

O/580/20

TRADE MARKS ACT 1994

**IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3409938
BY GLAM BRANDS LTD TO REGISTER**



IN CLASS 44

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 418061
BY S.A.M. MARQUES DE L'ETAT DE MONACO - MONACO BRANDS**

BACKGROUND AND PLEADINGS

1. Glam Brands Ltd (the applicant) applied to register trade mark 3409938 as a series of two on 27 June 2019 in the United Kingdom. The initial trade mark application was examined and objected to under section 41(2) of the Act on the basis of the two marks not forming a series. The applicant responded to the objection and proceeded with the one figurative mark (the 'contested mark'):



It was accepted and published in the Trade Marks Journal on 12 July 2019 in respect of the following services:

Class 44: *Advisory services relating to beauty;Advisory services relating to beauty care;Advisory services relating to beauty treatment;Advisory services relating to cosmetics;Airbrush tanning services;Beautician services;Beauty advisory services;Beauty care services;Beauty consultation services;Beauty therapy services;Beauty treatment services;Beauty treatment services especially for eyelashes;Body waxing services for the human body;Consultancy services relating to beauty;Cosmetic body care services;Cosmetic facial and body treatment services;Cosmetic make-up services;Cosmetic treatment services for the body, face and hair;Microneedling treatment services;Make-up consultation and application services;Manicure and pedicure services;Massage services;Eyebrow shaping services;Eyebrow tattooing services;Eyebrow threading services;Eyebrow tinting services;Eyelash curling services;Eyelash dyeing services;Eyelash extension services;Eyelash perming services;Eyelash tinting services;Facial treatment services;Hair care services;Hair styling;Hairdressing salon services;Information relating to beauty care;Nail salon services;Permanent makeup services;Skin care salon services.*

2. S.A.M. Marques de l'Etat de Monaco - MONACO BRANDS (the opponent) oppose the trade mark on the basis of section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is made on the basis of two of the opponent's earlier trade

marks, which given the dates of their filing qualify as earlier marks in accordance with section 6 of the Act. The details of the earlier marks, alongside the goods on which the opponent relies, are noted in the following table:

Earlier Trade Mark	Goods relied upon	Relevant dates
International Trade Mark Registration no.1223644 designating the European Union ('EU') for MONTE-CARLO ('the opponent's first registration')	Class 3: <i>Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices</i>	Date of designation of the EU: 18 June 2014 Date protection granted in the EU: 25 September 2015
International Trade Mark Registration no.1439157 designating the United Kingdom ('UK') for  (the opponent's second registration).	Class 3: <i>Non-medicated soaps; perfumes; essential oils; cosmetics; hair lotions; non-medicated dentifrices; depilatories; make-up removing products; lipstick; beauty masks; shaving products</i>	Date of designation of the UK: 30 July 2018 Date protection granted in the UK: 18 June 2019

- The opponent argues that the respective goods covered by its earlier marks are similar to the applicant's services, on the basis that they are at least complementary. The opponent submits that the mark applied for incorporates the word element 'MONTE-CARLO' which is also contained in both of its earlier trade marks. Accordingly, the opponent argues the respective marks are visually, phonetically and conceptually similar to at least a medium degree, and there is a likelihood of confusion. The opponent also points to their successful earlier EUIPO opposition (No. B3024448). The opponent requests the contested mark is refused in its entirety and they are awarded costs.

4. The applicant filed a counterstatement denying the claims made. The applicant asserts there is no likelihood of confusion because their mark is not similar (or identical) to either of the opponent's earlier marks and the goods and services are not similar either. The applicant also points to various other UK and EU trade marks containing the word 'MONTE CARLO' that have been registered in spite of the opponent's earlier marks. In its submissions the applicant also raised an argument of bad faith regarding the opponent's first registration.
5. In particular, I note that the applicant distinguishes their mark from the earlier marks on the basis that the 'GLAM' element in their mark is the main distinctive element whilst the 'MONTE CARLO' element is "sober ... and descriptive in nature"¹. The applicant claims they have no intention of producing products under their contested mark and that the opponent's cosmetic products and hair lotions would not compete with the services applied for. Further, there would be "very little likelihood of any association ... unless the applicant stocked the goods of the opponent"². The applicant also counters that their goods are only complementary to a "very slight degree, if at all"³. The applicant also submitted that as there are several similar registered trade marks containing 'MONTE CARLO', then the EUIPO and UKIPO have determined them as not similar nor likely to cause confusion with the opponent's earlier marks. The applicant also distinguished the EUIPO's earlier decision on the basis of various factors, including that the mark, applicant and contested specifications are different.
6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.
7. Both sides filed written submissions during the evidence rounds and the opponent filed final written submissions instead of a hearing. These will not be summarised but will be referred to as and where appropriate during this decision.

¹ See paragraph [8] of the applicant's Counterstatement

²See paragraph [22] of the applicant's Counterstatement

³See paragraph [25] of the applicant's Counterstatement

8. No hearing was requested and so this decision is taken following a careful perusal of the papers to which I refer, as necessary, below.
9. Both parties have had professional representation in these proceedings. The opponent is represented by Baron Warren Redfern and the applicant has been represented by Tony Lazaropoulos, who signed the Form TM8 as a “Principal” of PHI Legal.

