

O/1132/24

TRADE MARKS ACT 1994

**IN THE MATTER OF THE DESIGNATION OF
INTERNATIONAL REGISTRATION NO.
WO0000001723602 BY Y'AMOUR BV
FOR PROTECTION IN THE UNITED KINGDOM**

OF THE FOLLOWING TRADE MARK

Y'AMOUR

IN CLASSES 3, 18 AND 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 442470 BY
MOONHEE YA**

BACKGROUND AND PLEADINGS

1. International trade mark 1723602 (“the IR”) consists of the sign shown on the cover page of this decision (“Y’AMOUR”). The holder is Y’amour BV. The IR is registered with effect from 18 October 2022. 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. I note that the mark also claims a priority date of 12 July 2022 from Benelux Trade Mark no. 1467298. The holder seeks protection for the following goods:

Make-up preparations; make-up preparations for the face and body; mascara; lip rouge; eyeliner; blush pencils; cosmetic rouges; skin foundation; eyelid shadow; concealers; make-up powder; eyebrow colors in the form of pencils and powders; skin and hair care cosmetics; dermatological, skin-friendly soaps; natural cosmetics; organic cosmetics; essential oils and aromatic extracts; aloe vera preparations for cosmetic purposes; perfumery; ethereal oils; face creams for cosmetic use; anti-aging creams; skin masks [cosmetics]; non-medicated moisturisers; body lotions; sunscreen preparations; creams for tanning the skin; shampoos; hair conditioners; soap products; bath oil; shower and bath foam; beard care preparations; serums for cosmetic purposes; make-up removing preparations; cosmetic kits; massage oils and lotions; mineral oils [cosmetic]; nail care preparations; nail cosmetics; nail varnish removers; pumice stones for use on the body; impregnated cleaning pads impregnated with toilet preparations; cleaner for cosmetic brushes; emollient preparations [cosmetics]; seaweed for cosmetology; antiperspirants [toiletries]; dentifrices; shaving foam. (class 3)

Vanity cases, not fitted; make-up bags sold empty; small purses; drawstring pouches; cosmetic cases sold empty; cosmetic purses; tool bags sold empty; suitcases with wheels; travelling sets; shaving bags sold empty. (class 18)

Fitted vanity cases; cosmetic utensils; cases adapted for cosmetic utensils; make-up artist belts; hairbrushes; hair combs; make-up brushes; powder puffs; facial sponges for applying make-up; eye make-up applicators; applicator sticks for applying make-up; eyelash brushes; exfoliating brushes; skin cleansing brushes; facial cleansing sponges; natural sea sponges; body scrubbing puffs; shaving brushes; foam toe separators for

use in pedicures; appliances for removing make-up, electric; appliances for removing make-up, non-electric; cleaning instruments, hand-operated; dispensers for cosmetics and skin cleansing brushes and sponges. (class 21)

2. The request to protect the IR was published on 30 June 2023. On 11 August 2023, Moonhee Ya (“the opponent”) opposed the protection of the IR in the UK, in its entirety, under sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). For the purpose of the opposition, the opponent relies upon the following trade mark and all goods and services for which it is registered, as laid out below:

United Kingdom Trade Mark (“UKTM”) 3625148:

