

O/0555/23

TRADE MARKS ACT 1994

**IN THE MATTER OF THE UK DESIGNATION OF INTERNATIONAL
REGISTRATION NO. 1536081
IN THE NAME OF WOW COLOUR (GUANGDONG) TECHNOLOGY CO., LTD.**

FOR THE TRADE MARK

WOW COLOUR

IN CLASSES 3, 21 and 35

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 423339
BY FEDERICI BRANDS LLC**

BACKGROUND AND PLEADINGS

1. On 26 March 2020, International Registration (“IR”) No. 1536081 was registered for the figurative mark shown on the cover page of this decision, based on Chinese Trade Marks No.s 4391519, 43913583 and 43925368 in classes 3, 21 and 35. With effect from the same date, SEJIE (GUANGDONG) BEAUTY MAKEUP CO., LTD. (the original holder) designated the United Kingdom for protection of the mark.

2. The designation was accepted and published for opposition purposes on 27 November 2020, in respect of the following goods and services:

Class 3: *Dentifrices; breath freshening sprays; air fragrancing preparations; facial cleansers; hand lotions; essential oils; lipsticks; beauty masks; nail polish; false eyelashes; cosmetics; cosmetic pencils; perfumes; eyebrow pencils; mascara; nail art stickers; sunscreen creams; make-up remover.*

Class 21: *Ceramics for household purposes; tea services (tableware); boxes for dispensing paper towels; soap boxes; vases; piggy banks; nail brushes; combs; toothbrushes; floss for dental purposes; cosmetic utensils; fitted vanity cases; powder puffs; make-up removing appliances; make-up sponges; make-up brushes.*

Class 35: *Advertising; presentation of goods on communication media, for retail purposes; business management and organization consultancy; advisory services for business management; commercial administration of the licensing of the goods and services of others; import-export agency services; sales promotion for others; procurement services for others [purchasing goods and services for other businesses]; marketing.*

3. On 25 June 2021, ownership of the designated mark was transferred by assignment to WOW COLOUR (GUANGDONG) TECHNOLOGY CO., LTD. (“the holder”).¹

¹ On 11 August 2021, the Tribunal wrote to the representatives of the new holder to request confirmation that the holder stood by the statement made in the counterstatement, and that it was aware of and

4. The designation is opposed by Federici Brands LLC (“the opponent”). The opposition was filed on 25 February 2021 and is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).² The opposition is directed against all of the goods in Class 9 and some of the goods and services in classes 21 and 35 of the designation, as listed in the table under paragraph 23. The opponent relies upon the following marks:

COLOR WOW

International Registration No. WE1183964³

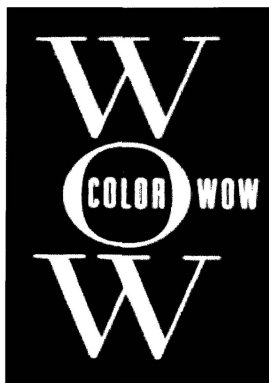
International Registration date: 13 November 2013

Protected for goods in the EU in Class 3.

Relying on all goods, namely:

Hair care preparations.

(The “964” mark); and



EUTM registration number 013911458⁴

Filing date: 26 June 2015

Registration date: 16 October 2015

accepted the liability for costs for the whole proceedings in the event that the opposition was successful. This was confirmed by the holder in its letter in response dated 19 August 2021.

² The grounds under section 5(3) as originally filed were withdrawn by the opponent in an email to the Registry dated 4 August 2021. The opponent maintains its opposition under Section 5(2)(b) only.

³ Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice (“TPN”) 2/2020 for further information.

⁴ Ibid.

Registered in Class 3

Relying on all goods, namely:

Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair.

(The “458” mark).

5. The opponent submits that the contested mark is similar visually, conceptually and phonetically to the earlier marks, and that contested goods and services are similar to the goods covered by the earlier marks. Consequently, the opponent submits that there is “a very real risk that consumers ... would believe that the goods and services provided by the applicant are connected to the opponent ... or have been produced with the consent or cooperation of the opponent”. The opponent therefore requests that the designation be refused protection under the provisions of Section 5(2)(b).

6. The holder filed a counterstatement denying the claims. With regard to the comparison between the holder’s mark and the earlier “458” mark, it submits that the marks are strikingly different in appearance, and as such there could be no possibility of confusion. With regard to the earlier “964” mark, it submits that the individual words which make up the competing marks, when used in relation to the contested goods and services, are low in inherent distinctive character. As such, it submits that the average consumer would be more than capable of distinguishing between the marks without confusion due to their visual and phonetic differences.

7. Both parties filed written submissions which will be referred to as and where appropriate during this decision. Both parties elected to file evidence, which will be summarised to the extent considered necessary. Neither party requested a hearing, therefore this decision is taken following careful consideration of the papers.

