

BL O/0761/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3575363

BY YOUNIQUE, LLC IN RESPECT OF THE TRADE MARK

YOU·OLOGY

IN CLASSES 3 AND 35

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 424871

BY ASSOCIATED NEWSPAPERS LIMITED

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY THE OPPONENT

AGAINST A DECISION OF MARK BRYANT

DATED 26 JANUARY 2023

DECISION

Introduction

1. This is an appeal from a decision of Mark Bryant, acting for the Registrar, dated 26 January 2023, in which he found that the opposition by Associated Newspapers Limited (“the Appellant or the Opponent”) failed against the registration in the UK in the name of Younique, LLC (“the Applicant” or “the Respondent”) of trade mark application number 3575363 for the mark shown above in respect of the following goods and services (“the Trade Mark”):

Class 3: *Skincare products, namely, non-medicated skin care preparations; Cosmetics; Make-up; toiletry preparations; Perfumery, essential oils; fragrances.*

Class 35: *Retail services in relation to the fields of cosmetics, skincare, perfumery and fragrances; Subscription-based order fulfilment services in the fields of cosmetics and skincare; Online retail services through direct solicitation by distributors directed to end-users in the field of cosmetics, skin care and beauty products; Retail services through direct solicitation by distributors directed to end-users in the field of cosmetics, skin care and beauty products; Retail shop-at-home party services in the field of cosmetics, skin care and beauty products.*

2. The opposition was based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).
3. For the opposition under s.5(2)(b), the Opponent relied on the following three earlier marks, and for the opposition under s.5(3), just the first mark mentioned below:

The “You Mark”

Trade mark no. 900193276:

YOU

The Opponent was put to proof of use of this mark pursuant to s.6A of the Act, and the Hearing Officer found that use had been shown in respect of the following goods/services:

Class 16: *Periodical publications; magazines.*

Class 41: *Publication of magazines; all the aforementioned services also provided on-line from a computer database or from the Internet.*

The “You Beauty Mark”

Trade mark no. 3029970 (series of 2 marks):



The services relied upon were in classes 35 and 44.

The “You Beauty Discovery Mark”

Trade mark no. 3029968:

YOU BEAUTY DISCOVERY

The services relied upon were the same as those in respect of the You Beauty Mark.

4. Only the Opponent filed evidence.

The Hearing Officer’s Decision

Section 5(2)(b)

5. The Hearing Officer found that none of the goods or services covered by the Trade Mark were similar to those covered by the You Mark, so that there could be no likelihood of confusion with that mark. Further, since the You Beauty Discovery Mark would not place the Opponent in a stronger position than the You Beauty Mark, only the latter mark was considered for the purposes of s.5(2)(b).
6. The Hearing Officer made the following findings:

The services

The class 3 goods under the Trade Mark were similar to a medium degree to the class 35 retail services and the class 44 “*information, advice and consultancy in relation to ... beauty ...; skin ... care*” and “*... in the field of cosmetics*” under the You Beauty Mark, and the class 35 retail services under the Trade Mark were identical to those under the You Beauty Mark.

Similarity between the marks

Visual similarity

There was a low to medium level of visual similarity between the Trade Mark and the You Beauty Mark.

Aural similarity

There was a low level of aural similarity between the Trade Mark and the You Beauty Mark.

Conceptual similarity

There was a low level of conceptual similarity between the Trade Mark and the You Beauty Mark.

The average consumer and the nature of the purchasing act

The average consumer would be members of the general public, who would pay an average level of attention, with the purchasing process being predominantly visual in nature, but aural considerations may play a part.

Distinctive character of the earlier trade marks

The You Beauty Mark had a reasonably low level of inherent distinctive character, but did not benefit from an enhanced level of distinctive character in respect of the Opponent's goods and services which were identical or similar to those covered by the Trade Mark.

Likelihood of confusion

There was no likelihood of direct or indirect confusion.

7. Accordingly, the Hearing Officer found that the opposition failed under s.5(2)(b).

Section 5(3)

8. The Hearing Officer made the following findings:

Reputation

The evidence clearly demonstrated that the You Mark had a reputation in respect of printed and online magazines, and so the Opponent was able to rely on the following goods and services:

Class 16: Magazines.

