

O-012-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2474268B
IN THE NAME OF PAUL JONES
FOR REGISTRATION OF THE TRADE MARK
GSD GOOD SKIN DAYS
IN CLASSES 3, 10, 35, AND 44**

AND

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO 99089
IN THE NAME OF BEAUTYBANK INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2474268B
in the name of Paul Jones
for registration of the trade mark
GSD Good Skin Days
in Classes 3, 10, 35 and 44**

and

**IN THE MATTER OF Opposition thereto
under No 99089
in the name of BeautyBank Inc**

DECISION

1. On 6 December 2007 Paul Jones applied to register the trade marks GSD GOOD SKIN DAYS in respect of the following goods in Classes 3, 10, 36 and 44

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| Class 03 | Cosmetics; non-medicated preparations for the care of the skin; moisturisers, body creams, firming lotions, cleansing lotions, skin creams, skin conditioners, toners; soaps; shaving foams, shaving balms, shaving gels; bath salts, bath crystals, bath bombs, bath foams, shower gels, shower washes; body powder; face creams and lotions; face powders; hair preparations; cosmetic washes; preparations for the removal of hair. |
| Class 10 | Surgical and medical instruments and apparatus; surgical and medical instruments and apparatus for laser treatments; surgical and medical instruments and apparatus for skin and body laser treatments. |
| Class 35 | Retail services connected with the sale of skin care and skin treatment goods, all being available in stores, online via a website and by mail order. |
| Class 44 | Medical services; consultation services relating to skin care; laser treatment of skin conditions; hair removal, tattoo removal; botulinum toxin treatments, filler treatments; cosmetic surgery. |

2. On 12 May 2009 BeautyBank Inc filed notice of opposition, the ground being in summary:

- | | |
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| Under Section 5(2)(b) | because the mark applied for is similar to the opponent's earlier marks and is sought to be registered in respect of goods and services that are identical to those for which these earlier marks are registered such that there exists a likelihood of confusion. |
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3. The earlier marks relied upon are detailed later in this decision.

4. The applicants filed a counterstatement in which they deny the ground on which the opposition is based.

5. The applicants and the opponents both ask for an award of costs in their favour.

6. Only the opponents filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 11 August 2010, when the opponents were represented by Mr Ian Bartlett of Beck Greener, their trade mark attorneys. The applicants were represented by Mr Chris McLeod of Hammonds LLP, their trade mark attorneys.

Opponent's evidence

7. This consists of a Witness Statement dated 11 June 2005 from Rita Odin, Vice President and Trademark Counsel for The Estee Lauder Companies Inc. the opponents in these proceedings.

8. Ms Odin gives a brief history of the Estee Lauder Companies and their business, including the GOOD SKIN brand which is supplemented by Exhibit RO1. This exhibit consists of a page from the Estee Lauder website headed "The Estee Lauder Companies Inc, Family of Brands". To the left is a list of what appear to be different brand names with the page opened to the "good skinTM". This states the name to have been introduced in 2004, Ms Odin placing this as being in the USA, in connection with "dermatologist formulated, fragrance-free skincare". It goes on to record that it was launched in the UK post September 2007. The products are listed as "instant deep wrinkle filler", "eye-lift and circle reducer", an "intensive clarity and smoothing peptide serum" and a "microcrystal skin refinisher".

9. Ms Odin goes on to refer to the GOOD SKIN website (goodskindermcare.com) saying that this was established in August 2004. She says that records of visits to the site have been maintained since July 2007 and show more than 10,000 per year having originated from the UK. Exhibit RO2 consists of pages from the site and amongst other products shows a range for skincare under the name "good skintm", the name usually placed in the upper portion of a logo composed of four circles placed two on two, but is also used on its own. The page states that these products are available exclusively from Kohl's department store or the Kohl website.

10. Ms Odin refers to the introduction of Tri-Aktiline skin treatment by Good Skin Labs, Dist in January 2007, at the same time setting-up of the internationally available goodskinlabs.com website specifically for the product. She goes on to say that this product was officially launched in the UK in January 2008 through Boots, the high-street retailer, Exhibit RO3 being an example of the accompanying press release and the resulting features. Most of these refer to the product as Tri-Aktiline from "Good Skin Labs" although there is one example dated 25 June 2008 that states "GoodSkin, the US brand from BeautyBank (Estee Lauder) which is launching in the UK this month at Superdrug stores". Ms Odin says that at the same time the website was extended to link the UK specific pages at goodskinlabs.co.uk. Pages from both websites are shown as Exhibit RO4 (printed on 7 October 2009) and mostly promote goods branded as Tri-Aktiline with GoodSkin mentioned

as part of the originator GoodSkin Labs. Exhibit RO5 consists of prints from the Boots website, listing the products and using the GoodSkin name in the same way as the GoodSkin websites.