8. In these proceedings, the opponent is represented by Mewburn Ellis LLP and the holder is represented by Murgitroyd & Company⁵.

EVIDENCE

Opponent's Evidence

9. The opponent filed evidence by way of two witness statements, both in the name of James Federici, who is Vice President and General Counsel of the opponent company, Federici Brands LLC.

10. The first witness statement is dated 29 June 2021⁶, and to which there are attached six exhibits, labelled **Exhibit JF1** to **Exhibit JF6**. Mr Federici states that the main purpose of the evidence is in response to the request for proof of use of the EU designation of IR1183964.

11. The second witness statement is dated 27 July 2021⁷, and to which there are attached a further two exhibits, labelled **Exhibit JF7** to **Exhibit JF8**. Mr Federici states that the main purpose of this second witness statement is to supplement the first witness statement with additional information on the use of the "964" mark in the EU.

Holder's Evidence

12. The holder filed evidence in support of its defence by way of a witness statement, dated 30 June 2022, in the name of Gareth Ian Price of the opponent's representatives Murgitroyd & Company, and to which there are attached four exhibits, labelled **Exhibit GIP1** to **Exhibit GIP4**.

13. I have read and considered all of the evidence and I will refer to the relevant parts at the appropriate points in the course of the decision.

⁵ I note that the holder's representatives were originally recorded as Urquhart-Dykes & Lord LLP, which later merged with Murgitroyd & Company. This has been reflected accordingly in these proceedings.

⁶ Resubmitted with an amended statement of truth, dated 29 July 2021.

⁷ Resubmitted with an amended statement of truth, dated 29 July 2021.

DECISION

14. 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.

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

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

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

...”

16. Each of the trade marks upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As the “458” mark had not been registered for more than five years at the date of designation for protection in the UK of the contested mark, it is not subject to the 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.

17. The opponent’s “964” mark had been protected for more than five years before the date of designation of the contested mark and, as a result, it is subject to use provisions. I note that on filing its Form TM8 Notice of Defence and Counterstatement, the holder required the opponent to provide proof of use of the mark for all the goods on which it relies. However, in its written submissions, the

holder states that, having reviewed the evidence of use submitted by the opponent, it admits that the evidence demonstrates use of the EU designation of the “964” mark in relation to “haircare preparations” during the relevant period.⁸ In view of this admission, I do not intend to summarise the evidence provided in relation to genuine use of the mark within the decision. I proceed on the basis that proof of genuine use of the mark has been provided in relation to all the goods on which the opponent relies.

Section 5(2)(b)

18. Section 5(2)(b) is relied on and reads as follows:

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

(a) ...

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

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

19. Section 5A states:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. 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*

⁸ See paragraphs 8 and 9 of the holder’s written submissions dated 30 June 2022.

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 and services

21. Section 60A of the Act provides:

“(1) For the purposes of this Act goods and services —

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification;

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

22. I am mindful of the fact that the appearance of respective goods in the same class is not sufficient in itself to find similarity between those goods, and that likewise, neither are goods and services to be automatically found to be dissimilar simply because they fall in a different class.

23. The goods and services to be compared are:

Opponent's goods	Holder's goods and services
<p>The "964" Mark <u>Class 3</u> <i>Hair care preparations.</i></p>	<p><u>Class 3</u> <i>Dentifrices; breath freshening sprays; air fragrancing preparations; facial cleansers; hand lotions; essential oils; lipsticks; beauty masks; nail polish; false eyelashes; cosmetics; cosmetic pencils; perfumes; eyebrow pencils; mascara; nail art stickers; sunscreen creams; make-up remover.</i></p>
<p>The "458" Mark <u>Class 3</u> <i>Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair.</i></p>	<p><u>Class 21</u> <i>Ceramics for household purposes; boxes for dispensing paper towels; soap boxes; nail brushes; combs; toothbrushes; floss for dental purposes; cosmetic utensils; fitted vanity cases; powder puffs; make-up removing appliances; make-up sponges; make-up brushes.</i></p> <p><u>Class 35</u> <i>Presentation of goods on communication media, for retail purposes</i></p>

24. In *Gérard Meric v OHIM*, Case T-133/05, the General Court ("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”.⁹

25. 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, ... 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”.¹⁰

26. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the channels of trade of the respective goods or services.

27. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the 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”.¹¹

⁹ Paragraph 29

¹⁰ Paragraph 23

¹¹ Paragraph 82

28. 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 Q.C. (as he then was), 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.”¹²

29. 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. ... Nevertheless the principle should not be taken too far. ... 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.”¹³

30. In its Statement of Grounds, the opponent submits that the later mark covers various make up and personal care and beauty items under Class 3 which it claims the average consumer would expect to have the same trade origin. It further submits that the competing products are inherently similar since they serve the same end function in terms of beauty and personal care, but would also be viewed as complementary to each other. In relation to the contested goods in Class 21, the opponent submits that those goods relate to the goods in Class 3 and which could be used in relation to hair care products. For the contested services in Class 35, the opponent submits that this covers retail type services which are unrestricted in scope,

¹² Paragraph 5
¹³ Paragraph 12

so would include retail services relating to the opponent's products. As a result, it submits that the average consumer would expect such services to originate from, or be linked to the opponent.