YAMOUR

Filing date: 12 April 2021

Registration date: 20 August 2021

Makeup; Lip makeup; Organic makeup; Eye makeup; Facial makeup; Nail makeup; Multifunctional makeup; Natural makeup; Eyelid doubling makeup; Eye makeup remover; Makeup setting sprays; Make-up foundation; Make-up pencils; Make-up preparations; Make-up primer; Make-up kits; Make-up removing lotions; Make up removing preparations; Make-up removing creams; Powder for make-up; Compacts containing make-up; Washing-up detergent; Washing-up liquids; Concealers; Eye concealers; Facial concealer; Cosmetics; Cosmetics and cosmetic preparations; Milks [cosmetics]; Eyebrow cosmetics; Cosmetic dyes; Creams (Cosmetic -); Cosmetic soaps; Cosmetic pencils; Pencils (Cosmetic -); Nail cosmetics; Functional cosmetics; Moisturisers [cosmetics]; Skincare cosmetics; Cosmetic powder; Eye cosmetics; Cosmetics preparations; Dyes (Cosmetic -); Cosmetic kits; Cosmetic rouges; Cosmetic moisturisers; Cosmetic masks; Cosmetic oils; Hair cosmetics; Mousses [cosmetics]; Colour cosmetics; Lip cosmetics; Skin balms [cosmetic]; Cosmetic bath salts; Cleansing creams [cosmetic]; Non-medicated cosmetics; Cosmetic eye pencils; Suntan lotion [cosmetics]; Body paint (cosmetic); Bath powder [cosmetics]; Cosmetic eye gels; Cosmetic hand creams; Facial washes [cosmetic]; Cosmetic facial lotions; Facial masks [cosmetic]; Body scrubs [cosmetic]; Facial gels [cosmetics]; Cosmetic body mud; Cosmetic tanning preparations; Cosmetic face powders; Sun block [cosmetics];

Skin care cosmetics; Nail hardeners [cosmetics]; Moisturising concentrates [cosmetic]; Powder compacts [cosmetics]; Skin creams [cosmetic]; Nail primer [cosmetics]; Facial creams [cosmetics]; Facial lotions [cosmetic]; Cosmetic sunscreen preparations; Cosmetic facial masks; Cosmetic nail preparations; Lip stains [cosmetics]; Cosmetic skin enhancers; Body creams [cosmetics]; Sun barriers [cosmetics]; Lip protectors [cosmetic]; Facial cleansers [cosmetic]; Skin masks [cosmetics]; Night creams [cosmetics]; Nail tips [cosmetics]; Nail paint [cosmetics]; Toning creams [cosmetic]; Moisturising gels [cosmetic]; Skin fresheners [cosmetics]; Cosmetic nourishing creams; Face wash [cosmetic]; Facial scrubs [cosmetic]; Suntan oils [cosmetics]; Tanning oils [cosmetics]; Cosmetics containing keratin; Smoothing emulsions [cosmetics]; Acne cleansers, cosmetic; Mineral oils [cosmetic]; Facial moisturisers [cosmetic]; Facial toners [cosmetic]; Lip coatings [cosmetic]; Cosmetics for suntanning; Skin cleansers [cosmetic]; Cosmetic skin fresheners; Henna [cosmetic dye]; Body care cosmetics; Tanning milks [cosmetics]; Tanning gels [cosmetics]; Facial creams [cosmetic]; Cosmetic sun oils; Cosmetic suntan preparations; Suntanning oil [cosmetics]; Beauty care cosmetics; Cosmetic hair lotions; Shaving stones being astringents for cosmetic purposes; Serums for cosmetic purposes; After-shave creams; Cosmetic hair dressing preparations; Cosmetic hair care preparations; Cosmetic hair regrowth inhibiting preparations; Hair rinses [for cosmetic use]; Hair tonics [for cosmetic use]; Bleaching preparations for cosmetic purposes; Hair care creams [for cosmetic use]; Hair care lotions [for cosmetic use]; Hair preservation treatments for cosmetic use; Cosmetic preparations for the hair and scalp; Skin care oils [cosmetic]; Skin care lotions [cosmetic]; Moisturising skin creams [cosmetic]; Moisturising body lotion [cosmetic]; Skin care creams [cosmetic]; Nail strengtheners; Nail enamel; Nail polish; Nail varnishes; Nail cream; Nail decolorants; Nail whiteners; Nail conditioners; Nail tips; False nails; Nail glitter; Nail polish removers; Nail polish pens; Nail varnish remover [cosmetics]; Nail polish removers [cosmetics]; Glue for strengthening nails; Nail base coat [cosmetics]; Cosmetic preparations for nail drying; Milk for cosmetic purposes; Cosmetic nail care preparations; Skin relief serum [cosmetic]; Cleansing milk for cosmetic purposes; Skin care preparations; Cosmetic creams for skin care; Cosmetic preparations for skin care; Body emulsions for cosmetic use; Cosmetic products for the shower; Body cream for cosmetic use; Perfumed powders [for cosmetic use]; Suncare lotions [for cosmetic use]; Skin creams; Exfoliating scrubs for cosmetic purposes; Exfoliating scrubs for the feet; Gel scrub; Facial serum for cosmetic use; Hydrating creams for cosmetic use; Skin moisturizers used as cosmetics; Topical skin sprays for cosmetic purposes; After-sun milk [cosmetics]; Sun care preparations for cosmetic use; Make-up base; Pores tightening mask packs used as cosmetics; Cosmetics in the form of lotions; Cosmetics in the form of milks; Cosmetic creams for firming skin

