

O/618/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATION NO. 3553407
IN THE NAME OF TRIDENT DISTRIBUTIONS LIMITED**

FOR THE TRADE MARK:

Wellness By Manuel

**IN CLASSES 3, 4, 5, 21, 25,
and 44**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP600001686
BY Carly Whelpley**

BACKGROUND AND PLEADINGS

1. On 09 November 2020, TRIDENT DISTRIBUTIONS LIMITED (“the applicant”) applied to register the trade mark

Wellness By Manuel

for the following goods and services:

Class 03: *Lotions for cosmetic purposes; Face and body lotions; Facial lotions [cosmetic]; Hair lotions; Hand lotions; Massage oils and lotions.*

Class 04: *Aromatherapy fragrance candles; Fragranced candles; Perfumed candles.*

Class 05: *Dietary supplements promoting fitness and endurance.*

Class 21: *Aromatic oil diffusers, other than reed diffusers.*

Class 25: *Clothing for leisure wear; Clothing for sports.*

Class 44: *Meditation services.*

2. The application was published for opposition purposes on 15 January 2021.

3. The application is opposed by Carly Whelpley (“the opponent”). The opposition was filed on 15 April 2021 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 and services in the application. The opponent relies upon its UK trade mark registration number 3458908, shown below, which has a filing date of 17 January 2020 and for which the registration procedure was completed on 11 August 2020:

The Wellness Manual

4. The opponent relies upon goods in Classes 3, 4 and 16 for which the earlier mark is registered, as set out in the Comparison of Goods table under paragraph 23.¹

5. The opponent submits that the applicant's mark is deceptively similar, being almost identical to her earlier registered trade mark, and covers identical or similar goods, which is likely to cause confusion in the minds of consumers. She asks that the application be refused, and that an award of costs be made in her favour.

6. The applicant filed a counterstatement denying the opposition in its entirety, however, it admits that the goods in Class 4 of the opponent's earlier mark are identical to the goods identified in Class 4 of the application, and further admits that the goods in Class 3 of the opponent's earlier mark have some degree of similarity to the goods identified in Class 3 of the application. It denies that there is any likelihood of confusion between the marks. Accordingly, it requests that the opposition be dismissed, and that an award of costs be made in its favour.

7. 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.”

8. 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.

¹ See Preliminary Issues, below, for further explanation.

9. In an official letter dated 22 June 2021, in accordance with Tribunal Practice Notice 2/2013, the parties were allowed until 06 July 2021 to seek leave to file evidence and/or request a hearing and until 20 July 2021 to provide written submissions.

10. While neither party sought leave to file evidence, both parties have filed written submissions in lieu of a hearing, which will not be summarised, but will be referred to as and where appropriate during this decision. This decision has therefore been taken following a careful perusal of the papers.

11. In these proceedings, the applicant is represented by LCF Law and the opponent is a litigant in person.

Preliminary Issues

12. Under the box entitled “Representation of your trade mark” on the Form TM7F, the opponent has recorded her mark, followed by the full specification of goods for which the mark is registered. Under Q1 of the form, she has indicated that she is relying on some goods and services, but has erroneously listed all of the goods covered by the applicant’s mark in Classes 3 and 4, although the Class 4 goods are common to both marks. Under Q12, she has further submitted that certain goods from her registration in Classes 3, 4, and 16 have been infringed by the applicant’s mark, although no direct comparison has been made.

13. In its counterstatement, the applicant submits that the opponent’s Form TM7F attempts to mislead the Tribunal by claiming that the Class 3 goods of the applicant’s mark are covered by her mark, and by referring to alleged infringements of the opponent’s goods which are not actually claimed in the applicant’s mark.

14. In my view, the opponent has not deliberately attempted to mislead. It is clear to me that she does not seek to rely on goods which are not covered by her registration, rather, she has mistakenly completed the form by confusing whose goods should be recorded in each of the sections of the form TM7F. She has indicated under Q11 that she is opposing all of the goods and services covered by the application. I will

therefore proceed to make a comparison of the applicant's goods and services against those goods covered by the earlier mark, as I see fit.

DECISION

15. 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”.

16. 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), 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,

...”

17. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the trade mark had not been registered for more than five years at the date the application was filed, it is not subject to the proof of use

provisions contained in section 6A of the Act. The opponent is, therefore, entitled to rely upon it in relation to all of the goods indicated without having to prove that genuine use has been made of them.

18. 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) –

19. 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

20. 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”.²

21. 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.”

² Paragraph 23

22. 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 and services. 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 may think that the responsibility for those goods lies with the same undertaking”.³

23. The goods and services to be compared are:

Opponent’s goods	Applicant’s goods and services
<p><u>Class 3</u> <i>Aromatic essential oils; Essential oils; Essential oils for cosmetic purposes; Essential oils for the care of the skin; Essential oils for use in the manufacture of scented products; Natural essential oils; Perfumery, essential oils; Essential oils and aromatic extracts; Essential oils for household purposes; Essential oils for household use; Essential oils for personal use; Essential oils for soothing the nerves; Essential oils for use in air fresheners; Aromatics [essential oils]; Blended essential oils; Aromatherapy lotions; Aromatherapy oil; Aromatherapy oils; Essential oils for aromatherapy; Essential oils for aromatherapy use; Air fragrance preparations; Air fragrance reed diffusers; Air fragrancing preparations; Almond oil; Aromatherapy lotions; Aromatic essential oils; Aromatic oils; Aromatic oils for the</i></p>	<p><u>Class 3</u> <i>Lotions for cosmetic purposes; Face and body lotions; Facial lotions [cosmetic]; Hair lotions; Hand lotions; Massage oils and lotions.</i></p>

³ Paragraph 82

bath; Bath and shower foam; Bath and shower gel; Bath and shower gels; Bath bombs; Bath cream; Bath creams; Bath crystals; Bath flakes; Bath milk; Bath oil; Bath oils; Bath preparations; Bath salts; Body and facial oils; Body creams; Body lotion; Body oil; Body oils; Body wash; Bubble bath; Face and body creams; Face and body lotions; Face oils; Foaming bath liquids; Fragrance for household purposes; Fragrance refills for non-electric room fragrance dispensers; Fragrances; Incense; Incense cones; Incense sachets; Incense spray; Incense sticks; Jasmine oil; Lavender oil; Linen (Sachets for perfuming -); Massage oil; Massage oils; Massage oils and lotions; Massage oils, not medicated; Massage waxes; Moisture body lotion; Moisturiser; Moisturisers; Oils for perfumes and scents; Perfume oils; Preparations for the bath; Preparations for the bath and shower; Room fragrances; Room fragrancng preparations; Room fragrancng products; Room perfume sprays; Room perfumes in spray form; Room scenting sprays; Scented bathing salts; Scented body creams; Scented body lotions; Scented body lotions and creams; Scented body spray; Scented fabric refresher sprays; Scented linen sprays; Scented linen water; Scented oils; Scented oils used to produce aromas when heated; Scented room sprays; Scented wax melts; Shower and bath gel; Shower and bath preparations; Shower cream; Shower creams; Shower gel;

<p><i>Shower gels; Shower oils; Shower preparations.</i></p>	
<p><u>Class 4</u> <i>Aromatherapy fragrance candles; Candles; Candles (Perfumed -); Candles and wicks for candles for lighting; Candles and wicks for lighting; Candles for lighting; Perfumed candles; Scented candles; Wicks for candles; Wicks for candles for lighting; Aromatherapy fragrance candles; Base oils; Candle wax; Fragranced candles; Lamp fuel; Lamp oil; Lamp oils; Lamp wicks; Tealight candles; Tealights; Wax for lighting; Wax for making candles.</i></p>	<p><u>Class 4</u> <i>Aromatherapy fragrance candles; Fragranced candles; Perfumed candles.</i></p>
	<p><u>Class 5</u> <i>Dietary supplements promoting fitness and endurance.</i></p>
<p><u>Class 16</u> <i>Adhesive bands for stationery purposes; Adhesive foils stationery; Adhesive labels; Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; Bags [envelopes, pouches] of paper or plastics, for packaging; Bags for packaging made of biodegradable paper; Bags for packaging made of biodegradable plastic; Bags made of paper for packaging; Bags of paper; Ball pens; Ball-point pen and pencil sets; Binders; Boxes for pens; Gift boxes; Gift packaging; Gift paper; Gift wrap; Packaging boxes of card; Packaging materials; Paper; Paper and cardboard; Paper sheets [stationery]; Paper stationery; Pen and pencil boxes;</i></p>	

