

**O/110/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3508299  
IN THE NAME OF KAREN WOOD  
FOR THE TRADE MARK:**

**Monaco Tan**

**IN CLASS 3**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001477  
BY S.A.M. Marques de l'Etat de Monaco-Monaco Brands**

## Background and pleadings

1. On 05 July 2020, Karen Wood (“the applicant”) applied to register the trade mark

# Monaco Tan

for the following goods:

Class 3: *Abrasive bands; Abrasive boards for use on fingernails; Abrasive cloth; Abrasive compounds; Abrasive emery paper; Abrasive emery paper for use on fingernails; Abrasive granules; Abrasive paper; Abrasive paper for use on the fingernails; Abrasive paper [sandpaper]; Abrasive paste; Abrasive preparations; Abrasive preparations for polishing; Abrasive preparations for use on the body; Abrasive preparations for vehicle care; Abrasive rolls; Abrasive sand; Abrasive sanding sponges; Abrasive sheets; Abrasive strips; Abrasives; Acne cleansers, cosmetic; Adhesive removers; Adhesives for affixing artificial eyelashes; Adhesives for affixing artificial fingernails; Adhesives for affixing false eyebrows; Adhesives for affixing false eyelashes; Adhesives for affixing false hair; Adhesives for affixing false nails; Adhesives for artificial nails; Adhesives for cosmetic purposes; Adhesives for cosmetic use; Adhesives for false eyelashes, hair and nails; Adhesives for fixing false nails; After shave lotions; After sun creams; After sun moisturisers; Aftershave; After-shave; Aftershave balm; Aftershave balms; After-shave balms; Aftershave creams; After-shave creams; Aftershave emulsions; After-shave emulsions; After-shave gel; Aftershave gels; Aftershave lotions; After-shave lotions; Aftershave milk; Aftershave moisturising cream; Aftershave preparations; After-shave preparations; Aftershaves; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use; Age retardant gel; Age retardant lotion; Age spot reducing creams; Agents for removing wax;*

*Air (Canned pressurized -) for cleaning and dusting purposes; Air fragrance preparations; Air fragrance reed diffusers; Air fragranting preparations; Alcoholic solvents being cleaning preparations; Alkali (Volatile -) [ammonia] detergent; All-purpose cotton buds for personal use; Almond milk for cosmetic purposes; Almond oil; Almond soap; Almond soaps; Aloe soap; Aloe soaps; Aloe vera gel for cosmetic purposes; Aloe vera preparations for cosmetic purposes; Alum blocks for shaving; Alum stones [astringents]; Amber [perfume]; Ambergris; Amla oil for cosmetic purposes; Ammonia for cleaning purposes; Ammonia [volatile alkali] [detergent]; Ammonia [volatile alkali] detergent; Animal grooming preparations; Anti-ageing creams; Anti-ageing creams [for cosmetic use]; Anti-ageing moisturiser; Anti-ageing serum; Anti-ageing serums for cosmetic purposes; Anti-aging cream; Anti-aging creams.*

2. The application was published for opposition purposes on 31 July 2020.

3. The application is opposed by S.A.M. Marques de l'Etat de Monaco-Monaco Brands ("the opponent"). The opposition was filed on 30 September 2020 under the fast track opposition procedure and is based upon Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon the following marks:

MONACO

International Registration No. WE1222204<sup>1</sup>

International Registration date: 18 June 2014

Date protection granted in EU: 28 September 2015

Protected for goods and services in Classes 3, 7, 30, 31 and 36

Relying on all goods in Class 3 only, namely:

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<sup>1</sup> Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

*Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.*

("the opponent's first mark"); and



International Registration No. WO1439126

Priority date: 02 February 2018

UK Date of Designation: 30 July 2018

Date Protection granted in UK: 09 May 2019

Protected for goods and services in Classes 3, 8, 9, 11, 12, 14, 15, 16, 18, 20, 21, 24, 25, 26, 28, 29, 30, 31, 32, 33, 35, 41, 43 and 45

Relying on all goods in Class 3 only, namely:

*Non-medicated soaps; perfumes; essential oils; cosmetics, hair lotions; non-medicated dentifrices; depilatories; make-up removing products; lipstick; beauty masks; shaving products; preservatives for leather (polishes); creams for leather.*

("the opponent's second mark").