Evidence

10. The opponent filed a witness statement in the name of James Maxwell Stacey, a Certified Trade Mark Attorney and Partner of Baron Warren Redfern. It is dated 18 February 2020. The purpose of Mr Stacey’s evidence was to adduce three exhibits (labelled Exhibits JMS01, JMS02 and JMS03). The contents of these exhibits, so far as are considered necessary, are briefly detailed below.

Exhibit JMS01

- a. Exhibit JMS01 comprises the results of the EUIPO’s Similarity tool for comparing goods and services. The results compare various Class 3 goods and Class 44 services and includes the EUIPO’s analysis on whether those mentioned are considered similar and why. I will come back to this evidence when I compare the goods/services.

Exhibit JMS02

- b. Exhibit JMS02 consists of a copy of the EUIPO’s decision in EUTM Opposition proceedings no. B3024448 in relation to EUTM Application no. 17035353 for the mark:



in Classes 3 and 44 in the name of Tony Lazaropoulos and Anna Lunhu; I refer to this as ‘the earlier opposition’.

- c. Exhibit JMS02 also includes the original decision in French and an annexed copy of the machine-generated English translation. The English translation confirms the opposition proceedings were based on what is the opponent's first registration relied on in these proceedings, with the opposition based on Article 8(1)(b) of the EUTMR, the equivalent of section 5(2)(b) of the Act. The opposition was upheld for all the contested goods and services.

11. The applicant filed a witness statement dated 20 April 2020 in the name of Anna Lunhu, a majority shareholder of the applicant. Ms Lunhu confirms that she is also the sole director and shareholder of another company (Grace Monte Carlo) that operates a beauty salon in Beausoleil, a commune in France adjoining the Principality of Monaco, named 'Glam Monte Carlo' which offers various beauty services and sells beauty products of other brands (only). Ms Lunhu mentions apparent discussions of a licence with Monaco Brands to use the mark 'Monte Carlo' in the period of 2017 to 2018. Ms Lunhu also states she is not aware of any products or services provided by Monaco Brands in the beauty industry.

12. Ms Lunhu's evidence also sought to adduce nine exhibits, however three of the exhibits (Exhibits AL3, AL4 and AL6) were in French and without an accompanying certified translation. The Tribunal clarified the position that the three exhibits needed certifying in order to be admissible and the applicant agreed to disregard them and proceed with the remaining six exhibits (Exhibits AL1, AL2, AL5, AL7, AL8 and AL9). I have briefly detailed those, as necessary, below and I have not taken the disregarded evidence into account.

Exhibit AL1

- a. Exhibit AL1 is a copy of a logo that Ms Lunhu states was initially filed at the EUIPO. Whilst no case details are provided, it appears to be the mark the subject of the earlier opposition noted above.

Exhibit AL2

- b. Exhibit AL2 is a copy of four webpages from the opponent's website. They are dated 16 April 2020. The webpages mention the opponent's branding and licence regime and its purpose. It states that the "purpose of the Monaco and Monte-Carlo brand licences is to develop the appeal and renown of the Principality by promoting its many assets". The 'MONTE-CARLO' word mark comprising the opponent's second registration is shown on the webpages. On the webpages shown, there is no mention of any products or services provided by the opponent in the beauty industry.

Exhibits AL5 and AL7

- c. Exhibit AL5 is email correspondence dated 26 June 2018 from Anna Lunhu directed to Monaco Brands and Exhibit AL7 is a letter from Ms Lunhu/Grace Monte Carlo to Cabinet Granger dated 28 June 2019. In these exhibits Ms Lunhu denies infringing Monaco Brands trade mark no.1223644 and seeks to discuss the use of Glam Monte Carlo. However, I do not consider the evidence relevant to the current proceedings, as I must determine the matter on the basis of the marks and matters before me.

Exhibit AL8

- d. Exhibit AL8 simply depicts an additional logo (of that shown in AL1) Ms Lunhu used for her business in June 2019; this is the logo the subject of this opposition.

13. For the avoidance of doubt and for reasons that will become apparent, whilst I received evidence⁴ from both parties about the corporate structure of the applicant, I do not consider it appropriate to summarise it here.

⁴See the opponent's Exhibit JMS03 and the applicant's Exhibit AL9

Proof of use

14. In their submissions, the applicant alleged the opponent incorrectly completed their Notice of opposition and statement of grounds (Form TM7) when it had stated that their first registration had not been protected for 5 years or more before the application date of the opposed application. The proof of use provisions are contained in section 6A of the Act, the relevant parts of which read:

Section 6A:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

*(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) in relation to which the conditions set out in section 5(1), (2)
or (3) obtain, and*

*(c) the registration procedure for the earlier trade mark was completed
before the start of the relevant period .*

*(1A) In this section “the relevant period” means the period of 5 years ending
with the date of the application for registration mentioned in subsection (1)(a)
or (where applicable) the date of the priority claimed for that application.*

.....”