11. Ms Odin goes on to refer to the Good Skin range of products being launched in the UK in mid 2008 via Superdrug (as referred to in Exhibit RO3), providing a list of all of the Superdrug outlets as Exhibit RO6. A list of the Good Skin products sold in the UK is shown as Exhibit RO7 with examples of the packaging being shown as Exhibit RO8. The list of products includes:

- Good Skin Soft Skin Creamy Cleanser
- Good Skin Perfect Balance Gel Cleanser
- Good Skin Clean Skin Foaming Cleanser
- Good Skin Soft Skin Moisturising Cream
- Good Skin Perfect Balance Moisture Lotion
- Good Skin Clean Oil-Free Lotion
- Good Skin Microcrystal Skin Refinisher
- Good Skin Instant Lightening Eye Cream
- Good Skin Megabalm Ultra Soothing Lip Treatment
- Good Skin All Calm Creamy Cleanser
- Good Skin All Calm Soothing Toner
- Good Skin All Calm Moisture Lotion
- Good Skin All Calm Moisture Cream
- Good Skin All Firm Moisture Cream
- Good Skin All Firm Rebuilding Serum
- Good Skin All Hydrated Moisture Cream

12. The packaging is for the Good Skin Soft Skin Moisturising Cream, Good Skin Perfect Balance Moisture Lotion, Good Skin Microcrystal Skin Refinisher, Good Skin All Calm Moisture Lotion, Good Skin All Firm Moisture Cream, Good Skin All Firm Rebuilding Serum and Good Skin All Hydrated Moisture Cream. The words “good skin” appears on external packaging and on some of the products, usually placed in the four circle logo accompanied by the trade mark indicator “™”.

13. Ms Odin states the wholesale figures for the GoodSkin range sold in the UK through Superdrug, excluding the GoodSkin Labs range to be as follows:

To 30 June 2008	in excess of £100,000
1 July 2008 – 30 June 2009	in excess of £300,000

14. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

15. The objection is made under Section 5(2)(b) which reads as follows:

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical

with the goods or services for which the earlier trade mark is protected

(2) A trade mark shall not be registered if because -

(a)

(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.”

16. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK), or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

17. The applicants rely on eight Community Trade Mark registrations all of which have a date of registration within five years of the date of publication of the application, so the provisions of The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

18. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the 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 B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657 at 32, That is the case where the component in the complex is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33, and Case T-28/05 *Ekabe International v OHIM – Ebro Puleva (OMEGA3)* [2007] ECR II-4307, paragraph 43, *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*.)

19. So where marks have a number of component features it is the contribution of the individual elements to the mark as a whole and in the impression conveyed to the “average consumer” of the goods and services in question that are important factors when considering

whether marks are similar and the potential for confusion as part of the “global appreciation”. Therefore, before looking at the question of whether the respective marks are similar it seems necessary to look consider the distinctiveness and dominance of the component parts.

20. The opponents rely on the following earlier marks:

CTM 3455052	GOOD SKIN & DEVICE
CTM 4419867	GOOD SKIN ALL
CTM 3458064	GOOD SKIN ALL BRIGHT
CTM 3456431	GOOD SKIN ALL CALM
CTM 3456571	GOOD SKIN ALL RIGHT
CTM 3457702	GOOD SKIN ALL FIRM
CTM 3458059	GOOD SKIN ALL HYDRATED
CTM 4118221	GOOD SKIN MICROCRYSTAL REFINISHER

21. Accepting that GOOD SKIN is capable of being used descriptively for the products concerned “when embedded in descriptive or informational text”, Mr Bartlett went on to say that “The thought expressed by GOOD SKIN is incomplete and provides no clear information”. He argued that the expression is distinctive and as can be seen from the packaging, functions distinctively for the goods for which it is used. In support Mr Bartlett referred me to the registration of PURE SKIN (No. 2405556) for cosmetics, etc in Class 3. Notwithstanding that I am not aware of the circumstances surrounding the acceptance of that application, for the following reasons I would not say that the marks PURE SKIN and GOOD SKIN are exactly a parallel.

22. The words GOOD and SKIN are both ordinary English words that I consider likely to be known to the public at large and anyone with an understanding of the English language. GOOD is an adjective with the meaning of “having a positive or useful effect; of a high quality or level” so is clearly laudatory. The word SKIN as a noun relates to “the natural outer layer which covers a person”. When used in connection with any product or service the word “GOOD” will be a positive exhortation whereas the word “SKIN” clearly describes anything for use on, or in connection with, skin care. In combination, they describe skin with correct or desired qualities, for example, free from blemishes, but this is not a characteristic of skin-care products per se but rather what may be achieved through their use. But even here they do not actually or specifically describe the purpose of such goods or services. That would be “hydrating”, “moisturizing”, “cleansing” etc.

