

BL O/0917/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3860301

BY PERI ALLURE LTD.

TO REGISTER THE TRADE MARK:

Peri Allure

IN CLASS 3

-AND-

THE OPPOSITION THERETO UNDER No. 439997

BY CHANEL LIMITED

Background and pleadings

1. On 16 December 2022, Peri Allure LTD. (“**the Applicant**”) applied to register the trade mark ‘Peri Allure’ in the UK. Registration is sought for a large variety of cosmetic goods in Class 3. The application was accepted and published for opposition purposes in the Trade Marks Journal on 30 December 2022.

2. On 28 March 2023, Chanel Limited (“**the Opponent**”), opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent relies on its UK trade mark registration ‘ALLURE’, trade mark number 1519696, which was filed on 26 November 1992 and became registered on 11 February 1994. It is registered in respect of a variety of goods in Class 3, however, for the purposes of the opposition, the Opponent only relies on the following goods:

Class 3

Preparations, all for application to the skin; skincare preparations; soaps; perfumes; eau de cologne; toilet water; cosmetics; non-medicated toilet preparations; non-medicated preparations for use in the care of the skin; anti-perspirants; deodorants for use on the person; all included in Class 3.

3. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

4. The Opponent argues that the marks are similar and that the respective goods are identical or similar, giving rise to a likelihood of confusion. It claims that the earlier mark is not only inherently distinctive of the goods for which it is registered, it also claims that its distinctive character has been enhanced as a result of the use made of it.

5. As the earlier mark had been registered for more than five years at the filing date of the contested mark, it is subject to the use conditions pursuant to section 6A of the Act. Accordingly, the Opponent made a statement that it has used its mark in relation to all of the goods relied on.

6. The Applicant filed a defence and counterstatement admitting that *“the Class 3 goods covered by the application are identical and similar to the Class 3 goods*

covered by the earlier mark”, but denying all other claims made.¹ The Applicant requested that the Opponent prove use of the earlier mark in relation to all the goods on which the Opponent relies.

7. Neither party filed submissions during the evidence rounds and only the Opponent filed evidence.

8. A hearing took place before me on 7 March 2024, at which the Opponent was represented by Marisa Broughton of Simmons & Simmons LLP. The Opponent filed a skeleton argument in advance of the hearing. The Applicant, who is not professionally represented, elected not to attend the hearing, and did not file any submissions in lieu of attendance.

9. I make my decision following a careful consideration of the papers before me and the oral submissions made on behalf of the Opponent at the hearing.

Assimilated law

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

Preliminary Issues

Proof of use

11. At the hearing Ms Broughton made submissions in relation to the requirement for the Opponent to prove use of the earlier mark. Those submissions were in line with the wording of paragraph 10 of the Opponent’s skeleton argument, as follows:

“10. Chanel will argue that, in the absence of any evidence, written submissions or attendance at the hearing by the Applicant, it should be pushing at an open

¹ See the Preliminary Issues section of this decision with regard to the Opponent’s claim of enhanced distinctive character.

door when seeking to establish use of the ALLURE Trade Mark at the hearing on the balance of probabilities.”

12. I reject this line of argument. The Applicant expressly requested, in section 7 of its Form TM8 Notice of Defence and Counterstatement, that the Opponent provide “proof of use”. Section 6A(2) of the Act provides that in opposition proceedings, the Registrar shall not refuse to register a trade mark by reason of an earlier trade mark unless the use conditions of the earlier mark are met. Despite the Applicant’s lack of commentary/submissions on the Opponent’s evidence, the onus remains on the Opponent to satisfy this tribunal that it has made genuine use of its mark.²

13. Furthermore, the Applicant is under no requirement in these proceedings to file any evidence at all since Rule 20 of the Trade Mark Rules 2008 (in relation to evidence rounds in opposition proceedings) is not concerned with the position where no evidence is required in order to support the case put forward in a counterstatement.³

14. I therefore proceed with this decision on the basis that the Opponent is required to prove genuine use of its earlier mark. That said, I do not overlook the fact that the Applicant has not made any challenge to the Opponent’s evidence.

Enhanced distinctive character

15. With regard to its claim that the earlier mark benefits from enhanced distinctive character as a result of the use made of it, the Opponent contends that this must be treated as not in issue. Its submissions in this regard are set out in its skeleton argument as follows (and repeated at the hearing):

“11. The Applicant did not deny in its Counter-Statement that the ALLURE Trade Mark has an enhanced distinctive character and did not file any evidence or submissions in these proceedings to contest the enhanced distinctive character of the ALLURE Trade Mark.

12. On the basis that the Applicant did not plead any defence to the enhanced distinctive character of the ALLURE Trade Mark at all, Chanel will argue that the Hearing Officer must treat this claim as not in issue. Further, Chanel will argue

² Section 100 of the Act.

³ See the Appointed Person’s decision: Case BL O/0141/24, paragraph 24.

that if the claim of enhanced distinctive character must be accepted, it would be extraordinary for the Hearing Officer to conclude that the ALLURE Trade Mark has not been put to use as pleaded by Chanel.

13. In this respect, reference is made to the comments of Professor Philip Johnson, sitting as the Appointed Person in Decision O/044/21 SKYCLUB at paragraphs 19 to 29, as to the rules of pleadings.”

16. I note that the reference to the *SKYCLUB* decision with regard to pleadings is to highlight the findings of the Appointed Person that a Hearing Officer cannot treat silence as a denial. The Appointed Person references the position in the Civil Procedure Rules (CPR) that “*where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5))*”,⁴ although he notes that “*this is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3))*”.⁵ He goes on to clarify the position as follows:⁶

“The procedure before neither the registrar nor the Appointed Person is governed by the CPR, but there is a Tribunal Practice Notice (TPN 4/2000) which deals with pleadings and provides a similar rule to the CPR:

19. A defence should comment on the facts set out in the statement of case and should state which of the grounds are admitted or denied and those which the applicant is unable to admit or deny but which he requires the opponent to prove.”

17. I am satisfied that the Applicant’s Form TM8 defence and counterstatement adequately addresses the allegations made, i.e. it addressed the similarity of the marks by denying it; it addressed the identity and/or similarity of the goods by admitting it; it denied there was a likelihood of confusion; it put the opponent to proof of use of its mark; and it put the Opponent on notice that the claim for enhanced distinctiveness

⁴ *SKYCLUB*, paragraph 24.

⁵ *Ibid.*

⁶ *Ibid.*, paragraph 25.

of the ALLURE mark solus (and not in conjunction with Chanel) was also in issue by submitting the following in its counterstatement (my emphasis for clarity):

“5. First, the Opponent relies highly on the repute of “CHANEL” to convey its **enhanced distinctive character** to the mark “ALLURE”. **The earlier mark “ALLURE does not enjoy the same repute of that of “CHANEL”**. [...]

The reputation of a parent company is not enough on its own to establish distinctive character. Therefore, the Applicant requests that the grounds of opposition should be considered for the earlier mark “ALLURE” in its own right without relying on the repute of CHANEL.”

Therefore, to paraphrase the Appointed Person in *SKYCLUB* (at paragraph 28), the parties were ready to proceed on that basis.

18. The Opponent has been put to proof of use and therefore that is the first question that must be determined. Where genuine use is established, it does not automatically follow that a mark enjoys enhanced distinctive character; it is a separate question to consider after genuine use has been established.

Opponent's evidence

19. The Opponent's evidence is provided in the Witness Statement of Laura Jane Duckworth, dated 4 September 2023, with 19 exhibits labelled LJD1 to LJD19. Parts of the witness statement are subject to a confidentiality order made by this Tribunal during the present proceedings, therefore those parts of the witness statement are not open to public inspection.

