

**DECISION  
of the Fifth Board of Appeal  
of 11 April 2022**

In case R 1562/2021-5

**FM World Sp. z o.o.**  
ul. Żmigrodzka 247  
51-129 Wrocław  
Poland

Applicant / Appellant

represented by Alina Budner Delex Kancelaria Radcowsko - Rzecznikowska, ul. Kpt.  
Stefana Pogonowskiego 54 lok.B1, 90-619 Łódź, Poland

v

**Azzedine Alaia SAS**  
7, rue de Moussy  
75004 Paris  
France

Opponent / Defendant

represented by Keltie LLP, No. 1 London Bridge, SE1 9BA London, United Kingdom

APPEAL relating to Opposition Proceedings No B 3 104 983 (European Union trade  
mark application No 18 097 376)

**THE FIFTH BOARD OF APPEAL**

composed of V. Melgar (Chairperson and Rapporteur), R. Ocquet (Member) and  
S. Rizzo (Member)

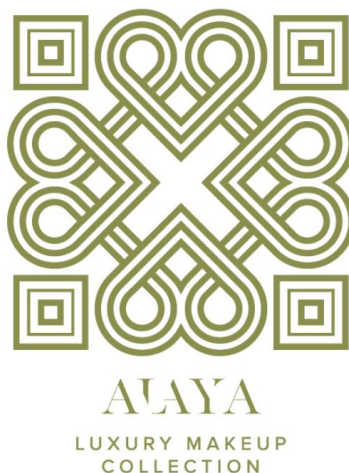
Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 10 September 2019, FM World Sp. z o.o. ('the applicant') sought to register the figurative mark



for the following list of goods:

Class 3 - Aloe vera preparations for cosmetic purposes; Antiperspirants [toiletries]; Aromatic oils; Lotions for cosmetic purposes; Balms, other than for medical purposes; Lip gloss; Nail glitter; Amber [perfume]; Tissues impregnated with cosmetic lotions; Essential oils of lemon; Deodorants for human beings or for animals; Air fragrance reed diffusers; Extracts of flowers [perfumes]; Herbal extracts for cosmetic purposes; Sunscreen preparations; Ethereal essences; Lipstick cases; Hair dye; Incense; Joss sticks; Cosmetics; Make-up preparations; Sun bronzers; Eyebrow cosmetics; Cosmetics for eye-lashes; Cosmetics for children; Skincare cosmetics; Cosmetic creams; Skin whitening creams; Hair spray; Nail polish; Cosmetic masks; Mint for perfumery; Almond milk for cosmetic purposes; Cleansing milk for toilet purposes; Soaps; Deodorant soap; Shaving soap; Almond soap; Hair nourishers; Jasmine oil; Gaultheria oil; Almond oil; Rose oil; Lavender oil; Rose oil for cosmetic purposes; Essential oils; Oils for toilet purposes; Oils for hair conditioning; Essential oils of lemon; Body oils [for cosmetic use]; Massage oils; Natural oils for cosmetic purposes; Ethereal essences and oils; Cedarwood (Essential oils of -); Cosmetic pencils; Air fragrance reed diffusers; Breath freshening strips; Teeth whitening strips; Musk [perfumery]; Eye-washes, not for medical purposes; Vaginal washes for personal sanitary or deodorant purposes; After-shave preparations; Lipstick; Pomades for cosmetic purposes; Make-up removing preparations; Depilatory preparations; Hair removal and shaving preparations; Douching preparations for personal sanitary or deodorant purposes [toiletries]; Bath preparations; Hair-waving preparations; Shining preparations [polish]; Nail care preparations; Skin, eye and nail care preparations; Hair straightening preparations; Tanning preparations; Phytocosmetic preparations; Collagen preparations for cosmetic purposes; Baths (Cosmetic preparations for -); Cosmetic preparations for slimming purposes; Astringents for cosmetic purposes; Breath freshening sprays; Perfumery; Antiperspirant soap; Face powder; Pumice stone; Bath salts; Bleaching salts; Shampoo; Dry shampoos; Cleansers for intimate personal hygiene purposes, non-medicated; Dentifrices; Air fragrancing preparations; Massage candles for cosmetic purposes; Talcum powder, for toilet use; Mascara; Cotton sticks for cosmetic purposes; Toilet water; Lavender water; Perfume water; Wax (Depilatory -); Moustache wax; Cosmetic kits; Nail varnish removers; Massage gels, other than for medical purposes; Dental bleaching gels; Gel eye patches for cosmetic purposes.

- 2 The application was published on 1 October 2019.
- 3 On 3 December 2019, AATC Trading AG, the predecessor-in-title of Azzedine Alaïa SAS ('the opponent'), filed an opposition against the registration of the published trade mark application for all the above goods.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) and Article 8(5) EUTMR.
- 5 The opposition was based, inter alia, on European Union trade mark registration No 2 613 461 for the word mark

### ALAÏA

filed on 13 March 2002 and registered on 9 September 2004 for the following goods:

Class 3 - Bleaching preparations and other substances for laundry use; cleaning, scouring and abrasive preparations; soaps; perfumery products, cosmetics, essential oils, hair lotions; dentifrices; make-up preparations; nail varnish; lipsticks; false nails.