around eyes; Cosmetic preparations for dry skin during pregnancy; Cosmetics for protecting the skin from sunburn; Cosmetics for the treatment of dry skin; Gels for cosmetic use; Eyelashes (Adhesives for affixing false -); Adhesives for affixing false eyelashes; Adhesives for affixing false eyebrows; Adhesives for affixing false hair; Adhesives for fixing false nails; Eyelashes; Eyelash dye; False eyelashes; Blush; Blush pencils; Face powders; Creamy face powder; Pressed face powder; Loose face powder; Eyeliners; Eyeliner pencils; Liquid eyeliners; Eye lotions; Eye pencils; Eye shadow; Eye sticks; Eye creams; Eye gel; Eyelid pencils; Under-eye enhancers; Under eye correctors; Eye wrinkle lotions; Eye correction serum; Beauty serums; Hair serums; Cosmetics for eye-brows; Eye make-up removers; Self-adhesive false eyebrows; Eyebrow gel; Eyebrow pencils; Eyebrow powder; Eyebrow mascara; Eye care products, non-medicated; Fragrance sachets for eye pillows; Skin, eye and nail care preparations; Cosmetics in the form of eye shadow; Eyelid shadow; Lipsticks; Lip cream; Lip liners; Lip conditioners; Lip glosses; Lip pencils; Lip balms; Lip rouge; Lip polisher; Lip neutralizers; Lip pomades; Lip care preparations; Lip gloss palettes; Lipstick cases; Non-medicated lip balms; Sun protectors for lips; Skin foundation; Skin toner; Skin conditioners; Skin moisturizers; Skin masks; Skin lighteners; Skin fresheners; Skin hydrators; Skin toners; Skin lotions; Skin lightening creams; Clay skin masks; Skin make-up; Skin cleansing foams; Skin care mousse; Skin calming serum; Skin cleansing lotion; Skin cleansing cream; Skin whitening preparations; Skin moisturizer masks; Oils for the skin; Skin whitening preparations [cosmetic]; Non medicated skin toners; Non-medicated skin creams; Essences for skin care; Creams for tanning the skin; Skin softening preparations; Tanning creams; Sun-tanning creams; Creams for firming the skin; Sun-tanning creams and lotions; Tanning preparations; Sun-tanning preparations; Sun tan milk; Sun-tanning gels; Sun-tanning lotions; Sun-tanning oils; Self tanning preparations; Colour cosmetics for the skin; Milky lotions for skin care; Foot masks for skin care; Hand masks for skin care; Hair care masks; Hydrating masks; Skin care creams, other than for medical use; Beauty masks; Beauty lotions; Beauty milks; Beauty gels; Beauty creams; Beauty soap; Hair masks; Cleansing masks; Hairstyling masks; Body masks; Beauty care preparations; Beauty balm creams; Beauty creams for body care; Body cleaning and beauty care preparations; Beauty preparations for the hair; Eyebrows [false]; Eyebrow colors; Eyebrow colors in the form of pencils and powders; Mascara; Long lash mascaras; Hair mascara; Eyeshadows; Eyeshadow palettes; Eye stylers; Eye gels; Gel eye masks; Eye brightening correctors; Adhesives for false eyelashes, hair and nails; Glue removers; Adhesive removers; Non-medicated creams; Facial toner; Essential oils; Essential oils for cosmetic purposes; Essential oils for the care of the skin; Body powder; Self tanning lotions [cosmetic]; Sun tan oil; Sun tan gel; Sun tan lotion; Sun bronzers; Sun creams; After sun