15. Applying section 6A of the Act, the relevant period for calculating whether a statement of use is needed is assessed by reference to the date an International Trade Mark Registration (‘IR’) is granted protection in the relevant territory (in this case 25 September 2015), not its date of designation (18 June 2014). It follows that the opponent correctly completed their Form TM7 and no statement of use is required since the opponent’s first registration was granted protection on 25 September 2015. Therefore, the date the opponent’s first registration was

protected is less than 5 years than the application date of the opposed application (27 June 2019).

16. As the opponent's second registration was granted protection on 18 June 2019, the same principle in the above paragraph applies.

17. Proof of use is not relevant in these proceedings under section 6A of the Act. Therefore, contrary to the applicant's submissions, I confirm I will not be striking out any grounds of opposition based on the opponent's first registration. The fact that neither earlier mark is subject to the proof of use provisions means that the evidence showing that the opponent may not have traded in relation to beauty type goods (or at least their website does not show such goods) is not relevant in this dispute; the opponent is entitled to rely on the goods for which the marks are protected.

PRELIMINARY ISSUES

Earlier successful EUIPO Opposition

18. As mentioned above, the opponent pointed to their successful earlier EUIPO opposition against EUTM No.17035353. The opponent initially stated in its statement of grounds that the contested earlier mark was "identical" to the contested mark in these proceedings, but in its final written submissions stated that "the opposed mark in question is highly similar to the mark in suit... with the differences ... being immaterial. Accordingly, clear parallels may be drawn from the earlier EUTM proceedings and this opposition". I first highlight that EUIPO decisions are not binding upon me and whilst I have borne the decision in mind, I have not placed significant weight on the outcome. This is not least because I must determine the matter on the basis of the marks before me, the comparison of which differs from the earlier opposition including the differences in the subject marks at issue which, although similar, are not the same. I should say for the record that the difference in applicant for the earlier opposition being different to the subject dispute is neither here nor there, so I will not delve into either party's evidence as to the corporate structure of the applicant.

Use of the contested mark

19. Throughout its submissions, counterstatement and evidence, the applicant has reiterated how they only offer a range of beauty services under the contested mark and have no intention of producing products bearing the mark. Rather, that the applicant would sell cosmetic, hair and other products from a number of other producers (as opposed to those of the opponent). However, I find these claims of little import for the following reasoning.

20. The likelihood of confusion must be based on the 'notional' use of the earlier mark for all the goods/services registered/applied for. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

21. Despite that the applicant has given certain assurances about the way in which the mark will be used and on which services (not goods), and whose goods they will sell as part of their services, my assessment will be based on a notional use of the respective parties goods/services. I should also add that the evidence about discussions relating to a licensee are similarly not relevant, as this tells me nothing about whether there exists a likelihood of confusion in these proceedings.

The applicant's claim of bad faith

22. In its submissions, the applicant also raised a claim that the opponent filed their second registration in bad faith and invites the Registrar to apply for a declaration of invalidity. The applicant accepts that bad faith claims would normally be instigated by the party who claims it, by way of opposition or invalidation proceedings, but highlights the provisions of section 47(4) of the Act which gives the Registrar a power to seek invalidation of its own motion, via Court proceedings, albeit solely on the grounds of bad faith. Whilst this power is noted, it has been rarely used (in fact, I am not aware of any instance in which it has been used). In my view, it would certainly not be appropriate for the Registrar to raise such a claim when it is in the process of adjudicating a dispute involving that mark. Thus, I do not plan to discuss this matter, nor the applicant's reasons for the claim, in any further detail.

State of the Register

23. In its counterstatement, the applicant argues that there are several 'MONTE CARLO' marks already on the Register and, therefore, there can be no likelihood of confusion between the opponent's earlier marks and the contested mark. Whilst I note the applicant's argument, it is not entirely clear what the applicant is asking the Tribunal to take from this. If it is that the average consumer has become accustomed to such marks in the marketplace, which therefore lessens the likelihood of confusion, I bear in mind the decision in *Zero Industry Srl v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-400/06 where the General Court stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere

fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

24. However, if the applicant's argument is that the opponent has previously allowed other marks containing 'MONTE CARLO' to exist on the Register, then, likewise, this has little relevance in the current proceedings because it is for the opponent to decide which marks it takes issue with and which marks it does not. The state of the register evidence has no bearing on these proceedings.

DECISION

Section 5(2)(b)

25. 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".

The opponent has based this opposition on two earlier marks. I will begin my assessment by considering the opponent's earlier trade mark IR no.1223644 MONTE CARLO before considering the second of the opponent's marks.