Class 41: Publication of magazines; all the aforementioned services also provided on-line from a computer database or from the Internet.

Link

The public would not make a link between the marks for the purposes of s.5(3).

9. Accordingly, the Hearing Officer found that the opposition failed under s.5(3).

The Appeal

10. The Opponent filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, Michael Conway of Haseltine Lake Kempner LLP appeared on behalf of the Appellant. The Respondent did not appear and was not represented.

Standard of review

11. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EQHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]). I have borne those principles firmly in mind.

Grounds of Appeal

12. The Appellant relied on three grounds of appeal, which I will deal with in turn. As the Appellant did not appeal the Hearing Officer's findings in relation to the goods and services which he had found to be dissimilar to those covered by the You Mark, only the Opponent's You Beauty Mark was relevant to the appeal in relation to s.5(2)(b), and only the You Mark was relevant to the appeal in relation to s.5(3).

Ground 1: Level of distinctiveness of the "You" element of the You Beauty Mark

Inherent distinctiveness

13. The Appellant agreed with the Hearing Officer's assessment that the word YOU was the dominant and distinctive element of the You Beauty Mark, but submitted that he wrongly held that the word YOU was of "reasonably low" inherent distinctiveness merely because it was a "personal pronoun" and "will be a word that is readily understood and commonly used". It was said in the Appellant's skeleton argument that that finding was based on "a bare submission from the Respondent, unsupported by evidence, that the word YOU, when used in relation to the relevant services, will be perceived as descriptive of "something that is personally directed at the consumer".". The Appellant did not agree that the word YOU would have a descriptive meaning when used in relation to the services in question, and argued that the Hearing Officer set too high a hurdle for the mark to possess distinctive character, without carrying out a proper assessment of whether the word YOU would be perceived as conveying a descriptive message about the goods/services.
14. In support of its argument, the Appellant referred me to the following extract from the CJEU's judgment in Case C-265/09 P, *OHIM v BORCO*, which concerned a single-letter mark:

"In relation, more particularly, to the fact that the sign at issue consists of a single letter with no graphic modifications, it should be borne in mind that registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark (Case C-329/02 P SAT.1 v OHIM [2004] ECR I-8317, paragraph 41).

It follows that, particularly as it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks, OHIM is required to assess whether the sign at issue is capable of distinguishing the different goods and

services in the context of an examination, based on the facts, focusing on those goods or services.”

15. The Hearing Officer’s findings in relation to the inherent distinctiveness of the YOU element of the You Beauty Mark are set out in the following paragraphs from his Decision:

“50. The opponent’s mark consists of the words YOU and BEAUTY. These words retain their own identity within the mark, despite being conjoined, because they are presented in different text styles and different colours. They do not obviously form a unit, but rather they retain individual character within the mark. The word YOU is at the start of the mark. The word BEAUTY is longer and provides a contribution to the mark but as it lacks distinctiveness and appears at the end of the mark, the word YOU is the dominant and distinctive element...

...

60. The opponent’s mark consists of the two word’s [sic] YOU and BEAUTY presented in such a way as the two words retain their own identity. Ms Evans submitted that the word YOU is of a low distinctive character because it merely indicates something that is personally directed at the consumer i.e. that the goods and services are suitable for you, the consumer. Mr Conway disagreed, submitting that there is no evidence of this. He argued that, as a personal pronoun, there is no reason why it should not have distinctive character. He conceded that it may be “very slightly allusive” but with a medium level of distinctive character. I am persuaded by Ms Evan’s [sic] submission. As a personal pronoun, the word YOU is not endowed with any great distinctive character and will be a word that is readily understood and commonly used. I must consider the mark as a whole and I note that Mr Conway accepted that the word “Beauty” is descriptive. Taking the two words together and taking account of the slight stylisation present in the mark, I conclude that it is endowed with a reasonably low level of inherent distinctive character.”

