

**o/0830/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. WO1636469**

**BY BEAUTY STORY**

**TO REGISTER THE TRADE MARK:**

**Voilà**

**IN CLASSES 3, 5, 18, 21 & 35**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 434061**

**BY COSATTO SPA**

## BACKGROUND AND PLEADINGS

1. International trade mark no.1636469 ('the contested mark') shown on the cover page of this decision was registered by BEAUTY STORY ('the holder') in France with effect from 17 May 2021. The holder designated the UK as a territory in which it seeks to protect the contested mark under the terms of the Protocol to the Madrid Agreement on the same date. The mark claims a priority date of 23 November 2020. The holder seeks protection for the following goods and services:

Class 3: Potpourris [fragrances]; incense; sun-tanning and after-sun creams; mucous membrane care creams; wipes impregnated with cleansing lotions for mucous membranes; massage creams not for medical use; hair-removing products; depilatory wax; shaving products, after-shave lotions; mouth care products (not for medical use); dentifrices; dental bleaching gels; creams for leather; shoe polish.

Class 5: Disinfectant soaps; diapers of paper or cellulose (disposable).

Class 18: Vanity cases (not fitted)

Class 21: Toilet utensils; toilet utensils or cases; scouring pads; soap holders; feather dusters; toilet brushes; brush-making materials; animal bristles [brushware]; toilet sponges; cotton waste for cleaning; electric and non-electric toothbrushes; dental floss; heads for electric toothbrushes; dental water jets; toothbrush cases; shaving brushes; shaving brush holders.

Class 35: Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of sale of toilet soaps, disinfectant soaps, toilet waters, toilet oils, toilet talc, creams for the care of mucous membranes, creams and lotions for intimate hygiene, wipes for intimate hygiene, wipes impregnated with cleansing lotions for mucous membranes, massage creams not for medical use, aftershave lotions, scented potpourri, pet shampoos, mouth care products

[not for medical use], depilatory products, depilatory wax, vanity cases, incense, products for perfuming laundry, toothpastes, tooth whitening gels, bleaching preparations and other substances for laundry use, cleaning, polishing, degreasing and abrasive preparations, leather creams, shoe polishes, diaries, calendars, posters, photographs, shopping vouchers, promotional vouchers, payment gift vouchers, payment gift cards, gift vouchers, including those for advertising or commercial purposes, discount vouchers, vouchers to be used towards the purchase of products or services, vouchers to be exchanged for products or services, discount coupons, promotional coupons, promotional codes [printed], greeting cards, identification cards [non-magnetic], promotional cards, loyalty cards, subscription cards, paper and cardboard [raw, semi-finished or for stationery or printing], cardboard, paper or plastic boxes and cases, including boxes and cases used as gift cases, bags, pouches, envelopes, wallets, boxes and foil, of paper, paperboard or plastics, wrapping paper and paperboard, packaging and wrapping for gift boxes, packages and bottles, of paperboard, paper or plastics, paperboard packages, paper cones, binders and articles for binders, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paintbrushes, typewriters and office supplies [except furniture], typefaces, printing blocks, writing implements, engraved or lithographed works of art, paintings, framed or unframed, watercolors, sewing patterns, drawings, drawing implements, paper handkerchiefs, paper towels, paper table linen, toilet paper, hat boxes, signs [paper or cardboard], non-fabric labels, flags [paper or cardboard], pennants [paper or cardboard], badges [paper stamps], decals, cardboard or paper boxes, posters, paper or cellulose nappies [disposable], electric or non-electric pencil sharpeners, stencils, paper towels, paper wipes for make-up removal, paper cutters, bibs, handkerchiefs and paper table linen, drawing pins, address books, cleaning pads, soap dishes, feather dusters, toilet brushes, brushing materials, electric and non-electric toothbrushes, dental floss, animal bristles [brushes and brushes], toilet sponges, cotton waste for cleaning, shaving brushes, shaving brush holders, bottles, tea infusers, electric toothbrush heads, mouth showers, insulated bags, money boxes, mugs, cups, glasses [receptacles], toothbrush cases; advertising services; demonstration of goods; sales promotion (for third parties); procurement services for third parties

(purchasing goods and services for other businesses); newspaper subscription services (for third parties); dissemination of advertisements; dissemination of advertising material (leaflets, prospectuses, printed matter, samples); business management assistance; postal, radio and television advertising; presentation of goods on all communication media, for retail purposes; accounting; document reproduction; employment agencies; computer file management; organization of exhibitions for commercial or advertising purposes; online advertising on a computer network; rental of advertising time on all communication media; publication of advertising texts; rental of advertising space.

2. The request to protect the contested mark was published on 8 April 2022. On 8 June 2022, COSATTO SPA ('the opponent') opposed the protection of the contested mark in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is aimed at the following goods and services:

Class 3: Sun-tanning and after-sun creams; mucous membrane care creams; wipes impregnated with cleansing lotions for mucous membranes; massage creams not for medical use; hair-removing products; depilatory wax; shaving products, after-shave lotions; mouth care products (not for medical use); dentifrices; dental bleaching gels.

Class 5: Disinfectant soaps; diapers of paper or cellulose (disposable).