26. 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, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

27. In its statement of grounds, the opponent claims that their goods and the applied for services share the same target consumer, ultimate purpose, distribution channels and producer and are, therefore, “at the very least complementary”⁵. The opponent submits that the respective goods and services are similar to a medium to high degree. In paragraph 9 of its statement of grounds, it refers to the EUIPO’s Similarity tool and uses a comparison between cosmetics and health spa services to support its claim. The EUIPO commented that health spa services and cosmetic goods may share the purpose of improving people’s appearance and hygiene and,

⁵ See paragraph [7] of the opponent’s statement of grounds.

thereby, target the same relevant public, and, may share distribution channels and be considered complementary since “it can be necessary to use the opponent’s products to perform the contested services and vice versa”. The opponent asserts the same logic applies to other services claimed by the applicant. Whilst I accept that the Similarity tool analysis can be a useful starting point, its results are not legally binding upon me, as is noted on the website itself⁶.

28. In paragraphs 23–26 of its counterstatement, the applicant asserts that while health spas use certain products in the provision of their services, the marketplace is large and health spas who create their own products commonly do so “... to compliment their health spa services ... and not compete in the general marketplace” [sic]. The applicant concludes that it is not necessary to use the opponent’s products to perform the contested services and that the contested services and opponent’s goods are “complimentary only to a very slight degree, if at all” [sic] and that none of their Class 44 services bear any similarity to the opponent’s “soaps”, “perfumery”, “essential oils” and “dentifrices”. Rather, there are only a few “potentially comparable goods and services”.

29. 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”.

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

⁶ See <http://euipo.europa.eu/sim/> where it is stated: “CF Similarity is a search tool which you can use in order to assess whether given Goods and Services are considered similar (and to what degree) or dissimilar according to the Participating IP Offices. The tool endeavours to reflect the practice of these IP Offices but the comparisons in the tool are NOT LEGALLY BINDING upon any entity. Furthermore, practice may differ from office to office. The extent to which the comparisons accurately reflect the current practice of any participating IP Office is the sole responsibility of that office.”

- (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.

31. In respect of the complementary relationship between goods (and by extension, services), in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity. Also, in *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court 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”.

32. Additionally, in *Sanco SA v OHIM*, Case T-249/11, the General Court 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.

33. With these factors in mind, the goods and services for comparison are as follows:

Opponent’s goods	Applicant’s services
<p>The opponent’s first registration:</p> <p>Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices</p>	<p>Class 44: Advisory services relating to beauty;Advisory services relating to beauty care;Advisory services relating to beauty treatment;Advisory services relating to cosmetics;Airbrush tanning services;Beautician services;Beauty advisory services;Beauty care services;Beauty consultation services;Beauty therapy services;Beauty treatment services;Beauty treatment services especially for eyelashes;Body waxing services for the human body;Consultancy services relating to beauty;Cosmetic body care services;Cosmetic facial and body treatment services;Cosmetic make-up services;Cosmetic treatment services for the body, face and hair;Microneedling</p>

	<i>treatment services;Make-up consultation and application services;Manicure and pedicure services;Massage services;Eyebrow shaping services;Eyebrow tattooing services;Eyebrow threading services;Eyebrow tinting services;Eyelash curling services;Eyelash dyeing services;Eyelash extension services;Eyelash perming services;Eyelash tinting services;Facial treatment services;Hair care services;Hair styling;Hairdressing salon services;Information relating to beauty care;Nail salon services;Permanent makeup services;Skin care salon services.</i>
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34. I will make the comparison with reference to the applied for services, grouping them together when it is relevant to do so⁷.

Advisory services relating to beauty treatment; Advisory services relating to cosmetics; Advisory services relating to beauty; Advisory services relating to beauty care; Beauty advisory services; Beauty consultation services; Consultancy services relating to beauty; Information relating to beauty care;

35. The above services are various types of consultancy and advisory services relating to beauty, be it specifically relating to cosmetics or a beautification service (e.g. beauty care and beauty treatment). “Cosmetics” in its ordinary and natural meaning covers substances/beauty products that are applied to your face, nails or body with user intent to beautify/improve one’s appearance.

36. Comparing the above services and the opponent’s “cosmetics”, there is some similarity, albeit at a very general level, in that both are aimed at a process of beautification. The nature and method of use is, though, clearly different. There is, though, further similarity on the basis that the users are shared – both are likely to

⁷ See *Separode Trade Mark BL O-399-10 (AP)*

encompass people intending to enhance/beautify their personal appearance. The applicant stated itself that its beauty salon provides a full range of beauty services besides using and selling beauty products (albeit of other brands) to their customers⁸. It seems logical to conclude that cosmetic products will be available to purchase through the same channels as beauty advisory services. I doubt that there is much of a competitive relationship between the goods and the advisory services, however there may be a degree of complementarity whereby goods could be recommended following the giving of advice, and in such a way that consumers may believe responsibility for those goods lies with the same undertaking as the service provider.