16. At the hearing before me, Mr Conway suggested that the Hearing Officer had erred by not taking into account the different types of average consumer, but simply applied his reasoning on this and other points in his Decision to a single class of average consumer, without recognising that the average consumer could be made up of different classes, who may perceive the distinctiveness of the marks in issue in different ways. Mr Conway argued that the Hearing Officer had failed to recognise that the YOU element would have brand

significance to some consumers, in particular when used in connection with cosmetics, as the word YOU did not say anything about the characteristics of those goods.

17. Mr Conway said that he had made it clear to the Hearing Officer at the original hearing that different classes of consumer may perceive the marks in different ways. For example, when considering the perception of the Trade Mark, Mr Conway submitted that, while the Opponent had accepted that some consumers may have perceived the OLOGY element of the Trade Mark, when used in conjunction with the YOU element, as meaning “*the science of you*”, other consumers may view it as “*a prominent and separate concept*”. However, Mr Conway argued that the Hearing Officer had not appreciated these possible different classes of consumers, but instead had taken a “*binary*” approach to this and other issues in the Decision.
18. In paragraph 54 the Hearing Officer expressly recognised that the Opponent had argued that consumers could perceive the Trade Mark in different ways, stating “*Mr Conway conceded that this is one of the possible meanings that may be attributed to the mark*”. This suggests that the Hearing Officer was clearly alive to the Appellant’s argument that some consumers may perceive the YOU element of the You Beauty Mark as a reference to the Appellant’s magazine, but ultimately the Hearing Officer did not agree with the Appellant that that was how a significant proportion of consumers would perceive the YOU element when considered in relation to the relevant goods and services. Mr Conway did not explain why the YOU pronoun would be any more inherently distinctive when used in relation to cosmetics than with any other goods or services. It is clear from paragraph 60 of the Decision that the Hearing Officer considered that the average consumer would perceive the YOU element as the personal pronoun in relation to all of the relevant goods and services under consideration, and as a result contributed to his overall conclusion that the You Beauty Mark as a whole only had a reasonably low level of inherent distinctive character. This conclusion was one which a reasonable tribunal could have reached, and not one which I see any reason to interfere with.
19. In any event, at the hearing before me, Mr Conway argued that the You Beauty Mark had a medium degree of inherent distinctiveness. The difference between “*relatively low*” and “*medium*” is not a proper ground of appeal for the reasons given by Iain Purvis KC sitting as the Appointed Person in *Greybox*, Case BL O/106/20 when he said at paragraph 23:

“This takes issue with the Hearing Officer’s view that the conceptual similarities between the marks were at a ‘fairly low level’. It is said that the conceptual similarity

should have been found to be at least at a 'medium' level. I do not consider there is any great value in debating differences between 'fairly low' and 'medium' degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise 'weight' to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal.”.

Enhanced distinctiveness

20. The Appellant’s arguments in relation to different classes of consumer perhaps had greater relevance in relation to its submission that the Hearing Officer failed to take into account the relevant class of consumer when determining the issue of enhanced distinctive character. In its Grounds of Appeal, the Appellant submitted *that “the Hearing Officer wrongly dismissed the Opponent’s submission that the reputation and enhanced distinctiveness attached to the Opponent’s YOU brand was a relevant consideration when assessing the ground of opposition under s.5(2)(b) of the Act [¶159-61]”*. The Appellant argued that the evidence which it had filed demonstrated that the You Mark, and by extension the YOU element of the You Beauty Mark, had an enhanced level of distinctiveness by virtue of its reputation as a women’s magazine (printed and online). The Grounds of Appeal also submitted that *“the Hearing Officer had accepted that consumers of the Opponent’s magazine overlap to a significant degree with the average consumer for the Applicant’s goods and services in classes 3 and 35 (see ¶136 and ¶186)”*. The Hearing Officer was therefore said to have erred by finding that the *“strong reputation”* in the You Mark (found in paragraph 87) was irrelevant to consumers’ perception of the You Beauty Mark. Instead, the Hearing Officer should have found that the YOU element of the You Beauty Mark had an enhanced level of distinctiveness *“at least for those consumers of the Applicant’s goods and services which overlap with those of the Opponent’s magazine and who therefore will be familiar with the YOU brand”*.
21. I set out below paragraphs 34-37 (which dealt with the comparison of the goods and services), 61 (which dealt with enhanced distinctive character), 86 (which dealt with the overlap between the relevant consumers) and 87 (which dealt with the strength of the reputation of the You Mark) of the Decision, as follows:

