

O-554-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3057365 BY
DENNIS BENCE**

TO REGISTER:

CULT OF VENUS

**AS A TRADE MARK
IN CLASS 3**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 60000140 BY
KELEMATA S.R.L.**

BACKGROUND

1. On 28 May 2014, Dennis Bence (“the applicant”) applied to register the trade mark shown on the cover page of this decision. The application was published for opposition purposes on 4 July 2014 for the following goods in class 3:

Perfumery, perfumes, liquid and solid perfumes, eau-de-cologne, toilet water, fragrances and fragrance products; soaps; cosmetics; toiletries; eye make-up, eye shadows, eye powders, eye creams, mascaras, eye liners, eye pencils, eyebrow pencils, face make-up, primers, foundations, concealers, powders, pressed powders, loose powders, cream and powder blushers, bronzers, lip sticks, lip glosses, lip liners, lip balms; nail varnish, nail polish, nail lacquer; nail polish remover; emery boards; skincare products; haircare products; nailcare products; handcare products; moisturisers, toners, cleansers, make-up removers; face masks, face packs; shampoos, conditioners, hair conditioning masks, hair sprays, hair gels, hair lotions, hair serums, hair mousses; depilatories; deodorants; anti-perspirants; body sprays; preparations, creams, gels, serums, lotions, sprays and mousses for tanning or for protection against the sun; after-sun preparations, creams, gels, serums, lotions, sprays and mousses; talcum powder; bath bombs, bath salts, bath gel, shower gel; toothpaste, mouthwash, teeth whitening preparations; false eyelashes, false nails; tissues and wipes impregnated with cosmetic preparations and cleansers.

2. The application is opposed by Kelemata S.r.l. (“the opponent”) under the fast track opposition procedure. The opposition, which is directed against all of the goods in the application, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for which the opponent relies upon all of the goods in the following Community Trade Mark (“CTM”) registrations:

Trade mark no.	Trade Mark	Applied for:	Registered:	Goods:
12295283	Venus Perfect	8/11/2013	12/3/2014	Class 3 - Soaps; Perfumery, essential oils, cosmetics, hair lotions; Foam baths; Gels and salts for the bath and shower; Talc; Creams and lotions for the lips, face, body and hands; Shampoos; Make-up preparations; Personal deodorant; Antiperspirants; Tissues impregnated with detergents for personal use.
12295325	White Venus	8/11/2013	12/3/2014	Class 3 - Soaps; Perfumery, essential oils, cosmetics, hair lotions; Foam baths; Gels and salts for the bath and shower; Talc; Creams and lotions for the lips, face, body and hands; Shampoos; Make-up preparations; Personal deodorant; Antiperspirants; Tissues impregnated with detergents for personal use.

3. In its Notice of Opposition, the opponent states:

“2. The mark applied for, CULT OF VENUS, is confusingly similar to the opponent’s earlier trade marks by virtue of the identity of the word VENUS. The additional word CULT does nothing to distinguish the marks. With regard to the opponent’s marks, the most prominent and distinctive part is the word VENUS. Furthermore, the mark applied for covers goods which are identical to those protected under the opponent’s trade marks in class 3.”

4. The applicant filed a counterstatement in which the basis of the opposition was denied; I shall return to the applicant’s comments below.

5. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(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 net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No 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 neither requested nor considered necessary; the opponent filed written submissions which I will refer to, as necessary, below.

DECISION

8. 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.”

An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or 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.”

9. In these proceedings, the opponent is relying upon the trade marks shown in paragraph 2 above, which qualify as earlier trade marks under the above provisions. As the opponent’s earlier trade marks had not been registered for more than five years when the application for registration was published, they are not subject to proof of use, as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods for which its earlier trade marks are registered.

