O/0839/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001653859
BY SCHON INTERNATIONAL KOZMETİK SANAYİ VE
TİCARET ANONİM ŞİRKETİ

TO REGISTER THE TRADE MARK:

CALLISTA

IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 436125 BY
COLLISTAR S.P.A.

BACKGROUND AND PLEADINGS

1. International trade mark 1653859 ("the IR") consists of the sign shown on the cover page of this decision ("Callista"). The holder is SCHON INTERNATIONAL KOZMETİK SANAYİ VE TİCARET ANONİM ŞİRKETİ. The IR is registered with effect from 6 September 2021. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the following goods in class 3:

Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; soaps; hair lotions; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations.

2. The request to protect the IR was published on 8 July 2022. On 8 September 2022, Collistar S.p.A. ("the opponent") opposed the protection of the IR in the UK under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). For the purpose of the opposition, the opponent relies upon the following trade marks and the goods laid out, respectively, below:

United Kingdom Trade Mark ("UKTM") 900410787[1]:
"The opponent's first mark"

COLLISTAR

Filing date: 11 December 1996
Registration date: 25 February 1999

Soaps; Perfumery, essential oils, cosmetics, hair lotions; Shampoo; Toiletries (class 3)

UKTM 918253950:
"The opponent's second mark"

[1] The opponent's marks are comparable marks based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

COLLISTAR MILANO

Filing date: 15 June 2020
Registration date: 25 September 2020

Cosmetics and cosmetic preparations; Natural cosmetics; Organic cosmetics; Cosmetics containing hyaluronic acid; Beauty care cosmetics; Cosmetics for use in the treatment of wrinkled skin; Cosmetics for use on the skin; Colour cosmetics; Body and facial creams [cosmetics]; Toning creams [cosmetic]; Facial cleansers [cosmetic]; Cosmetic moisturisers; Skin masks [cosmetics]; Hair masks; Mousses [cosmetics]; Oils for cosmetic purposes; Cosmetic preparations for bath and shower; Bath and shower preparations; Shower and bath foam; Bath salts; Shower salts not for medical purposes; Hair preparations and treatments; Cosmetic preparations for the hair and scalp; Hair conditioners; Hair dyes; Hair wax; Hair bleaching preparations; Hair fixers; Hair protection gels; Hair moisturisers; Hair spray; Hair lotions; Hair glaze; Hair mascara; Hair neutralizers; Oils for hair conditioning; Styling paste for hair; Hair powder; Shampoos; Dry shampoos; Dandruff shampoo; Hair-washing powder; Hair serums; Cosmetic preparations for skin firming; Cosmetic preparations for skin care; Sun care preparations; Impregnated cleaning pads impregnated with cosmetics; Cosmetic soaps; Cosmetic body scrubs; Facial toners [cosmetic]; Perfumery and fragrances; Perfumes; Air fragrancing preparations; Aromatics for perfumes; Extracts of perfumes; Natural oils for perfumes; Body deodorants [perfumery]; Deodorants for personal use [perfumery]; Cosmetic creams; Skin care creams [cosmetic]; Anti-aging creams; Depilatory creams; Washing creams; Non-medicated creams; Aromatherapy creams; Barrier creams; Cleansing creams; Recovery creams for cosmetic use; Make-up removing creams; Adhesives for false eyelashes, hair and nails; Anti-aging skincare preparations; Cosmetic preparations for skin renewal; Skin conditioners; Skin fresheners; Wipes impregnated with a skin cleanser; Skin make-up; Body glitters; Body butter; Cosmetic body mud; Body milks; Body lotions; Pumice stones for use on the body; Body powder; Body talcum powder; Abrasive preparations for use on the body; Make-up preparations for the face and body; Make-up; Lipsticks; Eyelid shadow; Mascara; Rouges; Make-up powder; Cotton wool impregnated with make-up removing preparations; Eyeliner; Cosmetic pencils; Nail varnish; Nail varnish removers; Blush pencils; Sponges impregnated with toiletries; Sponges impregnated with soaps; Soap; Scented soaps;

Deodorant soap; Beauty soap; Cotton wool for cosmetic purposes; Cotton swabs for cosmetic purposes; Make-up pads of cotton wool; Beard care preparations; Shaving sets, comprised of shaving cream and aftershave; Shaving gel; Beard dyes; Lotions for beards; Shaving foam; After-shave lotions; Shaving cream; Aftershave balms; Shaving balm (class 3)

Pharmaceuticals; Dermatological pharmaceutical products; Pharmaceutical lipsalves; Pharmaceutical preparations for hair care; Pharmaceutical preparations for skin care; Medicated skin creams; Skin care creams for medical use; Medicinal creams for the protection of the skin; Medicinal mud; Medicated talcum powder; Medicinal hair growth preparations; Sanitary preparations for medical purposes; Medicated shampoos; Skin tonics [medicated]; Face scrubs (Medicated -); Therapeutic medicated bath preparations; Medicated handwash; Anti-bacterial face washes (Medicated -); Medicated creams; Protective creams (Medicated -); Disinfectants; Disinfectants for hygiene purposes (class 5)

3. Under section 5(2)(b), the opponent submits that the similarities between the respective trade marks and the identity or similarity between the parties' goods gives rise to a likelihood of confusion on the part of the public, including a likelihood of association.

