

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2111766 BY LIDL STIFTUNG & CO.
KG TO REGISTER A TRADE MARK IN CLASSES 3 AND 21

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 50570 BY AVON
PRODUCTS INC.

DECISION

Introduction

1. This is an appeal to the Appointed Person by Lidl Stiftung & Co. KG (“the Applicant”) against the decision of Mr. Rowan, the Hearing Officer acting for the Registrar, dated 13th February 2002. By his decision the Hearing Officer upheld the opposition filed by Avon Products Inc (“the Opponent”) to an application by the Applicant to register the trade mark CAMORIS in respect of the following goods:

Class 03:

Soaps, perfumery, essential oils, cosmetics; make-up; deodorants and anti-perspirants; hair lotions, preparations for cleaning, care, treatments and improvements of hair and scalp.

Class 21:

Brushes, applicators, sponges, powder puffs all for use with make-up.

2. The opposition was based on section 5(2) and 5(iv)(a) of the Trade Marks Act 1994 (“the Act”). The Hearing Officer upheld the objection under section

5(2) and rejected the objection under section 5(4)(a). It is against the first of those findings that the Applicant appeals.

3. The objection under section 5(2) was founded upon the earlier registration by the Opponent of the trade mark AVON COMORES under No. 2061424 in respect of the following goods in Class 3:

Non-medicated toilet preparations; cosmetics; soaps, preparations for the hair; preparations for cleaning teeth; perfumes, toilet waters, eau d’colognes; deodorants for personal use; toilet articles; essential oils.

The decision of the Hearing Officer

4. The successful ground of opposition was raised under section 5(2)(b) of the Act which reads as follows:

“5 – (2) A trade mark shall not be registered if because –

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

5. In considering the issue under section 5(2)(b), the Hearing Officer first set out aspects of the guidance provided by the European Court of Justice (“ECJ”) in *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723.

6. The Hearing Officer then turned to consider the various contentions of the parties. He noted that one of the key issues in dispute concerned the inherent distinctiveness of the element COMORES in the Opponent's earlier trade mark. He recorded the submission of the Applicant that the average consumer would be aware that the word COMORES was indicative of a geographical location, sometimes known as "The Perfume Isles", and that these islands produced two thirds of the world's essential oils for perfume.

7. As a preliminary issue the Hearing Officer decided that, absent any evidence to the contrary, the Registrar should assume that an opponent's earlier trade mark was, prima facie, distinctive of the goods for which it was registered, and that if an applicant in opposition proceedings wished to show that the mark contained a descriptive element which would be seen as such by the average consumer, then it was for the applicant to show that that was the case. Having considered the evidence, the Hearing Officer decided that it was not established that the average consumer would be aware of the existence of the Comores as a group of islands and, moreover, that there was no evidence to show that those members of the public who might be aware of the existence of the islands would know that they were a source of essential oils. Overall he concluded that each element of the mark AVON COMORES was distinctive, as was the mark as a whole.

8. The Hearing Officer then considered the similarities between the goods and between the marks themselves. He found that the goods were either identical or similar. Turning to the trade marks, and in accordance with the guidance

provided by the ECJ, he considered the visual, aural and conceptual similarities between them, taking into account their distinctive and dominant components. He noted that the question must be assessed through the eyes of the average consumer.

9. At the outset the Hearing Officer remarked upon the marked visual difference between the two marks, in that the earlier trade mark is made up of two words, while that of the Applicant consists of only one word. However, he inferred, on the basis of the Opponent's evidence, that the word AVON appearing in the earlier trade mark was the Opponent's house mark and that the public at large would perceive it as such. This, he considered, was a factor which he had to take into account in assessing the similarities between the two marks.
10. The Hearing Officer then considered the similarity between the mark CAMORIS and the word COMORES. He reached the conclusion that they were indeed similar, visually and aurally. From a visual perspective he thought the similarities were very clear. Aurally he considered that the word CAMORIS was similar to COMORES, whether the latter was pronounced COM-MOR-ES or COM-ORES. Conceptually, and consistently with his earlier finding, he thought both words would be seen as made up words.
11. The Hearing Officer then arrived at his overall conclusion under section 5(2). He found that there was a likelihood of confusion and, in so doing, clearly had in mind that the AVON element of the earlier trade mark would be seen as a house mark:

“It seems to me that, whilst noting the AVON element in the opponents’ trade mark and it’s role as a house mark, the overall visual and oral similarities between the second element of the opponents’ trade mark and the applicants’ trade mark are sufficient for me to find that a likelihood of confusion as defined in section 5(2)(b) of the Trade Marks Act 1994 exists. Even if I am wrong on that point, it seems to me reasonable to assume that, even if the mark AVON is sufficient to avoid the likelihood of direct confusion, the average consumer on seeing the mark CAMORIS used on identical or similar products to those for which the mark AVON COMORES is registered, would wrongly believe that the goods came from the opponents or some economically linked undertaking. As such, there is a likelihood of confusion within the meaning of section 5(2)(b) and I find that the opponents’ ground of opposition succeeds and the application should be refused in its entirety.”