23. So if the words GOOD SKIN are descriptive, it is to the extent that they are a none-too covert allusion to what the use of products and services for skin care will bring about rather than being descriptive of such goods or services themselves. For goods such as perfumes and hair-care preparations the words GOOD SKIN do not have the same direct relationship to the skin but being used on the skin (in the case of hair-care preparations, on the scalp), still have descriptive connotations. Returning to the question of the mark PURE SKIN, the word PURE means “...without any extraneous and unnecessary elements” or “free of any ...”. Whilst in combination with the word SKIN the word PURE alludes to something “GOOD”, as a totality the whole makes little immediate sense, with a meaning only to be found after some consideration and interpretation.

24. The opponent’s earlier marks are not just for the words GOOD SKIN. There is a GOOD

SKIN logo containing a figurative element formed by four circles placed two above two, with the word GOOD in the upper left-hand circle, and the word SKIN in the right-hand circle. This figurative element is more than a mere background and separating the words into the circles contributes to the distinctive make-up. That said, in composite marks it is generally accepted that it is the words that speak so the mark will still be taken as GOOD SKIN. In the next mark the words GOOD SKIN are followed by “ALL”, another ordinary English word that is used as a determiner to mean “the whole quantity” or “everything”. Adding this word to the combination GOOD SKIN does not create a meaning with a sensible or complete whole, it begs the question, “all what?” The remaining marks also contain “GOOD SKIN ALL” followed by “Bright”, “Calm”, “Right”, “Firm” and “Hydrated”, all words that have varying degrees of capacity to describe a feature of skin, and/or the effect (or purpose) of the related skin-care product or service. Although grammatically unusual when preceded by “ALL”, they combine and connect to give some specificity to what is meant by GOOD SKIN.

25. The applicant’s mark consists of the letters GSD followed by the words GOOD SKIN DAYS. As far as I am aware (and there is no evidence to the contrary) GSD has no recognised meaning. Whilst I agree with the opponent’s assertion that in combination with the words GOOD SKIN DAYS the relevance of the letters GSD as an acronym or abbreviation become apparent, I do not agree that this relegates their distinctiveness to the same level as the words. Letters that form an abbreviation of descriptive words (other than of the name of the type of the goods or services) are capable of being distinctive even if the words alone would not, so can have a distinctive life of their own. I have already considered the combination GOOD SKIN but here there is the addition of “DAYS”. For certain of the goods at issue the word “DAY” would mean something used in the day, for example a “day” cream as opposed to a “night” cream but this is not the case in the pluralised form. Taken in the totality of the mark, this word hangs together with GOOD SKIN to make a whole that is a recognisable play on the phrase “Bad Hair Day”.

26. Insofar as the respective marks all contain the words GOOD and SKIN there must inevitably be some visual similarity but in their other elements are quite different. In the case of the earlier marks these additions have degrees of descriptiveness but in the totality of the marks make a contribution to the impression conveyed to the “average consumer” of the goods in question. In the case of the mark applied for this impression will be created by the mark as a whole. So whilst accepting that there are visual similarities in the mark applied for and the earlier marks, I do not consider that these are sufficient for the marks to be regarded as being visually similar.

27. Likewise this commonality in the use of the words GOOD SKIN will mean that the respective marks (including the composite mark because it is the words that speak) will have some similarity in sound when referred to in speech. That the suffix words in the opponent’s marks are descriptive makes it less likely that the consumer will use anything beyond GOOD SKIN as the point of reference. In the subject marks the letters GSD are not pronounceable as a word so in my view the emphasis will be on the other words. As I have already said, these all hang together to form a phrase and making it likely that the entirety of the mark will be enunciated. Balancing this I consider that the marks should be considered as being aurally similar.

28. To the extent that they have the words GOOD and SKIN in common the respective marks

will inevitably be connected to a similar idea but the marks must be considered in their totality. The suffix words in the opponents' marks serve as a qualifier as to what the use of "good skin" means, for example, GOOD SKIN "ALL hydrated", "ALL clear", "ALL bright", etc. In response to my questioning Mr Bartlett stated that with the exception of "Microcrystal skin refinisher" these "ALL" suffixes have distinctiveness. He further agreed that based on the PURE SKIN case to which he had previously referred, their contribution to the marks that they formed part of was not negligible and that they should be considered as capable of independent registration.

29. As I have said, the applicant's mark appears to be a play on "bad hair day" meaning "a day on which one's hair seems unmanageable" and less commonly, "a day when everything seems to go wrong". This is a phrase that I would say is reasonably well known and likely to be so amongst consumers of the goods in question. So even setting aside the three letters GSD, to me the respective marks when taken as wholes will send out different ideas.

