

O/0683/25

TRADE MARKS ACT 1994

IN THE MATTER OF  
INTERNATIONAL TRADE MARK REGISTRATION NO. 1743984  
BY VIVA BRANDS UG (HAFTUNGSBESCHRÄNKT)  
TO REGISTER IN THE UK AS A TRADE MARK:

# Viva Maia

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600003185  
BY VIVA AESTHETICS LIMITED.

## **BACKGROUND AND PLEADINGS**

1. On 08 May 2023, VIVA BRANDS UG (HAFTUNGSBESCHRÄNKT) (“the Applicant”) applied for protection in the UK of the trade mark displayed on the cover page of this decision, under number WO0000001743984 (“the application”). It was accepted and published in the Trade Marks Journal on 27 October 2023 in respect of the following goods:

Class 3: Toiletries; cleaning and fragancing preparations, not for personal use; essential oils and aromatic extracts; animal grooming preparations.

2. On 26 January 2024, the application was opposed by VIVA AESTHETICS LIMITED (“the Opponent”) by way of the fast track opposition procedure. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods specified in the application.
3. The Opponent relies upon the following two trade marks:

1. 

UK Trade Mark registration number UK00003506891

Filing date: 01 July 2020

Registration date: 23 October 2020

Relying on the following goods only:

Class 3: Cleaning and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices; non-medicated preparations for the care of the

skin; skin care preparations; skin creams; skin creams for use on the face and hands; skin lotions; cleansing milks and creams; cleansing preparations for the skin; cosmetic preparations for skin care; moisturisers; essences for skin care; creams for firming or toning the skin; skin lotions; soaps; cosmetics; cosmeceuticals; cosmetic preparations.



UK Trade Mark registration number UK0000 3705113

Filing date: 30 September 2021

Registration date: 28 October 2022

Relying on the following goods only:

Class 3: Cleaning and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices; non-medicated preparations for the care of the skin; skin care preparations; skin creams; skin creams for use on the face and hands; skin lotions; cleansing milks and creams; cleansing preparations for the skin; cosmetic preparations for skin care; moisturisers; essences for skin care; creams for firming or toning the skin; skin lotions; soaps; cosmetics; cosmeceuticals; cosmetic preparations.

4. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of section 6 of the Act. However, as neither had been protected for five years or more at the filing date of the application, they are not subject to the use requirements specified within Section 6A of the Act.

5. In its Form TM7F notice of opposition, the Opponent submits that the Applicant's mark is similar to its marks and has been applied for in respect of similar goods to those covered by the earlier registrations.
6. The Applicant filed a counterstatement submitting that there are sufficient visual, aural and conceptual differences between the marks to be considered dissimilar. The Applicant concedes that some of the contested goods in class 3 of the application, namely 'Toiletries; cleaning and fragrancings preparations, not for personal use; essential oils and aromatic extracts' are similar to the Opponent's goods, however, it contends that 'animal grooming preparations' are dissimilar.
7. The Opponent is represented by Briffa, and the Applicant is represented by Lewis Silkin LLP. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary, and no submissions in lieu were filed by either party. I make this decision having taken full account of all the papers, referring to them as necessary.

### **RELEVANCE OF EU LAW**

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **PRELIMINARY ISSUE**

9. On 23 July 2024 the Tribunal received a request via email from the Applicant to withdraw the International Registration with immediate effect. On 27 July 2024 the Tribunal sent a letter in response explaining that the International Registration cannot be withdrawn through the UKIPO and that the relevant form (MM7 – Record a renunciation) must be filed directly to WIPO to do so. Further, on the 26<sup>th</sup> of September 2024 and again on 07 March 2025, the Tribunal wrote to the Applicant asking it to confirm that the relevant form had been filed at WIPO, however no response to either correspondence was received. The Tribunal has not received any notification from WIPO regarding the withdrawal of the International Registration and therefore the opposition will proceed.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

10. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

[...]

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

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

11. Section 5A of the Act states as follows:

“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.”

12. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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 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**

13. Section 60A of the Act provides:

“(1) For the purpose 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.”

14. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

15. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut

for 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.”