4. The opponent claims that the applicant's mark consists of the separate word elements MONACO and TAN and that the word MONACO has its own independent distinctive and dominant presence in the overall mark, as well as forming the critical beginning of the mark opposed. Further, that by virtue of being generic, the word TAN will be disregarded by the average consumer. The opponent submits that by virtue of the common element MONACO in both of its earlier marks and the applicant's mark, the respective marks are visually, phonetically and conceptually similar to a high degree, and that the respective goods are "identical to a high degree

by virtue of broad terms covered by the earlier rights”.<sup>2</sup> In addition, the opponent asserts that the bulk of the respective products share the same target consumer, have the same ultimate purpose of use as well as composition, have the same channels of trade and distribution, and are at the very least complementary. The opponent concludes that there is a likelihood of confusion, including likelihood of association, and requests refusal of the mark applied for in its entirety and an award of costs in its favour.

5. The applicant filed a counterstatement denying the claims and requesting that the opponent provides proof of use of its earlier trade marks relied upon.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 No. 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

7. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

8. In an official letter dated 20 November 2020, in accordance with Tribunal Practice Notice 2/2013, the parties were allowed until 04 December 2020 to seek leave to file evidence and/or request a hearing and until 21 December 2020 to provide written submissions.

9. Only the opponent filed written submissions which will not be summarised, but will be referred to as and where appropriate during this decision. The applicant requested

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<sup>2</sup> Statement of Grounds, paragraph 7.

to be heard. This request was considered by the Registry and rejected, as a hearing was deemed unnecessary to deal with the case justly and at proportionate cost. This decision has therefore been taken following a careful perusal of the papers.

10. In these proceedings, the opponent is represented by Baron Warren Redfern and the applicant is a litigant in person.

### **Preliminary Issues**

11. The applicant requested that the opponent provide an EU CPNP CPSR regulatory approval number “for a product called MONACO or MONACO TAN”. It appears that this refers to the regulatory system for cosmetic products and the applicant stated that this is a requirement for putting certain cosmetic products on the EU market. She also requested that the mark be revoked as no products had been brought to market.

12. The Registry wrote to the applicant on 26 November 2020 confirming that she had not identified any potentially relevant connection between the EU CPNP code and a matter on which the registrar could make a decision as part of the opposition proceedings. I shall therefore take no further account of this in my decision. The letter also informed the applicant that the law allows owners of registered trade marks a period of five years from the date of registration within which to put their marks into commercial use. Only after this period has expired can a mark be challenged in revocation proceedings on the grounds of non-use.

### **DECISION**

13. 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”.

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

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

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

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

15. The two trade marks upon which the opponent relies each qualify as an earlier trade mark under the above provisions. As neither of these earlier trade marks had been protected for more than five years at the date the application was filed, they are not subject to the proof of use provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon them in relation to all of the goods indicated without having to prove that genuine use has been made of them.

16. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions

of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

### **Section 5(2)(b) –**

17. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

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

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

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



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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

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

### **Comparison of goods**

18. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, Case C-39/97, the Court of Justice of the European Union (CJEU) stated 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”.<sup>3</sup>

19. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- “(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.”

20. 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 between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

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<sup>3</sup> Paragraph 23

may think that the responsibility for those goods lies with the same undertaking".<sup>4</sup>