37. Weighing the various points above, I find a low-medium level of similarity between the applicant's aforementioned services and the opponent's "cosmetics". I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Beautician services; Beauty care services; Beauty treatment services; Facial treatment services; Beauty therapy services; Skin care salon services; Manicure and pedicure services; Nail salon services; Cosmetic body care services; Cosmetic facial and body treatment services; Cosmetic treatment services for the body, face and hair; Cosmetic make-up services; Make-up consultation and application services; Beauty treatment services especially for eyelashes;

38. A user uses the aforementioned services to beautify oneself and/or to improve the condition of their skin, nails, hair or eyelashes. As per my previous analysis, there is a general level of similarity in relation to purpose, trade channels and the same user, but, again, the nature and method of use differs. There may be a degree of competition as, for example, one may go for a facial treatment, or, alternatively, buy a facial product for home use. The goods and services can also be considered complementary to a degree.

⁸ See paragraph [2] of Ms Lunhu's Witness Statement

39. For the reasons given, and noting that I have found some competition (which I did not find in my previous analysis) I find a medium level of similarity between the applicant's services listed above and the opponent's "cosmetics". In my view, none of the opponent's other goods improve their position and, in fact, any similarity would be of a lesser (or no) degree.

Eyelash tinting services; Eyebrow tinting services; Eyelash dyeing services;

40. These services are specifically applied to the eye area (eyelash or eyebrow) and are typically offered by a beautician at a beauty salon or spa. The tinting and dyeing services include the application of cosmetics to darken or lighten the colour of the hair. There is, therefore, a shared aim with the opponent's "cosmetics", in that both are aimed at the process of beautification, including of the eye area. As per my above analysis, there is a general level of similarity in relation to purpose, trade channels and the same user is in play, yet the nature and method of use differs. There may also be a degree of competition as, for example, one may purchase an eyebrow dyeing kit to use at home instead of having their eyebrows tinted at a salon. Although the strength of tints offered professionally can be stronger than those store bought, I do not consider it unlikely that some products used may be the same and/or be offered as part of the above services in a way consumers may believe the same undertaking is involved. As some products may be the same and/or offered as part of the above services by way of a follow up treatment, I therefore consider the goods and services may also be considered complementary.

41. For the reasons given, I therefore find a medium level of similarity between the applicant's services listed above and the opponent's coverage of "cosmetics". I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Permanent makeup services; Eyebrow tattooing services;

42. Comparing these services with the opponent's "cosmetics", both are aimed at beautification and the users are likely people intending to beautify their personal appearance. I believe cosmetic products may be available to purchase through the same channels as these services, for instance via a beauty salon. Although the nature and method of use clearly differs, I think there is a small degree of competition given that the person who is looking to beautify themselves could choose to buy cosmetics or have permanent makeup applied. Permanent makeup services typically involve the use of specialist products (such as tattoo ink) and equipment rather than store or salon bought cosmetics. Eyebrow tattooing can be permanent or non-permanent and, therefore, may also be deemed a permanent makeup service. Nevertheless, since cosmetic products include semi-permanent products that can be applied and/or offered when the above service is being undertaken, there could be a degree of complementarity leading consumers to consider the same undertaking is responsible for both.

43. Overall, I consider there to be less similarity here than in respect of some of the comparisons made against the applicant's others services, so that I consider the above services have a low level of similarity to the opponent's "cosmetics", including those applied to the eye area. I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Eyebrow threading services; Eyelash curling services; Eyelash extension services; Eyelash perming services; Eyebrow shaping services;

44. The above services are all used on the eyelash or eyebrow area to beautify it by extending, removing, shaping or curling the hair. Whilst the opponent's "cosmetics" shares a beautifying purpose, I do not consider it to be as specific to the services. I neither consider their nature or method of use the same. While I do not consider these services compete with cosmetic products, they may share trade channels and be somewhat complementary in that, for instance, a user receives an eyebrow and/or eyelash service in a beauty shop and/or salon alongside the purchase of a

cosmetic product (such as an eyebrow dye or pencil). However, given the differences in the physical nature of the goods and services, any complementarity would, in my view, be of a low level.

45. For the reasons given, I find a low level of similarity between the applicant's services listed above and the opponent's "cosmetics". I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Airbrush tanning services

46. Airbrush tanning services are used by a person with the purpose of temporarily beautifying their skin, whether to change their complexion or shade of colour. Likewise, you can have self-tanning cosmetic products that are applied to human skin to temporarily change its colour. In providing airbrush tanning services, tanning solutions are sprayed onto the skin and, thus, the opponent's goods are important, if not essential, to provide the contested services. They target the same consumers as they can share the same trade channels, such as beauty salons who often sell their own beauty products and recommend them for further home treatments. However, it is also possible that the opponent's goods are sourced in places which would not necessarily be shared (for instance, in a retail outlet and online). Whilst their nature and method of use differs, I consider the services to have a degree of competition and complementarity with cosmetic products.

47. For the reasons given, I find a medium level of similarity between the applicant's "airbrush tanning services" and the opponent's "cosmetics". I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Microneedling treatment services

48. Microneedling treatment is an anti-ageing skin treatment. Whilst it shares a beautification purpose to the opponent's "cosmetics" and may well share users, the purpose is also specifically to enhance the condition of their skin, for instance, to

appear more youthful and heal it. The nature of the goods/services are different, though I consider some trade channels (such as goods/services offered at beauty salons) may be shared. I consider there may be a small element of competition between these services and certain cosmetics, for instance anti-wrinkle creams/serums. There may also be some complementarity in that a user of microneedling services is recommended certain cosmetics after the treatment and the relationship could be one in which customers may think that the responsibility for those goods lies with the same undertaking.