Contested goods in Class 3

Facial cleansers; hand lotions; essential oils; lipsticks; beauty masks; nail polish; false eyelashes; cosmetics; cosmetic pencils; perfumes; eyebrow pencils; mascara; nail art stickers; sunscreen creams; make-up remover.

31. As noted by the opponent, the holder admits that there is a low degree of similarity between its above listed goods and the opponent's earlier goods which the holder submits "may be sold in the same sections of retail stores supermarkets"¹⁴. I note that the goods relied upon by the opponent under Class 3 of both its earlier marks are all products for use in connection with hair. I agree with the holder that the contested goods are used for either personal hygiene, enhancing or protecting the appearance of the body, and to my mind, the same can be said for opponent's various hair preparations covered by both earlier marks, albeit that they are specific to use on hair, rather than the face or body. The goods are distributed through the same channels of trade which may be found in relatively close proximity in a supermarket or retail outlet, and there is likely to be an overlap in end users. However, I am mindful that the essential purpose of the earlier goods is specific to use on hair, which cannot be said of the holder's aforementioned goods. As guided by *YouView*, I do not consider that the natural meaning of the broad term "cosmetics" would encompass hair preparations. Overall, I find the goods to be similar to no more than a medium degree.

Dentifrices; breath freshening sprays.

32. The holder submits that its "*dentifrices; breath freshening sprays*" are used for oral hygiene and that such goods are not usually produced by the same undertakings as for the opponent's goods, and that they are dissimilar. Meanwhile, the opponent submits that the goods may be manufactured by the same undertakings, however, it

¹⁴ See paragraph 17 of the holder's written submissions dated 30 June 2022.

has provided no supporting evidence to demonstrate this. In *RALEIGH INTERNATIONAL Trade Mark* [2001] RPC 11, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person, observed that when goods (or services) are not identical or self-evidently similar, the opposition should be supported by evidence as to their similarity.¹⁵ I see nothing within the opposing specifications which immediately strikes me as being self-evidently similar, and therefore I consider that the goods are dissimilar.

Air fragrancing preparations.

33. These goods are designed to mask or remove unpleasant room odours and as such are different in nature, purpose and method of use to the opponent's earlier "*Hair care preparations*", including the specified hair products covered by the opponent's "458" mark. The goods are neither complementary to, nor in competition with, any of the earlier goods and although they are likely to be available from the same retail outlets, they would not be found side by side on supermarket shelves, or even in the same aisles. I find the competing goods to be dissimilar.

Contested goods in Class 21

Combs; cosmetic utensils.

34. The holder admits that the above goods could be used in conjunction with the earlier goods in Class 3, and as such, it submits that they are similar to a low degree. The opponent submits that the competing goods are highly similar, as they are usually sold in the same outlets and target the same public, and may all be manufactured by the same undertakings. To my mind, "*Combs; cosmetic utensils*" are different in nature, purpose and method of employ to the earlier Class 3 goods, although I agree that they may be used together. However, as Mr Daniel Alexander Q.C. (as he was then) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

¹⁵ Paragraph 20

“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.”¹⁶

While I acknowledge that there would be an overlap between the end users of the respective goods, 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.

Ceramics for household purposes; boxes for dispensing paper towels; soap boxes; nail brushes; toothbrushes; floss for dental purposes; fitted vanity cases; powder puffs; make-up removing appliances; make-up sponges; make-up brushes.

35. The opponent submits that the above listed applied-for goods are highly similar to its own goods in Class 3 for the same reasons that it gave for the similarity between its various hair preparations and the holder’s combs and cosmetic utensils, outlined above in paragraph 34. Moreover, it considers the competing goods to be complementary to each other. In my view, the holder’s “*Ceramics for household purposes; boxes for dispensing paper towels; soap boxes; nail brushes; toothbrushes; floss for dental purposes; fitted vanity cases; powder puffs; make-up removing appliances; make-up sponges; make-up brushes*” are even further removed from the earlier registered goods than combs and cosmetic utensils. As per the guidance in *Boston Scientific*, I do not consider the holder’s goods to be important to the earlier Class 3 goods to the degree that the average consumer would perceive them as emanating from the same undertaking. In the absence of evidence to the contrary, I find the goods to be dissimilar.

Contested services in Class 35

Presentation of goods on communication media, for retail purposes.