20. Ms Duckworth is the *“Head of Intellectual Property (Regional) of Chanel Limited (“Chanel UK”), the Opponent in this matter”*, she states that she has been employed by the Opponent since August 2018 and that for the purposes of her witness statement, *“references to “Chanel” refer to the business of Chanel (consisting of a number of affiliated and/or associated companies all of whom trade under the brand “Chanel”) whilst references to Chanel UK [refer to the Opponent] which carries on the Chanel business in the UK. Chanel UK is the ultimate parent company of Chanel.”*

21. The evidence has been filed in response to the Applicant's request for proof of use of the earlier mark and to support the Opponent's claim that the earlier mark has an enhanced distinctive character in respect of the goods relied on. Ms Duckworth states that the *"purpose of this witness statement is to set out the use of ALLURE on its own and as part of composite trade marks by Chanel and its subsidiaries (including Chanel UK) for fragrance, beauty and skincare products,"* and by way of background she states that *"Chanel is a luxury goods company. It makes and sells fashion clothing, jewellery, watches, eyewear (glasses), fragrance, makeup and skincare"*.

22. I have taken all of the evidence into account and shall refer to it to the extent that is necessary throughout this decision.

DECISION

PROOF OF USE

Legislation and case law

23. The relevant statutory provisions are contained in section 6A of the Act as follows:

- "(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.

[...]

- (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.”

24. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*⁷ 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

⁷ [2023] EWCA Civ 1247, paragraph 106.

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. [...] 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 [...].

(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 [...].

(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 [...].

(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 [...]. Internal use by the proprietor does not suffice [...]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter [...]. But use by a non-profit making association can constitute genuine use [...].

(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 [...].

(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 [...].

(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 [...].

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

25. The onus is on the Opponent to file evidence of use of its mark.⁸ The genuine use provision is not there to assess economic success or large-scale commercial use.⁹ In assessing the evidence, I must consider what the evidential picture as a whole shows me, not whether each piece of evidence shows use by itself;¹⁰ that said, where an earlier trade mark satisfies the use conditions in respect of only some of the goods for which it is registered, it shall be treated for the purposes of the proceedings as if it were registered only in respect of those goods.

26. Therefore, the Opponent can rely on its Class 3 goods, only to the extent that the evidence filed establishes that the earlier trade mark had been put to genuine use in respect of those goods within the five years leading up to the date on which the contested trade mark application was filed. **The relevant period in which the**

⁸ Section 100 of the Act.

⁹ *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

¹⁰ *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

Opponent must establish use of the earlier mark is therefore 17 December 2017 to 16 December 2022.

Evidence

27. The witness statement contains the following information, including a table prepared by the witness listing the launch dates of various ‘ALLURE’ products:

“9. The ALLURE Trade Mark was first used in the UK in 1996 on fragrance for women and associated fragranced bath and body products. Over the years, Chanel extended the use of the ALLURE Trade Mark and launched fragrances and fragranced bath and body products for men as well as make up products including lipstick, lip gloss and mascara. **Table 1** sets out the dates of first use of the ALLURE Trade Mark on the various products in the UK.

Table 1 – Dates of First Use		
Trade Mark	Product Description	Date of First Use
Fragrance		
ALLURE	Fragrance for women	1996
ALLURE SENSUELLE	Fragrance for women	2006
ALLURE HOMME	Fragrance for men	1999
ALLURE HOMME SPORT	Fragrance for men	2004
ALLURE HOMME SPORT EAU EXTREME	Fragrance for men	2012
ALLURE HOMME EDITION BLANCHE	Fragrance for men	2008
Bath and Body		
ALLURE	Body lotion	1997
	Hair mist	1999
	Bath gel	1998
	Soap	1998
	Deodorant	1999
ALLURE HOMME	Aftershave lotion	1999
	Aftershave moisturiser	2000
	Deodorant	2000
	Hair and body wash (shower gel)	1999
	Body spray	2023
	Soap	1999
ALLURE HOMME SPORT	Aftershave lotion	2005
	Aftershave moisturiser	2005
	Deodorant spray and stick	2005
	Hair and body wash (shower gel)	2005
	Body spray	2023
ALLURE HOMME BLANCHE	Aftershave lotion	2008
	Aftershave moisturiser	2009
	Shower gel	2010
	Deodorant	2009

Beauty		
ROUGE ALLURE	Lipstick	2006
ROUGE ALLURE VELVET	Lipstick	2011
ROUGE ALLURE VELVET EXTREME	Lipstick	2018
ROUGE ALLURE L'EXTRAIT	Lipstick	2022
ROUGE ALLURE LAQUE	Lip gloss	2020
ROUGE ALLURE INK	Lip gloss	2016
ROUGE ALLURE INK FUSION	Lip gloss	2019
NOIR ALLURE	Mascara	2022

10. The table above includes two products (ALLURE HOMME body spray and ALLURE HOMME SPORT body spray) which fall outside the relevant period for the purposes of this opposition. Nonetheless, this product development illustrates Chanel's continued extension of the ALLURE brand. In this respect, reference is also made to the launch of the NOIR ALLURE mascara in 2022 which, whilst recent, falls within the relevant period and also serves to illustrate the active development of the ALLURE brand."

28. For ease of reference, I shall collectively refer to the products listed in Table 1 of the Witness Statement as the '**ALLURE Goods**' (which is in line with the Witness Statement) and the various signs listed in that table as the '**ALLURE Brands**'.

29. Images of the ALLURE Goods listed in Table 1 are contained in Exhibit LJD3. Although these images are undated Ms Duckworth states that:

"15. [...] Chanel is seen as a timeless, classic brand, therefore the packaging does not usually change and if it [does], only in minor ways.

16. As can be seen from Exhibit LJD3, ALLURE is always presented as a freestanding prominent separate element. When used on fragrances and bath and body products, ALLURE is presented on the product in a much larger typeface in comparison with the other word elements."

30. Some examples taken from Exhibit LJD3 are included below:

Fragrances:



Bath and body:



Bath gel

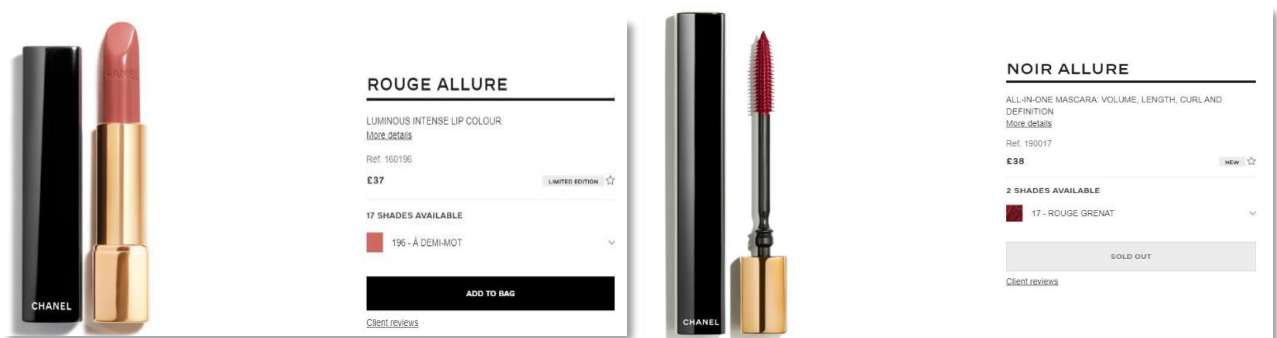
Deodorant

Moisturiser

Soap

Deodorant

Beauty:



Images of the 'beauty' products relate to images of lipsticks, liquid lipsticks and mascara. None of the images show 'ALLURE' on the products themselves, though those goods are sold by reference to signs featuring the word in their product name, as shown in the examples above.

31. At the hearing Ms Broughton submitted the following in relation to Exhibit LJD3 (my emphasis for clarity):

“the point that I wanted to address primarily was how prominent ALLURE is in each case. **It is less obvious with the screenshots for the lipstick because they are not showing their exterior packaging** but certainly for the fragrance, for the deodorant, skincare products and so on, you will see that ALLURE is by far the biggest brand on the packaging”.

