

O-201-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3499590

BY THE SPORTS PRODUCTS COMPANY LTD

TO REGISTER



AS A TRADE MARK

IN CLASS 3

AND

THE OPPOSITION THERETO UNDER NUMBER OP000421351

BY

ANAS MARTIROSIAN

Background and pleadings

1. On 11 June 2020, The Sports Products Company Ltd (“the applicant”) applied to register the trade mark, as shown on the cover page of this decision. It was accepted and published in the Trade Marks Journal for opposition purposes on 3 July 2020. The application relates to the following goods:

Class 3: Bath and shower oils [non-medicated]; Bath oils; Bath oils (Non-medicated -); Body massage oils; Body oil; Body oils; Essential oils; Essential oils for personal use; Hand oils (Non-medicated -); Natural essential oils; Non-medicated bath oils; Non-medicated oils; Aromatic essential oils; Aromatic oils; Aromatic oils for the bath; Massage oil; Massage oils; Massage oils, not medicated.

2. On 4 September 2020 Mr Anas Martirosian (“the opponent”) opposed the mark on the basis of sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. For the purposes of its opposition under sections 5(1), 5(2)(a) and 5(2)(b), the opponent relies on the following trade mark:

UK00003153165 (“the first earlier mark”)

Revite Cosmetics

Filing date: 4 March 2016

Date of entry in register: 17 May 2016

Class 3: Perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics, in particular creams, milks, lotions, Facial beauty masks, Facial scrubs, Facial moisturisers, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and

after-sun preparations (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers; hair-colouring and hair-decolorizing preparations; permanent waving and curling preparations; essential oils.

4. The opponent raises a further section 5(2)(a) opposition, based on the following trade mark:

UK00003290438 (“the second earlier mark”)

Revite

Filing date: 15 February 2018

Date of entry in register: 1 June 2018

Class 5: Nutritional supplements.

5. The opponent’s claims include the following (as they appear in the Statement of Grounds):

(a) *“nutritional supplements may widely use for skin purpose in the form of oils which creates a likelihood of confusion”;*

(b) *“The opponents goods covers the applicant goods "oils" which are highly identical with the applicants goods, therefore cause likelihood of confusion”;* and

(c) *“Another aspect opponent believes, applicant mark is highly similar and identical with the opponent mark, as both the mark contains a common term REVIT, The common term **REVIT** have more weightage than the other following term e.g Cosmetics or ARUB”.*

6. Under the section 5(2)(a) challenge, based on the second earlier mark, the opponent argues that: “nutritional supplements may widely use for skin purpose (sic) in the form of oils which creates a likelihood of confusion”.
7. The applicant filed a Notice of Defence and Counterstatement in which it contends as follows:

“We are called Revita Rub and not Revite Cosmetics (we do not produce cosmetics). We aim for the sports and massage therapy markets and not the cosmetics market. They do not have a styised (sic) trademark or logo so I don't see how there can be any confusion between the brands and products. Our brand/product is clearly distinguishable.”

8. In these proceedings the opponent is represented by United Legal Experts; and the applicant is unrepresented.
9. The opponent filed a Notice of Opposition and Statement of Grounds. The applicant filed a Notice of Defence and Counterstatement and brief submissions about its business. Neither side filed evidence. A hearing was neither requested nor considered necessary. I therefore give this decision after careful review of all the papers before me.

Preliminary Point

10. Before I deal with the substantive issues in these proceedings, there is one preliminary point I must address. In its Statement of Grounds, the opponent alleges that the “Applicant also uses the (R) which is a violation of Section 95 of the Trade Mark Act 1994, “Falsely representing trade mark as registered” which is a criminal offence. However, this provision is not now in point. The matter before me relates solely to opposition proceedings under section 5 of the Act and I do not have the power to consider the alleged criminal offence in these civil proceedings. It is also worth noting that a mark may be registered in another jurisdiction, which would make use of the ® symbol permissible in the UK.

DECISION

Section 5(1) and Section 5(2)(a)

Revite Cometics

11. Section 5(1) of the Act reads as follows:

“(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.”

12. Section 5(2)(a) of the Act reads as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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.”

13. Although the UK has left the EU, section 6(3)(a) of the European (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 Trade Marks Act relied on 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.

14. In order for claims under Section 5(1) and Section 5(2)(a) of the Act to succeed, the competing trade marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ*

Diffusion v. Sadas Vertbaudet SA, Case C-291/00, where the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

15. While the competing trade marks share the letters “REVIT” (in the same order), they are clearly not identical according to settled law. The contested mark does not reproduce the earlier mark without any modification or addition. The opponent’s mark consists of the words *Revite Cosmetics*; whereas the applicant’s mark is a composite mark consisting of a figurative element and word elements (in different sizes) in two predominant colours. To my mind, the dominant word element/s of this mark is/are *RevitaRub*; which clearly is not an exact replication of *Revite Cosmetics*. Although I consider that it is indisputably evident that the marks are not identical based on these elements alone, I also take into account the additional elements of the applicant’s figurative mark, which have no counterpart in the earlier mark. In particular: the word sequence “Natural Relief Oil”, and the stylised leaves flanked by “ESTD” on the left and “2020” on the right.

16. There are clear differences between the marks, which show that they could not be considered identical (according to settled caselaw). Accordingly, I find that the marks are not identical; and the claims under sections 5(1) and 5(2)(a) of the Act cannot succeed.

