



World Intellectual Property
Organisation (WIPO)
International Bureau
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Your Reference:
International Registration No:
WO0000001536751
Examiner: Claire Woodman
Direct Telephone: +44(0)1633814566
Date: 28 January 2021

Intl Reg No: WO0000001536751
Mark: HYALU CALM
Holder: LABORATOIRES VIVACY
Class(es): 3, 5

**Notification Of A Provisional Total Refusal Of Protection Based On An
Opposition By The United Kingdom Intellectual Property Office In
Accordance With Article 5 Of The Madrid Protocol**

I am writing to inform you that following receipt of an opposition to the above trade mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and **return it to this office** within **two months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at ipo.gov.uk/tmforms

The TM8 should be received on or before **26 March 2021** unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom (which for the purpose of the Act includes the Isle of Man, the Channel Islands and Gibraltar) on a form TM33 'Appointment

or change of agent or contact address', which is available at ipo.gov.uk/tmforms within this two month period.

If one is not provided within this time the refusal will be made final.

Claire Woodman

Trade Marks Registry

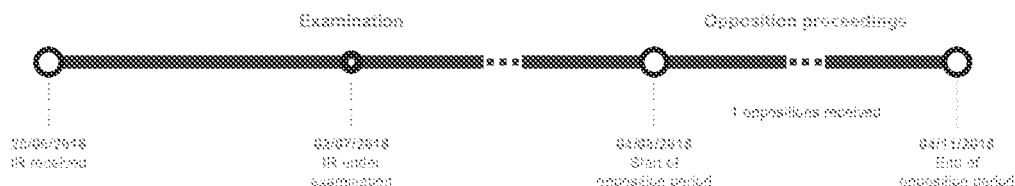


Protect your intellectual property in the European Union

EUTM file information

YALU
1410088

Timeline



Trade mark information

Name	YALU	Filing date	
Filing number	1410088	Registration date	13/12/2017
Basis	IR (Search on WIPO database)	Expiry date	13/12/2027
Date of receipt	28/06/2018	Designation date	13/12/2017
Type	Word	Filing language	French
Nature	Individual	Second language	Italian
Nice classes	3, 5, 35 (Nice Classification)	Application reference	5376/160
Vienna Classification		Trade mark status	Opposition pending
		Acquired distinctiveness	No

Goods and services

français (fr)



3 Savons; produits de parfumerie; huiles essentielles; lotions de soins capillaires; gel anti-âge; lotions anti-âge; hydratants anti-âge à usage cosmétique; crèmes anti-vieillessement; crèmes antirides; crèmes pour le visage [non médicamenteux]; cold-cream à usage non médical; cosmétiques pour le traitement des rides; préparations cosmétiques antirides pour le visage à usage topique; crèmes cosmétiques; crème pour blanchir la peau; eaux de toilette; eaux de senteur; préparations d'aloë vera à usage cosmétique; arômes alimentaires [huiles essentielles]; astringents à usage cosmétique; baumes autres qu'à usage médical; cosmétiques; cosmétique pour cils; cosmétiques pour les sourcils; gels de massage autres qu'à usage médical; cosmétiques, à savoir gels; gels hydratants [cosmétiques]; gels pour le visage; gels cosmétiques pour le contour des yeux; crèmes, lotions et gels hydratants; graisses à usage cosmétique; gelée de pétrole à usage cosmétique; lait d'amandes à usage cosmétique; laits de toilette; lotions à usage cosmétique; masques de beauté; huiles de toilette; huiles pour la parfumerie; huiles à usage cosmétique; pommades à usage cosmétique; préparations cosmétiques pour le bronzage de la peau; préparations cosmétiques pour le bain; préparations cosmétiques pour l'amincissement; préparations cosmétiques pour le soin de la peau; produits de parfumerie; préparations de maquillage; produits de toilette; serviettes imprégnées de lotions cosmétiques, cosmétiques pour la peau, crèmes non médicamenteuses pour la peau.

5

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X

Préparations dermatologiques; produits pharmaceutiques dermatologiques; substances pharmaceutiques dermatologiques; préparations pharmaceutiques à usage dermatologique; crèmes à usage dermatologique; gels à usage dermatologique; lotions pour la peau à usage médical; lotions de soin pour la peau à usage médical; préparations de soin pour la peau à usage médical; crèmes médicamenteuses pour la peau; compléments alimentaires, suppléments nutritionnels, compléments minéraux, compléments diététiques (à usage médical et non), préparations nutraceutiques, vitaminés, antioxydants, pour la flore intestinale, préparations, bactériennes, préparations alimentaires (à usage médical et non), compléments homéopathiques (à usage médical et non), médicaments homéopathiques, produits pharmaceutiques homéopathiques; substances diététiques à usage médical et substances alimentaires diététiques; compléments alimentaires; compléments vitaminés; compléments nutritionnels; compléments antioxydants; compléments probiotiques; produits, substances, préparations pharmaceutiques et produits, substances, préparations parapharmaceutiques.