moisturisers; Sun care preparations; Shampoos; Shampoo-conditioners; Dry shampoos; Hairspray; Hair bleaches; Hair oils; Hair creams; Hair gels; Hair dyes; Hair colorants; Hair glaze; Hair moisturisers; Hair conditioners; Hair shampoos; Hair spray; Hair nourishers; Hair colourants; Hair powder; Hair bleach; Hair lighteners; Hair chalks; Hair protection lotions; Hair curling preparations; Hair styling gels; Hair-waving preparations; Hair dyeing preparations; Hair care serums; Hair protection creams; Hair conditioner bars; Conditioners for use on the hair; Perfumery; Perfumes; Skin lightening compositions [cosmetic]. (class 3)

Wholesale services in relation to cosmetics and beauty products; wholesale services in relation to Non-medicated skincare products; online retail services relating to home decoration; online retail services relating to sunglasses; online retail services relating to fragrances; online retail services relating to cosmetic tools; wholesale services relating to cosmetic tools; online retail services relating to beauty device; wholesale services relating to beauty device; Retail services relating to jewelry; Online retail services relating to jewelry; Wholesale services relating to jewelry; Retail services relating to clothing; Online retail services relating to clothing; Wholesale services relating to clothing; Retail services in relation to luggage; Online retail services relating to luggage; Wholesale services in relation to luggage; Retail services in relation to bags; Retail services in relation to toiletries; Wholesale services in relation to toiletries; Retail services relating to fragrancing preparations; Wholesale services in relation to fragrancing preparations; Retail services in relation to cleaning preparations; Wholesale services in relation to cleaning preparations; Retail services in relation to fashion accessories; Retail services in relation to clothing accessories; Retail services in relation to hair products; Retail store services in the field of clothing; Online retail store services relating to clothing; Retail services in relation to sun tanning appliances; Retail services in relation to beauty implements for humans; Wholesale services in relation to beauty implements for humans; Retail services in relation to hygienic implements for humans; Wholesale services in relation to hygienic implements for humans; Retail services in relation to headgear; Wholesale services in relation to headgear; Retail services in relation to smartwatches; Retail services connected with the sale of clothing and clothing accessories; Online retail services relating to handbags; Online retail services relating to cosmetics; Online retail store services in relation to clothing; Online retail store services relating to cosmetic and beauty products; Wholesale services in relation to bags; Wholesale services in relation to clothing. (class 35)

3. In its statement of grounds, the opponent submits that “the Applicant mark contains the word Y’AMOUR which is wholly contained in the opponents mark, both marks have

identical alphabets, word and pronunciation therefore represents identical marks.” As regards to the applied-for goods, the opponent states that “the opponents goods covers the applicant goods which are highly identical with the applicants goods”. The opponent concludes that such factors give rise to a likelihood of confusion on the part of the consumer, including a likelihood of association.

4. In its counterstatement, the holder denies that the respective marks are identical (or similar) and that the applied-for goods are identical or similar to the goods or services relied upon. It denies that there exists any likelihood of confusion and asks that the IR be protected in the United Kingdom.

5. The holder is represented by London IP Limited and the opponent by United Legal Experts. Neither party filed evidence during the course of the proceedings, though the holder did elect to file written submissions. Neither party requested a hearing and neither filed 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.

Preliminary matter

7. I find it important to mention some of the comments in the opponent’s statement of grounds, specifically its referral to goodwill, misrepresentation and damage. It states:

“6. The opponent has used the earlier mark since 20 August 2021 through out the uk and has gained the goodwill in the earlier mark through sales and marketing of the goods mentioned under the trade mark.

7. That the opponent is highly concerned that the applicant is attempting to register the trade mark may lead to misrepresentation which would damage the opponents goodwill whilst also causing financial and repetitional damage to the opponent.”