¹⁶ Paragraph 18.

36. In its submissions, the opponent submits that the holder's above services are not restricted in scope and therefore could include services relating to the earlier Class 3 goods, which the holder denies. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

37. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut.”

38. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*¹⁷, and *Assembled Investments (Proprietary) Ltd v. OHIM*¹⁸, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*¹⁹, Mr Hobbs concluded that:

¹⁷ Case C-411/13 P

¹⁸ Case T-105/05, at paragraphs [30] to [35] of the judgment.

¹⁹ Case C-398/07 P

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

39. It is clear from the case law that where the holder's retail related services are to be compared with the opponent's goods, those services will be different in nature, purpose and method of use to those goods. However, I am able to find similarity in respect of the goods and the services at issue, providing that there is some complementarity and/or shared trade channels. As mentioned earlier, the holder's "*Presentation of goods on communication media, for retail purposes*" does not specify the nature of the goods and as such, it is feasible that the services could include presentation of the opponent's various hair products covered under Class 3 of both its earlier marks. Taking the guidance set out above into account, I find the contested services to be similar to the opponent's Class 3 goods to a medium degree.

40. A degree of similarity between the goods and/or services is essential for there to be a finding of likelihood of confusion: *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

41. In relation to the goods and services which I have found to be dissimilar, as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods and services, with the opposition failing to that extent.

The average consumer and the nature of the purchasing act

42. 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”.²⁰

43. 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.

44. In its written submissions, the opponent submits that the average consumer of the goods and services at issue will predominantly be the general public, who will pay an average degree of attention to the purchase of the goods. Meanwhile, the holder submits that the average consumer, being members of the public, beauticians and/or hair salons, will pay a higher than medium degree of attention during the purchasing process.

45. In my view, the average consumer for the competing goods and services for which I found similarity will most likely be a member of the general public. I also accept that

²⁰ Paragraph 60

the average consumer of haircare and cosmetic products could also be a professional such as a hairdresser or a beautician.

46. The goods are sold through a range of channels including supermarkets, chemists, wholesalers and online. In retail and wholesale outlets, the goods will be displayed on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a web page. In these circumstances, visual considerations will dominate the process, however I do not discount the aural element as the consumer may seek advice from sales staff. Although the price of the goods can vary considerably, on balance it seems to me that the cost of the purchase is likely to be relatively low and the goods will be purchased reasonably frequently. The consumer will want to ensure that the products are suitable for them and meet their specific needs, particularly in the case of cosmetics and hair products in Class 3. Consequently, I find that the level of attention of the general public when selecting the goods/considering the presentation of such goods for retail purposes will be medium, while the professional is likely to pay a higher than average degree of attention to the selection process.

Comparison of marks

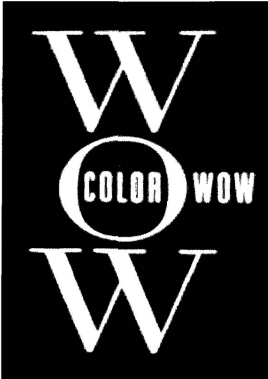
47. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference 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.”²¹

48. 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.

49. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade mark
<p data-bbox="204 786 427 819"><u>The “964” Mark</u></p> <p data-bbox="352 869 635 909">COLOR WOW</p>	<p data-bbox="842 1032 1353 1111">WOW COLOUR</p>
<p data-bbox="204 994 427 1028"><u>The “458” Mark</u></p> 	

50. The opponent submits that the holder’s mark and the earlier marks are visually and aurally highly similar, and are almost identical from a conceptual point of view.

51. The holder submits that visually, the contested mark and the “458” mark share a low level of similarity and are aurally similar to a medium degree, while it admits that the earlier “964” mark is visually, aurally and conceptually similar to the mark of the designation, although it does not specify to what degree.

²¹ Paragraph 34

Overall impression

52. The holder's mark consists of two words, the first word "WOW" is presented such that it gives the appearance that it has been handwritten in capital letters, and is immediately followed by the word "COLOUR" in capital letters in a slightly smaller standard typeface. The word "COLOUR" is allusive of goods such as lipsticks and cosmetics which either contain colour or are designed to add colour. For those goods, it is the word "WOW" which plays the greater role in the overall impression. For the remaining goods and services, due its stylisation, the word WOW makes a slightly greater contribution to the overall impression of the mark.

53. The opponent's "964" mark consists of two words, "COLOR WOW", presented in capital letters in a standard typeface, without any other elements to contribute to the overall impression. The overall impression conveyed by the mark therefore lies in the combination of these words. The word "COLOR" is allusive of *Hair care preparations* which are either for use on coloured hair or are designed as a colour treatment for the hair. Consequently, it is the word "WOW" which plays the greater role in the overall impression.