“Class 3

34. The high point of this comparison is that the opponent’s periodical publications, magazines and publication of magazines relate to skincare products (including such products being offered for sale in the magazine) and the retailing of the same. Applying the Canon criteria to this comparison, it is clear that the respective nature, purpose and methods of use of the goods and services are different. Magazines are printed paper products (or online equivalents) providing entertaining reading whereas the applicant’s goods are preparations for applying to the body for changing/improving its appearance. As a result, they are clearly not in competition with each other and nor are they complementary in the sense expressed in Boston Scientific. Finally, there is no overlap in trade channels.

35. In summary, I conclude that neither the opponent’s Class 16 goods nor Class 41 services share any similarity with the applicant’s Class 3 goods.

Class 35

36. Again the high point of the opponent’s case is that its magazine has a focus on health and beauty, and it also provides, from time to time, offers to purchase third party goods through its magazine. Once again, the nature, purpose and method of use of a magazine is different to that of a retail service and the respective trade channels will be different and the respective goods and services will not generally be in competition. Where a magazine includes offers to buy products, this is more aligned to advertising rather than retail services because such promotions/offers do not include the services associated with retail such as allowing the consumer to view the goods and seek information about them. The primary purpose of a magazine is to provide entertaining reading to the consumer, and they are bought for this reason whereas retail services are accessed with the principal purpose of providing an environment to compare, obtain information about goods and to purchase those goods. There may be some overlap in users because those interested in using retail services relating to skincare may also be interested in a magazine in the field of health and beauty, but this is not sufficient to find that the respective goods and services share any similarity.

37. In summary, I conclude that these respective goods and services do not share any similarity

...

Distinctive character of the earlier trade mark

...

61. Mr Conway urged me to take account of the reputation of the YOU element of the opponent's YOUBEAUTY mark, arguing that its reputation means that the YOU element benefits from enhanced distinctive character. He relied upon the GC judgment in *China Construction Bank Corp. v EUIPO, Case T-665/17*, where it held (at paragraph 52 of the judgment) that evidence showing that part of the earlier mark has acquired an enhanced degree of distinctive character through use may be relevant to the assessment of the distinctiveness of that element within the earlier mark. Such enhanced distinctiveness may affect the likelihood of confusion between that mark (as a whole) and a later mark including the same, or a similar, element. However, in the current case, the reputation shown by the opponent in respect of its YOU mark relates to magazines that are dissimilar to the applicant's goods and services. It would not be correct for a party to rely upon a reputation in part of a mark where that reputation relates to dissimilar goods and services to those relied upon because it would result in circumvention of the principle that likelihood confusion [sic] can only exist where there is some similarity between the respective goods and services. Consequently, this approach cannot apply here, and I dismiss this submission. In summary, the opponent's mark does not benefit from an enhanced level of distinctive character in respect of the opponent's goods and services that are identical or share similarity to the applicant's goods and services.

...

Extent of the overlap between the relevant consumers for those goods/services

86. The relevant consumer of the opponent's magazine are the newspaper purchasing members of the general public. The consumer of the applicant's goods and services will be members of the general public who are users of skincare products. Insofar as both relevant consumers are drawn from the general public, there is some similarity. The opponent goods are a lifestyle magazine aimed at female readers. This will increase the overlap.

Strength of the earlier mark's reputation

87. Taking account of the length of time that the opponent's magazine has been produced and the circulation figures associated with the Mail on Sunday newspaper (and therefore, the YOU magazine provided with the newspaper), I conclude that the magazine enjoys a strong reputation."