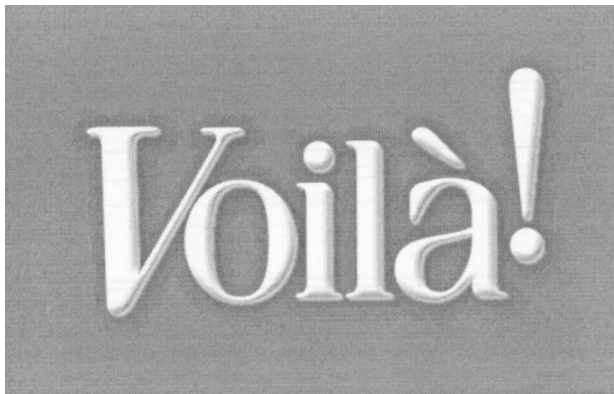
Class 21: Toilet utensils; toilet utensils or cases; scouring pads; soap holders; feather dusters; toilet brushes; brush-making materials; animal bristles [brushware]; toilet sponges; cotton waste for cleaning; electric and non-electric toothbrushes; dental floss; heads for electric toothbrushes; dental water jets; toothbrush cases; shaving brushes; shaving brush holders.

Class 35 Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of sale of toilet soaps, disinfectant soaps, toilet waters, toilet oils, toilet talc, creams for the care of mucous membranes, creams and

lotions for intimate hygiene, wipes for intimate hygiene, wipes impregnated with cleansing lotions for mucous membranes, massage creams not for medical use, aftershave lotions, pet shampoos, mouth care products [not for medical use], depilatory products, depilatory wax, vanity cases, toothpastes, tooth whitening gels, bleaching preparations and other substances for laundry use, cleaning, polishing, degreasing and abrasive preparations, cleaning pads, soap dishes, feather dusters, toilet brushes, brushing materials, electric and non-electric toothbrushes, dental floss, animal bristles [brushes and brushes], toilet sponges, cotton waste for cleaning, shaving brushes, shaving brush holders, bottles, tea infusers, electric toothbrush heads, mouth showers, money boxes, mugs, cups, glasses [receptacles], toothbrush cases;

3. The opponent relies on the following trade mark:

UK800889935



Filing date: 22 July 2005

Registration date: 02 July 2007

Relying upon some of the goods for which the earlier mark is protected, as follows:

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

4. The opponent claims that the marks are highly similar. They also claim that the goods and services at issue are identical or similar and this leads to a likelihood of confusion on the part of the relevant public.

5. The holder filed a counterstatement in which it denies that there is a likelihood of confusion. It does admit that the marks are similar but denies similarity of the goods and services and puts the opponent to proof of use of their mark.

6. The holder is represented by Ladas & Parry LLP and the opponent is represented by Keltie LLP.

7. The opponent filed evidence. Neither party requested a hearing nor provided submissions in lieu. This decision is therefore taken following careful consideration of the papers.

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.

## **Evidence**

9. The opponent's evidence consists of a witness statement dated 24 March 2023 by Nicola Cosatto who is the Managing Director of Cosatto Spa. This was accompanied

by six exhibits and the main purpose of the evidence is to provide proof of use of the opponent's mark.

10. I have read and considered the evidence and will refer to the relevant parts at the appropriate points in the decision.

## **DECISION**

11. Section 5(2)(b) is being relied upon and is 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”.

12. Section 5A of the Act is as follows:

“5A 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.”

13. 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 registered trade mark or international trade mark (UK) 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,

14. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. The earlier mark is subject to proof of use requirements as it has been registered for five years or more before the priority date of the contested mark, as per section 6A of the Act.

### **Proof of use**

15. I will begin by assessing whether there has been genuine use of the earlier registration.

16. Section 6A:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

(5)-(5A) [Repealed]

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

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

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

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

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

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

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

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

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

18. Section 100 of the Act states that:

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

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the priority date of the contested mark i.e. 24 November 2015 to 23 November 2020. This is a comparable mark and so, in accordance with paragraph 7(3) of Part 1 of Schedule 2A of the Act, the assessment of use shall take into account any use of the corresponding EUTM prior to IP Completion Day, being 31 December 2020.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax*

*Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is

genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

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

## Evidence

21. The witness statement from Nicola Cosatto states that the opponent has been making household products since 1932, starting with clothing pegs. They state that the product range expanded in the 1990’s to include storage solutions and home fragrance products.

22. The witness statement explains that the opponent’s product range consists of three main product lines: washing and cleaning products, storage solutions and home fragrance products.

23. Exhibit NC1 is a printout of the “About Us” page from the opponent’s website.

24. Exhibit NC2 is a screenshot of the homepage of the opponent’s website and shows the earlier mark on some of the products/packaging. The mark is shown as follows:



25. Exhibit NC3 are archive printouts from the opponent's website between 2015 and 2020. The mark is shown as follows on every screenshot:



26. The opponent provided sample invoices in Exhibit NC4. The opponent indicated that the goods sold under the earlier mark contain the letters 'VL' in the product code. I have extracted the following information from the invoices (I have only extracted information on the items shown if it is obvious what the goods are or if I can cross reference with the product catalogue in Exhibit NC6, any information that I cannot cross-reference or is not readily obvious has been left out):

<b>Date</b>	<b>Address</b>	<b>Item(s)</b>	<b>Unit Price (Euros)</b>	<b>Quantities</b>
28/4/2016	Banbury, UK	Medium storage box	4.66	108
		Large storage box	6.32	108

