

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2632762
BY HALLBRIDGE LIMITED
TO REGISTER THE TRADE MARK
NATURAL ANGEL
IN CLASS 3
AND
IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 104206 BY
CLARINS FRAGRANCE GROUP S.A.S.**

BACKGROUND

1) On 24 August 2012, Hallbridge Limited (hereinafter the applicant) applied to register the trade mark **Natural Angel** in respect of the following goods:

Cosmetics, lipstick; non-medicated toilet preparations; essential oils; soaps; dentifrices; shampoos; preparations for the hair, scalp, skin and for the nails; anti-perspirants; deodorants for use on the person; depilatory preparations; all included in Class 3.

2) The application was examined and accepted, and subsequently published for opposition purposes on 12 October 2012 in Trade Marks Journal No.6961.

3) On 11 December 2012 Clarins Fragrance Group S.A.S. (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

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

Mark	Number	Date of application / registration	Class	Specification
ANGEL	CTM 538515 8	13.10.06 27.09.07	3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; beauty products.

b) The opponent states that it has used its mark in the UK upon the goods for which it is registered and that it has a reputation in the UK. It contends that the mark in suit is very similar to its mark and that the goods in Class 3 of the mark applied for are identical or similar to the goods for which its mark is registered. Use of the mark in suit would be without due cause and would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the opponent's mark. It would also dilute the distinctive character of the opponent's mark and therefore be detrimental to the opponent's repute. The mark in suit therefore offends against Section 5(2)(b) and 5(3) of the Act.

4) On 5 March 2013 the applicant filed a counterstatement denying that the marks or goods opposed were similar. The applicant also put the opponent to proof of use of its mark. The applicant accepts that part of its specification (Cosmetics, lipstick; soaps; dentifrices; shampoos; preparations for the hair, scalp) is similar to the opponent's goods. However, it denies that the rest of its specification (non-medicated toilet preparations; essential oils; preparations for the skin and for the nails; anti-perspirants; deodorants for use on the person; depilatory preparations) are similar to the opponent's goods. They do not accept that the marks are similar.

5) Both sides evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 27 November 2013. At the hearing, the opponent was represented by Mr Reddington of Messrs Williams Powell; whilst the applicant was represented by Mr Waine of Messrs Murgitroyd & Company.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement dated 2 May 2013, by Peter William Taggart Cooke the company secretary of Clarins (UK) Ltd whose parent company is the opponent, a position he has held for fifteen years. He is authorised to make the statement on behalf of the opponent and he has full access to company records. He states that his company has used the mark ANGEL in the UK continuously since 1994 in relation to perfume, cosmetics, beauty products, accessories and services. He accepts that the principal product sold under the mark is perfume but he states that they also sell a range of personal care products under the mark. The products are available via the company website (muglerstore.co.uk) or retailers such as The Perfume Store. He also provides the following net trade sales figures for the UK, pointing out that the retail prices would be considerably higher. Also included are advertising figures which include TV, press, magazine and poster advertising; attendance at trade and consumer shows as well as direct marketing. The figures for sales promotion are also provided. This refers to samples, gifts with purchases, literature and display materials.

Year	£ million	Advertising £000	Sales Promotion £000
2006	5.15	-	-
2007	4.75	-	-
2008	5.42	683	814
2009	6.71	949	1,090
2010	7.07	1,498	1,166
2011	8.24	1,976	1,537
2012	8.85	1,486	1,189

7) Mr Cooke states that ANGEL perfume "is the number 7 ranking women's prestige fragrance product (by sales volume) in the UK and the Republic of Ireland with a market share of 1.5% which is greater than the market share of successful perfumes such as Marc Jacobs Daisy, Gucci Guilty, Chanel Coco, Chanel Allure and many other famous prestige women's fragrance lines". He also provides the following exhibits:

- PWTC1: This consists of a number of print outs from various websites which are dated March and April 2013, after the relevant date. There are also print outs which show Boots offering Angel perfume on 23 August 2010, and the Perfume store offering a perfume under the mark ANGEL on 12 October 2009.