32. I asked Ms Broughton if there were any parts of the evidence showing the external packaging of the lipsticks, but there were not, instead she directed me to an example of the outer packaging of the ‘NOIR ALLURE’ mascara as shown below:¹¹



33. Website screenshots taken from the Opponent’s website ‘www.chanel.com’ (dated in 2021) as well as the websites of the following UK retailers: ‘Selfridges’ (dated November 2017¹² and December 2021); and ‘John Lewis’ (dated in 2021 and May 2022), show the following products listed for sale:¹³

- ‘ALLURE’ – *fragrance (parfum; eau de parfum; and eau de toilette)*
- ‘ALLURE HOMME’ – *fragrance (eau de toilette); aftershave lotion; shower gel; deodorant; hair and body wash*
- ‘ALLURE HOMME SPORT’ – *deodorant*
- ‘ALLURE HOMME SPORT EAU EXTREME’ – *fragrance*

¹¹ Exhibit LJD16, page 268, dated 2 September 2022.

¹² The 2017 screenshot shows product listings for ‘ROUGE ALLURE’ and ‘ROUGE ALLURE VELVET’ lipsticks. These products are also listed in the screenshots dated within the relevant period contained in Exhibit LJD4.

¹³ Exhibit LJD4.

- 'ROUGE ALLURE' – *lipstick*
- 'ROUGE ALLURE VELVET' – *lipstick*
- 'ROUGE ALLURE L'EXTRAIT' – *lipstick*

Some images taken from the above product listings are included below:¹⁴



34. Ms Duckworth states that the ALLURE Goods have been sold for many years and have not only been stocked in Chanel's own UK-based stores, but also in major national department store chains; and that in 2022, the ALLURE Goods "*were stocked in over 700 outlets*". Ms Duckworth states that the ALLURE Goods have also been made available for sale online to UK customers via the Opponent's own website (since February 2017) and via UK retailers' websites "*including Boots, John Lewis, Selfridges, Harrods and Harvey Nichols*".¹⁵

35. A large selection of invoices headed 'CHANEL' show sales of ALLURE Goods to national UK retailers, namely:¹⁶ John Lewis, Selfridges & Co., The Fragrance Shop, WP Brown, Debenhams, Fenwick, Frasers, Morleys Department Stores, Harvey Nichols, The Boots Company,¹⁷ and Harrods.

¹⁴ Taken from Exhibit LJD4.

¹⁵ Paragraph 24 of the Witness Statement.

¹⁶ Exhibit LJD5.

¹⁷ Dated 15 December 2017 – just outside of the relevant period.

36. With the exception of three invoices, all are dated throughout the relevant period.¹⁸ The products listed include fragrances, body lotions, aftershave lotions, deodorants, bath and shower gels, soaps, moisturisers, hair mist, hair and body wash, lipsticks, lip gloss and mascara. Included in this evidence is a table prepared by the Opponent which helpfully indicates where those products are listed in the invoices and which of the ALLURE Brands it pertains to. I have included this table in Annex 1 of this decision for ease of reference.¹⁹

37. Ms Duckworth provides wholesale sales figures in Tables 2, 3, 4 and 5 of her Witness Statement as well as paragraph 28 of her statement. They relate to sales of the ALLURE Goods under various ALLURE Brands. Tables 9, 10, 11 and 12 of her Witness Statement contain market share figures. The specific details of these sales and market share figures are subject to a confidentiality order, which means that parts of the next few paragraphs have been redacted from the public version of this decision.

38. Table 2 reflects 'ALLURE' sales in 'fragrance', 'bath and body' and 'beauty' totalling in excess of £100 million from 2015 to 2021. Tables 3, 4 and 5 show a spread of sales across various ALLURE Brands in 'fragrance', 'bath and body' and 'beauty', totalling millions of pounds each year from 2015 to 2021. The sales of 'bath and body' products relate to: body lotion, soap, deodorant, bath gel, hair mist, aftershave lotion, aftershave moisturiser, hair and body wash and shower gel; and the 'beauty' sales relate to lipsticks and liquid lipsticks. Whilst 'fragrance' accounts for the majority of sales income, 'bath and body' and 'beauty' also contribute a significant portion. [REDACTED]

[REDACTED]

[REDACTED]

39. Paragraph 28 of the Witness Statement states that *"the NOIR ALLURE mascara was launched in September 2022 and the wholesale sales figures for the remainder of 2022 was in excess of [REDACTED]."*

40. In terms of market share, Tables 9 and 10 of the Witness Statement show that 'ALLURE' consistently achieved a significant share in the female and male fragrance

¹⁸i.e. invoices dated 9 October 2017 (pages 87 – 90 of Exhibit LJD5); 23 June 2017 (pages 103 – 104 of Exhibit LJD5); and 15 December 2017 (pages 143 – 148 of Exhibit LJD5).

¹⁹ At the hearing I sought clarification from Ms Broughton with regard to what the letters 'RA' stood for in the invoice product descriptions and she confirmed, as I had suspected, that it stands for 'ROUGE ALLURE'.

market in the UK year on year throughout the relevant period. Table 11 shows that 'ALLURE' consistently achieved a significant share in the lip product market from 2020 to 2022. [REDACTED]

[REDACTED] Ms Duckworth states that the figures represent a sizeable proportion of very saturated markets – and based on my own experience as a member of the public who may buy such goods, I agree with Ms Duckworth's evaluation. Table 12 supports and sets the context of the figures shown in Table 11 based on "*Chanel's Rouge Allure*" lip product.²⁰

41. With regard to advertising and promotional activities for:

(1) 'fragrances' and 'bath and body' products:

- (a) Ms Duckworth states that the fragrances and bath and body products bearing the 'ALLURE' trade mark are promoted via "organic" posts on its social media platforms and that it was not necessary to invest in paid-for advertising of the fragrances during the relevant period in light of the high sales figures, and consistent market share achieved without such investment.
- (b) With regard to the promotion of the bath and body products, she states that these lines are ancillary to the corresponding fragrances (i.e. they are scented with the 'ALLURE' fragrances and put on the market with the fragrances) therefore these products benefitted from the promotion of the fragrances themselves. She states that prior to the relevant period, the Opponent had invested in advertising and promoting the 'ALLURE' fragrances and makes reference to its 'celebrity ambassadors' who were appointed to "*raise the profile of the ALLURE Goods*".
- (c) Exhibit LJD6 contains promotional images of Diane Kruger (actress) from 1996 promoting the 'ALLURE' fragrance (see below); Anna Mouglalis (actress) from 2002 promoting the 'ALLURE SENSUELLE'

²⁰ The market share figures originate from 'The NPD Group', a market research company – see paragraph 56 of the Witness Statement and accompanying Exhibit LJD17.

fragrance (see below); and Danny Fuller (professional surfer) from 2012 promoting the 'ALLURE HOMME' fragrance.



(2) 'beauty' products:

(a) Ms Duckworth states that the Opponent (my emphasis for clarity):

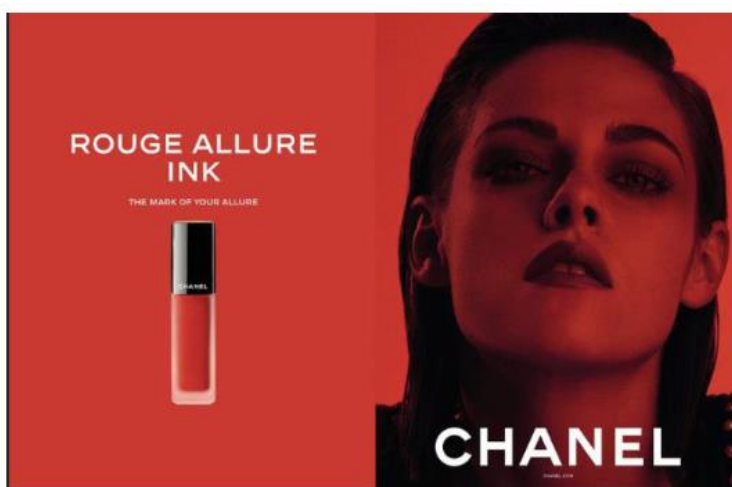
“has invested significant sums in advertising and promoting **lip products** bearing the ALLURE Trade Mark primarily via the use of celebrity ambassadors, paid advertorials, digital advertising on the websites of third parties, “organic” social media, Paid Social advertising on Instagram, X (formerly Twitter), Facebook, Snapchat and YouTube “Out of Home” billboard advertising as well as via its website at www.chanel.com”

(b) Table 8 of the Witness Statement reflects UK advertising spending for 'ALLURE' lip products for 2017, 2018, 2019 and 2022 that is well in excess of a million pounds and a selection of invoices is provided which support advertising spend in 2022 in relation to 'ROUGE ALLURE'.²¹ Ms

²¹ Exhibit LJD15.

