s Word Mark consists of one distinctive word, UNICORN, and one non-distinctive word, COSMETICS. By Comparison, the Application contains two distinctive words, UNICORN and MAGIC, and one non-distinctive word, COSMETICS. The additional distinctive word element and the visual impact this has cannot be overlooked.”*

42. The opponent’s mark comprises only two words, whereas the applicant’s mark comprises a device element and a total of three words, the first and last of which represent the opponent’s word mark in its entirety and are arranged in the same order to the extent that the word elements of both marks begin with ‘UNICORN’ and end with ‘COSMETICS’. I have already concluded that the device within the applicant’s mark will contribute equally to the overall impression. The absence of a device in the opponent’s mark is a clear point of difference. On balance, I find the competing marks to be visually similar to a medium degree.

43. Moving to consider the opponent’s device mark, the opponent states:

*“28. The dominant and distinctive element(s) of the Opponent’s earlier device mark is the mark, namely a side view of a unicorn’s head facing to the left.*

*29. A similar side view of a unicorn's head facing to the left is wholly incorporated in the Applicant's mark.*

*30. As a result, the Opponent's earlier device mark and the Applicant's mark are highly similar on both a visual and conceptual basis."*

44. The applicant denies that the marks are visually similar and asserts that the opponent's mark is unarguably a depiction of a unicorn, whereas the applicant's device could be perceived differently. It also refers to a difference between the apparent demeanour of each party's respective unicorn(s); the opponent's being portrayed as 'aggressive' and the applicant's appearing in what it describes as a 'resting state'. It goes on to state the following:

*"17. ...the Unicorn in the Opponent's Device Mark is significantly more detailed than the unicorns in the Application. There is far greater plumage included in the unicorn in the Opponent's Device Mark than in the unicorns in the Application. The unicorn in the Opponent's Device Mark appears far more realistic portrayal (sic) of a stereotypical unicorn whilst the unicorns in the Application are basic line silhouettes. Consequently, we reiterate that the marks are visually dissimilar."*

45. As accepted by both parties, the competing marks include (or consist exclusively of) representations of unicorns. This results in an inevitable degree of visual similarity. There is, importantly, only one unicorn depicted in the opponent's mark whereas the application clearly depicts two unicorns, which are combined to create an impression of a heart. I agree with the applicant's assessment insofar as they acknowledge the disparity in the respective illustrations. The stylisation of the device in the applicant's mark is relatively minimal, each unicorn having a precisely defined and straightforward shape. The opponent's unicorn, in contrast, is highly stylised with greater detail in its features and a wild mane. Another key difference are the words in the application, 'UNICORN MAGIC COSMETICS', which have no counterpart in the opponent's mark. This results in what I consider to be a low to medium degree of visual similarity.

## **Aural comparison**

46. Of the aural similarity between the opponent's word mark and the application, the opponent submits:

*"26. Aurally, the marks are highly similar, both beginning with the word "unicorn" and ending with the word "cosmetics". The only difference is the addition of the short word "magic" in the middle of the Applicant's mark."*

47. The applicant maintains in response:

*"12. Phonetically there are differences between the two marks due to the presence of the additional word MAGIC in the Application. The distinctive element of the Opponent's Word Mark, i.e. UNICORN contains three syllables. The distinctive word element of the Application, i.e. UNICORN MAGIC, contains five syllables. This increased length in the pronunciation of the Application over the Opponent's Word Mark will impact upon and be noticed by consumers."*

48. The opponent's word mark, in its entirety, will be articulated in a total of six syllables, specifically YOO-NI-CORN-COS-MET-ICS. As to the applicant's mark, it is well established that when a trade mark consists of a combination of words and figurative elements, it is by the word elements that the trade mark is most likely to be referred. Consequently, the mark will be articulated in a total of eight syllables (YOO-NI-CORN-MA-JIC-COS-MET-ICS), six of which are identical to those in the opponent's mark and are presented in the same order. This results in what I consider to be a fairly high degree of similarity. In my view, having already established that 'COSMETICS' is wholly descriptive of the goods at issue, consumers may choose not to articulate it when referring aurally to the trade mark(s). This necessitates a comparison between 'YOO-NI-CORN' and 'YOO-NI-CORN-MA-JIC' which, while it would stand to reduce it, still results in at least a medium degree of aural similarity.

49. I note the opponent submits that its device mark, in the absence of any text, will be articulated as 'unicorn', which they claim is the dominant component of the applicant's mark. It concludes, as a result, that the marks are aurally highly similar. As the applicant identifies, only the application contains a phonetic element. The correct approach is clarified by the GC in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10, in which it stated:

"46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks."

