

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2111766 BY LIDL STIFTUNG & CO. KG TO REGISTER A TRADE MARK IN CLASS 3

DECISION

1. This is an appeal to the Appointed Person from the decision of Mr. Pike acting on behalf of the Registrar, dated 26th August 1998 in which he refused to register the trade mark CAMORIS in class 3 in respect of a wide category of goods relating to soaps, perfumery and cosmetics. The mark was applied for on 2nd October 1996 by Lidl Stiftung & Co. KG and objection was taken to the application under section 5(2) of the Trade Marks Act 1994 because of the prior registration of trade mark No 2061424 "AVON COMORES" in Class 3 in respect of an overlapping specification of goods.

2. Section 5(2) of the Act reads as follows:
*"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 a earlier trade mark is protected,
or (b) it is similar to a 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".*

3. It was not in dispute that the trade mark Camoris was sought to be registered in respect of goods identical with or similar to those for which the Avon Comores mark was registered and thus the sole question before Mr. Pike, and before me on appeal, was whether the two marks were so similar as to create a likelihood of confusion on the part of the public which included the likelihood of association with the earlier trade mark.

4. Mr. Pike considered the two marks following well established authorities, particularly the statements of law by Parker J. in the *Pianoist* case (1906) 23 RPC at 777 and by Lord Ratcliffe in *De Cordova v. Vick Chemical Company* (1951) 68 RPC 106 and concluded

The combination of "Avon" and "Comores" does not hold together as a phrase, nor does it present a wholly different meaning to the separate components. In my opinion their combination will be taken by many members of the public, on first impression, as an indication that the manufacturer of the goods in question is using two separate trade marks in connection with this product. The word "Avon" is an element of the mark that will be seen as a house mark and members of the public are likely to confuse the words "Camoris" and "Comores" with the result that the respective trade sources are likely to be regarded as identifying goods emanating from the same source. I therefore hold that the presence, in this application, of the word "Avon" is not sufficient to avoid the finding that the marks are similar".

5. It is not in dispute that the word Avon, when used in relation to perfumery, cosmetics and make up is well known in this country as indicating products coming from a particular source. It does not merely indicate geographical origin. Although perhaps less well known, the word Comores is indicative of a geographical location. It is a Republic (sometimes referred to as Comoros) in the Indian Ocean between Madagascar and the African

coast. The main products of the country are vanilla, ylang-ylang and cloves. It was not in dispute that a significant portion, estimated at 2/3rds, of the world's perfume essence come from the Comores and as a consequence they are known as "The Perfume Islands". There was in evidence before Mr. Pike and before me some travel brochures relating to holidays in the Comores and there was also evidence that part of the grand prize in the most recent series of the television programme "Gladiators" was a holiday in the Comores.

6. Notwithstanding this evidence Mr. Pike held

"Whilst it is clear that a number of people have travelled to the Comores group of Islands, it is, in my opinion, the sort of destination that would be visited by relatively few in numbers. The holidays referred to in the brochures provided are relatively high in price and would be beyond the reach of the majority of members of the public. In such circumstances it seems unlikely that a significant number of people in this country would have visited the Comores and consequently they would not recognise the word "Comores" as being the name of a geographical location".

7. He went on

"The mark in question is, of course, "Avon Comores". The addition of the word "Avon" clearly identifies the sign as a whole as a trade mark and this serves to reduce the potential for "Comores" being identified as the geographical origin of the goods".

8. Mr. St. Ville who appeared on behalf of the Applicants before me criticised Mr. Pike's decision in a number of respects and I shall turn to these in due course. However I shall deal first with his criticism of the finding of fact

relating to the Comores by Mr. Pike. He submitted that Mr. Pike was wrong in concluding that to a significant portion of the public the word Comores when used in relation to perfumery cosmetics and the like would not have a geographical connotation and would be seen as an invented word. Where, as here, the word Comores does have, in fact, a geographical signification and, furthermore, where the geographical signification is of the place of origin of a large portion of the world's supply of perfume essence, he submitted that there was a substantial likelihood representatives of the trade would appreciate the connection between the word Comores (as it appears in the trade mark) and the Perfume Islands. In consequence, it was inevitable, he said, in the normal course of use of the trade mark Avon Camoris, that the public would come to recognise, (if they did not immediately recognise), the word Comores as indicating the Islands and the high quality of perfume essence that is exported from there.