Duckworth explains that Chanel did not invest in the advertising of lip products bearing the ALLURE trade mark in 2020 and 2021 due to the impact of the COVID-19 pandemic.

- (c) Exhibit LJD6 contains promotional images of: Kristen Stewart (actress) from 2013 promoting the 'ROUGE ALLURE INK' lipstick with the tagline "*the mark of your allure*" (see below); Anna Ewers (model) and Blesnya Minher (model) both images from 2022, promoting the 'ROUGE ALLURE L'EXTRAIT' lipstick.



- (d) Evidence of the advertorial campaigns run throughout 2021 and 2022 relate to 'shop the look' and 'product reviews' featuring images of a variety of the Opponent's 'ROUGE ALLURE' lip products, published in various UK publications including Metro, Echo and Evening Standard. The evidence shows that the collective circulation and readership figures for these various publications were into the millions, with Metro alone having circulation figures in excess of 1 million and readership figures in excess of 4 million; and the Evening Standard having circulation figures in excess of 800,000 and readership figures in excess of 25 million.
- (e) In 2017, 2018, 2019 and 2022 the Opponent ran digital marketing campaigns for its 'ROUGE ALLURE' lipsticks which included the publishing of digital advertisements on the UK websites of publications such as Vogue and Marie Claire. In 2022, one such UK campaign alone generated "*more than 5,000,000 ad and page impressions*".²²

²² Exhibit LJD8 and paragraph 36 of the Witness Statement.

- (f) In relation to paid social advertising, Ms Duckworth explains that ‘paid social’ means that target audiences are shown an advert even if they do not follow or subscribe to Chanel’s official social media advertising. She states that *“paid social is especially important in relation to the ALLURE lip products as these goods can be purchased online and the advertising allows Chanel to direct users directly to their website”*,²³ and posits that it is the future of advertising in the luxury fashion and beauty sectors since traditional print advertising has seen a relative demise.²⁴ A UK campaign for its ‘ROUGE ALLURE L’EXTRAIT’ lip product in 2022 reached an audience in excess of 12.5 million and garnered in excess of 65 million views.
- (g) Ms Duckworth explains that the Opponent’s “organic” social media strategy involves the promotion of its ALLURE Goods on its social media platforms. Some example posts promoting its ‘ROUGE ALLURE’ lip products during the relevant period are included in Exhibit LJD14. Chanel’s account on Instagram alone had in excess of 1.1 million followers from the UK in 2022, and Ms Duckworth refers to an online article published on ‘fashionunited.uk’ based on research conducted by a market research company, highlighting that Chanel was the number 1 luxury brand on social media in 2016.²⁵ She intimates that Chanel is a social media powerhouse and as a consequence concludes that *“this demonstrates that Chanel’s ALLURE campaigns [on its social media platforms] reach millions of consumers and result in millions of views and “likes”.*”

Form of the mark

42. The Opponent may rely on use of a mark *“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”*.²⁶ Put plainly, if the form in which it is used alters the distinctive

²³ Paragraph 37 of the Witness Statement.

²⁴ Ms Duckworth provides research data in Exhibit LJD9 to support this statement.

²⁵ Exhibit LJD 11.

²⁶ Section 6A(4)(a) of the Act.

character of the mark, then that form is not a 'variant form' and use of such sign cannot be relied on to establish genuine use of the registered trade mark.

43. The purpose of this provision is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. Where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.²⁷

44. The correct approach in assessing whether a mark has been used in a 'variant form' requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences).²⁸

45. In *Colloseum Holdings AG v Levi Strauss & Co.*,²⁹ the CJEU stated (my emphasis for clarity):

“[...] as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, [Case C-353/03], the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.”³⁰

46. The mark for which genuine use must be shown “*need not necessarily have been used independently [...] it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by*

²⁷ See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

²⁸ See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 13.

²⁹ Case C-12/12

³⁰ *Ibid.*, paragraph 32. It is noted that in the ‘*Nestlé*’ case (referenced by the CJEU), the court was asked to express a view on the rules concerning the distinctive character of trade marks. In *Nestlé* the dispute turned on whether the advertising slogan ‘*HAVE A BREAK*’ was able to acquire distinctive character as a result of its use as a part of the registered trade mark ‘*HAVE A BREAK ... HAVE A KIT KAT*’. The nub of the legal dispute was the question whether this kind of use of a sign can result in distinctiveness for trade mark purposes or whether it precludes recognition as a trade mark.

*the mark [...], as originating from a given undertaking.*³¹ In other words, “a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must [nevertheless] continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’”.³²

47. Indeed, in *Lactalis McLelland Limited v Arla Foods AMBA*,³³ Professor Phillip Johnson, sitting as the Appointed Person, in considering the correct approach to the ‘variant form’ test, stated:

16. [...] the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

48. Clearly, where a mark has been used exactly as registered the Opponent will be able to rely upon this to demonstrate use of the mark. However, where the mark has been used in combination with additional matter or in a variant form, it is necessary to assess whether this is acceptable use of the mark as registered or an acceptable variant of the mark.

49. The ‘ALLURE’ mark is registered as a word only mark, as such the protection afforded by the registration is not limited by any features such as typeface or capitalisation appearing on the Register. The stylisation of the word ‘ALLURE’ shown in evidence is minimal and does not alter the distinctive character of the word itself.

50. However, the evidence shows that ‘ALLURE’ is a sub-brand of ‘Chanel’ and that it is used in conjunction with that house brand; and ‘ALLURE’ has also been used as

³¹ See *Nestlé*, Case C-353/03, paragraphs 27 to 30 – which are the paragraphs the CJEU makes reference to in *Colloseum* (Case C-12/12). Although *Nestlé* addresses ‘use’ through which a trade mark acquires distinctive character, as the CJEU pointed out in *Colloseum*, at paragraphs 33 – 34, the criterion of use is still the same i.e. the requirements that apply to verification of the genuine use of a mark, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration.

³² *Colloseum*, Case C-12/12, paragraph 35.

³³ BL O/265/22

part of various composite signs such as 'ALLURE HOMME' and 'ROUGE ALLURE' and that the composite signs are always in conjunction with the house brand 'Chanel'.

51. In her Witness Statement, Ms Duckworth submits that:

"11. The use of ALLURE SENSUELLE, ALLURE HOMME, ALLURE HOMME SPORT, ALLURE HOMME SPORT EAU EXTREME, ALLURE HOMME EDITION BLANCHE, ROUGE ALLURE, ROUGE ALLURE VELVET, ROUGE ALLURE VELVET EXTREME, ROUGE ALLURE L'EXTRAIT, ROUGE ALLURE LAQUE, ROUGE ALLURE INK, ROUGE ALLURE INK FUSION and NOIR ALLURE all constitute use of ALLURE on the basis that ALLURE is a freestanding, distinctive and prominent component of the mark and operates as the sole indicator of the trade origin of the goods concerned.

[...]

14. ALLURE is a clearly visible freestanding element within the marks NOIR ALLURE, ALLURE SENSUELLE, ROUGE ALLURE L'EXTRAIT and ROUGE ALLURE INK FUSION and therefore retains its independent distinctive role within such marks."