5/9/2017	Germany	Wooden clothes hangers	2.635	12
		Wooden trouser hangers [unclear]	1.774	12
		Vacuum storage bag	2.606	12
		Vacuum storage bag	2.281	12
		Vacuum storage bag	2.142	12
		Jacket storage bag	1.368	12
		Fabric box	3.023	12
		Blanket storage box	1.617	12
		Travel pochette	1.608	12
		Shirt bag	3.376	12
		Electric accessories bag	2.304	12
		Medium organizer	1.625	12
		Coat storage bag	1.666	12
		Perfumed flowers	1.191	12
		Fragrant gems	1.099	24
		Perfume diffuser	2.705	12
		Small fabric box	3.092	12
		Large fabric box	4.889	12
		Cardboard box	3.389	12
		Perfume diffuser	2.705	12
Cedar wood wool protection for drawers	1.211	18		
5/4/2018	Germany	Large fabric box	5.826	12
		Organizer large	1.549	12
		“Guardaroba”	2.318	36
		Cedar wood wool protection for drawers	1.211	18
20/04/2018	Germany	Fabric large box	5.826	12

		Fabric blanket storage box	1.617	12
		Hanging toiletries bag (travel size)	2.662	12
		Small accessory caddy	2.559	12
		Fabric medium box	3.61	12
		Blanket cover	1.525	12
		2 Pcs sock drawer	3.744	12
		Overcoat cover	3.744	12
		“Guardaroba”	2.318	36
09/05/2018	Germany	2Pcs Sock drawer	3.744	12
		Blanket cover	1.525	12
		Fabric medium box	3.61	12
		Small accessory caddy	2.559	12
		Hanging toiletry bag (travel size)	2.662	12
		Large fabric box	4,822	12
		Blanket storage bag	1.617	12
16/07/2018	Prague, Czech Republic	Medium fabric box	2.97	24
		Medium fabric box	3.64	12
		Large fabric box	4.8	12
		Fabric coat storage bag	1.54	24
		Fabric jacket storage bag	1.33	12
		Fabric blanket storage box	1.57	12
		Fabric quilt storage bag	1.93	12
		3 piece bathroom storage set	2.29	12

		Hangers	2.2	12
		Skirt hangers	1.48	24
		Fabric coat storage bag	1.37	24
		Fabric jacket storage bag	1.18	36
		Storage box	2.99	12
		Fabric medium box	3.67	12
		Overcoat cover	1.69	12
		Medium organizer	1.3	36
		Large organizer	1.5	24
		Perfumed cards	1.07	120
		Perfume diffuser	2.63	24
		Overcoat cover	1.27	24
		Jacket cover	1.07	36
		Quilt cover	1.69	12
		Foldable basket	2.71	12
		Cardboard Box	2.51	48
		Maxi Cardboard box	2.51	48
		Tweed cardboard box	2.51	72
		Overcoat cover	1.36	24
		Storage box	1.36	24
		Storage box	3.55	12
		Overcoat cover	1.36	36
		Jacket cover	1.18	48
		Quilt cover	1.79	12
		Blanket storage box	1.65	12
		Shirt hanger	2.02	24
		Trouser hanger	0.86	12
		Trouser hanger	2.69	12
		Skirt hanger	1.87	24
		Narrow shoulder clothes hanger	1.44	12

		Narrow shoulder clothes hanger	1.21	24
		Skirt hanger with clips	1.48	24
		Narrow shoulder clothes hanger	1.69	36
		Perfumed flowers	1.16	12
		Perfumed flowers	1.16	24
		Perfumed flowers	1.16	24
		Perfumed flowers	1.16	24
		Perfumed flowers	1.16	24
		Perfumed flowers	1.16	24
		Perfume diffuser	2.06	12
		Perfume diffuser	2.06	24
		Cedarwood wool protection for drawers (16 balls)	1.21	36
		Cedarwood wool protection for drawers (24 hearts)	1.21	54
		Cedarwood wool protection for drawers (12 cubes)	1.21	18
		Cedarwood wool protection for drawers (16 acorns)	1.21	72
		Maxi cardboard box	2.56	24
		Storage box	2.92	12
		Storage box	3.55	12
		Storage box	4.62	12
		Overcoat cover	1.36	12
		Jacket cover	1.18	24
		Blanket cover	1.48	24
		Quilt cover	1.79	24

		Under bed storage case	2.02	24
		Accessory caddy	2.97	12
		Storage box	3.4	12
		Overcoat cover	1.27	12
		Jacket cover	1.07	36
		Blanket cover	1.38	12
		Quilt cover	1.69	36
		Under bed storage case	1.91	12
		Medium foldable drawer	1.27	36
		Large foldable drawer	1.43	48
		Foldable basket	2.71	12
		Large organizer	1.27	24
		4 shelf hanging organiser	3.53	12
		Fabric under storage bag	2.18	12
		Fabric box	2.97	12
		Medium fabric box	3.64	12
		Large fabric box	4.8	12
		Fabric blanket storage bag	1.57	12
		Fabric quilt storage bag	1.93	24
		Fabric underbed storage bag	2.18	12
		Vacuum storage bag	2.06	12
		Vacuum storage bag	2.22	12
		Vacuum storage bag	2.53	12
		5 clothes storage bags with perfume	0.63	48