4. In its counterstatement, the holder denied that there exists a likelihood of confusion, highlighting the conceptual, visual and phonetic differences between the marks. It also denies that the parties' goods are similar.

5. The holder is represented by Carolina Sanchez Margareto and the opponent by Barker Brettell LLP. Neither party filed evidence during the course of the proceedings. Neither party requested a hearing and only the opponent elected to file written submissions in lieu. This decision is taken following a careful perusal of the papers.

DECISION

Relevance of EU law

6. 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.

Section 5(2)(b)

7. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

8. Section 5A of the Act reads 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."

9. By virtue of their respective filing dates, the opponent's trade marks qualify as earlier marks pursuant to section 6 of the Act. As the opponent's first mark had completed its registration process more than 5 years before the designation date at issue it is, in principle, subject to proof of use pursuant to section 6A of the Act. However, in its counterstatement, the holder was asked whether it required the opponent to provide "proof of use" in respect of its earlier mark and, in reply, the holder answered "No". The

opponent is consequently able to rely upon both earlier marks and all goods it has stipulated without providing evidence of use.

Section 5(2)(b) – case law

10. 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

11. The competing goods are laid out at paragraphs 1 and 2 to this decision.

12. In addition to cases of *literal* identity, the General Court ("GC") set out a further provision as to when goods can be considered identical in *Gérard Meric v Office for Harmonisation in the Internal Market*[2]. It stated:

"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,

[2] Case T-133/05

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".

13. As I have already noted, the opponent has submitted that some of the parties' respective goods are identical and the remainder are similar. Whilst the holder has denied that the goods are similar, it seems quite clear that there are terms in the specifications which are identical, literally or otherwise. The holder's *soap* and *perfumery*, for example, are replicated identically in each of the opponent's specifications. The holder's *non-medicated cosmetics* is encompassed by *cosmetics* in both of the earlier specifications. I intend to initially approach my consideration of a likelihood of confusion on the basis that the respective marks are used in relation to identical goods. I will return to consider any goods which share a lesser degree of similarity only if it appears necessary.

The average consumer and the nature of the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited,* [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

"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."

15. The average consumer of the competing goods will be a member of the general public. The goods are typically self-selected from the shelves of a traditional retail establishment or an online equivalent. The marks' visual impression is therefore likely to play the greatest role in the selection process, though I do not discount the relevance of the marks' aural position as guidance may be provided orally from retail assistants, for example. To my knowledge, the goods are generally fairly low in cost and purchases will be made fairly frequently. Despite this, I appreciate that the consumer may nonetheless be alive to considerations such as quality or compatibility. Weighing all factors, I find the average consumer likely to apply between a low and medium degree of attention to its purchase of the relevant goods.

Comparison of trade marks

16. 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 judgment in *Bimbo SA v OHIM*[3], 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."

17. 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.

[3] Case C-591/12P

18. For ease, the parties' trade marks are displayed in the table below:

Opponent's trade marks	Holder's trade mark
COLLISTAR **COLLISTAR MILANO**	**CALLISTA**

19. The opponent's first mark comprises a single word of nine letters. Its overall impression resides solely, therefore, in the word itself.

20. The opponent's second mark comprises two words of nine and six letters respectively. Whilst the words hang together, given the nature of MILANO it seems likely that a greater weight will be carried by the mark's COLLISTAR element in terms of an overall impression.

21. The holder's mark comprises a single word of eight letters. The mark's overall impression resides only in the word itself.

22. Beginning with the opponent's first mark, the words in the respective marks visually coincide in their first, third, fourth, fifth, sixth, seventh and eighth letters. There is an additional (ninth) letter in the opponent's mark (R) and the marks differ in their second letter (O in the earlier mark, A in the later mark). I find a medium degree of visual similarity.

23. I make the same findings regarding the opponent's second mark as I have above, but there is a second word in the opponent's mark with no counterpart in the holder's mark. Whilst I keep in mind that the beginnings of marks generally have a greater impact on the average consumer,[4] I find the visual similarity is of a low degree.