- PWTC2: this consists of a sample of invoices for the period 8 July 2011 to 18 December 2012. These are addressed to a number of businesses in both the North and South of England and show perfume being sold under the Angel mark. There are items underneath the “Angel” products which state “perfume in hand cream”, “perfume in shower gel”, “perfume on body lotion”, “perfume in deo spray” as well as “Angel Xmas No 2 2011”. However, the invoices also have a number of other fragrances listed upon them.
- PWTC3: This shows examples of advertising in shopping malls and also co-operative advertising by the retailers such as Boots, the Perfume Shop and Debenhams. The products shown are perfume, shower gel and body lotion. It also shows examples of advertising in well known magazines such as *Hello*, *Grazia*, *Vogue* and *Elle*.
- PWTC4: Further examples of advertising in magazines such as Instyle (Feb 2012), Hello (December 2011), Glamour (December 2011). These show perfume and body exfoliant with the Angel mark, being advertised.
- PWTC5: circulation figures for the UK which includes all the magazines mentioned in his evidence. It shows that all the magazines used are very popular.

APPLICANT’S EVIDENCE

8) The applicant filed a witness statement, dated 10 August 2013, by Alison Wilson the opponent’s Trade Mark Attorney. She provides the following exhibits:

- AW1: The results of a search of the IPO Register for marks which contain the word “ANGEL” for goods in Class 3. As “state of the Register” evidence this does not assist my decision.
- AW2: This consists of printouts from websites showing use of some of the marks found in exhibit AW1. However, the searches were carried out on 12 August 2013. A number of clearly from the USA as the pricing is in dollars. Others appear to use the word “Angel” either as part of the retailers name or within a mark which contains a number of other words which alters the meaning of the word ANGEL. I do not find this evidence helpful in making my decision.

DECISION

9) The first ground of opposition is based on section 5(2)(b) which reads:

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

(a)

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

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

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

11) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The opponent was put to strict proof of use by the applicant, and, given the interplay between the dates of the two marks, the opponent’s mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004 paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark 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 period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

12) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the application was 12 October 2012 therefore the relevant period for the proof of use is 13 October 2007 – 12 October 2012. When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied, namely: the judgments of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the CJEU in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH*

[2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"

13) The earlier mark is a CTM which means that genuine use must be in the EC. In its judgment in *Leno Merken BV v Hagelkruis Beheer BV* C-49/11 (“ONEL”) the CJEU said:

“28 The Court has already - in the judgments in *Ansul* and *Sunrider v OHIM* and the order in *La Mer Technology* - interpreted the concept of 'genuine use' in the context of the assessment of whether national trade marks had been put to genuine use, considering it to be an autonomous concept of European Union law which must be given a uniform interpretation.

29 It follows from that line of authority that there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (see *Ansul*, paragraph 43, *Sunrider v OHIM*, paragraph 70, and the order in *La Mer Technology*, paragraph 27).

30 The Court has also stated that the territorial scope of the use is only one of several factors to be taken into account in the determination of whether that use is genuine or not (see *Sunrider v OHIM*, paragraph 76).

31 That interpretation may be applied by analogy to Community trade marks since, in requiring that the trade mark be put to genuine use, Directive 2008/95 and Regulation No 207/2009 pursue the same objective.”

14) Regarding the territorial scope of the use, the CJEU went on to say:

“52 Some of the interested persons to have submitted observations to the Court also maintain that, even if the borders of the Member States within the internal market are disregarded, the condition of genuine use of a Community trade mark requires that the trade mark should be used in a substantial part of the Community, which may correspond to the territory of a Member State. They argue that such a condition follows, by analogy, from Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 28, Case C-328/06 *Nieto Nuño* [2007] ECR I-10093, paragraph 17, and Case C-301/07 *PAGO International* [2009] ECR I-9429, paragraph 27).