- 6 By decision of 16 July 2021 ('the contested decision'), the Opposition Division upheld the opposition in its entirety and rejected the trade mark application for all the contested goods on the grounds that there was a likelihood of confusion. It gave, in particular, the following grounds for its decision:
  - The opposition is based on more than one earlier trade mark and is first examined in relation to earlier EUTM No 2 613 461.
  - The applicant presented arguments and evidence to demonstrate that the actual distribution channels and recipients of the parties' goods do not coincide. However, the comparison of the goods must be based on the wording indicated in the respective lists of goods of the earlier mark and of the contested sign. Furthermore, the excerpt from the National Court Register submitted by the applicant concerns its activities and not the goods of the mark applied for.
  - 'Soaps; make-up preparations; cosmetics; essential oils; perfumery; dentifrices' are identically contained in both lists of goods (including synonyms).
  - The contested 'perfume water; toilet water; lavender water; musk [perfumery]; amber [perfume]; air fragrance reed diffusers (listed twice); mint for perfumery', as well as the 'extracts of flowers [perfumes]; incense; joss sticks; air fragrancing preparations', are included in the opponent's broad category of 'perfumery products'. Therefore, they are identical.
  - The contested 'bleaching salts' are included in the opponent's broad category of 'bleaching preparations and other substances for laundry use'. Therefore, they are identical.

- The contested ‘essential oils of lemon (listed twice); herbal extracts for cosmetic purposes; ethereal essences; aromatic oils; gaultheria oil; jasmine oil; ethereal essences and oils; lavender oil; rose oil; almond oil; natural oils for cosmetic purposes; cedarwood (essential oils of -)’ are identical to the opponent’s ‘essential oils’, either because they are identically contained in both lists (including synonyms) or because the earlier goods include, or overlap with, the contested goods.
- The contested ‘deodorant soap; almond soap; shaving soap; antiperspirant soap’ are included in the opponent’s broad category of ‘soaps’. Therefore, they are identical.
- The contested ‘hair dye; deodorants for human beings or for animals; aloe vera preparations for cosmetic purposes; antiperspirants [toiletries]; nail glitter; sunscreen preparations; tissues impregnated with cosmetic lotions; lip gloss; lotions for cosmetic purposes; balms, other than for medical purposes; nail polish; skin whitening creams; almond milk for cosmetic purposes; hair spray; cosmetic masks; eyebrow cosmetics; cosmetics for eye-lashes; skincare cosmetics; cleansing milk for toilet purposes; cosmetic creams; hair nourishers; sun bronzers; cosmetics for children; oils for hair conditioning; cosmetic pencils; body oils [for cosmetic use]; oils for toilet purposes; rose oil for cosmetic purposes; baths (cosmetic preparations for -); make-up removing preparations; tanning preparations; nail care preparations; after-shave preparations; depilatory preparations; bath preparations; lipstick; cosmetic preparations for slimming purposes; astringents for cosmetic purposes; pomades for cosmetic purposes; douching preparations for personal sanitary or deodorant purposes [toiletries]; hair-waving preparations; hair removal and shaving preparations; hair straightening preparations; phytocosmetic preparations; skin, eye and nail care preparations; mascara; pumice stone; eye-washes, not for medical purposes; massage gels, other than for medical purposes; talcum powder, for toilet use; nail varnish removers; shampoo; dry shampoos; moustache wax; wax (depilatory -); cleansers for intimate personal hygiene purposes, non-medicated; vaginal washes for personal sanitary or deodorant purposes; bath salts; face powder; gel eye patches for cosmetic purposes; cosmetic kits; collagen preparations for cosmetic purposes’ are included in the opponent’s broad category of ‘cosmetics’. Therefore, they are identical.
- The contested ‘teeth whitening strips; breath freshening sprays; breath freshening strips; dental bleaching gels’ are at least similar to the opponent’s ‘dentifrices’ because they have the same purpose and coincide in end users and distribution channels.
- The contested ‘shining preparations [polish]’ are similar to the opponent’s ‘soaps’. Soap is a cleaning or emulsifying agent made by reacting animal or vegetable fats or oils with potassium or sodium hydroxide. As such, soap is a broad category that covers products used for household cleaning (e.g. soap for laundry use, soap for household use) and vehicle cleaning purposes (e.g. detergents for cars), soap for washing and cleaning the body and in such a way, enhancing its appearance and odour (e.g. soap for body care,

antiperspirant soap), as well as, soap for cleaning and conditioning leather articles. Polishing preparations are used to make a product smooth and shiny by rubbing. To that extent, their purpose is similar to that of soap. The goods can target the same consumer and be sold in the same retail outlets (e.g. the same section in department stores).