22. It is notable that, rather than accepting that the consumers of the Appellant's magazines "overlap to a significant degree" with the average consumer of the Applicant's goods and services, as the Appellant submitted, the Hearing Officer actually said in paragraphs 36 and 86 that there was "some" overlap between the relevant consumers of the Appellant's goods and services and the Applicant's goods and services, and that that overlap would be increased because the Appellant's goods are a lifestyle magazine aimed at female readers. This comment demonstrates that the Hearing Officer did specifically take into account the particular class of average consumer relied upon by the Appellant, namely the female reader of the Appellant's magazine.

23. Further, what is clear from the Hearing Officer's comments at paragraph 61 is that he was aware of the need to consider enhanced distinctiveness, but decided that it was not appropriate to take into account the reputation which he had found in the Appellant's You Mark in relation to magazines because he had found that there was no similarity between magazines and the Applicant's goods or services. The Hearing Officer found in paragraph 82 that the You Mark only had a reputation in relation to printed and online magazines:

"82. Mr Conway's submissions were confined to arguing that the opponent's YOU mark had a reputation in respect of printed and online magazines. Taking the evidence together with these submissions, I agree that the evidence clearly demonstrates the existence of a reputation of the YOU mark in respect of printed and online magazines."

24. Mr Conway accepted at the hearing before me that the Opponent had not tried to establish enhanced distinctiveness in the You Beauty Mark itself, as opposed to the YOU element of the You Beauty Mark. Nor did he seek to criticise the legal reasoning set out in paragraph 61 regarding the reputation of the YOU element for dissimilar goods and services when assessing the enhanced distinctiveness of the You Beauty Mark. The extract from the *BORCO* judgment set out in paragraph 14 above emphasises the importance of focussing on the relevant goods and services when considering the distinctive character of a trade mark.

Where the Opponent seeks to rely on its reputation in respect of dissimilar goods and services, those are issues for the opposition under s.5(3), discussed further below.

25. I therefore see no reason to interfere with the Hearing Officer's conclusion that the reputation of the YOU element of the You Beauty Mark in respect of magazines did not lead to enhanced distinctiveness of the You Beauty Mark in relation to the class 3 goods or class 35 services, which he had found to be dissimilar to magazines.
26. The appeal therefore fails under Ground 1.

Ground 2: Comparison of the marks

27. The Appellant submitted that the Hearing Officer correctly found that the words YOU and BEAUTY in the You Beauty Mark were likely to be perceived as retaining unconnected meanings, but erred in failing to take into account that, because of its descriptiveness, the word BEAUTY did not play an independent distinctive role within the You Beauty Mark, and so would be perceived by consumers as modifying the word YOU in some way. The Hearing Officer was then said to have erred by failing to consider that, in both the Trade Mark and the You Beauty Mark, the word YOU appeared *"alongside, but visually separated from, another word element of approximately the same length that does not have an independent distinctive role within the mark as a whole, and therefore would be seen by consumers as modifying YOU, particularly given the dominant position of YOU at the start of the two marks"*.

28. The Hearing Officer set out his findings in respect of the similarity of the marks as follows:

"50. The opponent's mark consists of the words YOU and BEAUTY. These words retain their own identity within the mark, despite being conjoined, because they are presented in different text styles and different colours. They do not obviously form a unit, but rather they retain individual character within the mark. The word YOU is at the start of the mark. The word BEAUTY is longer and provides a contribution to the mark but as it lacks distinctiveness and appears at the end of the mark, the word YOU is the dominant and distinctive element. The applicant's mark consists of the word YOU, a dot, and the suffix OLOGY. The opponent's case is that OLOGY lacks distinctive character, but Mr Conway sensibly withdrew this claim. I see no reason for it to be without distinctive character. He also submitted that the dot between the YOU and OLOGY elements of the applicant's mark results in the YOU element presenting as the dominant element. Ms Evans suggested that these elements

combine to form a unit that will be understood as meaning “the science of you”. I will discuss this in more detail shortly, but I record here that I do not agree with Mr Conway but concur with Ms Evans that the distinctive elements will combine to form a unit that is likely to be understood in the way suggested by her and this is not impacted by the presence of the dot. I conclude that the distinctive character residing [sic] in this unit rather than any single element.

