

O/0759/23

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001641951

DESIGNATING THE UK

IN THE NAME OF TS HEALTH PRODUCTS B.V.

FOR THE FOLLOWING TRADE MARK:

RIO COSMETICS

IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433636

BY RENITA LLC

BACKGROUND AND PLEADINGS

1. International registration no. 1641951 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is TS Health Products B.V.. The IR is registered with effect from 13 December 2021. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder claims a priority date of 10 September 2021 and seeks protection for the following goods:

Class 3 Cosmetic products.

2. On 18 May 2022, Renita LLC (“the opponent”) opposed the protection of the IR in the UK based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).¹ The opponent relies upon the following trade marks:

SIO

UKTM no. 3192326

Filing date 20 October 2016; registration date 13 January 2017

(“the First Earlier Mark”)

SiO

UKTM no. 3213879

Filing date 20 February 2017; registration date 12 May 2017

(“the Second Earlier Mark”)

SIO BEAUTY

UKTM no. 3214331

Filing date 22 February 2017; registration date 29 September 2017

Priority date: 26 October 2016

(“the Third Earlier Mark”)

¹ The opponent originally also relied upon sections 5(3) and 5(4)(a), but these grounds were withdrawn in the evidence rounds.

SiO

BEAUTY

UKTM no. 3214329

Filing date 22 February 2017; registration date 29 September 2017

Priority date: 26 October 2016

("the Fourth Earlier Mark")

3. The opponent relies upon all of the goods and services for which the earlier marks are registered as set out in the Annex to this decision. The opponent claims that the trade marks are similar and the goods are identical or similar, with the result that there is a likelihood of confusion.

4. The holder filed a counterstatement denying the claims made.

5. The holder is represented by Dehns and the opponent is represented by Venner Shipley LLP.

6. Neither party filed evidence. Neither party requested a hearing, but both filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

DECISION

8. Section 5(2)(b) of the Act reads as follows:

“5(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.”

9. By virtue of their earlier filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the earlier marks had not completed their registration process more than 5 years before the priority date of the designation in issue, they are not subject to proof of use. Consequently, the opponent can rely upon all of the goods and services identified.

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

11. The holder admits that the goods are identical.

The average consumer and the nature of the purchasing act

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

13. I agree with the holder's submission that the average consumer for the goods will be a member of the general public and may include professionals within the beauty sector (such as beauticians or makeup artists). The goods are unlikely to be very expensive and will be relatively frequent purchases. However, various factors will be taken into consideration such as suitability for skin types, ingredients and effectiveness. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

14. The goods are likely to be self-selected from the shelves of a retail outlet or an online equivalent. Consequently, visual considerations are likely to dominate the purchasing process. However, given that advice may be sought from retail advisors, I do not discount an aural component.

Comparison of trade marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

16. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

17. The First and Second Earlier Marks and the Third and Fourth Earlier Marks have identical specifications. The First and Third Earlier Marks are both word only marks, whereas the Second and Fourth Earlier Marks are stylised equivalents. Given that the IR is a word only mark, the First and Third Earlier Marks will clearly represent the opponent’s best case. If there is no likelihood of confusion in respect of these marks, there will also be no likelihood of confusion in respect of the Second and Fourth Earlier

Marks. Consequently, I will undertake the comparison on the basis of the marks that represent the opponent's best case.

18. The parties' respective marks are set out as follows:

Opponent's trade marks	The IR
SIO (the First Earlier Mark) SIO BEAUTY (the Third Earlier Mark)	RIO COSMETICS

Overall Impression

19. The First Earlier Mark consists of the three-letter combination SIO. There are no other elements to contribute to the overall impression which lies in these three letters. The Third Earlier Mark consists of the letters/word combination SIO BEAUTY. The overall impression of the mark lies in the combination of these letters/word, with the word BEAUTY being non-distinctive for the relevant goods. The IR consists of the words RIO COSMETICS. The overall impression lies in the combination of these words, with the word COSMETICS being non-distinctive.