35 Services de vente au détail et en gros pour des tiers également par correspondance et par autres moyens de communications y compris internet de savons, produits de parfumerie, huiles essentielles, lotions de soins capillaires, gel anti-âge, lotions anti-âge, hydratants anti-âge à usage cosmétique, crèmes anti-âge, crèmes antirides, crèmes pour le visage [non médicamenteux], cold-cream à usage non médical, cosmétiques pour le traitement des rides, préparations cosmétiques antirides pour le visage à usage topique, crèmes cosmétiques, crème pour blanchir la peau, eaux de toilette, eaux de senteur, préparations d'aloë vera à usage cosmétique, arômes (huiles essentielles), astringents à usage cosmétique, baumes autres qu'à usage médical, cosmétiques, cosmétique pour cils, cosmétiques pour les sourcils, gels de massage autres qu'à usage médical, cosmétiques, à savoir gels, gels hydratants [cosmétiques], gels pour le visage, gels cosmétiques pour le contour des yeux, crèmes, lotions et gels hydratants, graisses à usage cosmétique, gelée de pétrole à usage cosmétique, lait d'amandes à usage cosmétique, laits de toilette, lotions à usage cosmétique, masques de beauté, huiles de toilette, huiles pour la parfumerie, huiles à usage cosmétique, pommades à usage cosmétique, préparations cosmétiques pour le bronzage de la peau, préparations cosmétiques pour le bain, cosmétiques pour l'amincissement, préparations cosmétiques pour le soin de la peau, produits de parfumerie, préparations de maquillage, produits de toilette, serviettes imprégnées de lotions cosmétiques, cosmétiques pour la peau, crèmes dermatologiques [non médicamenteux]; services de vente au détail et en gros pour des tiers également par correspondance et par autres moyens de communications y compris internet de préparations dermatologiques, produits pharmaceutiques dermatologiques, substances pharmaceutiques dermatologiques, préparations pharmaceutiques à usage dermatologique, crèmes à usage dermatologique, gels à usage dermatologique, lotions pour la peau à usage médical, lotions de soin pour la peau à usage médical, préparations de soin pour la peau à usage médical, cold-cream à usage médical, compléments alimentaires, préparations et substances nutritionnels, minéraux, diététiques (à usage médical et non), nutraceutiques, vitaminés, antioxydants, pour la flore intestinale bactériens et préparations alimentaires et substances homéopathiques (à usage médical et non), substances diététiques à usage médical et substances alimentaires diététiques, compléments alimentaires, compléments vitaminés, compléments nutritionnels, compléments antioxydants, complément probiotiques, produits, substances, préparations pharmaceutiques; aide à la direction des affaires en matière de franchise.

Description

No data

Owners

SOFAR SWISS SA

ID	n/a	Country	CH - Switzerland	Hidden. You can set your contact details to be publicly available via the User Area.
Organisation	n/a	State/country	n/a	
Legal status	Aktiengesellschaft (AG)	Town	n/a	
		Post code	n/a	Hidden. You can set your contact details to be publicly available via the User Area.
		Address	Via Nassa 3 CH-6900 Lugano	Hidden. You can set your contact details to be publicly available via the User Area.

Representatives

HOFFMANN · EITL PATENT- UND RECHTSANWÄLTE PARTMBB

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ID	10624	Country	DE - Germany	Correspondence address
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Organisation	n/a	State/country	n/a	HOFFMANN · EITLE Patent- und Rechtsanwälte PartmbB Postfach 81 04 20 D-81904 München ALEMANIA	Hidden. You can set your contact details to be publicly available via the User Area.
Legal status	Legal person	Town	München		
Type	Association	Post code	81925		
		Address	Arabellastr. 30		Hidden. You can set your contact details to be publicly available via the User Area.
					Hidden. You can set your contact details to be publicly available via the User Area.