Section 5(2)(b) – case law

10. The following principles are gleaned from the decisions of the EU courts 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 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 great 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

11. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>Class 3 - Soaps; Perfumery, essential oils, cosmetics, hair lotions; Foam baths; Gels and salts for the bath and shower; Talc; Creams and lotions for the lips, face, body and hands; Shampoos; Make-up preparations; Personal deodorant; Antiperspirants; Tissues impregnated with detergents for personal use.</p> <p>(The opponent's earlier trade marks contain identical specifications)</p>	<p>Perfumery, perfumes, liquid and solid perfumes, eau-de-cologne, toilet water, fragrances and fragrance products; soaps; cosmetics; toiletries; eye make-up, eye shadows, eye powders, eye creams, mascaras, eye liners, eye pencils, eyebrow pencils, face make-up, primers, foundations, concealers, powders, pressed powders, loose powders, cream and powder blushers, bronzers, lip sticks, lip glosses, lip liners, lip balms; nail varnish, nail polish, nail lacquer; nail polish remover; emery boards; skincare products; haircare products; nailcare products; handcare products; moisturisers, toners, cleansers, make-up removers; face masks, face packs; shampoos, conditioners, hair conditioning masks, hair sprays, hair gels, hair lotions, hair serums, hair mousses; depilatories; deodorants; anti-perspirants; body sprays; preparations, creams, gels, serums, lotions, sprays and mousses for tanning or for protection against the sun; after-sun preparations, creams, gels, serums, lotions, sprays and mousses; talcum powder; bath bombs, bath salts, bath gel, shower gel; toothpaste, mouthwash, teeth whitening preparations; false eyelashes, false nails; tissues and wipes impregnated with cosmetic preparations and cleansers.</p>

In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

"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".

The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;

- e) 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.

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“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”.

In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the 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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

12. In its Notice of Opposition the opponent claimed that:

“...the mark applied for covers goods which are identical to those protected under the opponent’s trade marks in class 3.”

13. Ordinarily, as the applicant did not deny the above claim in its counterstatement (in fact it did not comment upon the competing goods at all), I would have proceeded on the basis that it accepted the opponent’s claim. However, because in its submissions, the opponent stated:

“4. The contested goods, with the exception of “toothpaste, mouthwash, teeth whitening preparations, false eyelashes, false nails” are identical to the earlier goods. Toothpaste, mouthwash, teeth whitening preparations, false eyelashes, false nails” of the contested application are highly similar to the earlier goods as they are all for the purpose of maintaining personal hygiene or for cosmetic use. A consumer would expect a company selling the earlier goods to also sell toothpaste, mouthwash, teeth whitening preparations, false eyelashes or false nails”,

I will consider the position, albeit, given the applicant’s apparent acceptance, only briefly. The opponent’s specification includes broad terms which encompass a wide range of goods; for example, “Perfumery”, “cosmetics”, “hair lotions”, “creams and lotions for the lips, face, body and hands” and “make up preparations”. The applicant’s specification also includes a wide range of goods, many of which are expressed in identical terms to those contained in the opponent’s specification, “perfumery”, “cosmetics” and “soaps” for example; where that is the case, the goods are literally identical. However, as the vast majority of the applicant’s goods would be included in one or more of the broad terms contained in the opponent’s specification, for example, “perfumes, liquid and solid perfumes; eau de cologne, toilet water, fragrances and fragrance products” in the applicant’s specification would all be encompassed by the term “Perfumery” in the opponent’s specification, the competing goods are, in those circumstances, identical on the principles outlined in *Meric*.

14. I now consider those goods in the application which the opponent admits are not identical to its goods, but argues are still highly similar i.e. “toothpaste, mouthwash, teeth whitening preparations, false eyelashes, false nails”. Whilst the users of the competing goods may be the same as may the physical nature of some of the competing goods, in reality, that level of generality tells one little. However, I agree with the opponent’s submission to the effect that there is a similarity in the intended purpose of the competing goods i.e. as part of a personal hygiene and/or beautification regime, and the competing goods are, of course, all for use in or on the body. In addition, the competing goods are, in my experience, likely to be sold in the same area of, for example, a supermarket even if they are not sold from the same shelves. Finally, as, for example, the applicant’s “false eyelashes” and “false nails” may be selected to complement or as an alternative to goods contained within the broad terms included in the opponent’s specification, there is, in my view, an element of complementarity/competition between the applicant’s “false eyelashes” and “false nails” and the opponent’s goods. Considered overall, there is, in my view, at the very least a reasonable degree of similarity between the opponent’s goods and the

applicant's "toothpaste, mouthwash, teeth whitening preparations, false eyelashes and false nails."