21. The goods to be compared are:

| Opponent's goods  | Applicant's goods   |
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| <p><b>The first earlier mark:</b></p> <p><u>Class 3</u></p> <p><i>Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</i></p>   | <p><u>Class 3</u></p> <p><i>Abrasive bands; Abrasive boards for use on fingernails; Abrasive cloth; Abrasive compounds; Abrasive emery paper; Abrasive emery paper for use on fingernails; Abrasive granules; Abrasive paper; Abrasive paper for use on the fingernails; Abrasive paper [sandpaper];</i></p>  |
| <p><b>The second earlier mark:</b></p> <p><u>Class 3</u></p> <p><i>Non-medicated soaps; perfumes; essential oils; cosmetics, hair lotions; non-medicated dentifrices; depilatories; make-up removing products; lipstick; beauty masks; shaving products; preservatives for leather (polishes); creams for leather</i></p> | <p><i>Abrasive paste; Abrasive preparations; Abrasive preparations for polishing; Abrasive preparations for use on the body; Abrasive preparations for vehicle care; Abrasive rolls; Abrasive sand; Abrasive sanding sponges; Abrasive sheets; Abrasive strips; Abrasives; Acne cleansers, cosmetic; Adhesive removers; Adhesives for affixing artificial eyelashes; Adhesives for affixing artificial fingernails; Adhesives for affixing false eyebrows; Adhesives for affixing false eyelashes; Adhesives for affixing false hair; Adhesives for affixing false nails; Adhesives for artificial nails; Adhesives for cosmetic purposes; Adhesives for cosmetic use; Adhesives for false eyelashes, hair and nails; Adhesives for fixing false nails; After shave lotions; After sun creams; After sun moisturisers; Aftershave; After-shave;</i></p> |

<sup>4</sup> Paragraph 82

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|  | <p><i>Aftershave balm; Aftershave balms; After-shave balms; Aftershave creams; After-shave creams; Aftershave emulsions; After-shave emulsions; After-shave gel; Aftershave gels; Aftershave lotions; After-shave lotions; Aftershave milk; Aftershave moisturising cream; Aftershave preparations; After-shave preparations; Aftershaves; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use; Age retardant gel; Age retardant lotion; Age spot reducing creams; Agents for removing wax; Air (Canned pressurized -) for cleaning and dusting purposes; Air fragrance preparations; Air fragrance reed diffusers; Air fragrancing preparations; Alcoholic solvents being cleaning preparations; Alkali (Volatile -) [ammonia] detergent; All-purpose cotton buds for personal use; Almond milk for cosmetic purposes; Almond oil; Almond soap; Almond soaps; Aloe soap; Aloe soaps; Aloe vera gel for cosmetic purposes; Aloe vera preparations for cosmetic purposes; Alum blocks for shaving; Alum stones [astringents]; Amber [perfume]; Ambergris; Amla oil for cosmetic purposes; Ammonia for cleaning purposes; Ammonia [volatile alkali] [detergent]; Ammonia [volatile alkali] detergent; Animal grooming preparations; Anti-ageing creams; Anti-</i></p> |
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|  | <i>ageing creams [for cosmetic use]; Anti-ageing moisturiser; Anti-ageing serum; Anti-ageing serums for cosmetic purposes; Anti-aging cream; Anti-aging creams.</i> |
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22. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as Appointed Person, said:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”<sup>5</sup>

23. In *Gérard Meric v OHIM*, Case T-133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.<sup>6</sup>

24. While making my comparison. I bear in mind the comments of Floyd J. (as he then was) in *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch):

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle

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<sup>5</sup> Paragraph 5

<sup>6</sup> Paragraph 29

should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."<sup>7</sup>

25. In its Statement of Grounds, and as referred to in its final written submissions, the opposition has set out its own analysis of the groups of goods that it considers similar. It asserts that the bulk of the respective products share the same target consumer, have the same ultimate purpose of use as well as composition, have the same channels of trade and are at the very least complementary. Where certain goods are not considered to be identical to one another, it submits that they must be considered similar by virtue of the standard analysis of similarity of goods and services. It further submits that the failure by the applicant to enter any pleadings in this respect amounts to an acceptance by the applicant of the opponent's arguments. The applicant, however, has stated emphatically that she disagrees with the opposition.

26. I acknowledge the analysis provided by the opponent which I will use as a starting point and I will now set out my own considerations of the comparison of goods, grouping them together where this is appropriate, as per *Separode*.