52. At the hearing Ms Broughton submitted that: *"some evidence was filed in exhibits 1 and 2 about how some of the additional elements that are used in combination with the ALLURE trade mark are either commonly used in the field or are descriptors."*

53. In this regard I note that in her statement, Ms Duckworth states that:³⁴

- (1) *"the words 'HOMME', 'HOMME EDITION', 'ROUGE', 'VELVET', 'INK' and 'LAQUE' are used by Chanel as descriptors"*. She provides dictionary evidence³⁵ to confirm the definitions of: 'HOMME' – the French word for man; 'EDITION' – a particular version; 'ROUGE' – red or reddish cosmetics for adding colour to the cheeks or lips; 'VELVET' – a fabric with a thick, close, soft pile or anything with a smooth soft surface; 'INK' – coloured liquid for writing or printing; 'LAQUE' – this dictionary entry obtained from the Cambridge Dictionary was in French, however, having reviewed the Oxford English Dictionary, I have ascertained that it refers to 'lacca' – a dark red resinous

³⁴ Paragraphs 12 and 13 of the Witness Statement.

³⁵ Exhibit LJD1.

substance and/or 'laquer' – a form of varnish and another word for fixative hairspray.

- (2) *“the words ‘ROUGE’, ‘HOMME’, ‘SPORT’, ‘EXTREME’, ‘BLANCHE’, ‘VELVET’, ‘INK’ and ‘LAQUE’ are commonly used in the perfume and cosmetics industries”* and as such she concludes that they *“have no or very limited distinctive character for the goods at issue”*. The supporting evidence³⁶ consists of screenshots of goods of third parties such as ‘Dior’, ‘Versace’, ‘Ralph Lauren’, ‘Armani’, ‘Guerlain’, ‘Yves Saint Laurent’, ‘Laura Mercier’, ‘Tom Ford’, ‘Gucci’, ‘Lancôme’, ‘Rimmel’, ‘Fenty Beauty’, ‘Ciaté’, ‘MAC’, ‘Revlon’ and ‘L’Oréal’ to name but a few, showing use of the words: ‘HOMME’ to denote fragrances for men and ‘SPORT’ to denote a variant of men’s fragrances; ‘EXTREME’ to denote a variant of a fragrance as well as a variant of lip products, mascara and eyeliner; ‘BLANCHE’ in relation to fragrance variants; ‘ROUGE’ in relation to lip products, blushers for the cheeks and eye shadows (in some instances to denote the colour of the products themselves); ‘VELVET’, ‘INK’ and ‘LAQUE’ in relation to lip products such as lipsticks and lip liners to denote the finish, texture and/or lasting power of those products; as well as ‘INK’ in relation to foundation for the face and ‘LAQUE’ for hairspray’.

54. I am satisfied that the evidence presented sufficiently supports a finding that the words ‘HOMME’, ‘HOMME EDITION’, ‘ROUGE’, ‘VELVET’, ‘INK’, ‘LAQUE’, ‘SPORT’, ‘EXTREME’ and ‘BLANCHE’ are either commonly used in the perfume and cosmetics industries or are descriptors in relation to perfumes and cosmetics and therefore these words are unlikely to be accorded much weight when added to the word ‘ALLURE’ in relation to the goods at hand.

55. As the average consumer myself, I am also aware that the word ‘ROUGE’ means red in French and that the word ‘NOIR’ means black,³⁷ and would be seen as descriptive and/or suggestive words in relation to cosmetics, particularly ‘ROUGE’ in

³⁶ Exhibit LDJ2.

³⁷ As per the examination guide of the Registry’s ‘Manual of Trade Mark Practice’, I note that French is one of the most widely understood European languages in the UK therefore most UK consumers are deemed to have an appreciation of common French words; and that the average UK consumer will be familiar with common non-English descriptors.

relation to cosmetics such as cheek and lip products (which typically are red or have red undertones) and 'NOIR' in relation to mascaras which are typically black.

56. Use of 'ALLURE' as part of the composite signs ALLURE HOMME, ALLURE HOMME SPORT, ALLURE HOMME SPORT EAU EXTREME, ALLURE HOMME EDITION BLANCHE, ROUGE ALLURE, ROUGE ALLURE VELVET, ROUGE ALLURE VELVET EXTREME, ROUGE ALLURE LAQUE, ROUGE ALLURE INK, and NOIR ALLURE is also use upon which the Opponent can rely since 'ALLURE' continues to be indicative of the origin of the relevant goods and has an independent distinctive role within those composite marks.

57. Taking all the foregoing into account and having regard to the evidence presented, I consider that, notwithstanding 'ALLURE', and the 'ALLURE' composite signs (listed in the preceding paragraph) are used in conjunction with 'Chanel', they continue to be perceived as indicative of trade origin and therefore the use presented is use upon which the Opponent can rely.

Conclusions on the proof of use evidence

58. I am satisfied that the evidence relates to use of the earlier mark in the UK during the relevant period and that such use is genuine. I must now consider whether it is sufficient to show use in relation to the full breadth of the specification relied on, or only some of those goods, whilst also bearing in mind that the Applicant has made no challenge to the evidence presented.

59. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,³⁸ Mr Geoffrey Hobbs Q.C. as the Appointed Person stated (my emphasis for clarity):

“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.”

³⁸ BL O/345/10.

60. The *Titanic Spa* case sets out how to approach the framing of a fair specification as follows (my emphasis for clarity):³⁹

- “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;
- iv) [...] the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used;
- 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**

³⁹ *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), paragraph 47.

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.”

61. In its skeleton argument the Opponent submits the following:

“The specification relied upon in the opposition is fair on the basis that Chanel has demonstrated significant use of the ALLURE Trade Mark in the UK during the Relevant Period in connection with each of the ALLURE goods [...]”.

62. I agree with the Opponent’s summation. My reasoning is set out below:

- (1) “Preparations, all for application to the skin; skincare preparations; soaps; perfumes; eau de cologne; toilet water; non-medicated toilet preparations; non-medicated preparations for use in the care of the skin; anti-perspirants; deodorants for use on the person; all included in Class 3”

The Opponent will plainly be able to rely on the above terms due to its use of the earlier mark on the following goods: fragrances (including parfum, eau de parfum and eau de toilette), hair mist, aftershave lotion, aftershave moisturiser, body lotion, soap, hair and body wash, shower gel, bath gel and deodorant.

- (2) “Cosmetics; all included in Class 3”

(a) The term ‘cosmetics’ (insofar as it relates to goods as opposed to medical procedures) refers to substances and products intended for application to the skin, hair, face and nails, typically to clean, fragrance, beautify or improve appearances (such as improving the complexion).⁴⁰ ‘Cosmetics’ can therefore encompass not only make-up products but also other beauty preparations such as face creams, serums, nail varnishes etc., as well as other personal care products for the skin, hair, face and nails including hand creams, body lotions, hair styling products, shampoos and

⁴⁰ See the entries for ‘cosmetic’ in the Oxford English Dictionary.

conditioners, fragrances, deodorants and body cleansing products, such as soap, shower gels and facial cleansers.

- (b) At the hearing Ms Broughton made the following submission (my emphasis for clarity):

“In total there have been 13 sub-brands that are used in combination with the ALLURE trade mark, covering everything from fragrances to hair mists, soaps, deodorants, lipstick, lip gloss and most recently mascara. One of the key points that we want to make is that the ALLURE trade mark has many brand extensions and these are not just historical. **This is a very active brand that continues to develop.**”

- (c) In this regard I note that the ‘NOIR ALLURE’ mascara was launched just before the end of the relevant period (although it is likely that the product would have been in development for quite some time before its launch); and that new product lines were added (albeit after the relevant period) to the ALLURE HOMME and ALLURE HOMME SPORT ranges (again, products that were likely to have been in development before the end of the relevant period).
- (d) Although the ‘ROUGE ALLURE’ lip products were first launched in 2006, later variants have continued to be added to the range, most notably the majority of the existing variants were added during the relevant period; in addition, the advertising spend in recent years (particularly during the relevant period) has focused on the promotion of the ‘ROUGE ALLURE’ products.
- (e) It is apparent from the evidence that the Opponent continues to expand the range of goods sold under the ‘ALLURE’ brand, therefore I see no justifiable reason to cut down the term “*cosmetics*” to those precise goods on which the mark has been used, as this “*would strip the proprietor of protection for all goods 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.*⁴¹ I also bear in mind that “*a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods covered by the registration*”,⁴² and evidence showing that a proprietor continues to add new product lines under the brand is all the more a compelling reason not to “*describe the use made by the trade mark proprietor in the narrowest possible terms.*”⁴³

- (f) Therefore, I find that the Opponent may rely on the broad term “*cosmetics; all included in Class 3*” due to the use shown in relation to the following cosmetic goods: lipsticks, lip glosses, mascara, fragrances, hair mist, aftershave lotion, aftershave moisturiser, body lotion, soap, hair and body wash, shower gel, bath gel and deodorant.