		4 jacket storage bags with perfume	0.72	72
		3 coat storage bags with perfume	0.77	72
		2 duvet storage bags with perfume	0.97	48
09/11/2018	France	40 Hearts in natural cedarwood	2.66	378
26/11/2018	Finland	Jacket cover	1.49	228
		2 fragrant locks (referred to as scented curls in the catalogue)	1.32	72
		2 fragrant locks	1.32	264
		Fabric coat storage bag	1.66	144
		Narrow shoulder shirt hanger	0.97	492
		Narrow shoulder shirt hanger	1.11	192
		Vacuum storage bag	1.29	696
		Vacuum storage bag	1.5	612
29/11/2018	Romania	Quilt cover	1.84	2
		Trouser hanger	0.89	1
10/08/2018	Croatia	Storage box	3.47	72
		Storage box	4.633	72
		Overcoat cover	1.29	72
		Jacket cover	1.088	72
		Blanket cover	1.408	72
		Quilt cover	1.726	72
		Under bed storage case	1.943	72
		Large foldable drawer	1.455	72

		Large organizer	1.29	72
		Laundry bag	1.144	72
		Vacuum storage bag	1.202	1200
		Vacuum storage bag	1.377	1200
		Vacuum storage bag	1.613	1200
10/12/2018	Belgium	Hangers	1.891	48
		Skirt hanger	1.841	24
		Wide shoulder clothes hanger	3.084	60
		Wooden hanger with thin shoulder	1.198	36
		Wooden wide shoulder hanger	2.597	36
		Wooden trouser hanger clip	1.748	36
		Lint roller	0.55	18
		Trouser hanger	1.605	36
		Narrow shoulder clothes hanger	1.428	48
		Narrow shoulder clothes hanger	1.198	24
		Narrow shoulder clothes hanger	0.912	96
		Clothes hanger with bar	2.448	12
12/12/2018	Slovakia	Cardboard box	2.53	6
17/12/2018	Belgium	Trouser hanger	0.816	180
		Steel trouser hangers	3.31	144
		Clothes hanger with bar	2.448	48

28/03/2019	Finland	Cedar wood wool protection for drawers	1.83	126
		Coat cover	1.74	612
24/01/2019	Greece	Quilt cover	1.778	96
		Blanket storage bag	1.357	96
		Soft box	4.895	72
		Scented sachet	1.038	48
		Scented sachet	1.038	96
		Scented sachet	1.038	72
		Perfumed cards	1.095	120
		Perfumed cards	1.095	120
		Perfumed cards	1.095	120
		Cedarwood wool protection for drawers	1.213	36
		Clothes brush	1.592	36
		Wool brush with Velcro	1.788	24
		Wooden hangers	1.792	24
		Wooden wide shoulder clothes hanger	2.656	60
		Wooden narrow shoulder hangers	1.064	240
		Steel belt rack	1.778	24
		Lint roller refill	0.73	120
		Wooden wide shoulder clothes hanger	2.531	24
		Skirt hanger	1.883	96
		Fabric storage bag	1.481	72
		Blanket cover	1.267	72
		Blanket storage bag	1.647	96
		Storage bag	1.248	48


		Quilt storage bag	1.569	96
		Shoe bag	1.624	24
		Coat shoulder cover	1.523	24
28/01/2019	Cyprus	Lint roller	0.55	108
		Lint roller refill	0.396	120
18/06/2020	Portugal	Vacuum storage bag	1.154	864
		Vacuum storage bag	1.318	960
		Vacuum storage bag	1.547	660
		Lint roller	0.517	486
		Lint roller refill	0.752	240
		Textile brush refill	0.394	24
		Wool care sheets	0.661	108
		Wool care sheets	0.661	72
		Scented hearts	1.052	12
		Clothes storage bags with perfume	0.673	72
		Jacket storage bags with perfume	0.767	24
		Duvet storage bags with perfume	1.042	24
05/06/2020	Romania	Non-woven drawer	3.09	12
		Fabric jacket storage bag	1.38	12
		Quilt storage bag	3.05	36
		Laundry basket	5.52	24
		Small polyester box	3.22	12
		Jacket storage bag	1.41	12
		Medium organizer	1.62	12
		Wooden trouser hanger	2.33	12
		Storage box	3.15	24

		Quilt cover	1.85	12
		Underbed storage case	2.1	12
		Coat storage bag	1.6	24
		Jacket storage bag	1.41	12
		Coat shoulder cover	1.46	12
		Handbag tidy	2.99	12
17/06/2020	Finland	Cedar wood wool protection for drawers	1.83	252
		Trouser hanger	0.87	84
		Vacuum storage bag	1.14	120
		Vacuum storage bag	1.32	240
		Vacuum storage bag	1.54	240
18/06/2020	Portugal	Vacuum storage bag	1.154	864
		Vacuum storage bag	1.318	960
		Vacuum storage bag	1.547	660
		Lint roller	0.517	486
		Lint roller refill	0.752	240
		Textile brush refill	0.394	24
		Wool protection cards	0.661	108
		Wool protection cards	0.661	72
		Scented hearts	1.052	12
		Clothes storage bags	0.673	72
		Jacket storage bags	0.767	24
		Duvet storage bags	1.042	24
04/11/2020	Spain	Under bed storage bags	4.33	2

27. The invoices are headed with a different 'cosatto' mark and the 'Voila' mark is shown fairly small at the bottom as follows:



28. Further, the opponent provided images of their products as shown on their website and in a catalogue from 2022 (Exhibits NC 5 & 6 respectively). I note that the catalogue is dated after the relevant period, however, in the witness statement it is confirmed that the images within these exhibits are representative of the products and packaging used by the opponent over many years. Below are some examples:



**Sottovuoto Italia 80x110**


[Add Reviews](#)