27. "*Abrasive bands; Abrasive boards for use on fingernails; Abrasive cloth; Abrasive compounds; Abrasive emery paper; Abrasive emery paper for use on fingernails; Abrasive granules; Abrasive paper; Abrasive paper for use on the fingernails; Abrasive paper [sandpaper]; Abrasive paste; Abrasive preparations; Abrasive preparations for polishing; Abrasive preparations for use on the body; Abrasive preparations for vehicle care; Abrasive rolls; Abrasive sand; Abrasive sanding sponges; Abrasive sheets; Abrasive strips; Abrasives*" in the applicant's specification falls within the broader term "*cleaning, polishing, degreasing and*

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<sup>7</sup> Paragraph 12

*abrasive preparations;* ” of the opponent’s first earlier mark and are therefore considered to be identical on the principle outlined in *Meric*. I find no similarity between these goods and the goods of the opponent’s second mark.

28. “*Adhesives for affixing artificial eyelashes; Adhesives for affixing artificial fingernails; Adhesives for affixing false eyebrows; Adhesives for affixing false eyelashes; Adhesives for affixing false hair; Adhesives for affixing false nails; Adhesives for artificial nails; Adhesives for cosmetic purposes; Adhesives for cosmetic use; Adhesives for false eyelashes, hair and nails; Adhesives for fixing false nails*”. Both the earlier marks contain the broad term “*cosmetics*”. I note that the *Collins English Dictionary*<sup>8</sup> defines the term “cosmetic” in British English as meaning “any preparation applied to the body, esp the face, with the intention of beautifying it”. While the various adhesives of the applicant’s mark are used for cosmetic purposes, rather than being cosmetics *per se*, in my view they are closely aligned and as such are considered complementary as outlined in *Boston Scientific Ltd*. The consumers of the cosmetics that the adhesives are intended to fix, for example artificial nails or eyelashes would be the same and the goods would share the same trade channels and be found on the same shelves or in the same aisles in retail outlets. I therefore find there to be a high degree of similarity.

29. “*Adhesive removers*”. I consider this term would be understood to refer to substances that remove glue and so, in my view, they are identical as per *Meric* to the “*cleaning, polishing, degreasing and abrasive preparations*” of the first earlier mark. Turning to the comparison with the goods covered by the second earlier mark, I consider that “*Adhesive removers*” in Class 3 are aligned to cosmetics as the term will include substances intended to remove adhesives used for cosmetic purposes and as such I find there to be a degree of complementary as outlined in *Boston Scientific Ltd*. They would share the same end user, they would be distributed through the same trade channels and be found on the same shelves or in the same aisles in retail outlets as the opponent’s “*cosmetics*” and I therefore find there to be a medium degree of similarity between “*Adhesive removers*” and “*cosmetics*”.

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<sup>8</sup> <https://www.collinsdictionary.com/dictionary/english/cosmetic>

30. “*After shave lotions; Aftershave; After-shave; Aftershave balm; Aftershave balms; After-shave balms; Aftershave creams; After-shave creams; Aftershave emulsions; After-shave emulsions; After-shave gel; Aftershave gels; Aftershave lotions; After-shave lotions; Aftershave milk; Aftershave moisturising cream; Aftershave preparations; After-shave preparations; Aftershaves; Alum blocks for shaving;* ”. The purpose of “aftershave” is to refresh and rehydrate the skin following shaving and is often perfumed and so may serve a dual purpose as a cologne. I consider the various aftershave products of the contested application to be included in the broader categories of “*cosmetics*” in the first earlier mark and to “*shaving products*” in the second earlier mark, and so identical according to the *Meric* principle.

31. “*After sun creams; After sun moisturisers; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use*”. The term “*after-sun*” is used to designate a product applied to the skin after exposure to the sun. Again, applying *Meric*, I consider the applicant’s goods to fall within the ambit of the term “*cosmetics*” included in the two earlier marks and as such to be identical.

32. “*Acne cleansers, cosmetic; Age retardant gel; Age retardant lotion; Age spot reducing creams; Almond milk for cosmetic purposes; Almond oil; Aloe vera gel for cosmetic purposes; Aloe vera preparations for cosmetic purposes; Alum stones [astringents]; Amla oil for cosmetic purposes; Anti-ageing creams [for cosmetic use]; Anti-ageing moisturiser; Anti-ageing serum; Anti-ageing serums for cosmetic purposes; Anti-aging cream; Anti-aging creams*”. All the aforementioned goods may be classified as cosmetics in its ordinary and natural meaning and as such they are considered identical to the goods of the two earlier marks.