[4] *El Corte Inglés, SA v OHIM*; Cases T-183/02 and T-184/02

24. Aurally speaking, the opponent's first mark is likely to be articulated in three syllables; roughly COLL-EE-STAR or COLL-IH-STAR. The holder's mark will likely be articulated in three syllables; CALL-IH-STAH. The marks' first and third syllables are similar and, if the second proposed articulation of the earlier mark is applicable, the marks' second syllable is identical (IH). Given these points of coincidence and the overall percussive similarity between the marks, in either case I find the aural similarity fairly high.

25. Again, my above reasoning applies to an aural comparison between the holder's mark and the first word in the opponent's second mark. However, the opponent's second mark also comprises a second word which is likely to be expressed in an additional three syllables; MIL-AH-NO. This second element has no counterpart in the holder's mark. Keeping in mind where the similarities are positioned, I find between a low and medium degree of aural similarity.

26. In *Usinor SA v OHIM*[5], the GC found that:

> "62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann* v *OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma* v *OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).
>
> 63. In the present case, the Board of Appeal correctly found that the signs at issue have a common prefix, 'galva', which evokes the technique of galvanisation, that is, the act of fixing an electrolytic layer to a metal to protect it from oxidation.
>
> 64. By contrast, the Board of Appeal incorrectly took the view that a conceptual comparison of the second part of the signs was not possible, because the suffixes 'llia' and 'lloy' were meaningless.

[5] Case T-189/05

65. That conclusion is based on an artificial division of the signs at issue, which fails to have regard to the overall perception of those signs. As stated in paragraph 59 above, the relevant public, which is French-speaking but has knowledge of the English language, will recognise in the mark applied for the presence of the English word ‘alloy’, corresponding to ‘alliage’ in French, even if the first letter of that word (‘a’) has merged with the last letter of the prefix ‘galva’, according to the usual process of haplology. That mark will therefore be perceived as referring to the concepts of galvanisation and alloy.

66. As far as the earlier mark is concerned, the suffix ‘allia’ is combined with the prefix ‘galva’ in the same way. The evocative force of the suffix ‘allia’ will enable the relevant public – on account of its knowledge and experience – to understand that that is a reference to the word ‘alliage’. That process of identification is facilitated still further by the association of the idea of ‘alliage’ (alloy) with that of galvanisation, the suffix ‘allia’ being attached to the prefix ‘galva’.

67. By breaking down the signs at issue, the relevant public will therefore interpret both signs as referring to the concepts of galvanisation and alloy.

68. Consequently, the conclusion to be drawn is, as the applicant correctly maintains, that the signs at issue are conceptually very similar, inasmuch as they both evoke the idea of galvanisation and of an alloy of metals, although that idea is conveyed more directly by the mark applied for than by the earlier mark.”

27. In its counterstatement, the holder makes the following submission regarding the marks’ conceptual position:

“From the conceptual point of view, the trademarks do not share any resemblance or related connotation. The contested trademark, CALLISTA, has different meanings in English. Whereas the trademark Collistar, has no definition and no meaning as it is not a real world (sic). But, since it is composed by two words, COLLI + STAR, the consumers, will be able to identify the term STAR, since it has an obvious meaning.”

28. In its written submissions in lieu of a hearing, the opponent states as follows:

> "2.14. The Opponent submits that the marks 'CALLISTA' and 'COLLISTAR' are conceptually neutral. Therefore, it is not possible to conduct a conceptual comparison of the marks.
>
> 2.15. The Applicant's comments in its counterstatement regarding the conceptual similarities between the marks are unfounded. They have not provided any of the supposed definitions of 'CALLISTA'; conducting a search of the online Cambridge Dictionary confirms that this word does not have a definition in English. For the word 'COLLISTAR', the Opponent agrees with the Applicant that this word does not have a definition in English and a search of the online Cambridge Dictionary confirms the same. However, the Opponent disagrees that consumers will split the mark 'COLLISTAR' into the individual elements 'COLLI' and 'STAR' when viewing the mark. Given that 'COLLI' has no meaning in English, there is no reason why consumers would separate this element from the mark as a whole when viewing the mark. As 'COLLI' is the first part of the mark, it therefore follows that, if consumers do not perceive 'COLLI' as an individual part of the mark, they would not perceive the 'STAR' element of the mark to be separate to the mark as whole."

29. In my view, the average consumer will view COLLISTAR as an invented word without a retrievable meaning. That being said, though I accept, as the opponent submits, that COLLI has no meaning in English, it seems likely nonetheless that the average consumer would readily identify that the trade mark incorporates an ordinary dictionary word; STAR, meaning either a two dimensional shape or a ball of gas visible in the night sky. In the opponent's second mark the same interpretation is likely to apply, with a lesser weight placed on the mark's MILANO element as it may simply be perceived as a geographical indicator informing the consumer that the goods at issue bear some degree of association to the city of Milan. When it comes to the holder's mark, the average consumer would likely consider it an invented word or one of foreign origin. I consider it somewhat reminiscent of female forename CALISTA, though neither party has suggested that it will be viewed in such a way nor do I consider it reflective of how the average consumer would perceive the mark. Weighing those considerations,

whilst neither COLLISTAR nor CALLISTA offer a clear concept overall, the -STAR element which will be identified in each of the earlier marks creates a degree of conceptual distinction. The MILANO element in the opponent's second mark also provides an element of distinction against the holder's mark, albeit given less weight for the reasons already provided.