- The contested ‘cotton sticks for cosmetic purposes’ are similar to the opponent’s ‘cosmetics’. On the one hand cosmetics include preparations for enhancing or protecting the appearance, odour or fragrance of the body, while on the other hand cotton sticks for cosmetic purposes are cotton-tipped swabs used for cleaning a small area or for applying or removing creams or make-up to the skin. Consequently, cotton sticks for cosmetic purposes are used to clean, apply or remove cosmetics from the face or body, and are therefore complementary to cosmetics. Additionally, they usually coincide in producer, relevant public and distribution channels.
- The contested ‘lipstick cases’ are similar to the opponent’s ‘cosmetics’. These goods have the same distribution channels, target the same end users and can have the same commercial origin.
- The contested ‘massage candles for cosmetic purposes’ are similar to the opponent’s ‘essential oils’ because they coincide in producer, end user and distribution channels.
- The contested ‘massage oils’ are included in the broad category of, or overlap with, the opponent’s ‘essential oils’. Therefore, they are identical.
- The goods found to be identical or (at least) similar are directed at the public at large. The degree of attention is considered to be average.
- The relevant territory is the European Union.
- Irrespective of the language spoken by the relevant consumers, the word ‘ALAÏA’ of the earlier mark and/or the word ‘ALAYA’ of the contested sign may be associated with names or considered as meaningless words. In either case, they are not descriptive, allusive, or otherwise weak in relation to the opponent’s goods and are distinctive to a normal degree. At least a part of this public will also understand the expression ‘LUXURY MAKEUP COLLECTION’ and consider it as a non-distinctive expression providing purely promotional information, namely that the goods belong to a range of high-quality beauty products.
- The Opposition Division finds it appropriate to focus the comparison of the signs on the part of the public for which the earlier mark ‘ALAÏA’ and the word ‘ALAYA’ of the contested sign have no meanings and the expression ‘LUXURY MAKEUP COLLECTION’ of the contested sign is understood.
- The figurative element of the contested sign constitutes a visible feature within the overall impression of the contested sign. However, despite its position at the top of the sign and its large size, this figurative element does

not overshadow the word ‘ALAYA’ written in fairly standard and clearly legible letters. This word plays an independent distinctive role in the contested sign and, as the first verbal element of that sign, catches more the public’s attention than the much smaller words ‘LUXURY MAKEUP COLLECTION’ positioned at the bottom of the sign and which are non-distinctive for the consumers taken into consideration.

- Visually, the earlier mark ‘ALAÏA’ and the word ‘ALAYA’ of the contested sign coincide in four letters in the same positions (‘ALA\*A’) and differ in the penultimate letter of each word (‘Ï’/‘Y’). Because of their position, these differing letters catch the public’s attention less, given that the public reads from left to right which makes the part placed at the initial part of the word the one that first catches the reader’s attention. The coincidences concern the only element of the earlier mark and the verbal element that plays an independent distinctive role in the contested sign and is larger than the additional words of the contested sign, which have no counterpart in the earlier mark. However, the signs differ in the figurative element of the contested sign which has a significant visual impact. The difference resulting from the additional expression ‘LUXURY MAKEUP COLLECTION’ has less impact because of the size, position and non-distinctive character. Therefore, the signs are visually similar to a below-average degree.
- Aurally, irrespective of the different pronunciation rules of the languages of the relevant public, the pronunciation of the earlier mark ‘ALAÏA’ and of the word ‘ALAYA’ of the contested sign is either identical or highly similar at least for a part of the relevant public. The pronunciation differs in the sound of the expression ‘LUXURY MAKEUP COLLECTION’ of the contested sign. However, this expression may even be omitted by consumers when they refer to the contested sign. Therefore, the signs are aurally identical or highly similar at least for a part of the relevant public.
- Conceptually, the signs are not similar for the consumers who understand the meaning of the expression ‘LUXURY MAKEUP COLLECTION’. Nevertheless, this does not amount to a significant conceptual difference between the two signs in question as this expression occupies a secondary position within the contested sign and is non-distinctive.
- The earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. The opponent argues that the earlier trade mark is inherently highly distinctive. However, it should be recalled that a mark or, by analogy, its components will not have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services. Therefore, the distinctiveness of the earlier mark must be seen as normal.
- The goods are identical or (at least) similar. The signs are visually similar to a below-average degree, aurally identical or highly similar (at least for a part of the relevant public). For the consumers who understand the expression ‘LUXURY MAKEUP COLLECTION’ the signs are not conceptually similar,

which has no significant influence given that this element is non-distinctive and secondary within the whole impression given by the contested sign.

- In view of the above, and taking into account that the similarities between the signs reside in the word ‘ALAIA’, which is the sole element of the earlier mark and distinctive to a normal degree, and the word ‘ALAYA’, which plays an independent distinctive role in the contested sign, and that the differing verbal elements do not have more impact or will not be given much weight, the consumers with an average degree of attention, are likely to believe that the identical or similar goods have the same or a related commercial origin.
  - The existence of several trade mark registrations, containing the word ‘alaia’ or ‘alaya’, is not per se particularly conclusive, as it does not necessarily reflect the situation on the market.
  - Considering all the above, there is a likelihood of confusion on the part of the public taken into consideration.
- 7 On 11 September 2021, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 9 November 2021.
- 8 In its response received on 14 December 2021, the opponent requested that the appeal be dismissed.