33. “*Almond soap; Almond soaps; Aloe soap; Aloe soaps*” are *Meric* identical to the term “*soaps*” in the first earlier mark and to “*Non-medicated soaps*” in the second earlier mark.

34. “*Amber [perfume]; Ambergris*” are also identical to the terms “*perfumery*” and “*perfumes*” respectively in the earlier marks per *Meric*.



35. “*Agents for removing wax*” are likely to be understood by the average consumer as cleaning agents and I therefore consider them to be identical as per *Merix* to the “*cleaning, polishing, degreasing and abrasive preparations*” in the specification of the opponent’s first earlier mark.

36. “*Air (Canned pressurized -) for cleaning and dusting purposes; Alcoholic solvents being cleaning preparations; Alkali (Volatile -) [ammonia] detergent; Ammonia for cleaning purposes; Ammonia [volatile alkali] [detergent]; Ammonia [volatile alkali] detergent*”. The purpose of the aforementioned goods would be for cleaning or laundry purposes and as such I find them to be identical on the *Merix* principle to “*Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations*” of the first earlier mark.

37. “*Air fragrance preparations; Air fragrance reed diffusers; Air fragrancing preparations*”. These goods are designed to mask or remove unpleasant room odours and as such fall within the broader category of “*perfumes*” and “*perfumery*” in the earlier marks. I find them to be identical per *Merix*.

38. “*All-purpose cotton buds for personal use.*” These goods are often used for applying cosmetics and removing make up. The physical nature of cotton buds differ to make up and/or make-up removing products and they are not in direct competition with such products, although there is an overlap where the end users of cotton buds are likely to be the same as the users of *cosmetics* and *make-up removing products*. The goods are distributed through the same channels of trade which may be found alongside each other in a supermarket or retail outlet. Taking all of these factors into account, I find that “*All-purpose cotton buds for personal use*” are similar to a low degree to “*cosmetics*” in both earlier marks and to “*make-up removing products*” in the second earlier mark.

39. “*Animal grooming preparations*”. The opponent submits that this term includes shampoos, soaps and dentifrices. However, it is my view, that when the average consumer thinks of shampoos, soaps or dentifrices, they will think of products for human use, and that this is the ordinary and natural meaning of the term. Moreover,

the relevant public would expect those goods specific to animal care to be qualified as such. Although the physical nature of the goods may be similar, the respective end users and uses will be different, although there may be some overlap in as much that pet owners who use products specific to animal care on their pets will also use shampoos and soaps intended for use by human beings on themselves. There will be an overlap in distribution channels, both being found in supermarkets, however, goods intended for human use would be found in different aisles to those intended to be used for animal grooming. The goods are not in competition with each other; neither are they complementary. I therefore find them to be dissimilar.

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

40. 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:

“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”.<sup>9</sup>

41. 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.

42. In its Statement of Grounds, the opponent submits that the average consumer will substantially include members of the public purchasing cosmetics, perfumery and the like as well as other cleaning and polishing products. It further submits that the average consumer will include business professionals such as buyers working for

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<sup>9</sup> Paragraph 60

retailers and wholesalers. It submits that the level of attentiveness will be average at best, especially for general public purchasing such goods.

43. In my view, the average consumer for the competing goods will most likely be a member of the general public. I also accept that the average consumer of cosmetics and similar beauty and skincare products could also be a professional such as a beautician or hairdresser, while the average consumer of cleaning preparations may be a cleaning company.

44. The goods are sold through a range of channels including supermarkets, chemists, wholesalers and online. In retail and wholesale outlets, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. In these circumstances, visual considerations will dominate the process, however I do not discount the aural element as the consumer may seek advice from sales staff. Although the price of the goods can vary considerably, on balance it seems to me that the cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. The consumer will want to ensure that the products are suitable for them and meet their specific needs, particularly in the case of cosmetics and hair products. Consequently, I find that the level of attention of the general public will be medium when selecting the goods, while the professional is likely to pay a higher than average degree of attention to the selection process.