<i>Stationery; Office stationery; Organizers for stationery use.</i>	
	<u>Class 21</u> <i>Aromatic oil diffusers, other than reed diffusers.</i>
	<u>Class 25</u> <i>Clothing for leisure wear; Clothing for sports.</i>
	<u>Class 44</u> <i>Meditation services.</i>

24. 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 the 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.”⁴

25. In *Gérard Meric v OHIM*, Case T-133/05, the GC stated that:

“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”.⁵

⁴ Paragraph 5

⁵ Paragraph 29

26. 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 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."⁶

27. The opponent submits that the goods covered by Classes 3 and 4 of the earlier mark are either identical or similar to those covered by the contested mark.

28. The applicant admits that the goods covered in Class 4 of the application, being "*Aromatherapy fragrance candles; Fragranced candles; Perfumed candles*" are identical to those goods covered in Class 4 of the earlier mark. I agree. It further admits that the applicant's "*Face and body lotions*" and "*Massage oils and lotions*" are identical to those goods covered in Class 3 of the earlier mark, and admits that the respective uses and users and physical nature of the remaining, non-identical goods are similar and therefore directly competitive, with the exception of "*hair lotions*". I do not intend to compare the Class 4 goods further, however I will consider the degree of similarity for those goods covered by Class 3 of the contested mark not considered to be identical by the applicant.

29. The applicant submits that the goods and services in Classes 5, 21, 25 and 44 are neither identical nor similar to the opponent's goods. I acknowledge the analysis

⁶ Paragraph 12

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

Class 03

30. "*Lotions for cosmetic purposes*". By dint of the goods being covered in Class 3, rather than Class 5 which includes lotions of a medicinal, rather than cosmetic, nature, I consider the term "*Face and body lotions*" in the earlier mark to be included in the broader category "*Lotions for cosmetic purposes*". As such, I find the goods to be identical as per *Meric*.

31. For the same reasoning as above, I find the term "*Facial lotions [cosmetic]*" to be *Meric* identical to the opponent's "*Face and body lotions*".

32. "*Hand lotions*". Going on the premise that hands are body parts, I find the term to be *Meric* identical to the opponent's "*Face and body lotions*". To those consumers who identify hand lotions as a distinct product to "*Face and body lotions*", in my view, the goods would share the same end users with the same method of use, i.e. applied directly to the skin, with both being used for the purpose of moisturising or hydrating the skin. They would also share the same channels of trade. To those consumers, the goods would be highly similar.

33. "*Hair lotions*". In my view, the term "*hair lotion*" could be perceived as referring to a form of shampoo or conditioner, or could include a styling lotion or specialist hair treatment. I acknowledge that there are products on the market which are multi-functional, designed to cleanse both the body and act as a shampoo/conditioner for the hair. As such, "*Hair lotions*" serve a similar, if not identical purpose and method of use as the applicant's "*Bath and shower gels*", with the same end users. The goods are distributed through the same channels of trade which may be found alongside each other in a supermarket or retail outlet. The opposing goods may also be in competition. However, I am mindful of the findings of *YouView*, and I do not consider that the core meaning or the ordinary and natural description of "*Hair lotions*" to

include “*Bath and shower gels*”. I therefore find them to be similar to a very low degree.

Class 05

34. “*Dietary supplements promoting fitness and endurance*”. The nature, purpose and method of use of dietary supplements, which would be ingested by the user, is very different to that of any of the goods in Class 3 of the earlier mark, many of which, for example “*Moisturisers*”, would be applied to the body in some way. The goods are neither complementary nor in competition, and as such, I find the competing goods to be dissimilar.