53 That argument cannot be accepted. First, the cases in question concern the interpretation of provisions relating to the extended protection conferred on trade

marks that have a reputation or are well known in the Community or in the Member State in which they have been registered. However, the requirement for genuine use, which could result in an opposition being rejected or even in the trade mark being revoked, as provided for in particular in Article 51 of Regulation No 207/2009, pursues a different objective from those provisions.

54 Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market (see, by analogy, with regard to the scale of the use, *Ansul*, paragraph 39).

55 Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

15) In the instant case there is, albeit only in narrative, a reference to sales in Eire, and so I am willing to accept that the product has been sold in more than one country in the EU. The opponent's registered specification reads as follows: "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; beauty products". The applicant contends that the opponent has only shown use on perfume. It contends that the turnover and promotion figures are not product specific and that the invoices provided are not sufficient to show genuine use. The opponent also pointed out that the use relied upon was mostly that on the website Thierry Mugler. I agree with some of these criticisms of the opponent's evidence, however, I do not accept the applicant's conclusions regarding genuine use. The invoices are a sample and, to my mind, show genuine, albeit small, use of the opponent's on more than just perfume. In his witness statement Mr Cooke stated that his company's website was called www.thierrymugler.co.uk and so this use is that of the opponent. Even ignoring undated evidence as well as the turnover and promotional figures, there is a cogent narrative complete with corroborating evidence which is dated and provides specifics regarding product and to whom it was supplied for me to come to the conclusion that the opponent has used its mark in relation to "Perfume, hand cream, shower gel, body lotion, and exfoliants". I will therefore use this reduced specification when carrying out the comparison test.

16) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice to the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below, by reference to the CJEU cases, which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

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

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

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

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

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

The average consumer and the nature of the purchasing process

17) I must now determine the average consumer for the goods of the parties. Clearly, the applicant’s specification is concerned, broadly, with toiletries and cosmetics. The opponent has shown use on perfume, hand cream, shower gel, body lotion, and exfoliants. Both sides’ specifications would appear to be aimed at the general public wishing to cleanse or beautify themselves. These products will vary in cost as will the level of attention paid. However, given that these types of products usually come in a range to suit different types of skin, colour and complexion and because the average consumer will be concerned about their appearance if they use the incorrect product I believe that these items will be selected with reasonable care. For the most part such items will be on display on supermarket /store shelves or online and the public will self select, although they could also be purchased in a salon or specialist outlet. Whilst aural considerations must not be overlooked it is the visual aspect of the competing trade marks that will dominate the selection process.

Comparison of goods

18) For ease of reference I reproduce the specifications of both parties. The opponent’s specification being the reduced one upon which it has shown use.

Applicant’s specification	Opponent’s specification
Cosmetics, lipstick; non-medicated toilet preparations; essential oils; soaps; dentifrices; shampoos; preparations for the hair, scalp, skin and for the nails; anti-perspirants; deodorants for use on the person; depilatory preparations; all included in Class 3.	Perfume, hand cream, shower gel, body lotion, and exfoliants.

19) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v.Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

'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.'

20) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed in *Canon*. In that case the factors to be taken into account were:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods 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 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 in the same or different sectors.

21) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

"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)."

22) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Segio Rossi v OHIM

- Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseno original Juan Bolanos) [2007] ECR I-0000, paragraph 48)."