30. Taking the above into account I come to the position that whilst I have found there to be similarities in the respective marks, in my view these are not sufficient for any of the earlier marks to be considered similar to the mark GSD GOOD SKIN DAYS.

31. There was not a great deal of discussion on the question of the similarity or otherwise of the respective goods. Mr Bartlett argued that the likelihood of confusion is increased by the identity in the products concerned in relation to Classes 3 and 44 and that in relation to those in Class 3 and 35 "that these are ordinary consumer items and services that consumers will not be carefully deliberated upon." The earlier marks all cover goods in Class 3 that are self evidently identical and similar to the cosmetics and preparations for the care of the skin, etc covered by the mark applied for. Likewise, in respect of Class 35 the application covers services for the retailing of the self-same goods covered by the earlier marks and in my view constitutes a similar service.

32. The earlier mark for the "GOOD SKIN and circles logo covers Class 44 and lists consultancy services in the "...use and selection of cosmetics....and beauty treatment" as being amongst the services covered in the specification. To my mind the words "...use and selection of..." describe a service that advises on cosmetics and beauty treatment that can be selected and used by the consumer themselves although conceivably may overlap into services provided by others. Whilst considering Class 44 of the application as encompassing services rendered for "cosmetic" purposes, with the exception perhaps of "hair removal" and some aspects of "skin care" consultancy these are specialised quasi-medical and potentially invasive treatments that are some distance away from the application of creams or lotions. As such, I consider that they are some distance apart from the services of the earlier mark. Class 10 of the application appears to cover the instruments and apparatus that would be used in the provision of such services and to my mind are about as dissimilar to the goods and services of the earlier marks as such services.

33. Therefore, the overall consideration of the likelihood of confusion will be on the basis that the respective goods in Class 3 of the application are identical and similar to those covered by the opponent's earlier marks, and that the services in Class 35 of the application are likewise similar. The services in Class 44 of the application will be considered to have some similarity with those of the corresponding class in the GOOD SKIN and circles logo,

but dissimilar to the goods covered by this and the other earlier marks. The goods in Class 10 of the application are to be considered dissimilar.

34. Where a trader elects to use words that have an obvious link (whether or not directly descriptive) to the goods and/or services for which it is, or will be used, they cannot be surprised when later, someone else elects to use the same words for a similar purpose. In such circumstances there will need to be a strong resemblance in the entirety of a later mark if there is to be a finding that it is similar. It is of course possible that two or more words that are individually meaningful can combine to create a highly distinctive whole but for the reasons that I have given, I do not consider that to be the case here. Likewise, as can be seen from the *Sabel* and *Canon* cases to which I was referred, a higher distinctiveness (and reputation) may be created through use, which in turn adds to the likelihood of confusion which is an argument relied upon by Mr Bartlett. Accepting that any use of the earlier marks made by the opponents "...largely accrued following the date of application..." Mr Bartlett submitted that "... their distinctiveness and scope of protection was always capable of being enhanced by use..." and that the position in respect of the likelihood of confusion "...at the date of the decision, as well as at the date of application, is a material factor..." that I should take into account.

35. In Case C-542/07 P *Imagination Technologies Ltd v Office for Harmonisation in the Internal Market*, an application to register the words PURE DIGITAL the Court of Justice of the European Communities (Fifth Chamber) confirmed that distinctiveness acquired by use must be acquired by the date of the application and not thereafter. The Court stated that if this were not the case a trade mark:

"... which is devoid of any distinctive character at the time when the application for registration is filed might serve as a basis for the application, in the context of opposition proceedings or an application for a declaration of invalidity, of a relative ground for refusal against a second mark whose filing date is after that of the first mark. Such a situation is particularly unacceptable when the second mark already has distinctive character at the time of filing whereas the first has not yet acquired it through use".

36. Although considered in the context of "acquired" rather than "enhanced" distinctiveness, the circumstances cited show that the Court considered the effect of taking into account events from after the date of application of the disputed mark would potentially be the same in both cases and fall within a situation described as "...particularly unacceptable." I do not therefore see any rationale for taking a different view. Even if I were to take the evidence that has been provided into account it would not persuade me that a stronger distinctive character and/or reputation has/have been established. That is the case even taking into account the claimed use to be in respect of a family of marks. There is a singular lack of the necessary detail in the information, and what has been provided does not appear particularly significant even without an informed understanding of the extent of the market.

37. Taking all of the above into account and adopting the global approach advocated, I come to the view that in the circumstances of this case, there is no likelihood of confusion and consequently, the ground of opposition is dismissed.

38. The opposition having failed the applicants are entitled to a contribution towards their costs. Both sides agreed that the circumstances of the case warranted an award being based on the set scale. I order the opponent to pay the applicants the sum of £1,750. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 19 day of January 2011

**Mike Foley
for the Registrar
the Comptroller-General**