### **Submissions and arguments of the parties**

- 9 The arguments raised in the statement of grounds may be summarised as follows:

#### *Comparison of the marks – Distinctive character of the opposed application*

- The Opposition Division misjudged the graphic element of the contested sign: it is original, it has an interesting composition and colours. In addition, it is larger than the word element ALAYA, thus it is in the foreground. Accordingly, it is the dominant element, stronger than the verbal element.
- The word ALAYA in the contested sign is not in normal typeface, but in fancy font (in particular regarding the letters ‘L’ and ‘A’).
- The two signs differ in the letter ‘Y’/‘I’. The letter ‘Y’ in the word ALAYA, makes the latter more eye-catching than the word ALAIA. The pronunciation of ALAYA is longer and fuller because of the letter ‘Y’ since the letter ‘I’ is pronounced shortly. ALAYA also stands out visually because it contains the letter ‘Y’.
- The contested sign also contains the wording ‘LUXURY MAKEUP COLLECTION’ which contributes to the distinctiveness thereof.

- The combination of fancy graphics, original lettering and adding additional words in the contested sign, with respect to the earlier mark, implies that there are no grounds to claim that the recipients of the goods marked with the contested sign may be misled and that the goods may be identified with the opponent or indicate an economic link between the applicant and the opponent.
- The two signs differ significantly.

*Relevant public – Degree of attention/Sales system (distribution channels)*

- The applicant’s products labelled with the contested sign are not sold through any direct selling system, i.e. shops, wholesalers, hairdressing, or beauty salons. They are not sold online either. The recipients of these goods are also not the opponent’s ordinary market recipients. They are customers with an increased level of attention. The sale of the applicant’s goods is only available to a narrow circle of recipients, i.e. people operating within the relevant MLM system.
- The recipients of the applicant’s products are ‘Franchise Branches’ of the FM World and its ‘Business Partners’. The goods may be purchased at demonstrations held within the MLM system or online by introducing a ‘Business Partners’ number while the opponent’s products are purchased by ordinary average market buyers.
- The Opposition Division’s reasoning, according to which ‘the particular circumstances in which the goods are actually marketed have no impact since they may vary in time depending on the proprietor’s wishes, cannot be accepted. Switching from a system to the other requires high inputs of finances, personnel, and investment.
- The entities introducing products on the market do not compete in any way.
- The prices of the products sold with the contested sign are relatively high, which implies that the level of attention of the average recipient is high (13/06/2007, T-441/05, I, EU:T:2007:178). The goods labelled with the contested sign cannot be commodities for ‘current consumption’ available to the average recipient. Accordingly, the level of attention of the consumer is not average, but increased.
- Given that the two marks differ significantly, the relevant goods have different recipients and different distribution channels, the level of attention of the recipients of the applicant’s goods is increased and the fact they are not ordinary market customers, there is no basis for upholding the contested decision.

10 The arguments raised in response may be summarised as follows:

- Whilst the pattern graphic of the contested sign may dominate the sign from a visual perspective, it has no impact on the phonetics of the mark.



Furthermore, from a visual perspective, the image is likely to be considered as decorative rather than having trade mark qualities. Likewise, the descriptive words ‘LUXURY MAKEUP COLLECTION’ may have an impact on the visual appearance of the mark, but they are so descriptive that they will quickly be overlooked in favour of the distinctive word ALAYA.

- The word ALAYA plays an independent distinctive role in the contested sign and, as the first verbal element, catches more the public’s attention.
- Whilst the degree of visual similarity may not be high, it is at least average and, in any event, the two marks are phonetically similar to a high degree.
- The respective marks are highly similar. The graphic element (being a decorative pattern) and the descriptive strapline (which is just as apt to describe the opponent’s goods as those of the applicant) are incapable of distinguishing the applicant’s goods from those of the opponent.
- The degree of distinctiveness of the earlier trade mark ALAÏA is normal and the distinctiveness of the word ALAYA in the contested sign is also normal, such that consumers will focus on (and compare) those elements.
- The applicant’s argument that the respective goods have different circles of recipients and different distribution channels is irrelevant. The opponent’s earlier rights are protected for identical and similar goods, that are not limited by trade channels or recipients.
- The applicant asserted that the level of attention of their consumers is ‘increased’ because of the high cost of the goods and the fact that they reach an elite circle of recipients. However, the contested goods are everyday consumer goods targeted at the public at large and the level of attention is average.

### **Reasons**

- 11 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 12 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

### *Scope of the appeal*

- 13 The applicant appealed the contested decision in its entirety, as the Opposition Division upheld the opposition and rejected the contested EUTM application.
- 14 Therefore, the Board will assess the legality of the contested decision in full.