Effectively, I cannot conduct an aural comparison as there are no such elements to consider within the opponent's figurative mark and I cannot make a presumption as to how the mark is likely to be articulated.

### **Conceptual comparison**

50. Referring to its word mark, the opponent submits the following:

*"27. Conceptually, the marks are again highly similar if not identical. Both refer to the fictional creature of a unicorn. The additional word "magic" in the Applicant's mark is consistent with the mythical nature of unicorns."*

51. The applicant states in response:

*"13. The Applicant submits that UNICORN or UNICORN MAGIC do not have any particular meaning in respect of the goods for which registration has been obtained"*

*or is being sought. Given the marks have no particular meaning we submit the position on the conceptuality of the marks is neutral.”*

52. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

53. In the case of the opponent’s word mark, the overall impression lies in the word ‘UNICORN’. ‘UNICORN’ will be easily and immediately understood by the relevant consumer as a mythical being often portrayed with physical features similar to those of a horse, identifiable by a single horn emerging from its forehead. The opponent’s device mark, consisting of only a unicorn, will evoke an identical concept.

54. As already concluded, the words ‘UNICORN MAGIC’ and the device element of the applicant’s mark contribute equally to its overall impression. ‘MAGIC’ will be easily understood by the average consumer as a way to categorise acts or powers which are, prima facie, inexplicable. In my experience, and as the opponent suggests, it is not unusual for magic to be associated with unicorns as it accords with their mythical and legendary status. As such, it does little to detract from the concept already presented by ‘UNICORN’, though it may be more suggestive of the being’s perceived abilities, rather than the being itself. The depiction of unicorns within the device reinforces the concept which the words have already created in the mind of the consumer. The conjunction of two unicorns to create a heart shape hints at a concept of duality and love which is absent from the opponent’s earlier marks. That said, unicorns (at large) is likely to be the overriding concept recalled by the average consumer in the case of each of the marks. Consequently, the competing marks are conceptually highly similar.

### **Distinctive character of the earlier trade marks**

55. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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

56. Without evidence to aid my assessment of the distinctive character of the opponent’s earlier trade marks, I have only their inherent characteristics to consider. It is widely accepted that words which are invented possess the highest degree of distinctive character, whilst words which are descriptive of the goods and/or services relied upon generally possess the lowest. The opponent’s word mark consists of two dictionary words, one of which is descriptive of the registered goods and therefore lacks distinctiveness. The other, being the most dominant, is not at all descriptive or allusive of the relevant goods. The opponent’s device mark provides an illustration of something which is, again, not descriptive or allusive of the relevant goods. On that basis, I find both of the opponent’s earlier marks to have an average degree of distinctiveness.

### **Likelihood of confusion**

57. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to

keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them retained in its mind.

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion occurs where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

59. Earlier in this decision I concluded that:

- The competing goods are either identical or similar to at least a very low degree;
- The average consumer is a member of the general public who will select the goods predominantly by visual means. I do not discount an aural element;
- At least an average degree of attention will be paid to the selection of the goods to the extent necessary to obtain, for example, the correct colour, compatibility and so on;
- The opponent's word mark is visually similar to the applicant's mark to a medium degree; its device mark is visually similar to a low to medium degree;
- The opponent's word mark is aurally similar to the applicant's mark to at least a medium degree. In the case of its device mark, no aural comparison can be conducted;
- The competing trade marks are conceptually highly similar;
- The opponent's trade marks possess an average degree of inherent distinctive character.

60. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He stated:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

61. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

62. In all three marks, UNICORN, either textually or figuratively, plays a distinctive role. When paired with the highly similar concept evoked by each of the marks as a result, I am of the view that the average consumer is likely to be confused when considering the competing marks in respect of goods which are similar even to a very low degree. Keeping in mind the effect of imperfect recollection and recalling that the degree of attention paid when selecting the goods is not at a high level, I am satisfied that the average consumer is, in this case, susceptible to direct confusion; i.e. it will mistake one mark for another. If I am wrong in this conclusion and, instead, the average consumer is able to immediately acknowledge the visual differences in the respective marks,

therefore avoiding direct confusion, I remain of the view that these are not sufficient to counteract the marks' highly similar conceptual message. The consumer will, at least, interpret the shared presence of UNICORN as an indication that they originate from the same or an economically linked undertaking.

### **Overall conclusion**

63. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

### **Costs**

64. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a Notice of Opposition and reviewing the counterstatement	£250
<b>Total:</b>	<b>£350</b>

65. I order Unicorn Magic Enterprises Ltd to pay to Unicorn Cosmetics Ltd the sum of **£350**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of August 2018**

**Laura Stephens**  
**For the Registrar**