Reference: VLSS0301012  
In stock: 120 items

**€9.49**  
Tax included

Sacco Sottovuoto, misure: 80x110 cm, made in Italy

Share this: [f](#)



**Custodia salvacoperta**  
*Blanket cover*  
cm 45 x 45 x 20



VLCATB005012



Pezzi per box / Pieces per box	12
Peso / Weight	Kg 1,68
Misure / Sizes	cm 32,5 x 25,5 x 18



Box per strato / Boxes per layer	10
Strati per pallet / Layers per pallet	9
Box per pallet / Boxes per pallet	90
Misure / Sizes	cm 80 x 120 x 177

**Custodia salvatrappunta**  
*Quilt cover*  
cm 60 x 45 x 30



VLCATB006012



Pezzi per box / Pieces per box	12
Peso / Weight	Kg 2,26
Misure / Sizes	cm 33 x 25,5 x 22,5



Box per strato / Boxes per layer	10
Strati per pallet / Layers per pallet	7
Box per pallet / Boxes per pallet	70
Misure / Sizes	cm 80 x 120 x 172,5

**Custodia sottoletto**  
*Underbed cover*  
cm 100 x 50 x 15



VLCATB007012



Pezzi per box / Pieces per box	12
Peso / Weight	Kg 2,54
Misure / Sizes	cm 35,5 x 29 x 22,5



Box per strato / Boxes per layer	8
Strati per pallet / Layers per pallet	7
Box per pallet / Boxes per pallet	56
Misure / Sizes	cm 80 x 120 x 172,5





## Analysis

### Form of the mark/how the mark is used

29. The mark, as registered, has been shown on the invoices. I note that throughout the evidence it is usually presented on a slightly different background – most often a black background with a blue wave shape underneath the word. However, the word ‘Voilà!’ retains an independent distinctive role in the mark and therefore, this is acceptable use.<sup>1</sup>

### Conclusions from the evidence on genuine use

30. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the comparable mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. As the relevant period ends before IP Completion Day, the relevant territory for genuine use is the EU. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and

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<sup>1</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

- The geographical extent of the use shown.

31. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>2</sup>

32. The opponent has not provided me with any turnover or overall sales figures nor any marketing/advertising figures in relation to their goods. However, they have provided me with sample invoices which show sales throughout several EU countries and also in the UK during the relevant period.

33. I have been provided with screenshots of the opponent's website through the relevant period and also a catalogue, which is dated after the relevant period. However, the opponent states within their witness statement that both exhibits are representative of the goods and packaging used by the company over many years, including the relevant period.

34. The mark has clearly been shown on the packaging of the products as evidenced in the website screenshots and the catalogue.

35. The products that are shown within evidence and that have evidence of sales are items such as: clothes hangers, storage boxes (either of fabric or cardboard), storage bags, organisers, scented cards, shapes and fragrance diffusers, lint rollers and brushes for clothes. I would consider these goods to be fairly low in cost and everyday purchases rather than a more considered purchase. I believe the home goods market to be fairly substantial. Although I do not have any turnover figures, the invoices do show continuous sales throughout the EU together with promotional catalogues and a website which all indicated use of the earlier mark which is enough to create and maintain a share in the market for the goods. I therefore find that the opponent has shown use for the above goods.

## **Fair Specification**

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<sup>2</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

36. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

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

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

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

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because

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

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

38. As a reminder, the opponent claims to have used the earlier mark on the following goods:

Class 5: Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides; herbicides.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paintbrushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

39. I can see no evidence of the mark being used in relation to any of the class 5 goods or anything that falls within those categories. There is nothing within the evidence to suggest the opponent provides anything of a medical or food nature nor anything for destroying vermin or any other pests. Therefore, I find that the opponent has not proved use of these goods.

40. The opponent has also not provided any evidence in relation to the following goods from class 21: combs and sponges; brush-making materials; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes and find they have not shown use of these goods also.

41. The term 'articles for cleaning' is very broad however, I cannot see anything within the opponent's evidence that shows products or articles used for cleaning. The closest item I would suggest is the fabric freshener shown in the catalogue however, the purpose of this good is to make clothes or fabric smell nice, not to actually clean it and therefore, I consider that the opponent has not shown use of this term.

42. In relation to the term 'household or kitchen utensils and containers (not of precious metal or coated therewith)', I have found there to be evidence in relation to storage boxes and bags above. None of the goods shown by the opponent are specified for kitchen use and rather, the boxes are usually termed as 'blanket boxes' or as accessory caddies. Therefore, I consider a fair term to be 'household containers'.

43. Next, is the term 'brushes (except paint brushes)'. The evidence in relation to brushes provided by the opponent clearly shows the brushes they sell are for brushing clothing and therefore, I find a fair term to be 'brushes for clothing'.

44. Therefore, I consider a fair specification for the earlier mark to be:

Class 21: Household containers (not of precious metal or coated therewith);  
brushes for clothing.

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

45. In making this decision, I bear in mind the following principles 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**

46. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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”.

47. 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.

48. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)* ('Meric'), Case T-133/05, the General Court ("the 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 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".

49. 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”.

50. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

51. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

52. The Parties’ respective specifications are:

<b>Contested goods</b>	<b>Opponent’s goods</b>
Class 3: Sun-tanning and after-sun creams; mucous membrane care creams; wipes impregnated with	Class 21: Household containers (not of precious metal or coated therewith); brushes for clothing.

cleansing lotions for mucous membranes; massage creams not for medical use; hair-removing products; depilatory wax; shaving products, after-shave lotions; mouth care products (not for medical use); dentifrices; dental bleaching gels;

Class 5: Disinfectant soaps; diapers of paper or cellulose (disposable).