Distinctive character of the earlier trade marks

30. 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 1-2779, paragraph 49).
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> 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)."

31. 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 descriptive or allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

32. In the absence of evidence showing the use made of the earlier mark, I have only the inherent position to consider. Earlier in the decision I found that COLLISTAR was likely to be viewed as an invented word which incorporates the word STAR. Without a clear meaning, even taking into account any concept derived from the marks' STAR element, the word carries no descriptive or allusive properties when considered against the goods relied upon. On that basis, I find the opponent's first mark inherently distinctive to a fairly high degree. In respect of the second mark, I have found the word element MILANO carries less of a weight and will likely be viewed as simply a geographical indicator. For that reason, I do not find this element to have a material impact on the mark's distinctiveness and, again, find the mark's inherent distinctiveness fairly high.

Likelihood of confusion

33. In determining whether there is a likelihood of confusion, 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 vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive it is, the greater the likelihood of confusion. Conversely, the less distinctive it is, the lower the likelihood of confusion.

34. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

35. I take note of the comments made by Mr Iain Purvis Q.C., as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he 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 something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

36. To make the assessment, I must adopt the global approach advocated by the case law whilst taking account of my earlier conclusions. I also bear in mind that the average

consumer rarely has the chance to make direct comparisons between trade marks and, instead, must rely upon the imperfect picture of them retained in its mind.

37. I will begin by considering a likelihood of direct confusion. I have already elected to begin by considering the likelihood of confusion where the marks are used in relation to identical goods. I have found that the average consumer is likely to apply between a low and medium degree of attention to its purchase of the relevant goods. In those circumstances, even where only a low degree of attention is applied, notwithstanding the visual and aural similarities I have found between the marks, in my view the average consumer will nonetheless readily identify the inclusion of STAR in the earlier marks' COLLISTAR element (or the absence thereof in the holder's mark). I have taken into account that none of the marks at issue present a clear concept, in their entirety at least, and that the earlier marks enjoy a fairly high degree of inherent distinctiveness. Still, even in its approach of a lowly considered purchase, I could not foresee, for example, an existing consumer of the opponent's COLLISTAR (or COLLISTAR MILANO) goods attempting a repurchase of the same goods and mistakenly selecting the holder's goods (or vice versa). At most the average consumer may notice some coincidence in the marks' letters and their phonetic impressions but, even in that scenario, all it would amount to would be an association which is not sufficient for a finding of confusion[6]. The identity between the parties' goods is essentially offset by the marks' differences; particularly the inclusion or otherwise of well-known dictionary word STAR. The likelihood of direct confusion is lower still where the average consumer applies any higher a degree of attention to its purchase.

38. I turn now to consider a likelihood of indirect confusion. A finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion; it requires a proper basis.[7] Whilst I acknowledge that the examples in *L.A. Sugar* are non-exhaustive, I do not find any are applicable to the present proceedings nor can I find any reasonable additional justification as to why the average consumer, having identified that the respective marks are different, would reach the conclusion that there must be some connection between their respective undertakings. Instead, I find the average consumer will simply attribute the marks' differences to their

[6] *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17
[7] *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

originating from distinct undertakings. The marks' differences are not, in my experience, consistent with what would likely be interpreted as a brand extension or sub-brand and any similarities between the words COLLISTAR and CALLISTA would be viewed as purely coincidental. In short, I do not consider there to be a likelihood of indirect confusion.

39. Having reached that conclusion in respect of identical goods, the opponent would be in no better position were I to assess the likelihood of confusion based on goods which shared a lesser degree of similarity. For clarity, I do not consider the distinctiveness of the earlier marks any greater in respect of any such goods nor do I consider that the attention paid will be any lower such to materially alter the outcome of my decision.

Conclusion

40. The opposition against the UK designation of IR no. 1653859 fails.

Costs

41. The holder has succeeded and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2023. In accordance with that TPN, I award the holder a sum of £300 for considering the statement of grounds and filing a counterstatement.

42. I order Collistar S.p.A. to pay SCHON INTERNATIONAL KOZMETİK SANAYİ VE TİCARET ANONİM ŞİRKETİ the sum of £300. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of August 2024

Laura Stephens
For the Registrar