18. It is noted that the Opponent’s goods relied upon in both of its earlier registrations are identical.

19. The goods to be compared are:

The Opponent’s goods	The Applicant’s goods
<p><b>Class 3</b>            Cleaning and abrasive preparations; non-medicated soaps; perfumery, essential oils, non-medicated cosmetics, non-medicated hair lotions; non-medicated dentifrices; non-medicated preparations for the care of the skin; skin care preparations; skin creams; skin creams for use on the face and hands; skin lotions; cleansing milks and creams; cleansing preparations for the skin; cosmetic preparations for skin care; moisturisers; essences for skin care; creams for firming or toning the skin; skin lotions; soaps; cosmetics; cosmeceuticals; cosmetic preparations.</p>	<p><b>Class 3</b>            Toiletries; cleaning and fragrancng preparations, not for personal use; essential oils and aromatic extracts; animal grooming preparations.</p>

20. The Opponent submits that the goods ‘Toiletries, essential oils and aromatic extracts’ in the application are identical to the goods contained within its earlier

registrations. Additionally, it contends that the remaining goods “cleaning and fragrancing preparations, not for personal use, animal grooming preparations’ are similar in association to the goods contained within the earlier registrations, stating that it is reasonable to believe that the average UK consumer would think there is a connection between the Applicant’s mark and its marks.

21. As stated above, the Applicant concedes that some of the contested goods in class 3 of the application, namely ‘Toiletries; cleaning and fragrancing preparations, not for personal use; essential oils and aromatic extracts’ are similar to the Opponent’s goods, though it does not say to what extent. On the other hand, the Applicant disagrees that its ‘animal grooming preparations’ are similar in any way to the Opponent’s goods.

#### *Toiletries*

22. I consider the Applicant’s term above broad enough to cover the Opponent’s goods. It is my view that the opponent’s terms would be included in the more general category contained within the Applicant’s specification. The Opponent’s goods are all types of toiletries and therefore, bearing in mind the principles of *Meric*, are considered identical.

#### *Cleaning and fragrancing preparations, not for personal use*

23. It is self-evident that both the application and the earlier marks include ‘cleaning preparations’ and therefore they are identical. I also consider the Applicant’s ‘fragrancing preparations, not for personal use’ broad enough to cover the Opponent’s ‘perfumery’ goods which are not limited to substances for use on the human body, the term perfume being defined (Collins online dictionary) as “1. a mixture of alcohol and fragrant essential oils extracted from flowers, spices, etc, or made synthetically, used esp to impart a pleasant long-lasting scent to the body, stationery etc.” It is my view that the opponent’s terms would be included in the more general category contained within the Applicant’s specification. Therefore, bearing in mind the principles of *Meric*, these goods are also considered identical.

### *Essential oils and aromatic extracts*

24. Again, it is self-evident that both the application and the earlier marks include 'essential oils' and therefore they are identical. I consider the Applicant's 'aromatic extracts' against the Opponent's 'essential oils.' Both sets of goods share the same nature and purpose, with both being liquids extracted from plants used for their scents in goods such as perfume. They also share the same users as both are typically used in the fragrance industry. Additionally, I consider that there is an element of competition between the goods due to the shared use. Essential oils are typically more concentrated than aromatic extracts however they serve the same purpose i.e., to fragrance. As a result, the consumer may choose one over the other depending on the strength of scent they wish to impart. There is also, therefore, an overlap in trade channels. Consequently, I find these goods to be highly similar.

### *Animal grooming preparations.*

25. The Opponent's specification includes the term 'perfumery' which, as I have found above at paragraph 23, covers goods that are not limited to use on the human body, including, for example, perfume for laundry purposes, perfumes for cardboard, and room perfumes. The goods could therefore plausibly include perfumery goods for animals, for example, perfumes used in animal grooming which itself would be caught by the broad nature of the Applicant's term animal grooming preparations. Consequently, and bearing in mind the principles of *Meric*, I find these goods to be identical.

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

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. 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 (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

27. 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:

“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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

28. I have no submissions from the Applicant on the identity of the average consumer. The Opponent, on the other hand, submits that given the goods at issue, the average consumer is likely to be a member of the general public who will display no more than an average level of attention when purchasing the goods.
29. I too consider that the average consumer of the respective goods will be the general public who use the products, however I also consider it to include business professionals working in the beauty or perfumery sector, for example, those running beauty salons and beauticians, as well as those who produce perfume and fragrances. The goods will be selected in varying degrees of frequency and the costs of the same will vary depending on the product. The selection process will involve mainly visual considerations, with consumers being exposed to the marks in-store in retail outlets, online, or via advertising. There is also the potential for aural considerations to be relevant on the basis of verbal recommendations or requests made to staff. Considerations such as

cost, ingredients, suitability, quality and reputation will be taken into account when purchasing the goods. I consider that the average consumer is likely to pay a medium level of attention to the goods in issue, for both members of the general public and professionals.

### **Comparison of trade marks**



30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 judgement in Case C-591/12P, *Bimbo SA v OHIM*, 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”.

31. 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 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 trade marks.