Class 21

35. “*Aromatic oil diffusers, other than reed diffusers*”. These goods differ in nature to the opponent’s “*Aromatic oils*”, although they may be used together. There is a degree of complementarity in that without the oils themselves, the diffusers would be redundant, while on the other hand, it is not necessary to utilise a diffuser in order to use the oils. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”⁷

There would be an overlap between the end users of the respective goods, and I acknowledge that some consumers may seek to purchase kits which include both a diffuser and a selection of oils which would be packaged under a single brand. However, the manufacturing process of the competing goods is very different, and when purchased individually, in my view, the average consumer would not automatically expect them to come from the same or economically linked undertakings. I therefore find the goods to be similar to only a low degree.

⁷ Paragraph 18.

Class 25

36. “*Clothing for leisure wear; Clothing for sports*”. I agree with the applicant that its Class 25 goods are dissimilar to the opponent’s goods, with the uses, users, and physical nature of those goods being different to, for example, the opponent’s “*Oils for perfumes and scents*”. In *Frag Comercio Internacional, SL, v OHIM*, Case T-162/08, the GC held that:

“Secondly, the Board of Appeal did not err in finding, in paragraph 20 of the contested decision, that the goods in Classes 18 and 25 covered by the earlier Community mark were not complementary in relation to the ‘perfumery’ in Class 3 covered by the mark applied for. In that regard, the Court has held previously that perfumery goods and leather goods in Class 18 cannot be considered similar. Perfumery goods and leather goods are plainly different as regards both their nature and their intended purpose or their method of use. Moreover, there is nothing that enables them to be regarded as in competition with each other or functionally complementary. The same conclusion must be drawn concerning a comparison between perfumery goods and clothing in Class 25. Those goods, as of themselves, also differ as regards both their nature and their intended purpose or their method of use. There is nothing, either, that enables them to be regarded as in competition with each other or complementary (Case T-150/04 *Mülhens v OHIM – Minoronzoni (TOSCA BLU)* [2007] ECR II-2353, paragraphs 31 and 32).”⁸

I consider there to be no similarity between “*Clothing for leisure wear; Clothing for sports*” and any of the opponent’s goods.

Class 44

37. “*Meditation services*”. The use of “*Aromatic essential oils*” may aid relaxation and encourage the state of mind necessary to meditate, and therefore there is likely to be

⁸ Paragraph 30.

some overlap in the end user of the goods and services, as well as in their general purpose. However the nature of the goods and services are different, as are the channels of trade. As per *Sandra Amalia Mary Elliot*, I do not consider them to be complementary. While a practitioner of the meditation services may offer such goods for sale, it is unlikely that those goods will have been produced by them, and the relevant public would not expect the respective goods and services to share the same commercial origin. Consequently, I find that “*Meditation services*” are dissimilar to “*Aromatic essential oils*”.

The average consumer and the nature of the purchasing act

38. 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. (as he was then) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.⁹

39. 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.

40. The average consumer of the competing goods which earlier in this decision I found to be either identical or similar, being various lotions and oils, as well as fragranced candles, will be the general public, although I acknowledge that goods such as essential oils may also be aimed at professional practitioners such as beauticians or massage therapists.

⁹ Paragraph 60

41. The applicant submits that its products are promoted and sold primarily through its own website, where the consumer attentiveness is relatively high. It further submits that the competing goods are not sold alongside each other on shop shelves.

42. I see no reason why both the applicant's and the opponent's goods could not, either now or in the future, be sold through a range of channels including supermarkets, chemists and wholesalers, as well as 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. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play a part, as the consumer may seek advice from sales staff or following word-of-mouth recommendation. 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 their specific needs, particularly in the case of cosmetic lotions. 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 base their selection on the suitability and performance of those goods, as well as the cost and the reputation of the brand. With their own reputation being paramount, they will pay a higher than average degree of attention to the selection process.

Comparison of marks

43. 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.”¹⁰

44. 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.

45. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
The Wellness Manual	Wellness By Manuel

46. The opponent submits that the competing marks are deceptively similar and are almost identical, which would cause confusion in the minds of consumers. In her written submissions, she further submits that the logos of both the applicant and the opponent are visually similar and has provided screen shots of the composite marks used by both as promoted on social media. However, the marks to be compared are the word only marks as shown above, rather than any composite signs used by either party.

