

O/0876/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003718035

BY SANDRA RIMSAITE

FOR THE FOLLOWING TRADE MARK:



IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 431335

BY MARK GAVIN

BACKGROUND AND PLEADINGS

1. On 4 November 2021, Sandra Rimsaite (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 26 November 2021 and registration is sought for the following goods:

Class 3 Skincare cosmetics; Skincare preparations; Anti-aging skincare preparations.

2. On 25 February 2022, the application was opposed by Mark Gavin (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UKTM no. 3273086 for the mark USKIN CARE, which was filed on 25 November 2017 and registered on 4 May 2018.¹ The opponent relies upon some goods for which the mark is registered, namely:

Class 3 Cosmetics; non-medicated toilet preparations; lotions, creams, gels, serums and preparations for the skin; protective lotions, creams and preparations for the skin; cleansing and moisturising creams, oils, lotions and preparations; suntanning, suncreening and sun care creams, oils, lotions and preparations; aftersun creams and preparations; skin bronzing and skin colouring preparations; anti-sunburn preparations; soaps; bath gel; perfumery; essential oils; lotions, creams, serums and preparations for care of the face, body, scalp, nails and hair; bath preparations; toilet articles; shaving preparations; cleansers, toners; perfumes; antiperspirants, deodorants; dentifrice; talcs; makeup; concealers for spots and blemishes; cosmetics; hair-care preparations; conditioner; shampoo; hair colouring preparations; hair spray; eye shadow, eye pencils, mascara, eye make-up, eyeliners, eyeliner brushes, eye creams, eye gels, eye gloss, eye balms; eyebrow colours;

¹ The opponent also originally relied upon UKTM no. 2627197 which, due to its registration date, is subject to the proof of use provisions in section 6A of the Act. However, as the opponent did not file any evidence, the reliance upon this mark was deemed withdrawn on 30 January 2023. Consequently, the applicant’s proof of use request is not applicable to these proceedings.

eyebrow cosmetics; eyebrow pencils; false eyebrows; false eyelashes; depilatory and exfoliating preparations; nail varnish; nail varnish remover; artificial nails.

3. The opponent claims that the marks are similar, and the goods are identical or similar, with the result that there is a likelihood of confusion.

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

5. The applicant is unrepresented, and the opponent is represented by Briffa.

6. Neither party filed evidence. Neither party requested a hearing, and neither 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. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

10. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. As the earlier mark had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant to section 6A of the Act.

11. 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

12. I have included only those goods which represent the opponent's best case in the table below. With that in mind, the competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 3</u> Cosmetics; [...] preparations for the skin.	<u>Class 3</u> Skincare cosmetics; Skincare preparations; Anti-aging skincare preparations.

13. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

14. “Skincare cosmetics” in the applicant's specification is identical on the principle outlined in *Meric* to “cosmetics” in the opponent's specification.

15. “Skincare preparations” in the applicant's specification is self-evidently identical to “preparations for the skin” in the opponent's specification.

16. “Anti-aging skincare preparations” in the applicant's specification is identical on the principle outlined in *Meric* to “preparations for the skin” in the opponent's specification.

The average consumer and the nature of the purchasing act

17. 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.”

18. The average consumer for the goods is a member of the general public or a professional working in the beauty industry (such as a beautician). The goods will be relatively low in price and will be reasonably frequent purchases. The average consumer is likely to consider factors such as reviews, suitability for skin type and ingredients. Consequently, I consider that a medium degree of attention is likely to be paid during the purchasing process.

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

Comparison of trade marks


20. 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.”

21. 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.

22. The respective trade marks are shown below:

Opponent’s trade mark	Applicant’s trade mark
<p style="text-align: center;">USKIN CARE</p>	 <p style="text-align: center;">US:KIN By Skincare Specialists</p>

23. The opponent’s mark consists of the words USKIN CARE. The overall impression lies in the combination of these elements. The word USKIN is more distinctive, due to

the descriptive nature of CARE. The applicant's mark consists of the words US and KIN separated by a colon, in large font. There are horizontal lines above and below the text, with the words "By Skincare Specialists" underneath in very small font and a hexagon device above. The letters USKIN play the greater role in the overall impression due to their size, with the colon and device playing a slightly lesser role. The horizontal lines, the font and the words "By Skincare Specialists" (which are descriptive in nature) play a much lesser role.