Correspondence

From	Procedure	Filing number	Subject	Date	Actions
	Opposition	003067805	B200B	24/11/2020	
	Opposition	003067805	B200A	23/11/2020	
IR		1410088	MPER1 - Notification of the entry / deletion of a representative in the EUIPO database	10/09/2020	
	Opposition	003067805	B227B - Notification to the applicant/holder of suspension of the opposition proceedings	12/05/2020	
	Opposition	003067805	B227A - Notification to the opponent of suspension of the opposition proceedings	12/05/2020	
	Opposition	003067805	B228B - Notification to the applicant/holder of refusal of the request for suspension	14/04/2020	
	Opposition	003067805	B228A - Notification to the opponent of refusal of the request for suspension	14/04/2020	
	Opposition	003067805	B236B	03/03/2020	
	Opposition	003067805	B236A - Notification to the applicant/holder of observations from the opponent	03/03/2020	
	Opposition	003067805	B224B	07/01/2020	
Showing 1 to 10 of 48 entries					

IR transformation

No data

Seniority

No data

Exhibition priority

No data

Priority

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Country	Filing number	Click for more information	State	X	Status

Country	Filing number	Date	Status
Switzerland	707452	13/06/2017	Claimed
Showing 1 to 1 of 1 entries			

Publications

Publication number	Date	Section	Description
2018/124	04/07/2018	M.1	IR_M_1
Showing 1 to 1 of 1 entries			

Cancellation

No data

Recordals

No data

Oppositions

Filing number	Date	Grounds	Opponent	Representative	Language	Reference	Status	Extent of opposition
003067805	02/11/2018	Likelihood of confusion	FIDIA FARMACEUTICI S.p.A.	DR. KUNZ-HALLSTEIN RECHTSANWÄLTE	French	S376/127W1j22/pfr	Suspended	Class 3 S produits parfume essentiels soins de visage; hyd; âge à us cosmétique anti-vieillesse; crèmes; crèmes [non mé cold-cre; non mé cosmétique traitement; préparat cosmétique pour le v topique; cosmétique pour bla eaux de de sente préparat vera à u cosmétique aliment; essentielle; astringe; cosmétique autres q médical; cosmétique cosmétique; sourcils; massage; usage m
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Filing number	Date	Class code	Opponent	Representation	Language	Reference	Status	Extent of search
								geis; gel [cosmét pour le v cosmétique contour crèmes, hydrata usage co gelée de usage co d'amanc cosmétique toilette; usage co masque huiles de huiles p parfume usage co pomma cosmétique prépara cosmétique bronzag prépara cosmétique bain; pr cosmétique l'amincis prépara cosmétique soin de l produits parfume prépara maquille de toilet imprégn cosmétique cosmétique peau; cr médicar pour la p Prépara dermat produits pharma dermat substan pharma dermat prépara pharma usage dermat crèmes dermat à usage dermat lotions p usage m de soin usage m prépara pour la p médical médicar pour la p complér aliment supplém nutrition complér minérau complér
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Click for more information x								

Filing number	Date	Classcode	Opponent	Representation	Language	Reference	Status	Extent of oppo
								diététique: médical et préparatio nutraceuti vitaminés, antioxydar fiore intest préparatio bactérienr préparatio alimentair médical et compléme homéopat usage méc médicame homéopat produits pharmacei homéopat substance: diététique: médical et alimentair diététique: compléme alimentair compléme vitaminés; compléme nutritionni compléme antioxydar compléme probiotiqu produits, s préparatio pharmacei produits, s préparatio parapharn

Showing 1 to 1 of 1 entries



Appeals

No data

Decisions

No data

Renewals

No data

Trade mark relations

No data

International Applications

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No data

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✕



Intellectual Property Office

Form TM7

Notice of opposition and statement of grounds

Fee ☒ £100 Opposition based on Section 5(1) and/or 5(2) ONLY

☐ £200 Opposition based on, or including, any other grounds

Note: If you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200

Use this form to notify of an opposition to a trade mark application or international registration and to set out the grounds on which you are basing this opposition.

Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2): use Form TM7F.

1. Trade mark number

Number of the trade mark you are opposing. If the opposition concerns an International Registration, help us identify the correct trade mark by adding "IR"

IR00001536751

2. Full name of applicant/holder

Whose trade mark you are opposing

LABORATOIRES VIVACY

3. Full name of opponent

SOFAR SWISS SA

Address

If the address is not within the United Kingdom, European Economic Area (EEA – which includes the European Union) or the Channel Islands you must have a representative in one of these regions and complete section 4 below

PLEASE NOTE: Publication of name and address and other information you provide. We publish the owner's name and address and other information you provide in our searchable records. You should provide a business or PO Box address if you do not want your home address published. I understand that name and address details and other information I provide will be published. ☐

Via Nassa 3

Lugano

Switzerland

Postcode CH-6900

ADDITIONAL INFORMATION: It will no longer be possible for two (or more) parties to jointly oppose a trade mark based on earlier marks/rights that they each own, unless the parties jointly own the relevant earlier marks/rights. Separate oppositions will now be required. See section 38(2A) of the Act.