*Article 8(1)(b) EUTMR*

- 15 Pursuant to Article 8(1)(b) EUTMR, a European Union trade mark application shall be rejected upon opposition where there is an earlier trade mark as referred to in Article 8(2) EUTMR and if, because of the identity with, or similarity to, the earlier sign and the identity or similarity between the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier mark is protected. A likelihood of confusion includes a likelihood of association with the earlier mark.
- 16 According to settled case-law, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 16-18; 29/09/1998, C-39/97, Canon, EU:C:1999:323, § 17). For the purposes of applying Article 8(1)(b) EUTMR, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (22/01/2009, T-316/07, easyHotel, EU:T:2009:14, § 42 and the case-law cited therein).
- 17 In line with the same case-law, a likelihood of confusion must be assessed globally, based on how the relevant public would perceive the marks and the goods and services in question and taking into account all factors relevant to the circumstances of the case (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 16; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18).

*The relevant public*

- 18 Account should be taken of the average consumer of the goods and services at issue, who is reasonably well-informed and reasonably observant and circumspect. The consumer's level of attention is likely to vary according to the category of goods and services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 42).
- 19 The relevant public is made up of consumers liable to use both the goods of the earlier mark and the goods covered by the mark applied for (13/05/2015, T-169/14, Koragel / CHORAGON, EU:T:2015:280, § 25 and the case-law cited).
- 20 When a section of the relevant public consists of professionals with a higher level of attention and another section of the relevant public consists of reasonably observant and circumspect average consumers, the public with the lowest level of attention must be taken into consideration for assessing likelihood of confusion (25/06/2020, T-114/19, B (fig.) / b (fig.), EU:T:2020:286, § 36).
- 21 The contested decision considered the level of attention of the relevant public as being average.

- 22 The applicant claims that the level of attention of its customers is increased, because its products are made available through a specific sales system, i.e. shops, wholesalers, hairdressing, or beauty salons (not online and not to the opponent's ordinary market recipients). According to the applicant, its goods are only made available to a narrow circle of recipients, i.e. people operating within the relevant MLM system (offline at demonstrations & meetings, online with a login as Business Partners), and their prices are relatively high. To this end, the applicant submitted a screenshot of its website demonstrating the prices of some products of its luxury make-up collection (e.g. GBP 36 for a powder, GBP 31 for an eyeshadow palette, GBP 25 for a face serum).
- 23 The applicant's argument that the relevant public is a professional public consisting exclusively of business customers must be rejected. In this regard, it appears that the relevant argumentation focuses on the goods actually marketed by the applicant on the one hand and by the opponent on the other hand. However, it must be recalled that the rights conferred by the mark extend to the goods and services for which it is protected. When determining the relevant public, the list of goods and services protected by the mark has to be taken into account rather than the products that are actually marketed under the mark in question. As long as the list has not been amended, the commercial decisions taken by the proprietor of the mark do not influence the definition of the relevant public (20/06/2019, T-389/18, WKU / WKA et al., EU:T:2019:438, § 39 and the jurisprudence cited).
- 24 The relevant public must therefore be determined not by reference to the goods actually marketed by the applicant and the opponent, but by reference to the list of goods set out in paragraphs 1 and 5 above (20/06/2019, T-389/18, WKU / WKA et al., EU:T:2019:438, § 40).
- 25 According to their description, the contested goods in Class 3 (cosmetics, perfumery products, bleaching salts, essential oils, soaps and further hair/dental/body care products) are not intended exclusively for a specialised public consisting of wholesalers and/or hair/body/beauty experts; they are rather categories that cover a wide variety of products. Thus, the contested goods in Class 3 are directed at the public at large and at business customers with specific professional knowledge or expertise (e.g. hair/body/beauty experts, wholesalers).
- 26 Regarding the level of attention of the relevant public, the Board points out that consumers tend to be attentive in the acquisition of body care products, on grounds of aesthetic considerations or personal preferences, sensitivity, allergies, type of skin and hair and so forth, as well as the expected effect of the products (18/10/2011, T-304/10, Caldea, EU:T:2011:602, § 58; for a critical overview of the relevant jurisprudence regarding cosmetics in Class 3, 23/03/2022, R 1410/2021-5, EST. KORRES 1996 HYDRA-BIOME (fig.) / Hydrabio et al., § 18-21). In this regard, it must be also taken into account that the prices of the relevant products can vary mainly according to their ingredients and special features (luxury products), as demonstrated by the applicant.
- 27 In light of the above, in the present case, the Board considers the level of attention of, at least part of, the relevant public as varying from average to high.

- 28 The earlier mark is a European Union trade mark. Thus, the relevant territory in respect of which the likelihood of confusion must be assessed is the European Union as a whole. This assessment is not disputed by the parties.

