

**O/0070/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3666170**

**BY RNB, S.L.**

**TO REGISTER THE FOLLOWING TRADE MARK:**

**U/1ST**

**IN CLASS 3**

**AND**

**AN OPPOSITION THERETO UNDER NUMBER 429748**

**BY YOU FIRST S.R.L.**

## BACKGROUND AND PLEADINGS

1. On 8 July 2021, RNB, S.L. (“the applicant”) applied to register “U/1ST” as a trade mark in the UK. The application was published for opposition purposes on 29 October 2021 and registration is sought for goods in Class 3.<sup>1</sup>

2. On 29 December 2021, You First S.r.l. (“the opponent”) opposed the application in full, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK trade mark (“UKTM”) number 914103551 (“the earlier mark”)<sup>2</sup> which has a filing date of 20 May 2015, a registration date of 21 October 2015 and is registered for goods in Classes 3, 4, 16, 18, 21 and 30. For the purposes of this opposition, the opponent relies upon *perfumery*<sup>3</sup> and *essential oils* in Class 3. A representation of the earlier mark is as follows:



3. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks, despite having “visual differences”, will be identically pronounced as “you first” and are conceptually identical or highly similar, and the

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<sup>1</sup> These will be listed in the goods comparison.

<sup>2</sup> On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark (“EUTM”). As a result of the opponent’s EUTM number 14103551 being registered before the end of the transition period, a comparable UKTM (the earlier mark) was created. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods or services.

<sup>3</sup> This term in the opponent’s specification is misspelled ‘perfumary’.

goods are either identical or similar. The opponent attests there is a likelihood of direct and indirect confusion.

4. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the opponent made a statement of use in relation to the goods relied upon.

5. The applicant filed a defence and counterstatement denying the grounds of opposition and requesting that the opponent provide proof of use of all the goods relied upon.

6. The opponent is represented by Armstrong Teasdale Limited and the applicant by Page, White & Farrer Limited. During the evidence rounds, both parties filed evidence in chief and the opponent filed evidence in reply. Neither party requested a hearing but both parties filed written submissions in lieu. The evidence and submissions will be referred to as and where appropriate throughout this decision, but I will summarise what was filed below.

## **EVIDENCE**

7. The opponent filed evidence in chief in the form of the first witness statement of Stefania Cuzzeri dated 11 May 2022 and its corresponding thirteen exhibits. Ms Cuzzeri is the Founder and Creative Director of the opponent company, a position she has held since 2015.

8. The applicant filed evidence in chief in the form of the witness statement of James Philip Cornish dated 1 July 2022 and its corresponding nine exhibits. Mr Cornish is a Trade Mark Attorney representing the applicant.

9. The opponent filed evidence in reply in the form of the second witness statement of Ms Cuzzeri dated 5 September 2022 and its corresponding three exhibits.

## **DECISION**

### **Relevance of EU law**

10. Although the UK has left the EU, 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 upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

### **Proof of use**

11. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A (1) This section applies where -

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

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

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

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

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

(3) The use conditions are met if -

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

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

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

12. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7. (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.”

13. Accordingly, for the purposes of assessing proof of use, the earlier mark will be treated as an EUTM for the part of the relevant period before IP completion day (31 December 2020) and, as such, use in the EU may be sufficient.

14. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

#### Relevant case law

15. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v*

*Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or



services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

16. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has

been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue, i.e. 9 July 2016 to 8 July 2021.

20. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the earlier mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK (or the EU, prior to IP completion day) during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

21. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole rather than whether each individual piece of evidence shows use by itself.<sup>4</sup>

22. The opponent claims to have used its earlier mark in relation to the following goods:

Class 3      *Perfumery; essential oils.*

23. Ms Cuzzeri's witness statement provides the following sales figures:

<b>Period</b>	<b>Territory</b>	<b>Sales (Euros)</b>
September 2015 – September 2016 <sup>5</sup>	EU	>50,000
October 2016 – December 2016 <sup>6</sup>	EU	>10,000
January 2017 – December 2017 <sup>7</sup>	EU	>10,000
January 2018 – December 2018 <sup>8</sup>	EU	>90,000
January 2019 – December 2019 <sup>9</sup>	EU	>10,000
January 2020 – December 2020 <sup>10</sup>	EU	>10,000

24. The sales figures, though not exact nor broken down by category, are supported by a large selection of invoices dated between September 2016 and December 2020. The invoices show sales across multiple regions in Italy. Where the goods listed in the invoices are written in Italian, I do not intend to attempt to translate them into English. From the descriptions which are either in English or I can easily understand the meaning of, the goods that appear in the invoices are eau de parfum, fragrance diffusers, candles and body creams.