63. In conclusion, the Opponent can rely on the full breadth of its specification.⁴⁴

CLAIM UNDER SECTION 5(2)(b) OF THE ACT

Legislation and Case Law

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

“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”.

⁴¹ See *Titanic Spa*.

⁴² *Ibid.*

⁴³ *Ibid.*

⁴⁴ i.e. the goods contained in the specification relied on for the purposes of this opposition, as detailed in paragraph 2 of this decision.

65. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v 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

66. The goods to be compared are shown in the table below:

Opponent's goods
Preparations, all for application to the skin; skincare preparations; soaps; perfumes; eau de cologne; toilet water; cosmetics; non-medicated toilet preparations; non-medicated preparations for use in the care of the skin; anti-perspirants; deodorants for use on the person; all included in Class 3.
Applicant's goods
Cosmetics; Skincare cosmetics; Moisturisers [cosmetics]; Cosmetics and cosmetic preparations; Hair cosmetics; Skin fresheners [cosmetics]; Cosmetics for eye-lashes; Cosmetics for suntanning; Organic cosmetics; Anti-aging moisturizers used as cosmetics; Lip cosmetics; Nail cosmetics; Non-medicated cosmetics; Natural cosmetics; Skin moisturizers used as cosmetics; Cosmetics preparations; Mousses [cosmetics]; Make-up palettes containing cosmetics; Tanning oils [cosmetics]; Tanning gels [cosmetics]; Cosmetics in the form of lotions; Facial creams [cosmetics]; Beauty care cosmetics; Colour cosmetics; Self-tanning preparations [cosmetics]; Cosmetics for animals; Eyebrow cosmetics; Tanning preparations [cosmetics]; Suncare lotions [for cosmetic use]; Decorative cosmetics; Multifunctional cosmetics; Eye cosmetics; Milks [cosmetics]; Body creams [cosmetics]; After-sun oils [cosmetics]; Skin masks [cosmetics]; Cosmetics for eye-brows; Tanning milks [cosmetics]; Functional cosmetics; Suntan oils [cosmetics]; Facial gels [cosmetics]; Skin care cosmetics; Fluid creams [cosmetics]; Cosmetics for children; Suntan lotion [cosmetics]; Non-medicated cosmetics and toiletry preparations; Humectant preparations [cosmetics]; Emollient preparations

[cosmetics]; Cosmetics in the form of creams; Powder compacts [cosmetics]; Sun-tanning preparations [cosmetics]; Cosmetic hair lotions; Suntanning oil [cosmetics]; Colour cosmetics for the skin; After-sun milk [cosmetics]; After-sun milks [cosmetics]; Cosmetic moisturisers; Sunscreens [for cosmetic use]; Cosmetic creams and lotions; Bath powder [cosmetics]; Skin recovery creams [cosmetics]; Night creams [cosmetics]; Body gels [cosmetics]; Body and facial creams [cosmetics]; Cosmetic products in the form of aerosols for skincare; Sun blocking lipsticks [cosmetics]; Cosmetics for use on the skin; Lip stains [cosmetics]; Sunscreen [for cosmetic use]; Cosmetic soaps; Sunscreen creams [for cosmetic use]; Cosmetic creams; Creams (Cosmetic -); Body care cosmetics; Cosmetics in the form of powders; Cosmetics for the use on the hair; Cosmetics containing keratin; Hair care lotions [for cosmetic use]; Cosmetic skin fresheners; Dyes (Cosmetic -); Cosmetic dyes; Cosmetics in the form of oils; Beauty lotions; Facial lotions [cosmetic]; Cosmetic facial lotions; Cosmetics containing panthenol; Nail paint [cosmetics]; Cosmetic suntan lotions; After-sun lotions [for cosmetic use]; Perfume oils for the manufacture of cosmetic preparations; Skin care lotions [cosmetic]; Nail hardeners [cosmetics]; Anti-aging creams [for cosmetic use]; Tissues impregnated with cosmetics; Nail tips [cosmetics]; Colour cosmetics for children; Nail primer [cosmetics]; Sun protecting creams [cosmetics]; Cosmetic products for the shower; Anti-ageing creams [for cosmetic use]; Smoothing emulsions [cosmetics]; Skin cleansers [cosmetic]; Perfumed powders [for cosmetic use]; Liners [cosmetics] for the eyes; Skin creams [for cosmetic use]; Cosmetic creams for the skin; Skin creams [cosmetic]; Body and facial gels [cosmetics]; Cosmetic oils; Moisturising skin lotions [cosmetic].

67. Clearly there are terms that are identical to each other, for example, the term “*cosmetics*” appears in both parties’ specifications; and “*preparations, all for application to the skin*” in the Opponent’s specification, is identical to “*moisturising skin lotions [cosmetic]*” in the Applicant’s specification on the principle outlined in *Gérard Meric v Office for Harmonisation in the Internal Market*,⁴⁵ in which the General Court held to the effect that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application and vice versa.

68. The Applicant has conceded that “*the Class 3 goods covered by the application are identical and similar to the Class 3 goods covered by the earlier mark*”, I therefore proceed on the basis of this concession i.e. that the goods are either identical and/or similar, bearing in mind that even where the goods are only similar, any degree of

⁴⁵ Case T- 133/05

similarity, even a low degree, is sufficient in order to consider a likelihood of confusion.⁴⁶

The average consumer and the nature of the purchasing act

69. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods in question. It is therefore necessary to determine who the average consumer of the goods is, and how the consumer is likely to select them.

70. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word 'average' merely denotes that the person is typical,⁴⁷ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.⁴⁸

71. The average consumer of the respective goods will be members of the general public.

72. The goods will range in price but are, for the most part, likely to be relatively inexpensive and will generally be purchased on a regular basis, as they are non-durable, and used (mostly) as part of a daily personal care regimen. In selecting the goods, the average consumer will take various factors into account such as cost, ingredients of the products, and whether the goods meet their specific needs and preferences. These considerations will apply even where the goods are of low cost.

73. The goods are likely to be selected visually, through a range of retail outlets, through websites, catalogues etc., although I do not discount that the goods may be selected orally by way of requests to staff. Therefore, the way the respective marks look is of primary importance, but the way they sound must also be taken into account.

⁴⁶ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49.

⁴⁷ *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), paragraph 60

⁴⁸ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

74. The purchasing process is likely to be more casual than careful and will not require an overly considered thought process. The average consumer will not typically demonstrate more than a medium level of attention when selecting the goods.

Comparison of marks

75. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union stated in *Bimbo SA v OHIM*,⁴⁹ 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.”

76. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the 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.

77. The marks being compared are shown below:

Earlier mark	Contested mark
ALLURE	Peri Allure

Overall impression

78. Both marks are word only marks, therefore the overall impression of each mark rests solely in the word/words making up the marks.

⁴⁹ Case C-591/12P, at paragraph 34.