The average consumer and the nature of the purchasing process

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; 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."

16. The average consumer of the goods at issue in these proceedings is a member of the general public. As the goods at issue are, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process. However, as, on occasion, it may be necessary for the average consumer to ask for the goods orally (for example when selecting designer perfumes in a retail outlet on the high street where the goods are often displayed in locked cabinets), aural considerations must not be ignored. The degree of attention displayed by the average consumer will vary considerably (compare, for example, the selection of an inexpensive bar of soap with the selection of an expensive designer perfume). However, as all of the goods are to be used in or on the body and will, to varying degrees, contribute to the average consumer's personal hygiene, appearance and self image, I conclude that in relation to the vast majority of the goods at issue, the average consumer will pay at least a normal degree of attention to their selection.

Comparison of trade marks

17. 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 the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

18. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

19. The trade marks to be compared are as follows:

Opponent's trade marks	Applicant's trade mark
Venus Perfect	CULT OF VENUS
White Venus	

20. It is upon the similarity in the competing trade marks that the majority of the parties' submissions are directed. The competing positions can, in my view, be summarised thus:

The applicant's submissions

- notwithstanding that the competing trade marks all contain the word VENUS, they convey different overall impressions;
- the word VENUS does not constitute the dominant element of the applicant's trade mark;
- the words CULT OF at the start of the applicant's trade mark are not negligible and cannot be discounted;
- the words CULT and VENUS have equal weight in the applicant's trade mark;
- there are significant visual, phonetic and conceptual differences which outweigh the fact the competing trade marks share a common element;
- the opponent's trade marks do not share a common visual and phonetic structure with each other, let alone with the applicant's trade mark;
- the word VENUS would be understood as meaning the Roman goddess of love and beauty or the planet named after this goddess;
- the applicant's trade mark hangs together and refers to a sect or group which worships the goddess Venus, whereas the opponent's trade marks consist of the name of the goddess with a "non-distinctive/ laudatory word" i.e. Perfect and "a commonplace colour's name" i.e. White;
- conceptually the opponent's trade marks differ from each other and from the applicant's trade mark.

The opponent's submissions:

- the word VENUS is interesting and fanciful (i.e. it is distinctive);
- the words White and Perfect in the opponent's trade marks are non-distinctive and would not hold much importance in the average consumer's mind. As a consequence, the consumer will more readily retain the element Venus;
- the words CULT OF do not hold the same level of interest or distinctiveness for the consumer as the word VENUS;
- while the elements within the applicant's trade mark may hang together, the consumer will rely upon the word VENUS to complete the meaning of the term CULT OF;
- without the word VENUS the words CULT OF are semantically incomplete;
- the components of the competing trade marks are separated and the structure allows a consumer to detect and identify the word VENUS within them;
- the competing trade marks are word only trade marks comprised of separated and relatively few components. The function of each component results in the word VENUS being the dominant and distinctive element of the competing trade marks;
- the sharing of the word VENUS leads to a level of visual and phonetic similarity between the competing trade marks;
- as the word VENUS has an independent distinctive role within the applicant's trade mark it reinforces the similarity between the competing trade marks.

21. In these proceedings, the opponent relies upon two trade marks both of which consist of two separate words in which the word Venus is presented in title case. In the first trade mark this word is accompanied by the word Perfect presented in title case as a suffix element, whereas in the second trade mark it is accompanied by the word White in title case in the prefix position. In its counterstatement, the applicant states that the words Perfect and White are "non-distinctive/laudatory" and "commonplace" respectively, a submission with which I agree. The opponent's trade marks consist of two words of equal length (in respect of the White Venus trade mark) and roughly equal length (in respect of the Venus Perfect trade mark). Although in line with the applicant's submissions, the words Perfect and White may have no or very little distinctive character, the fact remains that as these words contribute to the overall impression the opponent's trade marks convey, they must be taken into account when the competing trade marks are compared. That said, it is, irrespective of its positioning in the opponent's trade marks, the word Venus that will, in my view, have the greatest impact on the average consumer.