Class 21: Toilet utensils; toilet utensils or cases; scouring pads; soap holders; feather dusters; toilet brushes; brush-making materials; animal bristles [brushware]; toilet sponges; cotton waste for cleaning; electric and non-electric toothbrushes; dental floss; heads for electric toothbrushes; dental water jets; toothbrush cases; shaving brushes; shaving brush holders.

Class 35 Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of sale of toilet soaps, disinfectant soaps, toilet waters, toilet oils, toilet talc, creams for the care of mucous membranes, creams and lotions for intimate hygiene, wipes for intimate hygiene, wipes impregnated

<p>with cleansing lotions for mucous membranes, massage creams not for medical use, aftershave lotions, pet shampoos, mouth care products [not for medical use], depilatory products, depilatory wax, vanity cases, toothpastes, tooth whitening gels, bleaching preparations and other substances for laundry use, cleaning, polishing, degreasing and abrasive preparations, cleaning pads, soap dishes, feather dusters, toilet brushes, brushing materials, electric and non-electric toothbrushes, dental floss, animal bristles [brushes and brushes], toilet sponges, cotton waste for cleaning, shaving brushes, shaving brush holders, bottles, tea infusers, electric toothbrush heads, mouth showers, money boxes, mugs, cups, glasses [receptacles], toothbrush cases;</p>	
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Class 3

*Sun-tanning and after-sun creams; mucous membrane care creams; wipes impregnated with cleansing lotions for mucous membranes; massage creams not for medical use; hair-removing products; depilatory wax; shaving products, after-shave lotions; mouth care products (not for medical use); dentifrices; dental bleaching gels.*

53. I can see no overlap of the *Treat* factors between the above goods from the applicant's specification and the opponent's goods and therefore consider them to be dissimilar.

## Class 5

*Disinfectant soaps; diapers of paper or cellulose (disposable).*

54. Again, I can see no overlap of the *Treat* factors between the above goods from the applicant's specification and the opponent's goods and therefore consider them to be dissimilar.

## Class 21

*Toilet utensils; scouring pads; toilet sponges; cotton waste for cleaning; soap holders; electric and non-electric toothbrushes; dental floss; heads for electric toothbrushes; dental water jets; feather dusters;*

55. I find that the only overlap in the *Treat* factors between the above goods from the applicant's specification and the opponent's goods is of trade channels in so far as the goods may be found in the same home stores however, they would be sold in different areas of those stores so any overlap would be low. This on its own is not enough to persuade me that there is any finding of similarity and as such, I find these goods to be dissimilar.

*Toilet cases; toothbrush cases; shaving brush holders*

56. I consider that both of the above goods are containers which store other items (toiletries and toothbrushes) and therefore, they fall within the wider 'household containers (not of precious metal or coated therewith)' and I consider them to be identical under the *Meric* principles.

*Toilet brushes; shaving brushes;*

57. I consider that there is a slight overlap in nature and purpose with the opponent's 'brushes for clothing' and that the very general purpose of brushing something is

shared. They may overlap in trade channels in so far as they might be found in the same large homeware stores however, they will be sold in different parts of the store. They will differ in user, they are not complementary nor are they in competition and their specific purposes differ. I therefore find them to be similar to a low degree.

*Brush-making materials; animal bristles [brushware];*

58. In comparing the above goods to the opponent's 'brushes for clothing' I remind myself of the GC's findings in *Les Éditions Albert René v OHIM*, Case T-336/03:

"61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different."

In applying the above, I consider that there is no overlap of the *Treat* criteria and that these goods are dissimilar.

### Class 35

*Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of vanity cases, shaving brush holders, money boxes, toothbrush cases*

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

"9. 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."

60. However, on the basis of the European Courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

- 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).

61. I therefore consider that the applicant's services, whilst clearly differing in nature, purpose and method of use to the opponent's goods, there is some complementarity as the retail services relate to goods that I have either found to be similar earlier in this decision or would be similar (i.e. vanity cases would be *Meric* identical to household storage). There is an overlap in trade channels also. As the level of similarity between the goods themselves is identical under the *Meric* principles, it follows that the retail and wholesale services are a step further away due to the above findings. I therefore consider these services to be similar to a medium degree.

*Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of shaving brushes, toilet brushes;*

62. I apply the same findings as at paragraph 61 above however, I only found these goods to be similar to a low degree. Therefore, I consider the retail services related to them to be similar to a very low degree.

*Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of cake of toilet soaps, disinfectant soaps, toilet waters, toilet oils, toilet talc, creams for the care of mucous membranes, creams and lotions for intimate hygiene, wipes for intimate hygiene, wipes impregnated with cleansing lotions for mucous membranes, massage creams not for medical use, aftershave lotions, pet shampoos, mouth care products [not for medical use], depilatory products, depilatory wax, toothpastes, tooth whitening gels, bleaching preparations and other substances for laundry use, cleaning, polishing, degreasing and abrasive preparations, cleaning pads, soap dishes, feather dusters, brushing materials, electric and non-electric toothbrushes, dental floss, animal bristles [brushes and brushes], toilet sponges, cotton waste for cleaning, bottles, tea infusers, electric toothbrush heads, mouth showers, mugs, cups, glasses [receptacles]*

63. Unlike the services in paragraph 61 above, these retail/whole sale services relate to goods which I have found to be dissimilar (or which are not featured in the earlier goods comparison but would be dissimilar) to the opponent's goods. For the sake of

completeness, they clearly differ in nature, purpose, method of use and trade channels. They are not in competition nor are they complimentary. Even if there were an overlap in general user, this is not enough on its own to establish similarity. They are dissimilar.

64. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

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

65. I have found no similarity for the applicant’s class 3 and 5 goods and the following goods and services from classes 21 and 35 and therefore the opposition fails in relation to them:

Class 21: Toilet utensils; Toilet utensils[...]; scouring pads; toilet sponges; cotton waste for cleaning; soap holders; electric and non-electric toothbrushes; dental floss; heads for electric toothbrushes; dental water jets; feather dusters; brush-making materials; animal bristles [brushware];

Class 35: Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of sale of toilet soaps, disinfectant soaps, toilet waters, toilet oils, toilet talc, creams for the care of mucous membranes, creams and lotions for intimate hygiene, wipes for intimate hygiene, wipes impregnated with cleansing lotions for mucous membranes, massage creams not for medical use, aftershave lotions, pet shampoos, mouth care products [not for medical use], depilatory products, depilatory wax, toothpastes, tooth whitening gels, bleaching preparations and other substances for laundry use, cleaning,

polishing, degreasing and abrasive preparations, cleaning pads, soap dishes, feather dusters, brushing materials, electric and non-electric toothbrushes, dental floss, animal bristles [brushes and brushes], toilet sponges, cotton waste for cleaning, bottles, tea infusers, electric toothbrush heads, mouth showers, mugs, cups, glasses [receptacles]

66. The opposition will continue in respect of the applicant's:

Class 21: Toilet [...] cases; toothbrush cases; shaving brush holders; toilet brushes; shaving brushes

Class 35: Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of vanity cases, shaving brush holders, money boxes, toothbrush cases; shaving brushes

### **Average consumer and the purchasing act**

67. 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: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

68. 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 then was) 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 word

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

69. For the remaining class 21 goods, I consider they are generally purchased by the general public (not discounting professional and business purchasers). In any event, the goods are likely to be purchased fairly frequently and would have a fairly low base value, although there are certainly more valuable options available. The average consumer will likely consider factors such as aesthetics, ease of use, materials and functionality. Keeping all of this in mind, I consider the average consumer will likely pay a medium degree of attention when purchasing these products.

70. The selection of the goods is likely to be a more visual process whereby they are viewed on retail displays or photographs on websites/catalogues. There is, however, the possibility of the marks being spoken by sales representatives so I cannot discount the aural use of the marks.

71. For the class 35 services, again I think the average consumer is the public but consider that it is also possible for there to be business consumers. The services are likely to have been chosen by viewing promotional material and high street signage. The choice of all services at issue will largely be influenced by visual considerations but there is the possibility of word of mouth recommendations. When selecting the services at issue, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail) and knowledge of the staff. I therefore believe that the average consumer will pay a medium degree of attention during the selection process.

### **Comparison of the marks**

72. 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 at paragraph 34 of its judgment 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.”

73. 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.

74. I note that the holder accepted within their counterstatement that the marks are similar, however, they did not comment on the level of similarity. Therefore, I am still required to undertake a comparison in order to determine this.

75. The respective trade marks are shown below:

Contested Mark	Earlier Mark
<p style="text-align: center;"><b>Voilà</b></p>	 The image shows a stylized, 3D-effect wordmark 'Voilà!' in white on a grey rectangular background. The letters are bold and serifed, with a slight shadow effect. The exclamation point is also stylized and 3D.

76. The contested mark is a singular word mark and therefore, that is where the overall impression lies. The earlier mark is a stylised mark which is a grey rectangular

background with the word 'Voilà!' in white lightly stylised font in the middle. I find, in accordance with settled case law,<sup>3</sup> that the word element will be the dominant and distinctive component with the stylisation playing a much lesser role.

77. Visually, both marks contain the word 'Voilà' and the contested mark is contained wholly within the earlier mark. The earlier mark has the addition of the light stylisation and the exclamation mark at the end of the word which are not replicated within the contested mark. I therefore consider the marks to be visually similar to between a medium and high degree.

78. It is possible that there are some variations as to how the average consumer articulates the word 'Voilà' however, whichever way it is articulated it will be consistent across both marks. The marks are aurally identical.

79. Conceptually, 'Voilà' is a term which a significant proportion of consumers will understand is a French term that means 'here it is'. Alternatively, some consumers might recognise it to be a foreign word but not able to specify the language. For the average consumer, the concept will either be evoked from both marks or neither of them. For the consumers to whom they recognise it to be a foreign word but cannot assign any meaning, neither mark will convey a conceptual message. The marks are either conceptually identical or the position is neutral.

### **Distinctive Character of the Earlier Mark**

80. 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

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<sup>3</sup> See for instance: *Migros Genossenschafts-Bund v EUIPO*, T-68/17; and *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

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).”

81. The opponent has submitted evidence regarding use of its marks which I have summarised above. I will review the evidence to see whether it shows that use of the marks can be said to have enhanced the distinctiveness of the earlier mark.

82. In order to do this, first I must consider the level of inherent distinctiveness the earlier marks have. For the most part, words that are descriptive or allusive of the character of the goods and services provided are on the lower end of the scale of distinctiveness whereas invented terms are likely to possess the highest level of distinctiveness.