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<sup>4</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09.

<sup>5</sup> [9]

<sup>6</sup> [15]

<sup>7</sup> [19]

<sup>8</sup> [22]

<sup>9</sup> [25]

<sup>10</sup> [30]

25. The earlier mark appears on each invoice and there is evidence, dated within the relevant period, clearly showing the mark on the goods referred to in the invoices or the packaging of those goods.<sup>11</sup>

26. Taking the evidence as a whole I am satisfied that there has been genuine use of the earlier mark in the EU during the relevant period.

#### Fair specification

27. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

28. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

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<sup>11</sup> Exhibits SC2-3 and SC7-9.

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

29. It is clear to me from the evidence that the opponent has shown use of its trade mark in relation to perfumery, a term relied upon by the opponent. The opponent also relies on the term *essential oils*, a narrow term which I consider refers to the oils themselves; they tend to be bought as small bottles of liquid and have a variety of uses including health benefits and room fragrance. The evidence does not show use of the

mark on essential oils. I do not consider the sale of goods which may contain or use essential oils – such as candles, diffusers and body creams – to constitute genuine use of the term *essential oils*. Candles, diffusers and body creams are terms that are either not listed in the earlier mark’s specification or have not been relied upon by the opponent. As such, evidence going to sales of these goods is not relevant to the case before me.

30. I bear in mind that since the sales figures are not broken down by category, a portion of these will refer to goods the opponent cannot rely on. The result of this is a likely to be a relatively small turnover for *perfumery* alone. However, despite low sales numbers, I take account of the four-year period in which there have been sales and the geographical spread across Italy. I am satisfied that there has been real commercial exploitation of the mark on perfume goods during the relevant period, constituting genuine use. Accordingly, the opponent may rely upon *perfumery* for the purpose of this opposition.

### **Section 5(2)(b)**

31. Section 5(2)(b) of the Act states that:

“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.”

### **Relevant law**

32. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik*

*Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

### The principles

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

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

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

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

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

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



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

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

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

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

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

### **Comparison of goods**

33. In light of my findings above, the competing goods are shown below:

#### The opponent's specification (following proof of use)

Class 3      *Perfumery*

#### The applicant's specification

Class 3      *Make-up preparations; perfumery; toilet water; preparations for use in shaving; pre-shave and aftershave lotions; eau de cologne; essential oils; cosmetics; dentifrices; sunscreen; suntan lotion [cosmetics]; deodorants for personal use [perfumery]; tissues impregnated with cosmetic lotions; facial and body masks; hair masks; cosmetic preparations for scalp and hair care; shampoo; conditioning preparations for the hair; hair dye; hair lotion; hair-styling products; non-medicated*

*skin cream; skin care lotions [cosmetic]; non-medicated toiletries; cosmetic preparations for bath; cosmetic products for the shower; cosmetic preparations for the maintenance of the skin; cosmetic preparations for lip care; soaps and gels.*

34. In *Gérard Meric v OHIM*, the General Court (“GC”) confirmed that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):<sup>12</sup>

“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.”

35. *Perfumery* in both specifications is evidently identical. In accordance with *Meric*, some of the remaining terms in the applicant’s specification - *toilet water; eau de cologne; deodorants for personal use [perfumery]* – are identical to the opponent’s *perfumery*. I do not consider it necessary to undertake a full comparison of the remaining goods but consider the similarity to vary from dissimilar to similar to medium degree. I will proceed with the opposition on the basis of the identical goods.

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

36. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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:

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<sup>12</sup> Case T-133/05

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

37. I consider the parties’ goods to all be consumer items aimed at the general public. Some will be inexpensive and frequently purchased (low-cost deodorant, for example). Others, such as some perfume products, are more expensive but are purchased fairly frequently. The purchase will be overwhelmingly visual, with consumers self-selecting the goods from the shelves of physical retail stores or from their online equivalents. However, I do not ignore the potential for an aural aspect to the purchasing process, owing to conversations with retail assistants. Consumers will consider the fragrance, ingredients and suitability for their skin and needs when purchasing the goods. On the whole, no more than a medium degree of attention will be paid to the purchase, regardless of the cost of the goods.


### **Comparison of marks**

38. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

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

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

Earlier mark	Contested mark
	<p style="text-align: center;"><b>U/1ST</b></p>

41. Both parties have made submissions on the comparison of the marks, which I have taken into account and will refer to, where necessary, in my decision.