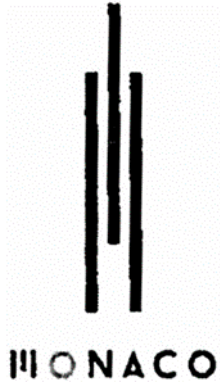
### **Comparison of marks**

45. 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”<sup>10</sup>

46. 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.

47. The respective trade marks are shown below:

| Opponent's trade marks   | Applicant's trade mark   |
|--|--------------------------|
| <p>The first earlier mark:</p> <p style="text-align: center;"><b>MONACO</b></p>  | <p><b>Monaco Tan</b></p> |
| <p>The second earlier mark:</p> <div style="text-align: center;">  </div> |                          |

48. The opponent submits that the word MONACO in the contested mark has its own independent distinctive and dominant presence in the overall mark, as well as forming

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<sup>10</sup> Paragraph 34

the critical beginning of the mark opposed. Further, that the word TAN would be disregarded by the average consumer by virtue of being generic. It submits that both earlier marks and the applicant's mark share the same word element MONACO and as such they are visually, phonetically and conceptually similar to a high degree.

### **Overall impression**

49. The opponent's first earlier mark consists of the word "MONACO" presented in a standard font and capital letters without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the word itself.

50. The opponent's second earlier mark consists of a number of components, including the word "MONACO" situated beneath a device element of three vertical lines of equal length with the central line presented at a different height to the inner and outer lines. The first letter of the word MONACO, representing the letter M, is presented as 3 vertical lines which are similar to the device element, and the second letter of the word is O, which is faded slightly. The final four letters N A C O are presented in a standard font and capital letters. Due to the size and position of the device within the mark it is my view that the word and device elements play an equal role in the overall impression. The stylisation of the word plays a secondary role and makes a lesser contribution to the overall impression of the mark.

51. The applicant's mark consists of two words, "Monaco" and "Tan", presented in a standard font and in Title Case without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore lies in the combination of these words. The word "Tan" is non-distinctive for "*After sun creams; After sun moisturisers; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use*", consequently, for those goods it is the word "Monaco" which plays the greater role in the overall impression. For the remaining goods, both words will make an equal contribution to the overall impression of the mark.

## **Visual comparison**

52. Both the first and second earlier marks and the contested mark share the same identical word element MONACO/Monaco, however the opposed mark contains the additional word “Tan”. I do not consider the difference in capitalisation/title case is relevant to the visual impact, as the registration of a word mark gives protection irrespective of capitalisation: see *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17. Meanwhile, the device element in the second earlier mark is a noticeable difference. In my view, the applicant’s mark is visually similar to the first earlier mark to a medium degree and is visually similar to the second earlier mark to a low degree.

## **Aural comparison**

53. The common element in all three marks is the word MONACO which would be pronounced identically, however the contested mark also includes the less distinctive word element TAN which would also be voiced. As the figurative element within the opponent’s second earlier mark would not be articulated, I consider the contested mark to be aurally similar to both earlier marks to a medium degree.

## **Conceptual comparison**

54. The word MONACO, which is common to all the competing marks, would be recognised by the average consumer as the name of a geographical location. The additional word TAN in the applicant’s mark would be understood by the relevant public as either a shade of the colour brown or as the process of darkening the natural skin colour following exposure to the sun. The combination “Monaco Tan” may also be perceived by some consumers as alluding to the resulting suntan from sunbathing in the glamorous location of Monaco. The device element in the second earlier mark would have no conceptual impact. Taking all of this into account, I consider the application to be conceptually similar to the earlier marks to at least a medium degree.

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

55. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

56. 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).”

57. As the opponent has filed no evidence regarding the distinctiveness of the earlier trade mark, I have only the inherent characteristics of its trade mark to consider. The first earlier mark consists of the word “MONACO” in plain font. Monaco is a geographical location, being the Principality of Monaco, on the French Riviera and bordered by France. It is common knowledge that Monaco has a reputation as the home of super-wealthy individuals, and is famous for its casino and events such as

the Monaco Grand Prix. While it is known for its glamour, there is no evidence to show that it has any particular association with the goods relied upon. The choice of the name of a glamorous location in relation to cosmetics is likely to be seen as allusive of the aspirations of the consumer to share some part of that glamorous lifestyle. I find that the first earlier mark to be inherently distinctive to a low to medium degree for *soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices* and to a medium degree for *Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and abrasive preparations*.