24. Visually, the marks overlap in that they all contain the letters USKIN, in the same order. They differ in the colon, the device, the horizontal lines and the words "By Skincare Specialists" in the applicant's mark and the word CARE in the opponent's mark. However, I note that it is the letters US KIN in the applicant's mark which play the greater role in the overall impression and that those letters appear identically in the opponent's mark. In my view, the marks are visually similar to a medium degree.

25. Aurally, the opponent's mark is likely to be pronounced YOU-SKIN-CARE or USS-KIN-CARE. Given the descriptive nature and size of the words "By Skincare Specialists" in the applicant's mark, I consider it unlikely that they will be articulated. In my view, the applicant's mark is likely to be pronounced YOU-ESS-KIN or USS-KIN. Consequently, there will be a significant proportion of average consumers who pronounce the first two syllables of the opponent's mark identically to the applicant's mark. For that significant proportion of average consumers, the marks will be aurally highly similar. Even if I am wrong, and the words "By Skincare Specialists" are pronounced, the marks will be aurally similar to a medium degree for a significant proportion of average consumers.

26. Conceptually, a significant proportion of average consumers will view the letters USKIN/US:KIN in the marks as 1) containing the words US and KIN, which will have the same conceptual meaning in both marks, 2) being a play on the words "YOU SKIN", which will have the same meaning in both marks or 3) having no meaning, resulting in conceptual neutrality. The words "By Skincare Specialists" and "CARE" in the marks are points of conceptual difference, although not distinctive ones. I do not consider that any message will be conveyed by the device in the applicant's mark.

Distinctive character of the earlier mark

27. 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).”

28. Registered trade marks possess varying degree of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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.

29. The opponent did not file evidence and, consequently, I have only the inherent position to consider. For a significant proportion of average consumers, who see the

opponent's mark as the conjoined words US and KIN, there will be no meaningful connection to the goods in issue. In my view, there will be an average (or medium) degree of distinctiveness. For the significant proportion of average consumers who see no meaning in the letters USKIN, the mark will be inherently highly distinctive. For the significant proportion of average consumers who see those letters as a play on the words "YOU SKIN" the mark will be inherently distinctive to between a low and medium degree, due to its allusive nature.

Likelihood of confusion

30. Confusion can be direct or indirect confusion. 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 respective goods may be offset by a greater degree of similarity between the marks and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, 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.

31. 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), who will pay a medium (or average) degree of attention during the purchasing process.

- c) The purchasing process is predominantly visual, although I do not discount an aural component.
- d) For a significant proportion of average consumers, the marks are visually similar to a medium degree and aurally similar to a high or medium degree (depending on how they are pronounced). Conceptually, however the marks are interpreted, the same meaning is likely to be attributed to the letters USKIN in both marks (if any). The words “By Skincare Specialists” and “CARE” act as points of conceptual difference, although not distinctive ones.
- e) The distinctiveness of the earlier mark varies from between low and medium (if it is viewed as a play on the words “YOU SKIN”) to high (if it is viewed as an invented word).

32. Given that the letters USKIN/US:KIN play a significant role in the overall impression of both marks, I consider that they are likely to be mistakenly recalled or misremembered as each other. The average consumer is likely to recall the more dominant element of both marks (with the word, CARE, in the opponent’s mark and the words, By Skincare Specialists, in the applicant’s mark) being overlooked. It is the more distinctive word elements that is likely to stick in the mind of the consumer, and the device in the applicant’s mark and the colon may be forgotten. Consequently, taking all of the above factors into account, I consider there to be a likelihood of direct confusion.

33. Even if the differences between the marks are recognised, I consider it likely that the average consumer will think that they originate from the same or economically linked undertakings, even if the earlier mark is attributed only between a low and medium degree of distinctiveness. This is because the common element USKIN/US:KIN is likely to be seen as indicating alternative brands being used by the same undertaking, with the additional device/word elements and the colon simply being variants of the same mark. Consequently, taking all of the above factors into account, I consider there to be a likelihood of indirect confusion.

CONCLUSION

34. The opposition succeeds in its entirety and the application is refused.

COSTS

35. As the opponent has been successful, he is entitled to a contribution towards his costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of £350, calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£250
Official fee	£100
Total	£350

36. I therefore order Sandra Rimsaite to pay Mark Gavin the sum of £350. This sum should 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 15th day of September 2023

S WILSON

For the Registrar