9. In my judgment this submission has force. I have concluded that Mr. Pike took a too restrictive approach to the evidence before him. The fact that a large number of people may not have visited the Islands on holiday, because of their location and the price, does not mean that people are not aware of the existence of the Islands. The fact that a television programme of popular appeal such as Gladiators chose a holiday in the Comores as part of their grand prize is, I think, a proper indication that the islands do have or are thought to have public recognition. In my judgment the use of the word Comores as part of the mark Avon Comores in the light of the reputation of the Comores Islands as producers of perfume essence, would lead to that mark being seen as a two word mark, the word Avon being a house mark and the word Comores being recognised not only as the trade mark of the goods but also as creating a connection or association with the Perfume Islands. In my judgment, the word Comores would not merely be taken as an invented word. In this respect therefore I accept Mr. St. Ville's submissions.

10. Mr. St. Ville went on to draw my attention to the recent decisions in the ECJ in *Sabel B.V. v. Puma A.G.* (1998) RPC 199 and the opinion of the Advocate General in *Lloyd Schuhfabric Meyer GmbH v. Klijsen Handel B.V.* (1999) ETMR 10 and made the following submissions
- (1) that the Registrar was wrong in his approach to the word Avon Comores in not treating the mark as a whole and in separating out the word Comores. He said the correct approach was to consider the mark as a whole, to make an assessment of the visual oral and conceptual similarity of the marks and then to ask whether there was a genuine or properly substantiated likelihood of confusion between the whole mark and the word Camoris.
 - (2) that consideration should be given to what he referred to as the "distinctive and dominant components of the mark" in which regard he draw my attention particularly to the word Avon.
 - (3) that a greater importance should be placed upon the introductory word or syllable of a mark; again he emphasised the introductory word Avon.
11. Mr. Morgan who appeared for the Registrar contended that Mr. Pike had not improperly dissected the mark into two parts and wrongly ignored the presence of the word Avon. He submitted that the mark is two words and would be seen as such and that the placing of undue emphasis on the word Avon would not be correct.
12. In my judgment Mr. St. Ville's submissions go too far and do not represent the law. I accept that in some cases, particularly in the case of single word marks consisting of a number of syllables, it will be proper to place emphasis on the first syllable since that is the syllable first to make an impression upon the mind of the public and it may well make a lasting impression such that less emphasis can properly be made on the later

syllables. Confusion may therefore be likely if the mark being compared has the same introductory syllable.

13. However this approach cannot be carried over readily to marks consisting of a number of words. Where a mark consists of two ordinary words and, particularly, where there are grounds for believing that the public will take one of the words to be a house mark and the other to be a mark relating to specific goods, the approach cannot be applied. The public will identify the two words for their respective purposes and give equal emphasis to both.
14. In the present case, the overall impression of the mark ("Avon Comores") is of two words and would be seen as such. Criticism cannot therefore properly be levelled against Mr. Pike for asking the question as to whether the word Camoris would be likelihood to be confused with Comores, provided that in asking the question one does not lose sight of the fact that the trade mark monopoly created in the first mark is in the two words "Avon Comores".
15. Because of this, it cannot be that there would ever be visual or oral confusion between the two marks used as such. One contains the word Avon and the other does not. The matter does not however rest there, I have to have regard to the imperfect recollection of the average consumer who is reasonably well informed. It is in this respect and not without some hesitation that I have come to the conclusion that Mr. Pike fell into error. He compared the two words "Comores" and "Camoris" as though they were both invented words. For the reasons I have given above, on the facts, the likelihood is that the word Comores would be recognised as indicating the Perfume Islands when used in relation to perfumery products. Whilst the similarities and differences between the two words Camoris and Comores, both visually and orally are plain, it is to be noted that no objection was raised to the registration of the word Camoris on the ground that it was so

similar to Comores that registration would be contrary to the provisions of section 3(1)(c), i.e. that the mark might be taken as indicating geographical origin. In my judgment this was correct. I do not believe that the similarities between Camoris and Comores are such that anyone knowing of the Comores Islands, would believe that Camoris was a reference thereto.

16. I accept that I have to consider a different question which is whether there exists a likelihood of confusion on the part of the public between the two marks, one of which contains the word Comores. Nonetheless the above consideration is one which can be properly taken into account as well as taking into account the differences between the two words and the fact that one is an invented word and the other is not. Taking all these matters into account I have concluded that the mark "Camoris" is not so similar to the mark "Avon Comores" that there exists the necessary likelihood of confusion on the part of the public.

I would therefore allow this appeal. In accordance with the usual practice there will be no order as to costs.

21/6/99.