49. For the reasons given, I therefore find a low level of similarity between the applicant's services listed and the opponent's coverage of "cosmetics". I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Body waxing services for the human body

50. Body waxing services are used by users wanting to remove unwanted body and/or facial hair. They are typically performed by a beautician at a beauty salon, spa or from the beautician or client's own home. In its ordinary meaning and bearing in mind the relevant case law on how to construe words in specifications⁹, I am doubtful the opponent's "cosmetics" could encapsulate any sort of 'waxing preparation' as a form of cosmetic. However, I acknowledge the above services share a channel of trade, ultimate use and user to the opponent's "cosmetics" wanting to improve their appearance (which could include by way of hair removal), yet I do not consider there to be any competition or complementarity. On this interpretation, I consider the above services share a low level of similarity to the opponent's "cosmetics".

51. In the event that my above interpretation regarding the ambit of "cosmetics" is incorrect and it indeed extends to waxing preparation as a form of cosmetic (such as waxing strips), my analysis slightly differs. Whilst I similarly identify that there

⁹ See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch); *Sky v Skykick* [2020] EWHC 990 (Ch); *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] F.S.R. 267

could be overlap in terms of their uses, users and channels of trade, I note the average consumer may, for example, elect to purchase waxing strips rather than obtaining the same result by utilising the services of, for example, a beautician. Therefore, I consider there is an element of competition between “cosmetics” and the aforementioned services. Nevertheless, as professional body waxing services are typically known to provide a more longstanding and effective result, they are not highly competitive. I neither consider the goods/services complementary. On this interpretation, I consider there would be a medium level of similarity between “cosmetics” and the above services.

52. For the reasons given, I therefore find a low or medium level of similarity between the applicant’s “body waxing services for the human body” and the opponent’s coverage of “cosmetics”. I have considered whether any of the opponent’s other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Hair care services; Hair styling; Hairdressing salon services;

53. Comparing the above hair-related services to the opponent’s “hair lotions”, there is some general similarity in that both are aimed to care for/clean/style hair and, respectively, are used by users intending to style or care for their hair. The nature and method of use is, though, clearly different. In terms of the trade channels, these are also likely shared, at least in the sense that is not uncommon for hair salons to sell hair products. I doubt there is much of a competitive relationship between the goods and services, however I consider the opponent’s coverage of “hair lotions” similar and complementary to these hair-related services since hair lotion may be applied and offered to purchase when the services are provided (for instance, within hair styling and hair care services).

54. For the reasons given, I therefore find a low-medium level of similarity between the applicant’s services listed above and the opponent’s coverage of “hair lotions”. I have considered whether any of the opponent’s other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Massage services

55. A massage is a type of therapy typically performed by a professional masseur/masseuse or therapist who uses their hands and an oil based lubricant (which could include essential oils) to manipulate their client's muscles and limbs. Essential oils are derived from plants and are used for their scent, flavours and health benefits. There is also a specific type of massage (aromatherapy massage) that uses various aromatic materials, including essential oils, and its purpose can be to relieve stress, muscle pain and provide specific health benefits. Although the opponent's "essential oils" have various uses and its nature and method of use differs to the applicant's "massage services", the purpose, user and trade channels may be shared. In my experience it is not uncommon for a beauty therapist to offer a range of related products as part of a treatment and I consider, for instance, essential oils could be offered. Whilst there is also a clear complementary relationship, I doubt there is much of a competitive relationship between the goods and services.

56. For the reasons given, I therefore find a low-medium level of similarity between the applicant's "massage services" and the opponent's coverage of "essential oils". I have considered whether any of the opponent's other goods improve their position. In my view they do not and, in fact, any similarity would be of a lesser (or no) degree.

Average consumer and the purchasing act

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade.

58. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention

is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

59. 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.”

60. In its final submissions, the opponent contends that the average consumer will be members of the general public using the contested services, with an average degree of attentiveness. I do not have any submissions from the applicant on this point. However, whilst the opponent stated the respective goods and services “share the same target consumer”¹⁰, the applicant countered that, on an objective analysis, whilst they would sell “cosmetic, hair and other products mostly to consumers who would attend the premises to use the services of the applicant”, the opponent would sell to a “wide range” of consumers via various sales channels (such as distribution networks and shops, including specialist retailers, beauty salons and hair salons)¹¹.

61. In my experience, the average consumer for the competing goods/services will most likely be a member of the general public. Whilst I accept that the opponent’s goods could be sold to other consumers, such as intermediaries, this is not where the conflict lies.