The Appeal

12. On the 13th March 2002 the Applicant gave notice of appeal to an Appointed Person. At the hearing the Applicant was represented by Mr. James St Ville instructed by Urquhart Dykes & Lord. The Opponent was represented by Mr. Colin Birss, instructed by Frank B. Dehn & Co. At the hearing both parties agreed that the appeal must be limited to a review of the decision of the Hearing Officer. This tribunal should show a real reluctance to interfere with with a conclusion reached by a Hearing Officer in a case such as this in the absence of a distinct or material error of principle.
13. The Applicant submitted that the Hearing Officer fell into error in a number of respects in reaching his conclusion. The principal submission made was that the Hearing Officer wrongly dissected the mark AVON COMORES and wrongly compared CAMORIS with COMORES rather than CAMORIS with AVON COMORES. It was submitted that the Hearing Officer then wrongly

relied upon that analysis to conclude there was a likelihood of confusion. In the result, it was submitted, he only paid lip service to the presence of the AVON element. In support of this submission the Applicant referred to the decisions of the ECJ in *Sabel* and *Lloyd* which make it clear that the global appreciation of the likelihood of confusion must be based upon the *overall* impression created by the marks, bearing in mind, in particular, their distinctive and dominant components and that the average consumer normally perceives a mark as a whole.

14. I found this submission of the Applicant very persuasive. However, after much consideration, I have found myself unable to accept it. First of all I believe that the Hearing Officer did have in mind that the earlier trade mark was AVON COMORES. He noted expressly in paragraph 49 of his decision that, on first impression, there was a marked visual difference between the two marks in that the Opponent's mark was made up of two words, while the Applicant's mark consisted of only one word.

15. Secondly, the Hearing Officer also had regard to the perceptions of the average consumer. In this connection he found that the public at large would perceive the word AVON in the Opponent's earlier trade mark as a house mark. I believe that the Hearing Officer properly came to that conclusion in the light of the evidence. AVON is clearly a very well known trade mark and the words AVON and COMORES do not, I think, present a different impression together from that which they do separately. I think it is perfectly reasonable to suppose

that the average consumer seeing the mark AVON COMORES would see COMORES as a denoting a particular brand coming from the house of AVON.

16. Thirdly, and having reached that conclusion, I believe it was then a matter which the Hearing Officer was bound to take into account as a relevant factor when assessing the similarities between the two marks and the likelihood of confusion. *Sabel* establishes that the matter must be judged through the eyes of the average consumer and all relevant factors must be taken into account. Moreover the marks must be assessed by reference to the overall impressions which they create.
17. Fourthly, and in the light of his finding about how the public would perceive the Opponent's mark, the Hearing Officer came to the conclusion that the word AVON might not always bear on the public's perception when purchasing AVON COMORES products and there was a likelihood of confusion in the light of the similarities between COMORES and CAMORIS. In my judgment the Hearing Officer adopted the correct approach and came to a reasonable conclusion.
18. The Applicant also submitted that the Hearing Officer fell into error in considering that the word COMORES would be pronounced COM-MO-RES. It was submitted that there was no evidence about pronunciation and that the Hearing Officer erred in placing weight on such a possible pronunciation which was fanciful and did not come naturally to him.

19. Again, I am unable to accept this submission. The Hearing Officer had no evidence before him as to how the public would pronounce either of the marks in issue. In those circumstances I believe he rightly considered the matter for himself in the light of his own experience. He concluded:

“Someone who is unaware of the islands on seeing the word COMORES might well have split it into three syllables and pronounce it COM MOR RES.”

20. In my judgment the conclusion which the Hearing Officer reached was a reasonable one. Moreover he found that even if he pronounced the second element of the earlier trade mark as COM-ORES, there was still a degree of aural similarity between the two marks. Again, I believe that the conclusion which the Hearing Officer reached in this respect was a reasonable one and I feel unable to say he clearly fell into error.

21. Finally it was submitted that the Hearing Officer fell into error in failing to find that the average consumer would appreciate the geographical significance of the word COMORES. Further, it was submitted, there was no evidence on which the Hearing Officer could rely to come to the conclusion that the average consumer would think the word COMORES was an invented word.

22. I reject this final criticism of the decision. In my judgment the Hearing Officer approached the matter correctly. He was obliged to consider how the average consumer would perceive the marks in issue. This required an assessment of the overall impressions created by the marks bearing in mind their distinctive and dominant components. In my view the Hearing Officer rightly considered that insofar as the Applicant wished to contend that the word COMORES

would be perceived as an indication of geographical origin, then it was incumbent upon it to establish that matter. The Hearing Officer found in the light of the evidence before him that the Applicant had not established that the general public were aware of the islands known as the Comores, still less their role in the production of essential oils for perfumes. He concluded that the islands did not appear, on the face of the evidence, to have any profile and that it followed that the public could not be aware of the islands as a source of perfume oils. In my judgment the Hearing Officer was entitled to reach the conclusion which he did. In the result he also rightly concluded that, conceptually, the earlier trade mark would be meaningless to the average consumer in terms of geographical indication.

Conclusion

23. In all the circumstances I do not believe the Hearing Officer erred in principle or was clearly wrong in deciding that the objection under section 5(2) was made out. Accordingly the appeal fails. I order that the Applicant pay the Opponent the sum of £1235.00 as a contribution towards its costs of the appeal, such sum to be paid on a like basis to that ordered by the Hearing Officer.

DAVID KITCHIN QC

17th September 2002