Visual Comparison

20. In relation to the visual comparison, the opponent submits:

“From a visual perspective, there is a high degree of similarity between the elements “RIO” and “SIO”; the marks share the same number of letters (three) and end with the same combination “IO”. The average consumer of cosmetic products (who rarely compare marks side by side) will remember that the main

elements of the marks are three letters ending with the combination “IO”, making “RIO” and “SIO” highly similar.”

21. The First Earlier Mark and the IR overlap in that they both have a three letter combination, ending in I-O, i.e. SIO in the First Earlier Mark and RIO in the IR. They differ in that the first letter of these three-letter combinations is S in the First Earlier Mark and R in the IR. The IR also has an additional word, COSMETICS, which is absent from the First Earlier Mark. I consider the marks to be visually similar to a low degree.

22. The same comparison applies to the Third Earlier Mark and the IR. However, the fact that there is an additional word in the Third Earlier Mark (albeit a different one), brings them closer together visually, as they are more similar in length. Consequently, I consider them to be similar to between a low and medium degree.

Aural Comparison

23. In relation to the aural comparison, the opponent submits as follows:

“From a phonetic perspective, the Opponent submits that, in pronouncing the words “RIO” and SIO”, the emphasis falls upon the final syllable “IO”. Although the letters found at the beginning of the words are pronounced differently, the differences are not significant. In referring to the marks verbally, some consumers may even substitute “RIO” for “SIO” and vice versa. Therefore, the Opponent submits that, phonetically, the elements “RIO” and “SIO” are similar to some degree.”

24. The First Earlier Mark is likely to be pronounced REE-OHH-COS-MET-IKS. The IR is likely to be pronounced SEE-OHH or SIGH-OHH. Alternatively, if perceived as an acronym, it could be pronounced ESS-AYE-OHH. At best, I consider there to be a low degree of aural similarity.

25. The Third Earlier Mark is likely to be pronounced SEE-OH-BUE-TEE or SIGH-OHH-BUE-TEE. As above, if the letters SIO are perceived as an acronym, it could be

read ESS-AYE-OHH-BUE-TEE. Although the actual number of syllables are more similar, they will be articulated very differently. Consequently, I consider any similarity to be at a low degree.

Conceptual Comparison

26. The letters SIO in the First Earlier Mark are unlikely to be attributed any meaning. By contrast, I agree with the holder that the letters RIO in the IR are likely to be seen as referring to the place, Rio De Janeiro. Consequently, these elements of the marks are conceptually dissimilar. The additional word, COSMETICS, in the IR also acts as an additional point of conceptual difference, but not a distinctive one.

27. The same applies to the Third Earlier Mark and the IR. I recognise that there will be some conceptual overlap in terms of the words COSMETICS and BEAUTY, although this will be non-distinctive.

Distinctive character of the earlier marks

28. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

29. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

30. The opponent has filed no evidence of use. Consequently, I have only the inherent position to consider. The opponent submits that its marks are highly distinctive inherently because the wording “SIO” does not allude to the products in question. Although it may be meaningless, SIO is a simple mark composed of just three letters. Whether considered as letters or a short word, it is not particularly striking or memorable. In my view, the First Earlier Mark has an average (or medium) degree of distinctiveness. I note that the Third Earlier Mark contains the additional word BEAUTY. However, given that the word is non-distinctive for the goods, I do not consider that this adds anything to the distinctiveness of the mark overall. Consequently, the Third Earlier Mark is also inherently distinctive to an average (or medium) degree.