79. The Opponent's witness states that the word 'peri' means 'about' or 'around' and serves as a prefix to qualify the following word,⁵⁰ and provides examples of words which include this prefix such as 'perinatal', 'perimenopause' and 'periurban'.⁵¹ As such, the Opponent submits that this element of the contested mark is non-distinctive or at best weakly-distinctive in connection with the Class 3 goods at issue.⁵²

80. The Opponent refers to Exhibit LJD19 to highlight its point that 'peri' is specifically used in connection with Class 3 goods. This evidence comprises of examples of Class 3 goods (namely various cosmetic creams), sold under the brands 'NASSIFMD', 'BIODERMA', 'VICHY' and 'URIAGE'. Whilst this evidence shows that 'peri' is used in connection with Class 3 goods, it is nevertheless used in the ordinary way in which that prefix is intended to be used i.e. to mean 'about' or 'around'. This is because in each instance, the term 'peri' is not used in conjunction with the brand name itself (the examples are not 'PERI NASSIFMD' nor 'PERI VICHY' for example), but rather 'peri' is used to describe where or when to apply the product. For example, a 'peri-orbital' eye cream for use around the eyes (orbital referring to the area around the eyes); 'peri-oral' lip creams (oral meaning relating to the mouth) for "*irritations around the mouth*" and "*soothing & repairing [the] mouth area*"; a 'revitalizing' facial cream directed for use during 'peri-menopause'.

81. Whilst I acknowledge that (amongst other things) 'peri' can refer to the prefix meaning 'about' or 'around', I fail to see how this renders it non-distinctive when used in conjunction with the word 'ALLURE' in relation to Class 3 goods, and the evidence presented does not assist me in reaching the conclusion favoured by the Opponent.

82. Even if 'peri' is perceived as a prefix to the ordinary word 'allure' (the way in which it forms a prefix to the ordinary words 'natal', 'menopause', 'oral', 'orbital' etc.), this does not render it negligible, especially when considering that the purpose of a prefix is to modify the meaning of the word it is added to.

83. In any event, even if an element of a mark is non-distinctive and/or descriptive,

⁵⁰ Paragraph 58 of the Witness Statement.

⁵¹ Exhibit LDJ18 – dictionary definitions.

⁵² Paragraph 52 of the Opponent's Skeleton Argument.

that does not of itself render it negligible or invisible,⁵³ whether a consumer attaches any weight to such an element or not does not negate its existence.

84. The overall impression of the contested mark rests in the combination of the words 'PERI' and 'ALLURE' and I do not negate the presence of the word 'PERI' in favour of making a comparison solely on the basis of the word 'ALLURE' because I do not consider it to be a negligible element of the mark.

Visual comparison

85. The word 'ALLURE' is wholly reproduced in the contested mark and therefore this element is identical to the earlier mark. However, the marks are visually similar overall to a medium degree owing to the presence of the word 'PERI' in the contested mark, which represents a point of dissimilarity between the two competing marks which sits at the beginning of the contested mark and would not go unnoticed.

Aural comparison

86. The word 'PERI' in the contested mark represents a point of aural dissimilarity between the competing marks, however its presence in the contested mark does not alter the pronunciation of the second word 'ALLURE'. Therefore 'ALLURE' will be pronounced identically in the respective marks. Overall, I assess the degree of aural similarity as medium.

Conceptual comparison

87. The word 'ALLURE' is an ordinary word meaning something or someone with an attractive pull/enticement. I think this would be commonly understood by the average consumer. The parties are in agreement on the meaning of that word at least and I consider both marks share the same concept with regard to that word.

88. The Applicant submits that 'PERI' means "*a beautiful and graceful supernatural being/fairy*" according to the various dictionary entries listed in its counterstatement, including one from the "*Oxford dictionary*"; accordingly it submits that 'PERI ALLURE'

⁵³ *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22.

refers to the attractive power of a 'PERI' and therefore the distinctive and dominant part of the contested mark is 'PERI'.

89. The Opponent's submissions are insistent that 'PERI' would be understood by a significant proportion of the relevant public as a prefix, and denies that the average consumer would understand it as a reference to a fairy, or at least in the event that the word does mean 'fairy', it submits that *"this does not preclude a finding that a significant part of the relevant public will also understand the term to mean 'about or 'around'. [...] The fact that a dictionary definition exists in the English language has no bearing on whether the average UK consumer is familiar with that definition."*⁵⁴

90. Whilst I was not aware that 'PERI' has an additional meaning of 'fairy', I acknowledge that it is referenced as such in the Oxford English Dictionary.⁵⁵ However, I am far from satisfied that the average consumer of the goods at hand would be aware of this. I would need evidence beyond a dictionary entry to convince me, contrary to my own experience, that 'PERI' would be commonly understood by the average consumer as meaning 'fairy'.

91. It is certainly my understanding that 'PERI' is a prefix meaning about or around, but again, I am not convinced that this would be commonly understood by the average consumer, especially when seen out of context i.e. not in conjunction with a qualifying word. For example, a consumer of cosmetics (who understands the meaning of the prefix 'peri') is not going to think that 'peri-allure' means that the cosmetic product is for application 'about' or 'around' their 'allure' (that is nonsensical) in the same way they would understand a lip cream indicated for 'peri-oral' use is for use around the mouth.

92. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁵⁶ I have nothing before me to convince me that any of the meanings referenced above would be immediately grasped by a significant proportion of the average consumer of the relevant goods. Indeed, it may even be perceived as not having any particular meaning at all. Either way, it is an element which is not

⁵⁴ Paragraphs 53 and 55 of the Opponent's skeleton argument.

⁵⁵ The entry in the Oxford English Dictionary being *"a beautiful or graceful person; a fairy"*.

⁵⁶ This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

present in the earlier mark and therefore represents a point of difference between the two competing marks.

93. I note that even if the most plausible possibility is that a significant proportion of the average consumer perceives it as a prefix, the primary meaning of the word ‘allure’ is not altered by the addition of the prefix, and the overall conceptual message of the contested mark would, in that instance, be ‘about/around allure’, which is not significantly different to the meaning of ‘allure’.

Distinctive character of the earlier mark

94. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. This is because the more distinctive the earlier mark, the greater the likelihood of confusion may be,⁵⁷ although it is the distinctive character of a component that is similar between the marks that is particularly relevant.⁵⁸

95. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,⁵⁹ 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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

⁵⁷ *Sabel v Puma*.

⁵⁸ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38 and 39.

⁵⁹ Case C-342/97.

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).”

96. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

97. The word ‘ALLURE’ is an ordinary word, which when seen in the context of the Opponent’s goods alludes that they may have the effect of making someone alluring either through their appearances (by the application of make-up for example) or through their scent - for example, a person’s scent can be said to be ‘alluring’. It is therefore inherently distinctive to a low to medium degree.

98. The inherent distinctive character of a mark can however be enhanced by virtue of the use that has been made of it and the Opponent has made a claim to that effect.

I note the following from the Opponent’s evidence:

- (1) the Opponent started using the ‘ALLURE’ brand in the UK in 1996 in relation to fragrances, and has since continued to add various cosmetic products to the line over the years;
- (2) the Opponent has not only expanded its product range it has also continued to expand the ‘ALLURE’ brand by introducing various brand extensions, such as the ALLURE HOMME fragrance for men which was launched in 1999 and most recently the NOIR ALLURE mascara launched in September 2022;
- (3) the images of the products show ‘ALLURE’ quite prominently on the packaging of the fragrances and bath and body products with the house brand ‘Chanel’ having a more discreet placement, for example etched on the fragrance bottle top. Although it was submitted that the lip products are sold with an outer packaging I have no evidence of this, only evidence of the exterior packaging of the ‘NOIR ALLURE’ mascara which shows that brand

as the most prominent. That said, the evidence shows that the lip products are marketed as 'ROUGE ALLURE';

- (4) sales of its 'ALLURE' fragrances, beauty, and bath and body products totalled in excess of £100 million from 2015 to 2021;
- (5) the products are put on the market not only via the Opponent's own UK stores and through their own website, but also via national, large-scale retailers such as John Lewis as well as being made available for sale online via those retailers (supporting invoices show consistent wholesale sales of its ALLURE Goods to retailers during the relevant period). In 2022, the ALLURE Goods were stocked in over 700 outlets;
- (6) though in most recent years, and certainly within the relevant period, the Opponent shifted the focus of its paid promotional activities onto its make-up products, it nonetheless continued to promote its other 'ALLURE' products through its social media platforms. Part of its advertising campaigns have involved appointing celebrity ambassadors to raise the profile of the goods (specifically the fragrances and the lip products) and the evidence shows it used various national advertising streams with significant reach throughout the UK, for its advertising campaigns;
- (7) as a result of its sales and promotion, the evidence shows that the 'ALLURE' products consistently achieved a significant market share despite the saturation of the market for those goods. Although the bath and body products are described by the Opponent as ancillary products to its fragrances, these products still achieved a notable share of the market due to their association with the fragrances since they are put on the market and sold adjacent to the fragrances themselves.