22. As to the applicant's trade mark, this consists of three separate words presented in upper case; the last of which is the word VENUS. As the words CULT OF appear

at the beginning of the trade mark, I agree with the applicant that they are not negligible and will not be overlooked. However, I agree with the opponent that the word VENUS completes the meaning of the words CULT OF in the applicant's trade mark. As a consequence of those conclusions, the overall impression created by the applicant's trade mark is, in my view, likely to result from the trade mark as a whole rather than from an element within it (be it the word CULT or the word VENUS); I will bear these conclusions in mind when conducting the visual, aural and conceptual comparison.

23. Although the opponent relies upon two earlier trade marks in which the word Venus appears in either the prefix or suffix position, given the nature of the words which accompany it, the positioning of the word Venus in these trade marks does not, in my view, impact to any material extent on the degree of visual, aural and conceptual similarity identified below. When considered from a visual and aural perspective, the presence of the words CULT OF as the first part of the applicant's trade mark and notwithstanding the laudatory/commonplace nature of the words Perfect and White and their positioning in the opponent's trade marks, results, in my view, in a relatively low degree of visual and aural similarity between the competing trade marks. Conceptually, I agree with the parties that the average consumer will understand the word Venus as a reference to the goddess or the planet named after her. Whilst I also agree with the applicant that its trade mark may be understood as a reference to a group devoted to the goddess Venus, it is, in my view, equally likely to be understood as a reference to a group devoted to the planet Venus. Whilst the opponent's trade marks are unlikely, in my view, to create any concrete conceptual image in the mind of the average consumer, the fact that the competing trade marks contain the word Venus (which may evoke the same conceptual imagery), results, in my view, in a fairly high degree of conceptual similarity between the parties' trade marks.

Distinctive character of the opponent's earlier trade marks

24. 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 – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings – *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

25. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it had made of its earlier trade marks; as a consequence, I have only the inherent characteristics of the opponent's trade marks to consider. I have already concluded that the words Perfect and White are likely to be considered laudatory/non-distinctive and commonplace respectively, and that the word Venus will be considered fanciful/distinctive. Considered as totalities, the opponent's trade marks are, in my view, possessed of at least a normal degree of inherent distinctive character.

Likelihood of confusion

26. 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade marks as the more distinctive these trade marks are, 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 he has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are either identical or similar to at least a reasonable degree;
- the average consumer is a member of the general public who will select the goods by both visual and oral means, with visual means likely to dominate the selection process;
- although the degree of care taken during the selection process can vary considerably, the average consumer is likely to pay at least a normal degree of attention to the selection of the vast majority of the goods at issue;
- despite the presence of the words Perfect and White in the opponent's trade marks, it is the word Venus that is likely to have the greatest impact on the average consumer;
- the overall impression created by the applicant's trade mark is likely to stem from the trade mark as a whole;
- the competing trade marks are visually and aurally similar to a relatively low degree and conceptually similar to a fairly high degree;
- the opponent's earlier trade marks are possessed of at least a normal degree of inherent distinctive character.

27. Having revisited those findings, I have further concluded that notwithstanding the fairly high degree of conceptual similarity, the relatively low degree of visual and aural and similarity between the competing trade marks is sufficient to avoid direct confusion i.e. where one trade mark is mistaken for the other. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it

is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

28. I begin by reminding myself that I have already concluded that the competing trade marks share only a relatively low degree of visual and aural similarity. However, notwithstanding that conclusion, the fairly high degree of conceptual similarity resulting from the fact that the competing trade marks share the distinctive word Venus, will, in my view, and irrespective of the cost of the goods at issue, fix itself in the average consumer's mind and lead them to assume that the applicant's trade mark is a sub-brand or brand extension of the opponent's trade marks and that its goods are those of the opponent or some undertaking economically linked to them. There will, as a consequence, be a likelihood of indirect confusion and the opposition under section 5(2)(b) of the Act succeeds accordingly.

Overall conclusion

29. The opposition based upon section 5(2)(b) of the Act succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

30. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Opposition fee:	£100
Written submissions:	£200
Total:	£500

31. I order Dennis Bence to pay to Kelemata S.r.l. the sum of **£500**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19th day of December 2014

C J BOWEN
For the Registrar
The Comptroller-General