¹⁰ See paragraph [7] of the opponent’s Statement of Grounds

¹¹ See paragraph [22] of the applicant’s Counterstatement

62. The applied for services range in price, from relatively low cost (for instance, beauty/cosmetic advice) to a more medium cost (such as treatment), and the regularity of purchase will range from frequent to infrequent. When selecting such services, the average consumer is likely to consider the qualifications held by the staff, the range of treatments offered and the suitability of those treatments to the user's desired purpose for the service. Insofar as the goods are concerned, I consider that they are also available in a relatively broad range of prices (from expensive designer goods to budget goods) and consumers will consider various factors, that could include the compatibility, colour and ingredients. Overall, I consider the average consumer will pay at least a medium degree of attention to the selection of the respective goods/services.

63. The services are most likely to be provided through beauty and/or hair salons, spas and potentially at consumer and beautician's homes by way of house calls. I also consider some advisory and consultancy services to be provided at make-up counters in a bricks and mortar retail outlet. The services on offer will be displayed on the premises frontage, a treatment list or on a display board in salons where they will be viewed and selected by the consumer. The services provided may also be displayed on websites, where a similar process will apply in that the consumer will be able to view a list of treatments and book an appointment directly through the website. The goods are most likely to be the subject of self-selection from traditional bricks and mortar retail outlets (ranging from specialised beauty outlets/make-up counters to supermarkets), catalogues and websites. They also may be bought directly from beauticians/health and wellness spas. This leads me to find that the selection of such goods and services 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, beauticians and cosmeticians to give word of mouth recommendations.

Comparison of marks

64. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

65. 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 marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

66. The respective trade marks are shown below:

The opponent's first registration	The applicant's mark
MONTE-CARLO	

67. The opponent submits that the contested mark incorporates the earlier mark in its totality, and that they are therefore similar visually, phonetically and conceptually to at least a medium degree¹². The applicant, however, disagrees and submits there is very little similarity with the earlier mark.

¹² See paragraph [4] of the opponent's Statement of Grounds

Overall impression

The applicant's contested mark

68. The application consists of a teal blue figurative mark with the word elements 'GLAM' and 'MONTE CARLO'. The 'GLAM' element is in a lightly stylised serif typeface using lowercase lettering, below this is a striped bow shaped rope device, with the words 'MONTE CARLO' beneath and justified right on the second line in an uppercase extended typeface. The GLAM element is by far the most prominent (even though it may not be greatly distinctive), with the other elements playing a more secondary role.

The opponent's mark

69. The opponent's mark is a word mark that solely consists of the word 'MONTE-CARLO' in normal black font. I consider the overall impression lies in the word itself.

Visual Comparison

70. Visually, the contested mark coincides with the opponent's first registration by wholly incorporating the word 'MONTE-CARLO' (except the hyphen, which I discount as affecting the overall impression). However, this point of similarity resides in an element which plays a much smaller and more secondary role in the overall impression. I discount any difference created by the colour and type face used – this is because the opponent's mark can notionally be used in any standard typeface and colour. The marks differ in that the contested mark includes the large and dominant 'GLAM' element and rope device (I accept the latter plays a secondary role). Taking all of this into account, I find that the application is similar to the opponent's mark to only a low degree.

Aural Comparison

71. The aural element of the opponent's mark is 'MONTE-CARLO', which will be pronounced in four syllables as 'MON-TE-CAR-LO'. Whilst this word is wholly contained in the contested mark, alongside the aural element 'GLAM', which is one syllable pronounced as spelled, I consider it more likely than not that the 'MONTE CARLO' element in the contested mark will not be spoken and, rather, that only 'GLAM' would be used. If it is not spoken, then there is no aural similarity between the contested mark and the opponent's first registration. If it is spoken, then any aural similarity is of a medium level.

Conceptual Comparison

72. I believe the average consumer of the contested mark would consider the word elements as conveying the strongest conceptual meaning. I find that the word 'GLAM' will be seen as a reference to 'glamour' and 'glamorous' and, thereby, has a concept based around that word. I also find that the secondary element 'MONTE CARLO' refers to the region of Monte Carlo that is in the Principality of Monaco. I also note that the applicant contends that the rope device adds a "distinctive playful and nautical theme to the mark"¹³. However, I consider it unlikely that the average consumer will analyse the mark in that level of detail to come to that viewpoint.

73. The opponent's first registration solely includes the word 'MONTE-CARLO' and, respectively, I believe the average consumer would immediately understand this as a reference to the region of Monte Carlo, which brings to mind its locality known for its casino, races and lavish lifestyles. Whilst, therefore, there is a shared conceptual meaning in that both marks make reference to the geographical location Monte Carlo, albeit in the contested mark that reference relates to an element of the mark which plays a secondary role, there is also a conceptual difference in that the contested mark makes reference to the word GLAM (it's more

¹³See paragraph [8] of the applicant's Counterstatement

visually dominant component), which is absent from the applied for mark. On this basis, I consider there to be a medium degree of conceptual similarity at best.

Distinctive character of the earlier mark

74. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). 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).*

*23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”*

75. Registered trade marks can possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced

by virtue of the use made of it. The opponent has not pleaded that the distinctive character of its earlier mark has been enhanced by virtue of the use made of it, nor have they filed evidence to suggest that this is the case. Consequently, I have only the inherent position to consider.