23) In the table below I set out my views on the similarity or otherwise of the two specifications:

Applicant's specification	Opponent's specification	
soaps;	shower gel,	Identical
non-medicated toilet preparations;	shower gel	Identical
depilatory preparations;	exfoliants.	Identical
preparations for the hair, scalp, skin and for the nails;	hand cream, shower gel, body lotion, and exfoliants.	Identical
essential oils	Perfume,	Very similar
shampoos;	shower gel,	Identical
Cosmetics,	hand cream, body lotion,	Identical
lipstick; dentifrices; anti-perspirants; deodorants for use on the person; all included in Class 3.	Perfume, hand cream, shower gel, body lotion, and exfoliants.	Similar

Comparison of trade marks

24) The trade marks to be compared are as follows:

Applicant's marks	Opponent's mark
Natural Angel	ANGEL

25) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

26) The applicant's products are, broadly speaking, cosmetics, cleansers and beauty products. The word "Natural" clearly will be seen to allude to the product being "pure" or consisting of natural products such as plant oils or fruits. I therefore believe that the

word "Angel" is more distinctive and is the dominant component, although I do not lose sight of the fact that the two words could be said to refer to the user of the products, particularly female users.

Visual / Aural and Conceptual similarity

27) Clearly both marks contain the word ANGEL. The only difference being that in the applicant's mark has the word "Natural" as the initial word. As stated earlier the initial word clearly alludes to the purity of the product in terms of its ingredients. Clearly, there is a significant visual, aural and conceptual similarity between the marks albeit there are minor differences. Overall, the respective marks share a high level of similarity.

Distinctive character of the opponent's earlier trade mark

28) The opponent has provided evidence of use of its mark, however I do not believe that the sales figures shown and the market share achieved are sufficient for the opponent to benefit from an enhanced reputation. However, to my mind the opponent's mark is inherently very distinctive for the goods for which it is registered as it has no obvious meaning when used on perfume, hand cream, shower gel, body lotion, and exfoliants.

Likelihood of confusion

29) I must now take all the above into account and consider the matter globally. I need to take into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence does not allow me to find the opponent to have an enhanced reputation in class 3 goods, however the goods in question are either identical or at least similar and the marks are also highly similar such that, allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in total.**

30) I now turn to consider the opposition under Section 5(3) which reads:

"5.3 A trade mark which-

(a) is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

31) The relevant principles can be gleaned from the case law of the Court of Justice of the European Union. In particular, cases *General Motors Corp v Yplon SA (Chevy)* [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Intel Corporation Inc v CPM United Kingdom Ltd -* [2009] RPC 15 and *L'Oreal SA and others v Bellure NV and others - Case C-487/07*. These cases show that:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal*, paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41.

32) The opponent claims that it has used its ANGEL Community Trade Mark on, broadly speaking, perfume and cosmetics, since 1994 and that the mark is well known and has a substantial reputation, particularly in the UK. On the basis of *Chevy* I consider that the opponent needs to demonstrate that at the relevant date a significant part of the persons in a substantial part of the Community knew of the trade mark of the opponent, although that can equate to use in one member state (*PAGO International GmbH v Tirol Milch registrierte Genossenschaft mbH* Case C-302/07). Absent public opinion survey I must take into account "the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it" (*Chevy*). Taking into account that the relevant public is the general public, the opponent has to show its market share in relation to perfumes and cosmetics at large. The opponent has provided sales and promotion figures for the UK but does not specify which products out of the wide reaching specification these relate to. The opponent does state that it "is the number 7 ranking women's prestige fragrance product (by sales volume) in the UK and the Republic of Ireland with a market share of 1.5%". However, the term "prestige fragrance product" is not defined nor are any figures relating to the perfume sales provided. There is some evidence of advertising but it is very limited in scope. The opponent has not provided evidence from the trade in relation to its reputation or market share. In my opinion the opposition under section 5(3) does not get over the first hurdle. **The opposition under Section 5(3) therefore fails.**

CONCLUSION

33) The opponent has been successful in its opposition under Section 5(2)(b) but has failed under Section 5(3). **The application is to be refused in its entirety.**

COSTS

34) As the opponent has been successful overall it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Preparing evidence	£400
Preparing for and attending a hearing	£500
TOTAL	£1,100

35) I order Hallbridge Limited to pay Clarins Fragrance Group S.A.S. the sum of £1,100. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of December 2013

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