42. The earlier mark is figurative and comprises the word elements 'YOUFIRST' and 'PURA RINASCITA', the former being positioned above the latter. The letters U and F in YOUFIRST are conjoined and the word as a whole is in a slightly different, slightly larger font to that of PURA RINASCITA. Surrounding the word elements is a wreath-type device incorporating flowers, leaves, butterflies and birds. The opponent submits that the dominant and distinctive element of its earlier mark is the word element YOUFIRST, with the wreath device making much less of a contribution to the overall impression and the words PURA RINASCITA playing an even lesser role.<sup>13</sup> However, in figurative marks, it is not the case that word elements must always be considered to be dominant.<sup>14</sup> Given its highly decorative nature and that it forms a large proportion

<sup>13</sup> Submissions in lieu at [20] and [21].

<sup>14</sup> See *L&D SA v OHIM* [2008] E.T.M.R. 62 and *Metamorfoza d.o.o. v EUIPO*, Case T-70/20, EU:T:2021:253.

of the mark, I consider the wreath device to be as dominant in the mark as the word element YOUFIRST. The words PURA RINASCITA cannot be ignored: whilst they are in a smaller font than YOUFIRST, they are distinctive and are not so small within the mark that they will go unnoticed. They are slightly less dominant in the mark than the other elements but are equally distinctive.

43. The contested mark contains the letter U followed by a forward slash, the numeral 1 and the letters S and T. None of the four characters are dominant in the mark, with all four playing an equal role in the overall impression of the mark, which lies in its entirety: U/1ST.

#### Visual comparison

44. Visually, the marks coincide in their letters U, S and T, used in the same order but not consecutively. All other elements in both marks differ. The remainder of the word element YOUFIRST is not shared between the marks and the words PURA RINASCITA along with the highly decorative wreath device have no counterpart in the contested mark. Further, the forward slash and numeral 1 in the contested mark are not apparent in the earlier mark. Overall, I find any visual similarity between the marks to be of a very low degree.

#### Aural comparison

45. I agree with the opponent that the word elements YOUFIRST and U/1ST will be pronounced identically as the ordinary dictionary words YOU and FIRST. I further agree that the wreath device will not be articulated.

46. However, when it comes to the words PURA RINASCITA, I remind myself that the aural similarities must be assessed by reference to the overall impression of the mark bearing in mind the distinctive and dominant components, but that 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 element (Sabel).

47. I am also cognisant of the comments of Mr Philip Harris, sitting as the Appointed Person in BL O/115/22, who explained that ignoring, in the aural comparison, elements which are not negligible may give rise to an unprincipled dissection of the trade marks.

48. The words PURA RINASCITA are not negligible and add to the distinctiveness of the earlier mark. Further, the opponent's point that the words are in Italian is not a sufficient reason for me to eliminate the words from the aural comparison. It seems reasonable to me to conclude that English-speaking consumers would at least attempt to pronounce PURA RINASCITA, even if that pronunciation is not perfect.

49. Taking account of the aural identity between the elements YOUFIRST and U/1ST as well as the words PURA RINASCITA not featuring in the contested mark, rendering the earlier mark significantly longer than the contested mark, I find the marks to be aurally similar to a medium degree.

#### Conceptual comparison

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.<sup>15</sup> The assessment must be made from the point of view of the average consumer.

51. Despite the presentation of these elements differing, I consider YOUFIRST in the earlier mark and U/1ST in the contested mark to conjure the same meaning in the minds of consumers, that being the definition of the ordinary dictionary words YOU and FIRST used together. 'YOU FIRST' is a common phrase which I consider to have two main meanings: either 'you [go] first' or '[put] you first', i.e. prioritise yourself. This accords with the parties' submissions on the point.

52. Whilst the words PURA RINASCITA are not negligible and create a point of conceptual difference between the marks, consumers are likely to see the words as foreign or invented, attributing no meaning to them. With the wreath device adding

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<sup>15</sup> [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

very little in the way of a conceptual message for the earlier mark, overall, I find the marks to be conceptually similar to a high degree.

### **Distinctive character of the earlier mark**

53. In *Lloyd Schuhfabrik Meyer* 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).”

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods/services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

55. I will consider first the inherent distinctiveness of the earlier mark. It consists of the words YOUFIRST PURA RINASCITA and a decorative wreath device. The opponent submits that the distinctive character of the earlier mark lies in the word element YOUFIRST, which it describes as the common element between the marks. Similar to the applicant's submissions, I do not consider YOUFIRST to be hugely distinctive for the goods at issue. Though they are not descriptive or allusive, YOU and FIRST are ordinary dictionary words which are often used together. This element of the mark by itself has no more than a medium degree of distinctiveness. The fact that there is some minor stylisation to the letters U and F in that they are conjoined does not alter this finding since the words are clearly legible as YOU and FIRST. The highly decorative wreath, however, together with the words PURA RINASCITA add to the distinctiveness of the mark. As I have indicated above, the words PURA RINASCITA are not so tiny that they are negligible in the mark, neither does the fact they are in Italian render them irrelevant to the assessment of the mark's distinctiveness. In my view, all elements of the mark add to its high inherent distinctive character.