*Comparison of the goods*


- 29 The Opposition Division held that the contested goods in Class 3 are identical or (at least) similar.
- 30 The Board notes that the Opposition Division's assessment and conclusion regarding the comparison of the goods in question have not been disputed by the applicant.
- 31 The Board agrees with the reasoning carried out in the contested decision and the outcome as to the relevant goods in Class 3 being partly identical and partly similar, to which it hereby refers, in order to avoid repetition, bearing in mind that it may adopt the grounds of a decision taken by the Opposition Division, which thus make up an integral part of the reasons for the Board's own decision (13/09/2010, T-292/08, Often, EU:T:2010:399, § 48; 11/09/2014, T-450/11, Galileo, EU:T:2014:771, § 36).
- 32 The Board also notes that goods are identical when they are included in a more general category designated by the other mark (05/02/2020, T-44/19, TC Touring Club, EU:T:2020:31, § 91; 13/09/2018, T-94/17, Tigha, EU:T:2018:539, § 46).
- 33 Article 1(a) of Regulation (EC) No 1223/2009 of the Parliament and of the Council of 30 November 2009 on cosmetic products ('the Cosmetics Regulation') defines a 'cosmetic product' as 'any substance or mixture intended to be placed in contact with the external parts of the human body (epidermis, hair system, nails, lips and external genital organs) or with the teeth and the mucous membranes of the oral cavity with a view exclusively or mainly to cleaning them, perfuming them, changing their appearance, protecting them, keeping them in good condition or correcting body odours'.
- 34 Therefore, the Board confirms that all the contested goods are partly identical and partly similar to the opponent's goods.

*Comparison of the signs*

- 35 The signs in conflict have to be compared visually, phonetically and conceptually. Such a comparison must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25; 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).
- 36 The perception of the marks by the average consumer of the goods in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (12/06/2007, C-334/05 P,

Limoncello, EU:C:2007:333, § 35 and the case-law cited; 20/11/2019, T-695/18, FLORAMED (fig.) / MEDIFLOR et al., EU:T:2019:794, § 42).

- 37 The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41 and the case-law cited).
- 38 It is only if all the other components of the mark are negligible that the assessment of similarity can be carried out solely on the basis of the dominant element (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42). According to case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, namely, the visual, phonetic and conceptual aspects (06/06/2013, T-580/11, Nicorono, EU:T:2013:301, § 35 and the case-law cited).
- 39 The signs to be compared are:

<b>ALAÏA</b>	
<i>Earlier mark</i>	<i>Contested sign</i>

- 40 The earlier word mark ‘ALAÏA’ consists of five letters and might be perceived as a name. According to the case-law, the relevant public perceives marks containing surnames or forenames of persons without any particular conceptual meaning, unless the forename or surname is particularly well-known, inter alia, as the name of a famous person (27/06/2019, T-268/18, Luciano Sandrone / DON LUCIANO, EU:T:2019:452, § 87; 30/06/2021, T-531/20, ROLF (Fig.) / Wolf et al., EU:T:2021:406, § 63).
- 41 In the present case, the Board did not identify any term with which the relevant public could associate the name ‘ALAÏA’. Therefore, the earlier EUTM ‘ALAÏA’

has no meaning in relation to the relevant goods in Class 3 and is normally distinctive.

- 42 The contested sign is figurative. It contains a figurative element composed of ornamental patterns in various shapes (squares and hearts). This figurative element does not represent any clear and unambiguous meaning as a whole. Underneath this figurative element are the word elements: 'ALAYA' and 'LUXURY MAKEUP COLLECTION'. All the elements of the contested sign have an olive-green colour.
- 43 The word element 'ALAYA' of the contested sign also consists of five letters and might also be perceived as a name (as the earlier word mark 'ALAÏA'). The Board did not identify any term with which the relevant public could associate it. Thus, the word element 'ALAYA' of the contested sign has no meaning in relation to the relevant goods in Class 3 (cosmetics) and is normally distinctive.
- 44 The wording 'LUXURY MAKEUP COLLECTION' is descriptive in relation to the relevant goods in Class 3 (cosmetics), as it designates at least their kind (makeup collection) and quality (luxury). The relevant consumer throughout the EU will perceive it as referring to a selection of high-quality makeup products. In particular, the aforementioned is the literal meaning of the words 'LUXURY', 'MAKEUP' and 'COLLECTION' in English. In addition, they will be understood by non-English speakers, as all of them are basic English words extensively used in commerce and advertising (especially in the fashion sector). Consequently, the wording 'LUXURY MAKEUP COLLECTION' provides the purely promotional information that the goods belong to a range of high-quality beauty products, as correctly demonstrated by the Opposition Division (19/02/2021, R 348/2020-2, ICONIC LUXURY HOTELS (fig.) / Icon by petit palace hoteles et al., § 44; 18/03/2019, R 1480/2018-4, NYX PROFESSIONAL MAKEUP pin-up tease (fig.) / Teeez, § 24; 27/05/2021, R 1513/2020-1, UNICA COLLECTION (fig.) / unico hotels (fig.), § 46; 29/10/2020, R 880/2020-4, Studio kassl / SC STUDIO CLASSICS COLLECTION (fig.), § 28). Thus, it is non-distinctive.
- 45 The word element ('ALAYA') of the contested sign is written in a slightly stylised and clearly legible upper-case script with a small 'cutting' in the letters 'L' (on its down left side) and 'Y' (on its right side). This word plays an independent distinctive role in the contested sign and, as the first verbal element of that sign, catches more the public's attention (who reads from left to right). To the contrary, the non-distinctive English wording 'LUXURY MAKEUP COLLECTION' is of a secondary importance due to its subordinate position and small size. Even though the figurative element of the contested sign is large and visually co-dominant, the relevant public is likely to refer to the mark by the word element 'ALAYA'.
- 46 Indeed, when a trade mark is composed of verbal and figurative elements, the consumer is likely to focus primarily on the denominative element as a point of reference (20/06/2019, T-390/18, WKU WORLD KICKBOXING AND KARATE UNION (fig.) / WKA et al., EU:T:2019:439, § 65; 02/12/2020, T-687/19, Mar / MARK (fig.), EU:T:2020:582, § 63) and there is no reason why this principle would not apply in the present case. Neither the large-sized