Email address

Complete if you have no representative and would like us to correspond with you by email

4. Representative name

If you have no representative, go to section 5.

Hoffmann Eitle PartmbB

Address

The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.

NOTE: We will communicate with the representative if this section has been completed.

13–15 Bouverie Street

London

United Kingdom

Postcode EC4Y 8DP

Email address

Complete if you would like us to correspond with you by email

dlewis@hoffmanneitle.com

5. Related proceedings

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.

IPO Registry

UK Courts

EUIPO

Number

6. Opposition notification date

If you have informed the applicant/holder of an intention to oppose the trade mark application, designation – enter the date you notified them.
[**See Note]

****Note:** An opposition launched without giving the applicant or holder a reasonable opportunity to withdraw the application, international designation or amendment may result in the opponent being ineligible for an award of costs.

7. Declaration

I believe that the facts stated in this form and the attached statement of grounds are true.

Signature

D. Lewis

Name

(BLOCK CAPITALS)

DEBRA LEWIS

Date

14 January 2021

8. Your reference

Complete if you would like us to quote this in communications with you, otherwise leave blank.

E1011314

Contact details

Name, daytime telephone number of the person to contact in case of query.

Debra Lewis
Apollonia Werner
+44 207 4270200
+49 89 924090

Number of sheets attached to this form

5

Checklist

Please make sure you have remembered to:



Sign and date the form

Email your form to us:

Send your form, saved as a PDF to:

forms@ipo.gov.uk

For help saving your form as a PDF see:

<https://www.gov.uk/government/publications/how-to-file-documents-with-the-intellectual-property-office/how-to-file-documents-with-the-intellectual-property-office>

If you cannot email your form, post to:

Intellectual Property Office
Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)

☒

Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> COMPLETE SECTION A

☐

Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION B

☐

Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION C

☐

Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION D

☐

Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION E

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

☐	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
☐	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
☒	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number

Your trade mark

IR00001410088

Type of mark

Please tick

☐	UK	☐	EUTM	☒	International
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Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

YALU

Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

☒	All goods and services
☐	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?

☐

Yes

☒

No > GO TO Q4

Q3. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☐

Yes

☐

No > GO TO Q3b

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

☐	All goods and services
☐	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

> GO TO Q4.

Q3b. Please state any proper reasons for non-use.

DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?

✓	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar.

All of the goods of the opposed mark are identical to those of the earlier mark.

The opposed mark HYALU CALM relates to dermatological, skin care and cosmetic products. In such a context the word "calm" is not distinctive as it indicates that the products are for calming irritated skin. The word "hyalu" does not have a meaning in English and also appears at the beginning of the mark, both of these factors indicating that the distinctive and dominant part of the mark is "HYALU". The customers for such products are likely to be the general public and they are likely to pay no more than average attention to the purchase of such products. The dominant and distinctive part of the mark "HYALU" is phonetically very similar to the earlier mark YALU, the only difference being a slight "H" sound at the beginning of the word, if indeed this letter is pronounced at all, as the "H" is silent in many English words and is not pronounced in others in many regions. Furthermore, the marks are visually very similar as the marks only differ by the addition of the letter "H" in the opposed mark. Conceptually, neither mark has meaning in English and therefore exhibit no conceptual differences. Due to the strong visual and phonetic similarities between the respective marks and the identical nature of their respective goods, there exists a likelihood of confusion.

Fees and payment

We will only process the form with this section completed (one form per payment)

To check the correct fee for this form, search on [GOV.UK](https://www.gov.uk/search?q=trade+mark+forms+and+fees) for 'trade mark forms and fees'

Total Fee Paying (£)

100

Your own reference (Optional)

E1011314

Your contact details should we have a query

Name

Debra Lewis/Martina Selvadurai

Email

dlewis@hoffmanneitle.com; mselvadurai@hoffmanneitle.com

Phone

+44 207 4270200

How would you like to pay?

Tick one

☐

Using a debit or credit card – you will need the internet to pay by card

- 1** Go to our secure website – <https://fees.ipa.gov.uk/pay>
- 2** Enter your name, email address and total amount to pay from above
- 3** As proof of payment, write below the 16-digit reference number displayed from the online payment screen.
DO NOT write your debit/credit card number

☒

Deduct from IPO deposit account

IPO deposit account number

D02656

☐

Cheque – make payable to 'Intellectual Property Office'

☐

Bank transfer

Reference – use your IPO deposit account number if you have one or an application number or your name if you don't.

Use the following bank account details

Sort code	20-18-23
Account number	80531766
Account name	Intellectual Property Office
SWIFT code	BARCGB22
IBAN number	GB92 BARC 2018 2380 5317 66