99. Having taken all the evidence into account I conclude that, by the filing date of the contested mark, the distinctiveness of the earlier mark had been enhanced to a medium to high degree through the use made of it by the Opponent in the UK. I make this finding notwithstanding the evidence shows that 'ALLURE' is a sub-brand of Chanel. Just because a mark is a sub-brand, does not mean that its distinctiveness cannot be enhanced through the use made of it.

Conclusions on likelihood of confusion

100. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁶⁰ I must also consider the average consumer of the services, the nature of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.⁶¹

101. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.⁶² The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.⁶³

102. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods bearing the later mark come from the same undertaking or from an economically linked undertaking.⁶⁴ For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.⁶⁵

103. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are

⁶⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

⁶¹ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

⁶² *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

⁶³ See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

⁶⁴ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

⁶⁵ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

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).”

104. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“12. 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. For example, one category of indirect

confusion which is not mentioned is where the sign complained of incorporates the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licensing).”

105. I have found that the respective goods are identical and/or similar and that the average consumer is a member of the general public who will pay a medium degree of attention when selecting the goods.

106. With regard to the comparison of the marks, notwithstanding the identity of the word ‘ALLURE’, the marks are visually and aurally similar to a medium degree overall, owing to the presence of the word ‘PERI’ in the contested mark.

107. The marks share the same concept with regard to the word ‘ALLURE’ and the presence of the word ‘PERI’ in the contested mark does not alter the meaning of the word ‘ALLURE’. Whilst there is disagreement between the parties about the conceptual meaning of the word ‘PERI’, it is the perception of the average consumer that is of importance and there is nothing before me to suggest that a significant proportion of the average consumer will immediately grasp a particular concept in relation to the word ‘PERI’. In any event, a conceptual difference in this case is not enough to neutralise the visual and aural similarities between the marks,⁶⁶ especially when taking into account that the selection process of the goods is primarily visual and has an aural element.

108. I have found that the earlier mark is inherently distinctive to between a low and medium degree and that the distinctiveness of the mark has been enhanced to between a medium and high degree because of the use made of it by the Opponent.

109. Certainly the Opponent’s evidence has shown that the Opponent itself has launched various iterations of the ‘ALLURE’ brand by adding descriptive and/or non-distinctive elements to the mark placed either after it, such as ‘ALLURE HOMME’ or before it such as ‘ROUGE ALLURE’. However, I do not consider ‘PERI’ to be a descriptive and/or non-distinctive element that would go unnoticed by the average

⁶⁶ See the decision of the Appointed Person in *Diramode S.A. v Richard Turnham and Linda Ann Turnham* (‘PINKIES’ trade mark), BL O/566/19, paragraphs 28 and 29.

consumer. Therefore I rule out the possibility of making a finding of direct confusion, particularly when taking into account that 'PERI' forms the first element of the mark.

110. Taking all the above factors into account, I consider that the average consumer, or a significant proportion thereof, would be indirectly confused as to the origin of the goods at hand. This is because the average consumer will clearly see that the later mark is different from the earlier mark, but also it incorporates the earlier mark (whose distinctive character has been enhanced through use) in such a way that is not inconsistent with the way in which the Opponent incorporates 'ALLURE' into its various sub-brands (e.g. by placing 'ALLURE' as the second element). Consequently, I find that this will lead consumers to believe that there is an economic link between the parties, either because they believe that the identical/similar goods have been co-branded; or because they believe that 'PERI ALLURE' is another sub-brand of 'ALLURE' because of the shared element of enhanced distinctive character.

OUTCOME

111. The opposition under section 5(2)(b) of the Act is successful. Subject to any appeal, contested trade mark application number 3860301 shall be refused registration.

COSTS

112. The Opponent has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Opponent the sum of £4,400 based on the contributory scale set out in Tribunal Practice Notice 1/2023. The sum is calculated as follows:

Official fee for filing Form TM7	£100
Preparing the Statement of Grounds	£300
Preparing evidence	£2,000
Preparing for and attending a hearing	£2,000
TOTAL	£4,400

113. I therefore order Peri Allure LTD. to pay Chanel Limited the sum of **£4,400**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 18th day of September 2024

Daniela Ferrari

For the Registrar

Annex 1

Table contained in Exhibit LJD5

Trade Mark	Product Description	Exhibit LJD5 page no.
Fragrance		
ALLURE	Fragrance for women	83, 86, 89, 94, 96, 97, 99, 100, 103, 108, 116, 117, 119, 123, 125, 132, 141, 149
ALLURE SENSUELLE	Fragrance for women	89, 95, 96, 99, 100, 103, 108, 118, 130, 144, 151, 158, 159
ALLURE HOMME	Fragrance for men	83, 86, 90, 94, 98, 99, 100, 103, 105, 109, 116, 123, 125, 133, 142, 150
ALLURE HOMME SPORT	Fragrance for men	83, 86, 90, 94, 96, 98, 99, 103, 109, 118, 119, 123, 125, 130, 131, 133, 134, 140, 142, 144, 150
ALLURE HOMME SPORT EAU EXTREME	Fragrance for men	90, 95, 98, 99, 101, 108, 122, 126, 130, 52, 133, 159
ALLURE HOMME EDITION BLANCHE	Fragrance for men	90, 95, 96, 101, 109, 116, 118, 122, 124, 126, 131, 136, 145, 151
Bath and Body		
ALLURE	Body lotion	96, 100, 103, 108, 132, 149
	Hair mist	90, 130, 144
	Bath gel	100, 116, 130, 149
	Soap	144, 149, 158
	Deodorant	105, 149
ALLURE HOMME	Aftershave lotion	98, 109, 133
	Aftershave moisturiser	90, 100, 109, 131, 134, 150
	Deodorant	90, 94, 96, 98, 103, 109, 116, 122, 131, 144, 150
	Hair and body wash (shower gel)	109, 122, 150
ALLURE HOMME SPORT	Aftershave lotion	100, 109, 122, 126, 150
	Aftershave moisturiser	98, 100, 109, 122, 131, 150
	Deodorant spray and stick	96, 98, 100, 103, 109, 116, 122, 131, 144, 150
	Hair and body wash (shower gel)	95, 101, 103, 109, 122, 131, 150
ALLURE HOMME BLANCHE	Aftershave lotion	90
	Aftershave moisturiser	90, 151
	Shower gel	90, 101, 104, 131, 152
	Deodorant	90, 101, 109, 152, 159
Beauty		
ROUGE ALLURE	Lipstick	87, 91, 92, 93, 101, 102, 110, 111, 112, 113, 114, 115, 120, 129, 131, 135, 143, 146, 148, 154, 155, 156, 157
ROUGE ALLURE VELVET	Lipstick	84, 87, 91, 92, 93, 104, 111, 112, 113, 114, 119, 143, 155, 156, 157
ROUGE ALLURE VELVET EXTREME	Lipstick	91, 92, 111, 112, 114, 120, 129, 157
ROUGE ALLURE L'EXTRAIT	Lipstick	106, 107, 127, 128, 138
ROUGE ALLURE LAQUE	Lip gloss	85, 107, 128, 134, 138
ROUGE ALLURE INK	Lip gloss	85, 88, 91, 93, 102, 107, 111, 112, 113, 114, 121, 123, 128, 47, 155
ROUGE ALLURE INK FUSION	Lip gloss	114
NOIR ALLURE	Mascara	137, 139, 140