Likelihood of confusion

31. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser

degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing act. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

32. I have found as follows:

- a) The goods are identical.
- b) The average consumer is a member of the general public, or a professional in the beauty industry (such as a beautician or makeup artist) who will pay a medium degree of attention during the purchasing process.
- c) The purchasing process is predominantly visual, although I do not discount an aural component.
- d) The First Earlier Mark and the IR are visually and aurally similar to a low degree and conceptually dissimilar.
- e) The Third Earlier Mark and the IR are visually similar to between a low and medium degree, aurally similar to a low degree and conceptually dissimilar (apart from a non-distinctive overlap between COSMETICS and BEAUTY).
- f) The First and Third Earlier Marks are inherently distinctive to an average (or medium) degree.

33. Bearing in mind the differences between the marks, I do not consider that they are likely to be mistakenly recalled or misremembered as each other, even when used on identical goods. The three-letter combinations in each mark are likely to be distinguished, in my view, because the different letter is at the beginning of the marks,

which tends to have more of an impact than the end.² Further, differences in shorter marks tend to make more of an impact. The differing letter also means that one of the party's marks has a concept (being a place) and the other's do not. Taking all of the above factors into account, I do not consider there to be a likelihood of direct confusion.

34. Having identified the differences between the marks, I can see no reason for the average consumer to conclude that they originate from the same or economically linked undertakings. I do not consider there to be a likelihood of indirect confusion.

35. For the avoidance of doubt, even if there is a significant proportion of average consumers who view the letters RIO as having no meaning and the conceptual position between the three-letter combinations is therefore neutral, I still consider the differing visual and aural position is sufficient to avoid there being a likelihood of direct or indirect confusion.

36. Given that the Second and Fourth Earlier Marks are less similar to the IR, there will also be no likelihood of confusion in respect of these marks.

CONCLUSION

37. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

38. As the holder been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the holder the sum of **£650**, calculated as follows:

Considering the Notice of opposition and filing a counterstatement	£300
Written submissions in lieu	£350

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Total

£650

39. I therefore order Renita LLC to pay TS Health Products B.V. the sum of £650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of August 2023

S WILSON

For the Registrar

ANNEX

The First and Second Earlier Marks

Class 3

Cosmetic pads; Wrinkle-minimizing cosmetic preparations to be applied on skin; Wrinkle-minimizing cosmetic preparations for skin; Anti-aging and anti-wrinkle creams, serums, moisturizers, lotions, toners, cleansers, creams, oils, gels for the skin; Wrinkle-minimizing skin care preparations; Cosmetic preparations for skin renewal; Cosmetic preparations for skin care; Cosmetics and cosmetic preparations, none including hair products; Cosmetics sold as an integral component of non-medicated skincare preparations; Non-medicated skin care preparations; Skin care preparations for skin renewal; Wipes, cloths or tissues impregnated with a skin cleanser; Non-medicated skin cleaning preparation; Skin cleansers.

The Third and Fourth Earlier Marks

Class 3

Cosmetic pads; Wrinkle-minimizing cosmetic preparations to be applied on skin; Wrinkle-minimizing cosmetic preparations for skin; Anti-aging and anti-wrinkle creams, serums, moisturizers, lotions, toners, cleansers, creams, oils, gels for the skin; Wrinkle-minimizing skin care preparations; Cosmetic preparations for skin renewal; Cosmetic preparations for skin care; Cosmetics and cosmetic preparations, none including hair products; Cosmetics sold as an integral component of non-medicated skincare preparations; Non-medicated skin care preparations; Skin care preparations for skin renewal; Wipes, cloths or tissues impregnated with a skin cleanser; Non-medicated skin cleaning preparation; Skin cleansers.

Class 35

Wholesale store services and on-line retail store services connected with the sale of beauty, health, skin care and personal care preparations and products, and cosmetics, none of the aforementioned relating to hair products; retail store services connected with the sale of beauty, health, skin care and personal care preparations and products, and cosmetics, none of the aforementioned relating to hair products, provided via mobile applications, wireless communication, computer systems and television; Retail store services connected with the sale of beauty,

health, skin care and personal care preparations and products, and cosmetics, none of the aforementioned relating to hair products; retail services in relation to pharmaceutical preparations.