47. The applicant submits that the distinctive and dominant component of the earlier mark is the word “Wellness”, being an ordinary word in common use, and it provides

¹⁰ Paragraph 34

a definition from the online edition of the Cambridge English Dictionary.¹¹ It submits that the opponent's mark is largely descriptive, being the adjective to the common noun "Manual".

Overall impression

48. The opponent's mark consists of three words "The Wellness Manual", presented in a standard font and title case without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the combination of the words. As submitted by the applicant, the word "wellness" is a descriptor of the word "manual", both words being preceded by the definite article "the". While the word "The" will contribute to the overall impression conveyed, in itself it is non-distinctive and will make a relatively low contribution to the overall impression. The word "Manual" would be non-distinctive in relation to handbooks or printed matter giving guidance or instruction, and the word "Wellness" would be seen as the subject matter of that manual, however, the opponent's Class 16 goods do not include any such printed matter. The overall impression primarily rests in the words "Wellness Manual".

49. The applicant's mark consists of three words, "Wellness By Manuel" presented in a standard font and title case without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore rests in the combination of the words. As the word "Wellness" alludes to goods and services which are designed to induce health and happiness, it is the forename "Manuel" which makes a slightly greater contribution to the overall impression of the mark.

Visual comparison

50. Both marks are made up of three words, which have the word "Wellness" in common, although the position of the word within the marks is different in each, being placed at the start of the applicant's mark and in the middle of the opponent's mark.

¹¹ The definition provided is "the state of being healthy, especially when it is something that you actively try to achieve" or "activities that are designed to help people feel healthier and happier" or "the business of providing these activities".

The words “The” and “By” in the respective marks are considered to be non-distinctive, while the words “Manual” and “Manuel” have only one letter difference. Considering the marks as a whole, I find there to be a high degree of visual similarity between them.

Aural comparison

51. The common element of the competing marks is the word “WELLNESS”, which will be pronounced identically in both. The word “Manual” in the opponent’s mark will be pronounced as three syllables MAN-YOU-ULL (mænjʊəl), while the word “Manuel” in the applicant’s mark is likely to be pronounced by the average UK consumer as two syllables MAN-WELL (mæn’wɛl). The word “the” in the earlier mark, and the word “by” in the contested mark will also be voiced, being announced as “THE WELL-NESS MAN-YOU-ULL” and “WELL-NESS BY MAN-WELL”, respectively. I find the marks to be aurally similar to a medium degree.

Conceptual comparison

52. With regard to conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)* the GC held:

“... In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the Larousse dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it.’”¹²

53. As already mentioned by the applicant, the word “WELLNESS” is a dictionary defined word which relates to health and happiness. The average consumer will perceive the opponent’s mark as a guide to health, with some consumers seeing the

¹² Paragraph 8.

word “The” at the start of the mark as indicating that the manual is a definitive authority on the subject of wellness. While the opponent’s goods do not actually include printed matter, the mark is highly allusive of the health benefits brought by the use of goods such as essential oils and fragranced candles, the use of which may be recommended in such a handbook in order to promote “wellness”. The overall concept conveyed by the opponent’s mark is of a guide, or manual, providing information on the subject of “wellness”.

54. In comparison, in my view, the average UK consumer will recognise “Manuel” in the applicant’s mark as a masculine forename, commonly associated with the Spanish language, which the applicant submits is a relatively unusual name in the UK. While the name “Manuel” by itself has no concept,¹³ the overall idea conveyed by the applicant’s mark is of the provision of goods and services which are specifically focussed on fostering “wellness”, with the name “Manuel” serving to distinguish the provider of those goods and services.

55. The opponent submits that the competing marks convey a similar general meaning which would produce the same mental reaction in customers. I do not agree that the marks would produce the same reaction, as the conceptual message is not identical, with the only shared concept being that of “wellness”. Consequently, I find the marks to be conceptually similar to no more than a medium degree.

Distinctive character of the earlier mark

56. 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.

57. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

¹³ See *Luciano Sandrone*, paragraphs 84-89.

“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).”