decorative figurative element nor the small-sized non-distinctive wording 'LUXURY MAKEUP COLLECTION' are likely to help identify the contested goods as coming from a particular undertaking.

- 47 **Visually**, the signs are similar to a low degree. The earlier word mark 'ALAÏA' and the word 'ALAYA' of the contested sign coincide in four letters in the same positions ('ALA\*A') and differ in the penultimate letter of each word ('Ï/'Y'). Because of their position, these differing letters catch the public's attention less, given that the public reads from left to right which makes the part placed at the beginning of the word the one that first catches the reader's attention. The coincidences concern the only element of the earlier mark and the verbal element that plays an independent distinctive role in the contested sign and is larger than the additional wording 'LUXURY MAKEUP COLLECTION' of the contested sign, which has no counterpart in the earlier mark (28/05/2020, T-333/19, GN Genetic Nutrition Laboratories (fig.) / GNC GENERAL NUTRITION CENTERS et al., EU:T:2020:232, § 41-44, where the signs were found to be visually similar to an average degree because of the common beginnings of the dominant elements GN and GNC).
- 48 There is no great variation in the stylisation of the word elements of the contested sign, as claimed by the applicant. All word elements in the contested figurative mark are easily recognisable and legible.
- 49 The signs differ due to the figurative element of the contested sign (ornamental patterns in various shapes) which has a significant visual impact. The difference resulting from the additional expression 'LUXURY MAKEUP COLLECTION' has less impact because of its size, position and non-distinctive character.
- 50 **Aurally**, the signs are identical or highly similar at least for a part of the relevant public, as they will be both pronounced 'a-la-ja' or 'a-la-ia'. Contrary to the applicant's submission, there are no grounds to consider that the pronunciation of ALAYA is longer and fuller because of the letter 'Y' and that the letter 'I' is pronounced shortly.
- 51 The pronunciation differs in the sound of the expression 'LUXURY MAKEUP COLLECTION' of the contested sign. Taking into account the small size and position of these words within the sign (at the end), the fact that they have less impact and the tendency of consumers to abbreviate a mark comprising a number of words to make it easier to pronounce, this expression may even be omitted by consumers when they refer to the contested sign.
- 52 In any event, it must be recalled that where a trade mark consists of several words, consumers tend not to pronounce non-distinctive word elements of the sign if those elements can be clearly separated from the distinctive element of the trade mark. This is particularly true if the additional, less distinctive words are written in lower case or are placed at the end of the sign, as in the present case (08/11/2017, T- 271/16, THOMAS MARSHALL Garments of legends (fig.) / MARSHALL et al., EU:T:2017:787, § 69; 14/11/2017, T- 129/16, claranet (fig.) / CLARO et al., EU:T:2017:800, § 74).

- 53 **Conceptually**, the signs are dissimilar for the consumers who understand the meaning of the expression ‘LUXURY MAKEUP COLLECTION’. Nevertheless, this does not amount to a significant conceptual difference between the two signs in question as this expression occupies a secondary position within the contested sign and is non-distinctive, whereas the highly similar word elements ‘ALAÏA’ and ‘ALAYA’ are meaningless.

*Distinctiveness of the earlier mark*

- 54 Account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element that is descriptive of the goods and services for which it has been registered and other criteria; in particular, how intensive, geographically widespread and long-standing the use of the mark has been (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 22-23).
- 55 In determining the degree of distinctive character of a trade mark, an overall assessment has to be made of the greater or lesser capacity it has to identify the goods or services for which it has been registered as coming from a particular undertaking.
- 56 As such, the distinctive character of a trade mark can only be appraised, firstly, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public.
- 57 The earlier EUTM ‘ALAÏA’ is meaningless for the relevant public, as already mentioned. Thus, the earlier mark does not convey any semantic content in relation to the earlier goods in Class 3 (bleaching/cleaning/scouring/abrasive preparations, soaps perfumery, cosmetics, essential oils, hair lotions, dentifrices; make-up preparations, nail varnish, lipsticks, false nails).
- 58 As a result, the earlier mark enjoys a normal degree of inherent distinctiveness.