83. As mentioned above, ‘Voilà’ is a term that a significant proportion of consumers will recognise as a foreign word. Whether or not the average consumer is able to attribute a meaning to the mark, I do not believe any possible meaning has a relationship to the goods relied upon. I therefore consider it to be inherently distinctive to a fairly high degree.

84. It is the UK market that is relevant to an assessment of enhanced distinctiveness. The opponent has not provided me with any turnover or overall sales figures nor any

marketing/advertising figures in relation to their goods. Only one of the sample invoices was to a UK consumer. In light of this, and the limited information on how the goods are marketed to the UK consumer, I do not believe that they have shown enhanced distinctiveness in the UK market and therefore the distinctive character of the earlier mark remains at its inherent level.

### **Likelihood of confusion**

85. 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. 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. 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 goods and services and vice versa. 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.

86. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the word element is the dominant and distinctive element of the earlier mark, with stylisation playing a much smaller role. With the contested mark, the overall impression lies in the word 'Voilà' as that is the only element.
- I have found the marks to be visually similar to between a medium and high degree.
- I have found the marks to be aurally and conceptually identical (or conceptually neutral depending on the understanding of the consumer).

- I have found the earlier mark to be inherently distinctive to a fairly high degree.
- I have identified the average consumer for the goods and services to be a combination of members of the general public as well as professionals/businesses. The purchasing process is likely to be predominantly visual.
- I have concluded that a medium level of attention will be paid during the purchasing process.
- The remaining goods and services at issue range from similar to a very low degree to identical.

87. Given I have found that the earlier mark is wholly replicated within the contested mark, and that they are aurally and conceptually identical (for a significant proportion of consumers), I am satisfied that the average consumer paying a medium degree of attention is unlikely to recall the marks accurately and may not remember that one of them includes an exclamation mark and slight stylisation. They are likely to mistake one mark for the other even where the level of similarity between the goods is low. Consequently, I find there to be a likelihood of direct confusion between the marks.

88. In the event that I am wrong in finding there to be a likelihood of direct confusion, I will now go on to consider whether there could be indirect confusion. Mr Iain Purvis Q.C. said further in *L.A. Sugar Limited v Back Beat Inc*:

“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).”

89. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”<sup>4</sup>

90. In the case of indirect confusion, the average consumer has noticed the differences between the marks but still believes them to be linked. The differences that the average consumer might notice in this case are the stylisation and exclamation mark of the earlier mark. As previously mentioned, I have found the stylisation to not be a highly distinctive element of the mark. The average consumer, seeing that the extraneous matter in the mark as being of lower distinctiveness and a slight change in the presentation of the word element, will then see the contested marks as simply another way of using the earlier mark. Therefore, I find that indirect confusion is likely to occur.

## **Conclusion**

91. The opposition has been successful, and registration is refused, subject to any appeal, in relation to the following goods and services:

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<sup>4</sup> Paragraph 12

Class 21: Toilet [...] cases; toothbrush cases; shaving brush holders; toilet brushes; shaving brushes

Class 35: Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of vanity cases, shaving brush holders, money boxes, toothbrush cases; shaving brushes; toilet brushes

92. The opposition fails in relation to the following goods and services for which the mark may proceed to registration (along with the unopposed goods and services), subject to any appeal:

Class 3: Sun-tanning and after-sun creams; mucous membrane care creams; wipes impregnated with cleansing lotions for mucous membranes; massage creams not for medical use; hair-removing products; depilatory wax; shaving products, after-shave lotions; mouth care products (not for medical use); dentifrices; dental bleaching gels.

Class 5: Disinfectant soaps; diapers of paper or cellulose (disposable).

Class 21: Toilet utensils; Toilet utensils[...]; scouring pads; toilet sponges; cotton waste for cleaning; soap holders; electric and non-electric toothbrushes; dental floss; heads for electric toothbrushes; dental water jets; feather dusters; brush-making materials; animal bristles [brushware].

Class 35: Retail and wholesale services in shops, and via worldwide computer networks, by catalog, by mail, by telephone, by radio and television, and via other electronic means of cake of toilet soaps, disinfectant soaps, toilet waters, toilet oils, toilet talc, creams for the care of mucous membranes, creams and lotions for intimate hygiene, wipes for intimate hygiene, wipes impregnated with cleansing lotions for mucous membranes, massage creams not for medical use, aftershave lotions, pet shampoos, mouth care products [not for medical use], depilatory products, depilatory wax, toothpastes, tooth whitening gels, bleaching preparations and other substances for laundry use, cleaning,

polishing, degreasing and abrasive preparations, cleaning pads, soap dishes, feather dusters, brushing materials, electric and non-electric toothbrushes, dental floss, animal bristles [brushes and brushes], toilet sponges, cotton waste for cleaning, bottles, tea infusers, electric toothbrush heads, mouth showers, mugs, cups, glasses [receptacles]

93. In these proceedings, I consider that the applicant has enjoyed a greater degree of success and is therefore entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. Given the applicant's counterstatement was very short and they did not respond to the opponent's evidence, I will adjust the award accordingly. I therefore award the applicant the sum of £350 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a counterstatement and reviewing the opponent's statement	£200
Considering the other side's evidence	£150
<b>TOTAL</b>	<b>£350</b>

94. I therefore order COSATTO SPA to pay BEAUTY STORY the sum of £350. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is any appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 28<sup>th</sup> day of August 2024**

**L Nicholas**  
**For the Registrar**