54. The opponent's "458" mark comprises the letters "W O W" presented in a white Roman typeface in upper case, with the letters positioned in the centre of a black rectangular background, with the letters and the rectangular shape running vertically from top to bottom. Inside the middle letter, being the letter "O", is the word "COLOR", which is presented in capitals in a much smaller, white standard typeface, and which runs horizontally from left to right within the confines of the letter "O". Positioned immediately to the right of the letter "O", but still within the black rectangular background, is the word "WOW", presented in the same white standard typeface and being the same size as the "COLOR" element, and which also runs horizontally from left to right. In my view, given its size and positioning, it is the vertical word "W O W" which has the most impact in the composite sign and plays the greatest role in the overall impression of the mark, with the smaller "COLOR WOW" elements playing a secondary role, although they would not go unnoticed. I consider the background to be a purely decorative element, designed to allow the white lettering to stand out, and

which does not add to the trade mark message conveyed by the words and does little to contribute to the overall impression of the mark.

Visual comparison

55. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case.

56. Both the earlier “964” mark and the holder’s mark contain the same two words, “COLOR/COLOUR” and “WOW”, albeit presented in reverse order in the holder’s mark as “WOW COLOUR” as opposed to the earlier “COLOR WOW”. Besides the word order, the typeface used for the word “WOW” and the additional letter “U” in the word “COLOUR” in the holder’s mark create visual differences between the contested mark and the earlier mark. It is my view that the differences between the marks would not be overlooked, however, given the unremarkable stylisation of the “WOW” element in the holder’s mark, overall, I consider the marks to be visually similar to at least a medium degree.

57. The earlier “458” mark contains the words “WOW” and “COLOR WOW” presented as described previously. As such, it encompasses the holder’s mark in its entirety, the variation in the spelling of the word “COLOUR” (COLOR) notwithstanding. However, besides the repetition of the word “WOW” in the earlier mark, being a point of disparity between the marks, it is the presentation of the marks at issue which create the biggest point of difference between them. To my mind, the vertical arrangement of the principle component “WOW” in the earlier mark makes for a greater visual impact in comparison to the horizontal presentation of the holder’s mark, and further serves to isolate any visual similarities between the contested marks. Considering the marks as a whole, I find there to be a low degree of visual similarity between them.

Aural comparison

58. Both the earlier “964” mark and the contested mark would be read as two separate words, “COLOR WOW” and “WOW COLOUR” respectively, clearly denoting phonetic

differences between the marks. However, there are also similarities, as the words COLOR/COLOUR and WOW would be pronounced identically in each of the respective marks, albeit in a different order in each, with both marks pronounced as three syllables, “CULL-UH-WOW” and “WOW-CULL-UH”. In my view, the marks are aurally similar to a medium degree.

59. I consider that some consumers would voice the earlier “458” mark in its entirety as four syllables, “WOW-CULL-UH-WOW”, while other consumers would only articulate the vertical “WOW” component as a single syllable. The contested mark will be pronounced in its entirety as three syllables, “WOW-CULL-UH”. I consider that in whichever way the earlier mark is pronounced, it is aurally similar to the holder’s mark to a medium degree.

Conceptual comparison

60. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]²².

61. The word “WOW”, which is common to all the competing marks, is an ordinary, dictionary defined word which would be recognised by the average consumer as an exclamation expressing surprise or admiration. As mentioned earlier in this decision, the word “COLOR”/“COLOUR”, which is also present in each of the marks, is allusive of goods such as hair products and cosmetics which either contain colour or are designed to add or enhance colour. I consider that the words “WOW” and “COLOR”/“COLOUR” in combination will be perceived by the average consumer as meaning that the colour element of those goods is particularly remarkable. In my view, the repetition of the word “WOW” in the “458” mark merely serves to reinforce the message of surprise or admiration. I therefore consider the marks to be conceptually identical. Even in relation to those goods or services for which the word “COLOR”/“COLOUR” is not allusive, the concept of surprise or admiration conveyed by the “WOW” component in the competing marks will still be construed identically.

²² Paragraph 56.

Distinctive character of the earlier marks

62. 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.

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

64. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up 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 made of it. The opponent claims that it has shown sufficient evidence of use of the EU designation of its International “964” mark and that consequently, the mark has acquired enhanced distinctive character through use.

65. Both earlier marks consist of the dictionary defined words “WOW” and “COLOR”, the “WOW” element being included twice in the “458” mark. I consider that the words in combination would be perceived as alluding to surprise at the remarkable results produced by the various hair products which are designed for use on coloured hair or as a colour treatment for the hair.

66. I note the holder’s submissions that it considers the “964” mark to comprise a descriptive word followed by a laudatory word and as such, it submits that it is only slightly higher than the threshold whereby the mark would be refused registration.²³ While I acknowledge the laudatory quality of the word “WOW”, the combination with the preceding word “COLOR” is slightly unusual, rendering the mark in its totality greater than the sum of all its parts. However, given the allusive quality of the mark, I consider it to be at the lower end of the range of distinctive character, although not of the very lowest degree.