76. In regards to the distinctive character of a registered trade mark, I refer to *Formula One Licensing BV v OHIM*, Case C-196/11P where the CJEU found that:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

77. The opponent’s mark consists of the words ‘MONTE-CARLO’ in plain font. Monte Carlo is an administrative area of the Principality of Monaco. It is the applicant’s contention that these words are descriptive as a place name and the trade mark

has “very little, if any, distinctiveness”¹⁴. As stated above, I must accept that it has some distinctive character. There is no evidence to show that Monte Carlo has a particular association with the goods relied upon. That said, it is common knowledge that Monte Carlo has a reputation for super-rich lifestyles, its renown casinos and being where the Monaco Grand Prix is held. Respectively, Monte Carlo is associated with glitzy and fashionable people, who may well take pride in their beauty and appearance. In light of the opponent’s goods being in the field of beauty, given that distinctiveness falls within a range, I consider the words ‘MONTE-CARLO’ are at the lower end of the spectrum, although not of the very lowest degree as put forward by the applicant.

Likelihood of confusion

78. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole,

¹⁴ See paragraph [9] of the applicant’s Counterstatement

and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

79. In distinguishing between direct and indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“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).”*

80. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

81. The applicant’s services range from a low to a medium level of similarity to the opponent’s goods and the earlier mark has a relatively low level of inherent distinctive character. There is only a low level of visual similarity and a medium level of conceptual similarity, together with either no, or a medium, level of aural similarity depending on whether MONTE CARLO is articulated.

82. Notwithstanding the principle of imperfect recollection, and taking all of the above factors into account, I consider the differences between the marks will be sufficient to enable the average consumer with a likely medium degree of attention to

differentiate between the parties' marks, even on services that I have found to be of a medium similarity. It follows that I do not consider there is a likelihood of direct confusion.

83. I now turn to consider whether there is a likelihood of indirect confusion. Of course, I bear in mind that the three categories of indirect confusion identified by Mr Purvis QC above (paragraph 79) are just illustrative – he stated that indirect confusion “tends” to fall in one of them. Having borne this in mind, I come to the view that the average consumer would not believe that the services come from the same or a related undertaking as the goods, or vice versa. This is primarily because the average consumer, paying a medium level of attention, would focus on the more dominant element of the contested mark ('GLAM'), and would see the 'MONTE CARLO' element used in the way it is in the contested mark, as being more locational than as a (sub) brand identifier. Therefore, the average consumer would not put the co-occurrence of words down to their being an economic connection when the respective goods/service were encountered. Further, even if the MONTE CARLO element is seen as an independent and distinctive element within the composite mark, the common element is low in distinctiveness. In such circumstances, and bearing in mind the similarities between the marks, their overall impressions and that the goods/services have a medium level of similarity at best, I likewise find that there is no indirect confusion. One further point I stress is that in making the above findings, I have borne in mind that the word GLAM, the most visually dominant part of the contested mark, is not, itself, greatly distinctive. However, in my view, when the average consumer encounters the contested mark, they will still see this as part of the overall trade origin message; it does not, contrary to the opponent's submissions, result in the average consumer focusing on the MONTE CARLO element as the main indicator of trade origin.

The opponent's second registration and the contested mark

84. The opposition based on the opponent's first registration has failed, so I must consider whether its second registration puts it in a better position. I will state the position shortly, namely that the opposition on the basis of the second registration

would fail for the same/similar reasons as the first. For the record, and in case of appeal, I record that:

- There is a greater degree of visual difference between the marks, so that any similarity is very low.
- There is a greater degree of aural difference due to the presence of the extra letters MC.
- The conceptual analysis is the same.
- The average consumer analysis is the same.
- The distinctiveness of the earlier mark assessment is the same, when one bears in mind that it is the distinctiveness of the common element that is key¹⁵.
- I note that the goods covered by the earlier mark are broader (for instance, “depilatories”) and some also carry a medium level of similarity to the applicant’s services (for instance, the opponent’s “beauty masks” and the applicant’s coverage of facial treatments). However, none produce a materially greater degree of similarity to the services than any of those assessed in relation to the opponent’s first mark.
- When the above analysis is borne in mind, there are no reasons why there would be a likelihood of confusion. In fact, there is even less likelihood of confusion, whether direct or indirect.

CONCLUSION

85. The opposition has been unsuccessful and the application may proceed to registration.

COSTS

86. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Using that TPN as a

¹⁵See Mr Iain Purvis Q.C, particularly at paragraphs [38-39] in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

guide, I award the applicant the sum of £900 as a contribution towards the cost of the proceedings on the following basis:

Preparing a counterstatement and considering the other side's statement:	£400
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Preparing evidence (and written submissions) and considering and commenting on the other side's evidence:	£500
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87.I therefore order S.A.M. MARQUES DE L'ETAT DE MONACO - MONACO BRANDS to pay GLAM BRANDS LTD the sum of £900. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 18th day of November 2020

Bethany Wheeler-Fowler
For the Registrar