56. Whilst the opponent has filed evidence from which I can make an assessment as to an enhanced distinctive character, I consider the evidence to be deficient for this purpose in a number of ways. As explained at [24], the sales figures are neither exact nor broken down by the category of goods. Despite there being some evidence of marketing materials and features in magazines (Vogue Italy and Vanity Fair Italy), I remind myself that the relevant territory for enhanced distinctiveness is the UK. Further, I have not been provided with the amount spent on marketing or the market share held by the opponent. Based on the evidence before, I am not satisfied that the distinctiveness of the earlier mark has been enhanced through use.

### **Likelihood of confusion**

57. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*) from the perspective of the average consumer. In making my assessment, I must keep 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*). The factors considered above have a degree



of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.

58. I have found the marks to be visually similar to a very low degree, aurally similar to a medium degree and conceptually similar to a high degree. I have found the earlier mark as a whole to have a high degree of inherent distinctive character, to which all elements contribute. I have identified the average consumer to be a member of the general public who, paying a medium degree of attention, selects the goods predominantly by visual means, though there may be an aural element to the purchase. As explained at [35], I will consider the matter based on the identical goods.

59. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Limited v By Back Beat Inc.*, BL O/375/10, where Iain Purvis QC (as he then was), sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised 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).”

60. I bear in mind that aurally, YOUFIRST and the entirety of the contested mark are identical. However, there are other elements in the earlier mark, including PURA RINASCITA which I am not persuaded will be ignored during the pronunciation of the mark. Even in circumstances where consumers shorten the earlier mark to YOUFIRST for convenience, I do not consider it likely for those consumers to entirely forget the words PURA RINASCITA which, as I have already indicated, are not non-distinctive within the mark and are not negligible. Further, it is appropriate to consider the objective conditions under which the marks may be present on the market:<sup>16</sup> the purchase is overwhelmingly visual and visually, there are no immediately obvious shared elements. The fact that YOUFIRST and U/1ST are presented differently will not go unnoticed, neither will the wreath device nor the words PURA RINASCITA. I find it highly unlikely that the average consumer would mistake one mark for the other. Even for identical goods, I do not consider there to be a likelihood of direct confusion.

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<sup>16</sup> See *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03.

61. I turn now to indirect confusion. The opponent suggested indirect confusion could occur in the following circumstances:<sup>17</sup>

“[...] the consumer may assume the later mark is a sub-brand of the earlier mark (the parent brand) with its modern shorthand look designed to target a younger audience.”

62. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

63. In order to find indirect confusion in this case, it would be necessary to conclude that the average consumer will see U/1ST as an alternative presentation of YOUFIRST, or vice versa, perhaps in the way described by the opponent, and conclude that the presence of either element must mean one mark is a brand of the owner of the other mark. I do not consider the words ‘YOU FIRST’ to be so strikingly distinctive that consumers would assume any undertaking using those words in an entirely different format must be related. I have already concluded that the remaining elements in the earlier mark are not negligible and so the consumer would also have to assume that the removal of the wreath device and the words PURA RINASCITA are consistent with a sub-brand or rebranding, for example. I do not consider these elements, PURA RINASCITA in particular, to be logical with a finding of indirect confusion. I bear in mind that the more distinctive the earlier mark, the greater the likelihood of confusion and that the earlier mark is highly inherently distinctive. However, the high distinctiveness afforded to the mark is the result of the totality of the mark’s elements and not the YOUFIRST element alone. Taking everything into consideration, even for identical goods, I do not consider there to be a likelihood of indirect confusion.

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<sup>17</sup> The opponent’s statement of grounds.

## **CONCLUSION**

64. The opposition under section 5(2)(b) has been unsuccessful and the application may proceed to registration.

## **COSTS**

65. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,200, calculated as follows:

Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering the other side's evidence	£700
Preparing submissions in lieu of a hearing	£300
<b>Total</b>	<b>£1,200</b>

66. I therefore order You First S.r.l. to pay RNB, S.L. the sum of £1,200. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

**Dated this 23rd day of January 2023**

**E FISHER (née VENABLES)**

**For the Registrar**