67. In relation to the “458” mark, in making my assessment, I take into account the guidance given in the Common Practice Convergence document issued by the European Trade Mark and Designs Network (“Europeantmdn”) in relation to figurative marks containing non-distinctive words.²⁴ The stylisation of the mark cannot be ignored and lends an extra layer of distinctive character to the dictionary defined words contained within the composite mark, as does the repetition of the word “WOW”. I therefore consider the mark to be inherently distinctive to no more than a medium degree.

68. I now turn to the matter of enhanced distinctiveness. The opponent has filed evidence in support of the earlier marks relied upon. The territory relevant to the

²³ See paragraph 38 of the holder’s written submissions dated 30 June 2022.

²⁴ Common Communication on the Common Practice of Distinctiveness – Figurative Marks containing descriptive/non-distinctive words, 2 October 2015.

assessment of enhanced distinctiveness is the United Kingdom. I must now assess if that evidence demonstrates whether, at the date of designation for the contested mark, the earlier marks enjoyed an enhanced degree of distinctive character by virtue of the use made of them in relation to the UK market.

69. The holder submits that when the size of the British haircare market is taken into consideration, the sales of the opponent are insignificant and not sufficient to give the earlier marks an enhanced distinctive character.²⁵

70. I note that in the opponent's first witness statement, Mr Federici refers to Exhibit JF1 as a copy of a (redacted) witness statement filed by the opponent in separate proceedings, ("BUYWOW") which Mr Federici states shares identical issues with those in the proceedings before me. Accordingly, the associated (redacted) exhibits labelled JF9 – JF11 have also been included as part of the evidence.

71. In the first witness statement, Mr Federici states that use of the mark has taken place around the world and specifically within the UK, continuously and consistently since 2012 and throughout the relevant period in respect of a range of hair care preparations. I note that the second witness statement evidences use in the EU, rather than the UK, and as such, is not pertinent to the relevant territory for demonstrating enhanced distinctiveness through use.

72. Much of the evidence provided by way of the first witness statement relates to the "BUYWOW" statement and related exhibits. Mr Federici refers to the sales figures provided for the BUYWOW proceedings and adds additional sales figures for the year 2019, all of which I note are in US dollars (US\$), although they state that they refer to UK sales:

²⁵ See the holder's written submissions and the witness statement of Gareth Ian Price, both dated 30 June 2022, and the accompanying Exhibit GIP3.

UK Sales

14. The sales figures (taken from Federici's accounts) for COLOR WOW branded products in the UK during the Relevant Period are:-

YEAR	TOTAL UK SALES in US\$
2013	\$1,147,233
2014	\$2,971,895
2015	\$3,891,420
2016	\$2,765,585
2017	\$1,756,151
2018	\$4,398,779

UK Sales Figures

11) I refer to paragraphs 14 and 15 of the BUYWOW statement (attached as Exhibit JF1) and to the associated exhibits referred to therein. As the figures given in the BUYWOW statement end in 2018, I can additionally state the sales figures for the UK in 2019 are:

Year	Total UK Sales in US\$
2019	\$5,894,536

73. Mr Federici states that the opponent has sold hair care related merchandise such as hair brushes in the UK. As hairbrushes and the like are not relied upon in these proceedings, it is not clear from the above figures how much relates to the goods at issue and how much relates to the additional merchandise. I accept Mr Federici's explanation that although the invoices included in Exhibit JF3 do not explicitly refer to the COLOR WOW" mark, the relevant products are identified by the code CW, which he cross references with an example of the related code appearing on a corresponding product in exhibit JF4.