51. In respect of visual similarity, both marks share the same first word YOU, but differ in other respects. The second elements that, visually, form the greater proportion of both marks, are different. I conclude that the respective marks share similarity but that this is between a low and medium level.

52. Aurally, the opponent’s mark consists of the three syllables roughly approximating to U-BEW-TY. The applicant’s mark consists of the four syllables U-OL-O-GEE. Therefore, the [sic] share only the first syllable, the remaining syllables are different and the applicant’s mark is longer. Taking all of this together, I find the respective marks share a low level of aural similarity.

53. Conceptually, the opponent’s mark will be perceived as being formed by the two unrelated concepts of YOU, being the second person pronoun, and BEAUTY meaning “...the state of being beautiful” or as a synonym meaning “good-looker, looker [informal], lovely [slang], sensation”. Therefore, two possible concepts appear apparent. The first is where the two words retain unconnected meanings. I consider this by far the most likely and the meaning that the majority of the relevant public are likely to perceive. There is a further possible meaning, namely, that the words form an exclamation “you beauty!” meaning “you (are a) looker” or similar. However, without an exclamation mark or context that would lead to this perception and because of the different presentation of the words leading the relevant public to see the words as being independent, I consider that this meaning is unlikely to be perceived.

54. As Ms Evans submitted, and as I noted earlier, the applicant’s mark is likely to be perceived as meaning “the science of you”. Mr Conway conceded that this is one of the possible meanings that may be attributed to the mark, claiming that the OLOGY element is likely to impart the impression of science and that it is common for this type of claim to be used in respect of Class 3 goods.

55. Taking the above into account, the respective marks share the concept created by the second person pronoun YOU, but they differ in all other respects, and I conclude that this creates a low level of conceptual similarity between the marks.”

29. The Hearing Officer found that the You Beauty Mark consisted of two separate words, each of which had their own common meaning, and which were displayed in different text styles and different colours. The YOU element was found to be dominant because it appeared at the start of the mark and because the word BEAUTY lacked distinctiveness. The fact that the Trade Mark was made up of the word YOU together with the letters OLOGY led the Hearing Officer to conclude that the average consumer would perceive the Trade Mark as one invented word meaning “*the science of you*” (in the same way that the element OLOGY in words such as BIOLOGY, DERMATOLOGY etc relates to science). The Appellant accepted that skincare brands are often marketed in a “*sciencey way*”. The dot which separates the two word elements is relatively insignificant and it was therefore reasonable for the Hearing Officer to conclude that the dot would not impact on that impression. He therefore contrasted the Trade Mark with the You Beauty mark in that the YOU element was dominant in the You Beauty Mark but not in the Trade Mark. This is a reasonable conclusion which I see no reason to interfere with.

30. Finally, the Appellant repeated its assertion that the Hearing Officer approached the Trade Mark on the basis that all consumers would perceive the mark the same way, rather than recognising that a significant proportion of such consumers could read the YOU element of the mark as having brand significance, rather than merely consisting of a personal pronoun.

31. The Hearing Officer set out his findings on direct confusion in the following way:

“63. In the current case, I have found that:

- The respective goods of the opponent’s YOU mark and the applicant’s mark are dissimilar and there can be no likelihood of confusion;*
- In respect of comparing the contested application with the opponent’s 3029970 YOU BEAUTY mark, I found:*

o The applicant’s Class 3 goods share a medium level of similarity to some of the opponent’s retail services and the respective Class 35 services are identical;

o The word YOU is the dominant and distinctive element of the opponent's mark and the applicant's mark consists of elements that form a unit with no one element dominating;

o The respective marks share a low to medium level of visual similarity and a low level of aural and conceptual similarity;

o The average consumer is a member of the general public who will pay an average degree of care and attention during the purchasing act. This will be visual in nature but I do not ignore that aural considerations may play a part;

o The opponent's mark is endowed with a reasonably low level of inherent distinctive character that is not enhanced through use.