*Overall assessment of the likelihood of confusion*

- 59 The appreciation of likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the earlier mark on the market, the association which can be made with the registered mark, the degree of similarity between the marks and between the goods or services identified. It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).
- 60 Such a global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular, the similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods or services may be offset by a lower degree of similarity between the marks, and vice versa (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 29/09/1998, C-39/97, Canon, EU:C:1998:442,



§ 17). The more distinctive the earlier mark, the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

- 61 Furthermore, it needs to be taken into account that the consumer rarely has the opportunity to make a direct comparison between the different marks, but must place his or her trust in the imperfect recollection of them that he or she has kept in his or her mind (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23; 03/03/2004, T-355/02, Zirh, EU:T:2004:62, § 41; 18/04/2007, T-333/04 & T-334/04, House of Donuts, EU:T:2007:105, § 44).
- 62 In the present case, the goods in conflict in Class 3 were found to be partly identical and partly similar. They are directed at the public at large and at business customers with an average to high degree of attention. The signs in conflict are visually similar to a low degree and aurally identical or highly similar (at least for a part of the relevant public). For the consumers who understand the expression ‘LUXURY MAKEUP COLLECTION’, the signs are conceptually dissimilar. The earlier mark enjoys a normal degree of inherent distinctiveness.
- 63 In view of the above and taking into account that the similarities between the signs reside in the word ‘ALAIÀ’, which is the sole element of the earlier mark and distinctive to a normal degree, and the word ‘ALAYA’, which plays an independent distinctive role in the contested sign, the relevant public may attribute the origin of the identical and similar goods covered by the contested sign to the owner of the earlier mark. The secondary and/or non-distinctive (verbal and figurative) elements of the contested sign do not have more impact or will not be given much weight; thus, they are not sufficient to avoid a likelihood of confusion. It is conceivable that the contested mark may be perceived by the relevant public as a sub-brand or a variation of the earlier mark (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49).
- 64 In light of the foregoing considerations and taking into account the notion of imperfect recollection and the interdependence of the various factors, there exists a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR.
- 65 Even for a public with a higher level of attentiveness, the fact remains that the average consumer only rarely has the chance to make a direct comparison between the different marks, but must place his or her trust in the imperfect picture of them that he or she has kept in mind (16/07/2014, T-324/13, Femivia, EU:T:2014:672, § 48; 15/10/2020, T-49/20, Robox / Orobox, EU:T:2020:492, § 92, 99). For example, when there is a strong likelihood of confusion created by other factors, such as the identity or close overall similarity between the marks and the identity of the goods/services, the attention of the relevant public alone cannot be relied upon to prevent confusion (21/11/2013, T-443/12, ancotel, EU:T:2013:605, § 53-56; 28/05/2020, T-333/19, GN Genetic Nutrition Laboratories (fig.) / GNC GENERAL NUTRITION CENTERS et al., EU:T:2020:232, § 59).

- 66 Accordingly, the applicant's argument that the relevant public will be more aware of the identity of the producer of the contested goods is ineffective (10/11/2021, T-239/20, Ruxximera / Ruximera, EU:T:2021:771, § 57; 10/11/2021, T-542/20, Ruximblis / Ruximera et al., EU:T:2021:775, § 57; 10/11/2021, T-248/20, Ruxymla / Ruximera, EU:T:2021:772, § 57).
- 67 As a result, a likelihood of confusion pursuant to Article 8(1)(b) EUTMR cannot be ruled out for all the contested goods.
- 68 Finally, given that earlier EUTM registration No 2 613 461 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268, § 45-46; 08/05/2019, T-37/18, Brave Paper / BRAVO et al., EU:T:2019:300, § 71).
- 69 Accordingly, since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the claim of an enhanced degree of distinctiveness of the earlier mark under Article 8(5) EUTMR.

### *Conclusion*

- 70 The Board concludes that there is a likelihood of confusion between the contested sign and the earlier EUTM for the relevant public of the EU interested in the contested goods in Class 3 (cosmetics, perfumery products, bleaching salts, essential oils, soaps and further hair/dental/body care products).
- 71 In light of the above, the appeal must be dismissed, the contested decision must be confirmed, and the opposition must be upheld.

### **Costs**

- 72 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent's costs of the opposition and appeal proceedings.
- 73 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550.
- 74 As to the opposition proceedings, the Opposition Division ordered the applicant to bear the opposition fee of EUR 320 and the opponent's representation costs which were fixed at EUR 300. This decision remains unaffected. The total amount for both proceedings is therefore EUR 1 170.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the opponent's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the applicant in the opposition and appeal proceedings is EUR 1 170.**

Signed

V. Melgar

Signed

R. Ocquet

Signed

S. Rizzo

Registrar:

Signed

p.o. P. Nafz