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

<b>The Applicant's mark</b>	<b>The Opponent's marks</b>
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<h1>Viva Maia</h1>	<p data-bbox="815 342 970 416">Mark 1 (891 mark)</p>  <p data-bbox="815 674 970 748">Mark 2 (113 mark)</p> 
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33. The Opponent submits that the marks are visually highly similar. They state that visually all of the marks incorporate the identical word 'VIVA' with the only differences being the addition of the words 'SKIN CLINICS' in its second mark, and the addition of the word 'MAIA' in the Applicant's mark. The Opponent also submits that phonetically the marks are similar to a high degree. They state that both the earlier marks and the application are dominated by the 'VIVA' element which has a strong and striking sound pattern. Additionally, the Opponent submits that the Applicant's mark ends with the sound "-A" which is the same as the way the end of its marks are pronounced. Finally, the Opponent submits that conceptually the marks are similar to a very high degree. They state that the marks incorporate the identical dominant word 'VIVA' and would therefore be perceived by the general public as having identical meanings. Further, they submit that the word 'VIVA' is a distinctive word derived from Spanish and Italian and it is unlikely to be commonly known to the average UK consumer. Consequently, they argue that if shown these marks side by side it would be reasonable to expect the average UK consumer to assume that they have the same or substantially similar conceptual meaning.

34. The Applicant submits that visually its mark consists of the two words 'Viva Maia' whereas the Opponent's marks consist of the stylised word 'VIVA' and 'VIVA SKIN CLINICS'. They state that the addition of the word 'Maia' creates a striking difference between the marks. Next, the Applicant submits that the word element 'VIVA' will be pronounced identically in all of the marks, however the addition of the word 'Maia' in its mark again creates a clear aural difference. Finally, the Applicant agrees with the Opponent that the word 'VIVA' is derived from Spanish and Italian, however submits that this is unlikely to be perceived by the average UK consumer. Further, that the word 'Maia' is unlikely to be perceived as having any particular meaning. Consequently, the Applicant contends that the average UK consumer would not immediately grasp any conceptual message in relation to either of the Opponent's marks, nor its mark, and therefore there is no conceptual similarity.
35. I have considered the two marks relied upon by the Opponent and will base the comparison on its 891 mark (Mark 1). The Opponent's two registrations both contain the exact same specification, and it is my view that the 113 mark (Mark 2), with the additional non-distinctive words 'SKIN CLINICS' is less similar overall to the Applicant's mark. Consequently, its case is no better under this mark.

### **Overall Impression**

36. The Applicant's mark consists of the words 'Viva Maia'. There are no other elements in the mark to contribute to its overall impression, which lies in the words themselves. I consider the words to be co-dominant, distinctive elements, with both contributing equally to the overall impression of the mark. The Opponent's 891 mark consists of the stylised word VIVA. I find that the word element of the mark is the dominant and distinctive element, and that the simple stylisation will be viewed merely as a decorative feature that has little impact on the overall impression of the mark.

### **Visual Comparison**

37. The element that overlaps in the marks is the word 'VIVA', albeit in a different font and case. The Applicant's mark contains the additional word 'Maia' which is not present in the Opponent's mark. Bearing in mind the overall impression of the marks, I find there to be no more than a medium degree of visual similarity.

### **Aural Comparison**

38. Aurally, the word 'VIVA' contains two syllables and will be identically articulated in both the Opponent's and the Applicant's marks. As for the word 'Maia' in the Applicant's mark, this will be pronounced as two syllables (MY-UH). The word VIVA is the only verbal element present in the Opponent's 891 mark. The stylistic elements the Opponent's mark will not be articulated. Consequently, and bearing in mind the overall impression of the marks, I find that the marks are aurally similar to a medium degree.

### **Conceptual Comparison**

39. Conceptually, the word 'VIVA' may be understood by a small proportion of the average consumer as a word to express support or approval as per its dictionary definition.<sup>1</sup> On the other hand, I find it more likely that a significant proportion of the average consumer will perceive the word as familiar, but with no instant meaning, i.e., they may have encountered the word before but will not attribute an immediate meaning to it. It is therefore likely to be perceived as an invented word, or word in a foreign language. Consequently, I consider the Opponent's 891 mark conveys no immediately identifiable concept. The word 'Maia' in the Applicant's mark will likely again be attributed no meaning and would instead be perceived as a made-up word or word in a foreign language. The Applicant's mark as a whole therefore conveys no identifiable concept. Bearing in mind the overall impression of the marks I find the marks to be conceptually neutral.

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<sup>1</sup> <https://dictionary.cambridge.org/dictionary/english/viva>

## **Distinctive character of the opponent's mark**

40. 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).”

41. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced

degree of distinctiveness and has not filed any evidence to that effect. As such, I have only the inherent position to consider.

42. The Opponent submits that the word 'VIVA' is the dominant distinctive element of both of its marks'. The Applicant, on the other hand, contends that the word 'VIVA' is in common use among a substantial number of undertakings, and therefore possesses such low levels of distinctiveness that the average consumer will be accustomed to distinguishing between trade marks that coincide in the word 'VIVA'.
43. The Opponent's 891 mark consists of the stylised word 'VIVA' which is likely to be perceived as an invented word or word in a foreign language. However, as stated above, it is my view that whilst the word may be perceived in this way, it may still be familiar to the average consumer without them attributing any meaning to it. The word VIVA is not descriptive or allusive of the goods concerned. The stylisation of the word adds very little to the overall distinctiveness of the mark. As a result, I find the 891 mark to possess a medium to high degree of distinctive character.

### **Likelihood of confusion**

44. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.
45. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e., 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 (see *Canon*, C-39/97, para 17). It is

necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

46. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.
47. Throughout the course of this decision, I have determined that:
  - The respective goods range from being highly similar to identical.
  - The average consumers are members of the general public and professionals in the beauty and perfumery industries who will demonstrate a medium level of attention during the purchasing process.
  - The purchasing process for the goods will be primarily visual in nature, though aural considerations have not been excluded.
  - The opponent's marks possess a medium to high degree of inherent distinctive character.
  - The marks at issue are visually similar to no more than a medium degree. The marks are aurally similar to a medium degree. The marks are conceptually neutral.

48. I acknowledge that both marks contain the identical word 'VIVA' at their beginnings, a position where the attention of consumers is usually directed.<sup>2</sup> However, the marks differ in that the contested mark contains the additional word "Maia". Although the marks overlap in the shared word 'VIVA', the additional word in the applicant's mark creates a difference that is unlikely to be overlooked. Therefore, despite some overlap created by the commonality of the word 'VIVA', in my view, this will be outweighed by the differences. Consequently, it is unlikely that the competing marks will be mistaken or misremembered for one another. Rather, the aforementioned differences are likely to be sufficient to enable consumers to differentiate between them. In my judgement, taking all the above factors into account, the differences between the competing trade marks are likely to enable consumers, even those paying a medium level of attention, to avoid mistaking the marks for one another, notwithstanding the principles of imperfect recollection and interdependency. As a result, I find that there is no likelihood of direct confusion, even in relation to goods that are identical.

49. I turn now to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., 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 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

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<sup>2</sup> While it is a general rule that beginnings of marks have more of an impact (see *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02), it is not always the case (see *CureVac GmbH v OHIM*, T-80/08)

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.).

(a) 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)".

50. 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, 16 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.

51. As highlighted above, Mr Purvis Q.C. in *L.A Sugar* sets out that there are three main categories of indirect confusion, and that indirect confusion ‘tends’ to fall in one of them.
52. In this instance, I consider the word ‘VIVA’ to be inherently distinctive, possessing a medium to high degree of distinctiveness. It has no relationship to the goods concerned and would be perceived by the relevant consumer as an invented or foreign word with no immediately discernible meaning. It is therefore considered that the shared use of ‘VIVA’ would not be perceived as a mere coincidence by the relevant consumer, but instead would assume there is an economical connection between the marks, even though the additional element of the Applicant’s mark (Maia) is, of itself, distinctive. This is even more the case where the goods are highly similar or identical. Further, I also remind myself that I have found the two elements in the Applicant’s mark to be co-dominant, with the word ‘Viva’ retaining an independent distinctive role.<sup>3</sup> Consequently, I find there to be a likelihood of indirect confusion.

## Conclusion

53. The opposition under Section 5(2)(b) of the Act has succeeded in full. Subject to any successful appeal, the application will be refused for all of the goods concerned.

## Costs

54. The Opponent has been successful these proceedings and is entitled to a contribution towards its costs. The relevant Tribunal Practice Notice for these proceedings is TPN 1/2023, which states that costs in an opposition brought under the fast-track procedure are capped at £600 (excluding official fees). Accordingly, I award costs to the Applicant on the following basis:

Official Fee	£100
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<sup>3</sup> *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

Preparing the notice of opposition and Considering the counterstatement	£250
Total	£350

55. I therefore order **VIVA BRANDS UG (HAFTUNGSBESCHRÄNKT)** to pay **VIVA AESTHETICS LIMITED** the sum of £350. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of July 2025**

**Oliver Rose'Meyer**  
**For the Registrar**