64. Mr Conway submitted that the YOU element is dominant in both the opponent's marks and the applicant's mark and when factoring in imperfect recollection there is a likelihood of confusion. Ms Evans submitted that the applicant's mark is dissimilar to the opponent's mark, therefore, there is no direct likelihood of confusion. I accept that the word YOU is the dominant element of the opponent's mark, but as I have already discussed, I do not agree that it is the dominant element of the applicant's mark. Rather it forms a unit with the OLOGY element to create a distinctive combination. Also keeping in mind that the word YOU is a personal pronoun very commonly used and understood by consumers, it is likely that the consumer will only perceive this meaning of YOU when viewing it in the context of the applicant's mark. It is not likely that it will even bring the opponent's mark to mind, let alone be confused with it. I conclude that even with identical services being involved, there is no likelihood of direct confusion when considering each mark as a whole."

32. I have already discussed how the Hearing Officer had appreciated the Appellant's arguments relating to different classes of relevant consumer and had expressly acknowledged that a relevant class of consumer consisted of female readers of the Appellant's lifestyle magazine. There is nothing in the Decision which suggests that he did not have that class of consumer in mind when he reached his conclusions in paragraph 64. As the Hearing Officer expressly pointed out in that paragraph, it is necessary to assess the likelihood of confusion in light of (among other things) the relevant classes of goods and services and considering each of the marks as a whole. His reference to "this meaning of YOU" shows that he had in mind the alternative option of a reference to the Appellant's magazine, but decided that that was not

the meaning that the average consumer would attribute to the YOU element in the context of the Trade Mark. That was a conclusion which he was entitled to reach.

33. Accordingly, the appeal fails under Ground 2.

34. As I have found that the appeal fails under Grounds 1 and 2, the Appellant's conclusion that the Hearing Officer should have found both a likelihood of direct and indirect confusion is rejected.

Ground 3: The link pursuant to s.5(3)

35. The Appellant submitted that the Hearing Officer wrongly concluded that there was not the requisite link between the Trade Mark and the You Mark.

36. In particular, the Appellant argued that, having found that the You Mark had a "*strong reputation*" for women's magazines, the Hearing Officer contradicted himself with his later finding that the mark had a "*reasonably low*" distinctive character. This argument is similar to the one discussed above under Ground 1 relating to the distinctiveness of the YOU element as part of the You Beauty Mark. As set out in paragraph 23 above, the Hearing Officer had found that the You Mark had a reputation in relation to printed and online magazines. He then went on to set out his findings in respect of the requisite link as follows:

"Link

83. As identified above, whether a link exists must be assessed globally taking account of all relevant factors, including the following:

Degree of similarity between the respective marks

84. The word YOU is the only element of the opponent's mark and the first element of the applicant's mark. The applicant's mark also contains a dot and the suffix OLOGY. Taking account of these similarities and differences, I conclude that they are similar to a low to medium degree.

Degree of similarity between the goods/services

85. As I discussed earlier, the respective goods and services are dissimilar.

Extent of the overlap between the relevant consumers for those goods/services

86. The relevant consumer of the opponent's magazine are the newspaper purchasing members of the general public. The consumer of the applicant's goods and services will be members of the general public who are users of skincare products. Insofar as both relevant consumers are drawn from the general public, there is some similarity. The opponent goods are a lifestyle magazine aimed at female readers. This will increase the overlap.

Strength of the earlier mark's reputation

87. Taking account of the length of time that the opponent's magazine has been produced and the circulation figures associated with the Mail on Sunday newspaper (and therefore, the YOU magazine provided with the newspaper), I conclude that the magazine enjoys a strong reputation.

Strength of the earlier mark's distinctiveness

88. As I have already discussed, I consider the distinctive character of the word YOU to be reasonably low. The word is a personal pronoun and commonly understood and used as such. Consequently, the word YOU is not endowed with any great distinctive character and will be a word that is readily understood and commonly used.

