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The Body Shop versus TheFaceShop - a close shave

Mark Schweizer (Meyerlustenberger Lachenal) · Thursday, January 12th, 2017

Korean company [THEFACESHOP Co., LTD](#), Seoul, Korea, registered the mark TheFaceShop (see Fig.1) claiming protection for cosmetics, perfumes and related products and retail trade therewith in March 2014 in Switzerland.

THE**FACE**SHOP

Fig. 1

As one can imagine, the British company [THE BODY SHOP INTERNATIONAL PLC](#), Sussex, England, was not amused and opposed the registration based on its word mark THE BODY SHOP and its figurative mark The Body Shop (see Fig. 2), both claiming protection for identical or highly similar products as the younger mark.

THE BODY SHOP

Fig. 2

The Swiss IPO dismissed the oppositions based on the reasoning that the elements THE and SHOP of the older mark were directly descriptive for the claimed goods and services. It had not been shown that these elements profited from acquired distinctiveness. The comparison of the (mildly) distinctive elements BODY and FACE did not lead to a legally relevant likelihood of confusion.

On appeal, the Federal Administrative Court came to a different conclusion and cancelled the registration of the younger mark. The Court reasoned that the common elements THE and SHOP were indeed descriptive and not distinctive. Nonetheless, when comparing two marks, they must be compared as a whole. Non-distinctive elements can support a finding of a likelihood of confusion if they are found in the same position in both marks.

In the case at hand, both marks were formed according to the same structure, i.e. THE [WORD] SHOP. The identical position of the non-distinctive elements, the similar meaning of BODY and FACE, the same number of characters in all elements, and the hardly distinctive figurative element of the younger mark (bold type for FACE) lead to an overall highly similar impression which leads the relevant consumers to believe that TheFaceShop (fig.) was a line of facial cosmetics of The Body Shop International Plc. Whether THE BODY SHOP had acquired a reputation in Switzerland through

continuous use since 1983 could therefore be left undecided.

I think the Federal Administrative Court got it right. There is something smelly here, and I do not mean the perfumes of the parties.

Decision B-2711/2016 of 12 December 2016

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