58. The applicant submits that the earlier mark is largely descriptive and that it is unaware that the mark has been used in a way that the lack of inherent distinctiveness has in any way been displaced by distinctiveness developed through widespread use.

59. The opponent submits that if her mark was used in relation a book or handbook, then the mark would be descriptive, but she contends that on the goods for which the mark is registered, the sign is not descriptive but arbitrary, and as such it is inherently distinctive.

60. The earlier mark comprises three ordinary, dictionary defined words, one of which is the definite article and non-distinctive. The remainder of the mark creates an impression of some form of instruction in the pursuit of “wellness”. Invented words usually have the highest degree of distinctive character, while words which are descriptive of the goods relied upon typically have the lowest degree. As considered

earlier in paragraph 53 of this decision, to my mind, the mark strongly alludes to the type of products that one might find recommended in such a guide. Consequently, I find the mark to be at the lower end of the spectrum, although not of the very lowest degree.

Likelihood of confusion

61. There is no scientific 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.

62. 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]).

63. 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).”

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

65. 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 high degree; they are aurally similar to a medium degree, and they are conceptually similar to no more than a medium degree;
- The inherent distinctive character of the earlier mark is at the lower end of the spectrum;
- The contested goods in Class 3 and Class 4 are either identical or highly similar to the opponent's goods, with the exception of "*hair lotions*", which I found to be similar to a very low degree;
- The contested goods in Class 21 are similar to the opponent's goods to a low degree;
- The remaining goods and services are dissimilar.

66. A degree of similarity between the services is essential for there to be a finding of likelihood of confusion. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

67. As no similarity was found for the goods and services in Classes 5, 25 and 44, there is no likelihood of confusion to consider for these goods and services.

68. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the CJEU confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion:

“The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”¹⁴

69. Earlier in this decision, although I found the marks to be conceptually similar to no more than a medium degree, I found there to be a high degree of visual similarity and a medium degree of aural similarity between the marks. It is settled case-law that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind. In spite of the distinctive character of the earlier mark being at the lower end of the spectrum, allowing for imperfect recollection, and taking into account the respective goods which are considered to be identical or highly similar, which offsets a lesser degree of similarity between the marks, I consider the differences between the marks to be insufficient to avoid them being mistakenly recalled as each other. Consequently, I find that there is a likelihood of direct confusion for those goods which were considered to be identical or with a high degree of similarity. For those goods which I found to

¹⁴ Paragraph 45.

share only a low degree of similarity, being *Hair lotions* and *Aromatic oil diffusers, other than reed diffusers*, given the low degree of distinctive character of the earlier mark, I do not consider that the average consumer would mistake the goods with those of the opponent and I therefore find there to be no likelihood of direct confusion for those goods.

70. I now turn to 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 he then was), 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.

71. Keeping in mind the global assessment of the competing factors in my decision, although the marks share the common word “WELLNESS”, and for some consumers, sight of one mark may bring to mind the other mark, in my view, it is unlikely that the average consumer would assume that there is an economic connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. in *L.A. Sugar* are not exhaustive, but I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other. I therefore find that there is no likelihood of indirect confusion.

72. The opposition under section 5(2)(b) succeeds with respect to “*Lotions for cosmetic purposes; Face and body lotions; Facial lotions [cosmetic]; Hand lotions; Massage oils and lotions*” in Class 3, and “*Aromatherapy fragrance candles; Fragranced candles; Perfumed candles*” in Class 4.

Conclusion

73. The opposition has been partially successful. The application by TRIDENT DISTRIBUTIONS LIMITED may proceed to registration in respect of the following goods and services:

Class 3

Hair lotions

Class 5

Dietary supplements promoting fitness and endurance.

Class 21

Aromatic oil diffusers, other than reed diffusers.

Class 25

Clothing for leisure wear; Clothing for sports.

Class 44

Meditation services.

Costs

74. Both parties have enjoyed a share of success, and I note the completed costs Pro Forma filed on behalf of the applicant. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Considering the balance of success is roughly equal, adopting a “rough and ready” approach to the matter, I have concluded that both parties should bear their own costs.

Dated this 20th day of August 2021

Suzanne Hitchings

For the Registrar,

the Comptroller-General