89. I keep in mind that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. The high point is that the opponent's case is that its YOU magazine is a lifestyle magazine aimed at women and will include articles about cosmetics and skin care products, but this is insufficient reason to conclude that the requisite link [sic]. This is because:

(i) the word YOU does not have the identity asserted by Mr Conway outside the field of magazines but, rather it is a very commonly used personal pronoun that has the ability to be used in a way where its dictionary meaning is retained. This is the case here, and;

(ii) because of the distance between the respective parties' goods and services the relevant public will not be prompted to make a link between them.

90. *In summary, I conclude that the requisite link is not likely to exist and, consequently, the ground based upon section 5(3) falls at this point and it is not necessary that I go on to consider detriment or unfair advantage.*”

37. The headings set out by the Hearing Officer in those paragraphs of his Decision are the (non-exhaustive) list of relevant factors laid down in paragraph 42 of the judgment of the CJEU in *Intel Corporation Inc. v CPM United Kingdom Ltd, Case C-257/07*. These factors must be assessed globally in determining whether the requisite link exists. Accordingly, just because the Hearing Officer found that the You Mark had a strong reputation in relation to magazines does not mean that he was required to find the requisite link. The Appellant sought to rely on the evidence showing that the Appellant’s YOU magazine had participated in tie-ups and competitions involving beauty brands and created a beauty-related spin-off under the You Beauty Mark. However, the Hearing Officer referred to this evidence in paragraph 9 of his Decision when he was required to review all the evidence filed in support of proof of use of the You Mark. His conclusion was that that evidence was insufficient to demonstrate proof of use outside of magazines. I therefore disagree with paragraph 14 of the Grounds of Appeal, where the Appellant stated *“the Hearing Officer’s analysis in relation to the ‘link’ seems to overlook the evidence supplied regarding the nature of the Opponent’s reputation and the connection with the Applicant’s goods and services”*. In fact, it is clear that the Hearing Officer did have particular regard to the *“nature”* of the Opponent’s reputation, recognising that it lay only in respect of magazines, and not in connection with the Applicant’s goods or services.
38. The Appellant referred to paragraph 54 from *Intel* in its skeleton argument, which the Hearing Officer had not expressly referred to in his Decision. This states *“the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.”*. The problem for the Appellant is that the You Mark consists of a commonly used pronoun, so that when it is used in respect of goods which are dissimilar to magazines, it is far more likely to be perceived by the average consumer as the common pronoun rather than bring to mind the Appellant’s magazine. This is reflected in paragraphs 88 and 89 of the Decision.
39. For the same reasons as set out above in relation to the distinctiveness of the You Beauty Mark, I reject the criticism of the Hearing Officer’s decision relating to the relevance of the reputation of the You Mark to his conclusions on the distinctiveness of the You Mark in

respect of the relevant goods and services. Mr Conway sought to criticise the Hearing Officer for failing to take into account enhanced distinctiveness, because there is no mention of that in paragraph 86. I do not accept that criticism. The Hearing Officer does refer to the fact that the Appellant's goods are a lifestyle magazine aimed at female readers, which demonstrates that he did have in mind the actual use made of the You Mark when reaching his conclusions on distinctiveness. However, he is consistent in his view of the distinctiveness of the YOU element throughout the Decision. He concludes at paragraph 89 by saying "*the word YOU does not have the identity asserted by Mr Conway outside the field of magazines but, rather it is a very commonly used personal pronoun that has the ability to be used in a way where its dictionary meaning is retained. This is the case here*".

40. The Appellant has not identified any error of principle or law in the Hearing Officer's decision that the requisite link did not exist, so it was not necessary for him to go on to consider the further criteria of unfair advantage and/or detriment.

41. The Appeal under Ground 3 fails.

Conclusion

42. The appeal fails and is dismissed.

Costs

43. Since the Respondent did not take part in the appeal, I make no order in relation to costs of the appeal.

44. I therefore order that the Appellant pay to the Respondent the sum of £1,450, being the costs awarded by the Hearing Officer, to be paid within 21 days of the date of this decision.

Simon Clark
The Appointed Person
9 August July 2023

Representation:

Appellant: Michael Conway (Haseltine Lake Kempner LLP)

Respondent: Did not appear and was not represented