8. It also indicated that it intended to file evidence in support of its submissions¹, though it appears that no evidence was filed. The opponent’s consideration of matters such as those reproduced above are noted but nonetheless appear more consistent with a passing off claim. For clarity, sections 5(1) and 5(2)(a) are the only pleaded grounds in the present proceedings and, in the absence of a direct pleading and any supporting evidence, the scope of the opposition does not extend to grounds under section 5(4)(a) (for example).

Section 5(1) and 5(2)(a) grounds

9. Section 5 of the Act states that:

“1. A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

2. A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

¹ See paragraph 12 of the opponent’s statement of grounds

10. An “earlier trade mark” is defined in section 6(1) of the Act:

“In this Act an ‘earlier trade mark’ means –

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

11. By virtue of the marks’ respective filing dates, the opponent’s trade mark clearly qualifies as an earlier mark pursuant to section 6 of the Act. As the opponent’s mark had not completed its registration process more than 5 years before the designation date at issue it is not subject to the proof of use provisions laid out in section 6A of the Act. Consequently, the opponent is able to rely upon its mark and all goods and services for which it is registered without providing evidence of use.

12. Given that the only grounds pleaded by the opponent rely, to begin with, upon a finding of identity between the respective marks, this is the first matter I must determine. In the event that I find the parties’ trade marks are not identical, the opposition falls, under both grounds, at the first hurdle. The Court of Justice of the European Union (CJEU) held in *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*², that:

“... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

13. I have reproduced the opponent’s remarks on the matter of identity at paragraph 3 to this decision.

² Case C-291/00

14. In its submissions, the holder denies that the marks are identical. It states:

“The Earlier mark consists of a single word whereas the Subject Application consists of the single letter Y with an apostrophe and a second word, AMOUR. Visually there are clear differences between the marks that would not go unnoticed by the average consumer. ...

Conceptually, the Earlier Mark has no meaning in English but would be likely to be seen by the average consumer as a Middle Eastern word... The Subject Application is likely to be seen by the average consumer as a mark deriving from the Spanish, or French language with “AMOUR” or “AMOR” being commonly understood as meaning “LOVE”. ...

Aurally, the marks are clearly not identical.”

15. What separates the marks is the inclusion, or absence, of an apostrophe positioned after the marks' first letter (Y). Whilst I acknowledge that such a small difference is likely to render the parties' marks highly similar, particularly visually, I am not satisfied that the marks are identical. The definition in *LTJ Diffusion* suggests that marks should be deemed identical where one “reproduces, without any modification or addition, all the elements constituting the trade mark” (my emphasis). The holder's mark clearly provides an addition insofar as it incorporates an apostrophe which is absent in the opponent's mark. It is also positioned toward the beginning of the mark, after the first letter, which changes the mark's structural makeup and is likely to be viewed as relatively unconventional from the perspective of the UK consumer. I do not find this alteration “so insignificant” that it would be unnoticed. Furthermore, without embarking on too detailed a conceptual comparison between the marks, the positioning of the apostrophe, to my mind, alters the marks' respective conceptual impressions to a degree which will be readily acknowledged by the average consumer. In brief, I find it likely that the earlier mark will be viewed simply as an invented word whereas the holder's mark will be considered reminiscent of the fairly well-known French term *L'amour* meaning love (vaguely speaking) with one character substituted, or at the very least it will be viewed as a word from a foreign language, by virtue of its punctuation. If my conceptual

interpretation is found to be incorrect, my findings on the mark’s structural composition still stand; the difference in the marks’ makeup, one being a single word and the other comprising a single letter, an apostrophe and a single word, will be readily identified by the average consumer. These combined findings lead me to the view that the average consumer would not fail to notice the difference between the respective marks, and are sufficient to steer me from a finding of identity. Consequently, I dismiss the opponent’s claims under sections 5(1) and 5(2)(a).

Conclusion

16. The opposition against the UK designation of IR no. 1723602 fails.

Costs

17. 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”) 1/2023. In accordance with that TPN, I award costs as follows:

Considering the statement of rounds and filing a counterstatement:	£250
Filing written submissions:	£350
Total:	£600

18. I order Moonhee Ya to pay Y’amour BV the sum of £600. 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 27th day of November 2024

**Laura Stephens
For the Registrar**