Invoice No 14137

Invoice Date 01/02/2016

FEDERICI BRANDS LTD

2 Uxbridge Street
London W8 7SY
VAT Reg: GB 905 9110 40

Invoice Address

Amazon EU SARL, UK Branch
60 Holborn Viaduct

London

EC1A 2FD

VAT # 727 2558 21

Payment Terms 90 DAYS AFTER INVOICE

Delivery Address

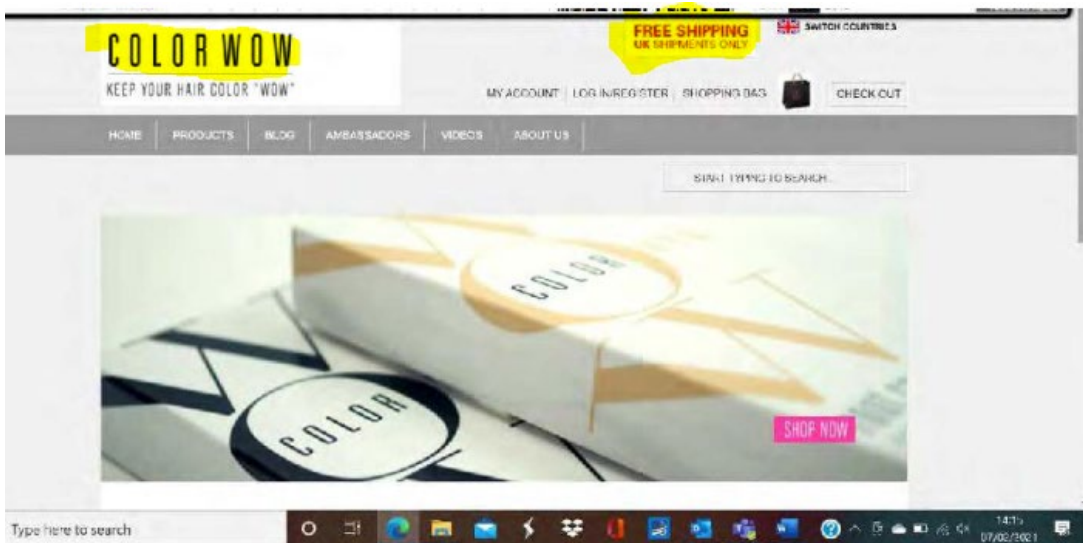
Amazon.co.uk Ltd [EUK5]
Phase Two, Kingston Park
Flaxley Road
Peterborough
Cambridge
PE2 9EN

Telephone

Invoice Currency £
Customer Code AMA001

Order Number 1003331	Customer Order Ref 3BZV8A9K	Quantity	Despatch Note 14112	Nett Price	Total
Part	Description				
CW513	POP & LOCK SHELLAC-55ML UPC 5060150185137	2	Per EA	38.50	77.04
CW521	MOUSSE-DARK 200ML UPC 5060150185212	2	Per EA	45.36	90.72
CW542	ROOT COVERUP-LT BROWN UPC 5060150185427	2	Per EA	157.74	313.44
CW543	ROOT COVERUP-MED BROWN	2	Per EA	315.68	626.88

74. The screenshots from the various exhibits show both the words “COLOR WOW” in a slightly stylised form, and variants of the “458” mark, as shown below, although I acknowledge that due to the size/quality of the images, the wording is not particularly clear:





★★★★★ 605 Reviews

ROOT COVER UP



I note that many of the screenshots have been provided via the wayback machine and are dated within the relevant period.

75. The advertising spend is set out in a table within the BUYWOW statement (Exhibit JF1) with the additional figures for the year 2019 included in the first witness statement:

20. Below is a table setting out Federick's marketing spend (PR and advertising) in the UK between 2013 and 2018

YEAR	MARKETING SPEND
2013	£134,246.81
2014	£247,396.06
2015	£405,072.96
2016	£424,404.76
2017	£328,071.18
2018	£482,777.23

13) I refer to paragraphs 16 to 21 of the BUYWOW statement (attached as Exhibit JF1) and to the associated exhibits referred to therein. As the figures given in the BUYWOW statement end in 2018 I can additionally state that the advertising figures for the UK in 2019 are:

Year	Total UK Advertising/Marketing Spend in GBP	14
2019	681,006.80	

The figures are shown in relation to Federici as the company, rather than giving a breakdown of the advertising spend for the relevant brand, although I acknowledge the examples of the PR reports for the UK showing promotional and marketing activity included at Exhibit JF6, which include outlets such as Telegraph.co.uk, Harpersbazaar.co.uk and Prima.co.uk .

76. It is clear that the marks (and variations thereof, which I do not consider affect the distinctive character of the marks as registered) have been used as trade marks on various haircare preparations in the UK during the relevant period. Although the figures have not been broken down and are said to include goods such as hairbrushes, in Mr Federici's witness statement and the accompanying exhibits, it is clear that the core products to which the marks relate are hair care preparations. I consider that the opponent has done enough to show the volume of sales by cross referencing the product codes with those shown on the invoices. While I only have the submissions of the holder in relation to the opponent's market share in what I would consider to be a saturated market, the UK sales figures and advertising spend are not insignificant. Overall, I consider that the marks have been enhanced through use in the UK by a modest degree only.

Likelihood of confusion

77. There is no simple formula for determining whether there is a likelihood of confusion. It is clear 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 services and vice versa (*Canon* at [17]). 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]).

78. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), 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).”

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

80. Earlier in this decision, I considered the average consumer of the goods and services for which I found identity/similarity to be the general public who would pay a medium degree of attention during the predominantly visual selection of the goods and services. I also considered the professional buyer within the hair and beauty industry, where I found the level of attention paid during the selection process would be higher than average. For both groups of consumer, I found that visual considerations would dominate the process, however I did not discount the aural considerations.