58. The second earlier mark also contains the word MONACO, but includes other elements such as a device element and some, albeit minimal, stylisation of the word, the combination of which I consider gives the mark a medium degree.

### **Likelihood of confusion**

59. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

60. The contested mark is a composite mark which contains an element identical to the earlier mark. 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, 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.”

61. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

62. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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).”

63. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

64. Earlier in this decision, I found that:

- The level of attention of the general public as the average consumer will be medium when selecting the goods, while the professional consumer is likely to pay a higher than average degree of attention to the selection process;
- Both groups, whilst not ignoring aural considerations, will select the goods at issue by predominantly visual means;
- The competing trade marks are visually similar to a low to medium degree and are aurally similar to a medium degree, with at least a medium level of conceptual similarity;
- The first earlier mark is inherently distinctive to a low to medium degree, while the second earlier mark is possessed of a medium degree of inherent distinctive character;
- All the contested goods except for “*Animal grooming products*” are identical or similar to at least a low degree to the opponent’s goods.

65. Although the average consumer views the mark as a whole, case law also directs me to bear in mind the dominant and distinctive elements of the marks. For “*After sun creams; After sun moisturisers; After-sun creams; After-sun lotions; After-sun lotions [for cosmetic use]; After-sun milk; After-sun milk [cosmetics]; After-sun milk for cosmetic use; After-sun milks; After-sun milks [cosmetics]; After-sun oils [cosmetics]; After-sun preparations for cosmetic use*”, the common and dominant element “MONACO” in the applicant’s mark would be foremost in the minds of the average

consumer. The additional word TAN is likely to be perceived as non-distinctive for these goods. The combination “Monaco Tan” would be seen by some consumers as alluding to the resulting suntan from sunbathing in the glamorous location of Monaco. Keeping in mind the interdependency between the marks, it is my view that for these goods there is likelihood of imperfect recollection leading to a significant proportion of the relevant public directly confusing the later mark with the “*cosmetics*” of the earlier marks.

66. For the remaining goods which I found to be identical or similar to at least a medium degree, the combined words “Monaco Tan” do not naturally fit together. The average consumer will identify the separate meanings of the two words which play an independent role and make an equal contribution to the overall impression of the contested mark. I consider that as per *Medion*, the word “Monaco” in the composite mark “Monaco Tan” has an independent, distinctive significance which would again result in a significant proportion of the relevant public directly confusing the later mark for the earlier marks.

67. In case I am wrong in this, I will consider whether there might be a likelihood of indirect confusion. Here the average consumer recognises that the marks are different but assumes that the goods are the responsibility of the same or connected undertakings. 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.

68. In my view, although the marks share the common word element “MONACO”, it is unlikely that the average consumer would assume that there is an economic connection between the parties. I find that there is no likelihood of indirect confusion.

69. The opposition succeeds in relation to all the goods for which I found similarity in paragraphs 27 - 38 of this decision.

70. The section 5(2)(b) ground fails in respect of the remaining goods.

## Conclusion

71. The opponent has been partially successful. The application by Karen Wood may proceed to registration in respect of the following goods:

### Class 3

*Animal grooming preparations.*

## Costs

72. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Applying the guidance in that TPN, and taking into account the partial success of the applicant for which I have made a very slight reduction to the costs, I award the opponent the sum of £530, which is calculated as follows:

|                                |             |
|--------------------------------|-------------|
| Official fee:                  | £100        |
| Filing a notice of opposition: | £180        |
| Filing written submissions:    | £250        |
| <b>Total:</b>                  | <b>£530</b> |

73. I therefore order Karen Wood to pay S.A.M. Marques de l'Etat de Monaco-Monaco Brands the sum of £530. 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 19<sup>th</sup> day of February 2021**

**Suzanne Hitchings  
For the Registrar,  
the Comptroller-General**