81. In relation to the earlier “964” mark, I found it to be visually similar to at least a medium degree to the holder’s mark, aurally similar to a medium degree, and conceptually identical. In relation to the earlier “458” mark, I found it to be visually similar to the holder’s mark to a low degree, aurally similar to a medium degree, and conceptually identical

82. Overall, I considered the degree of inherent distinctive character of the earlier “964” to be at the lower end of the range but not of the lowest degree, and I considered the “458” mark to be inherently distinctive to no more than a medium degree. I found that both marks have been enhanced through use in the UK during the relevant period by a modest degree only.

83. The holder has filed evidence through the witness statement of Gareth Ian Price and attached exhibits to support its submissions regarding the market share of the opponent within the haircare products industry and the co-existence of goods branded

“WOW” in the UK. Exhibit GIP4 largely comprises examples of hair products by different undertakings marked “WOW”, although I note that details of actual UK trade mark registrations have not been cited. However, this has no bearing on my assessment. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71).”

84. I have weighed up each of the competing factors in my decision, not least the differences as well as the similarities between the competing marks, including the degree of visual and aural similarity between them, as well as the conceptual identity as determined above, all of which play a part. Bearing in mind the principle of imperfect recollection, I consider the differences between the contested designation and the earlier “964” mark to be insufficient to avoid them being mistakenly recalled as each other, in spite of the low degree of distinctive character of the earlier mark, which has been enhanced through use by only a modest degree. In my view, the average consumer would be likely to recall the separate words “WOW” and “COLOR/COLOUR”, but be less certain about the order of those words, or notice/recall the stylisation of the “WOW” component in the holder’s mark or the different spelling of the word “COLOR”/“COLOUR”. Overall, I find that there is a likelihood of direct confusion between the marks for those goods and services for which I found there to be similarity/identity.

85. While allowing 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, given the low degree of visual similarity between the holder's mark and the earlier "458" mark, particularly as I found that visual considerations would predominate during the purchasing process, I consider it unlikely that they would mistake one mark for the other. To my mind, realistically, any likelihood of direct confusion between the marks is negligible.

86. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion.

87. 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.

88. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

89. Keeping in mind the global assessment of the competing factors in my decision, it is my view that while consumers will notice the differences between the contested mark and the earlier “458” mark, they will conclude that they are attributable to a variant brand from the same, or economically connected, undertakings or that the differences are logical and consistent with a brand extension. Consequently, I consider there to be a likelihood of indirect confusion in relation to those goods and services for which I found there to be similarity/identity.

90. To recap, I have found there to be a likelihood of direct confusion between the contested designation and the earlier “964” mark, and a likelihood of indirect confusion between the holder’s mark and the earlier “458” mark.

91. The opposition under section 5(2)(b) succeeds in respect of the following goods and services only:

Class 3

Facial cleansers; hand lotions; essential oils; lipsticks; beauty masks; nail polish; false eyelashes; cosmetics; cosmetic pencils; perfumes; eyebrow pencils; mascara; nail art stickers; sunscreen creams; make-up remover.

Class 21

Combs; cosmetic utensils.

Class 35

Presentation of goods on communication media, for retail purposes

92. The opposition fails in respect of the remaining goods and services.

CONCLUSION

93. The holder has been partially successful. The IR will be refused protection for the goods and services listed above under paragraph 89, however, subject to any successful appeal, the IR will be granted protection in the UK in respect of the following goods only:

Class 3

Dentifrices; breath freshening sprays; air fragrancing preparations.

Class 21

Ceramics for household purposes; boxes for dispensing paper towels; soap boxes; nail brushes; toothbrushes; floss for dental purposes; fitted vanity cases; powder puffs; make-up removing appliances; make-up sponges; make-up brushes.

COSTS

94. Both parties have enjoyed a share of success, with the greater part going to the opponent, who is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2016. I have made a reduction to the costs to reflect the partial extent of the success. I note that during the case management conference held on 4 August 2021, the Hearing Officer agreed to the opponent’s request that the section 5(3) ground be deleted, and the opponent acknowledged that the removal of a ground at that stage of the proceedings could have implications on any cost award.²⁶ Accordingly, I have reflected this in my calculations. Applying the guidance in the TPN, I award the opponent the sum of £800, which is calculated as follows:

Official fee (for opposition under Section 5(2)(b) only):	£100
Preparing a statement and considering the counterstatement:	£200
Filing evidence and written submissions:	£500
Total:	£800

95. I therefore order WOW COLOUR (GUANGDONG) TECHNOLOGY CO., LTD to pay Federici Brands LLC the sum of £800. The above sum should be paid within

²⁶ See official letter sent from the Registry, copied to both parties, dated 05 August 2021.

twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 14th day of June 2023

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