Revite

17. The opponent’s second earlier mark consists exclusively of the word *Revite*. Therefore, I find that the assessment between the *Revite* mark and the mark applied for is very similar to the preceding discussion in respect of the identity between the applicant’s mark and the opponent’s *Revite Cosmetics* mark. *Revite* is clearly not identical under law to the composite mark, *RevitaRub*. The

latter mark does not reproduce the earlier mark without any modification or addition. In addition to the element/s “RevitaRub”, the mark applied for includes stylised leaves flanked by “ESTD” and “2020” and the words “Natural Relief Oil”. These elements have no counterparts in the earlier mark. Moreover, they (particularly the stylised leaves) contribute to the identity of the mark at issue. I do not consider that the differences between the marks to be so insignificant as to go unnoticed by the average consumer. Accordingly, I find that the marks are not identical and the claim under Section 5(2)(a) of the Act in relation to the *Revite* mark, also fails in its entirety.

Section 5(2)(b)

18. I turn now to consider the opposition under section 5(2)(b) of the Act in relation to the first earlier mark. Section 5(2)(b) provides 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.”

19. An earlier trade mark is defined under section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

a registered trade mark, international trade mark (UK) or Community trade mark 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

20. The opponent’s first earlier mark is an earlier mark within the meaning of Section 6(1) of the Act. Further, given that it has not been registered for more than five years at the date the contested application was filed, it is not subject to the proof of use provisions contained in section 6A of the Act.¹ The opponent is, as a consequence, entitled to rely upon its earlier mark in relation to all of the goods indicated without having to prove that genuine use has been made of it. Therefore, I must make the assessment based upon the full width of the goods relied upon by the opponent, regardless of whether or not the mark has actually been used in relation to those goods. This is because the opponent is entitled to protection across the breadth of what it has registered on a ‘notional’ use basis.

Section 5(2)(b) – case law

21. The following principles are gleaned from the decisions of the courts of the European Union 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.

¹ As these proceedings commenced after 14 January 2019, when the Trade Mark Regulations 2018 came into force, the relevant period for proof of use purposes is the five years prior to and ending on the date of application of the contested application.

The principles:

- (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 the earlier mark to mind, 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 the goods

22. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

23. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (l) The respective users of the respective goods or services;
- (m) The physical nature of the goods or acts of services;
- (n) The respective trade channels through which the goods or services reach the market;
- (o) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (p) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

24. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“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”.

25. The parties' respective goods are as follows:

The opponent's goods	The applicant's goods
<p>Class 3: Perfumes, eaux de toilette; bath and shower gels and salts not for medical purposes; toilet soaps; deodorants for personal use; cosmetics, in particular creams, milks, lotions, Facial beauty masks, Facial scrubs, Facial moisturisers, gels and powders for the face, body and hands; sun-tanning milks, gels and oils and after-sun preparations (cosmetics); make-up preparations; shampoos; gels, mousses and balms, preparations in aerosol form for hairdressing and haircare; hair lacquers; hair-colouring and hair-decolorizing preparations; permanent waving and curling preparations; essential oils.</p>	<p>Class 3: Bath and shower oils [non-medicated]; Bath oils; Bath oils (Non-medicated -); Body massage oils; Body oil; Body oils; Essential oils; Essential oils for personal use; Hand oils (Non-medicated -); Natural essential oils; Non-medicated bath oils; Non-medicated oils; Aromatic essential oils; Aromatic oils; Aromatic oils for the bath; Massage oil; Massage oils; Massage oils, not medicated.</p>

26. I find that “*Body massage oils; Body oil; Body oils; Essential oils; Essential oils for personal use; Hand oils (Non-medicated -); Natural essential oils; Non-medicated oils; Aromatic essential oils; Aromatic oils for the bath; Aromatic oils; Massage oil; Massage oils; Massage oils, not medicated*” – are either identically worded to, or amount to identity (under the *Merck* principle), with the term “*essential oils*” in the earlier mark’s class 3 specification. These goods are similar in their nature, purpose, and methods of use. They are produced by using various plant extracts and are generally intended for personal care and/or therapeutic purposes. Considering that they are not pharmaceuticals or medicated products, they can also be substituted with one another. For example, essential oils can be used as massage oils and in aroma therapy. They

are accordingly in competition. I consider further that they target the same end user and share the same channels of distribution. Therefore, these contested goods are identical to the opponent's term *essential oils*, in class 3 of the contested *Revite Cosmetics* mark.

27. The remaining terms; "*Bath and shower oils [non-medicated]; Bath oils; Bath oils (Non-medicated -); Non-medicated bath oils*" are all encompassed by the term "bath and shower gels ... not for medical purposes" within the opponent's specification. Therefore, the respective terms are *Merix* identical or at least highly similar.

Average consumer and the purchasing act

28. As indicated by the caselaw cited above, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. 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".

29. For the purpose of assessing the likelihood of confusion, it must also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.²

30. The parties have made no specific submissions on the average consumer, nor on the purchasing process, for the respective specifications. I therefore find that the average consumer is a member of the general public. As the goods at issue are commonplace consumables, the level of attention paid by the average consumer will generally be moderate; however, it may be the case that a proportion of the relevant public will take a higher than average level of care and attention at the point of selection, due to the nature of the goods at issue (this particularly applies in situations where considerations of allergies or other skin sensitivities are important).

31. I consider that the goods are most likely to be obtained by self-selection from the shelves of a retail outlet, from a website equivalent or perhaps from a specialist undertaking. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there may be an aural component to the purchase of the goods, given that orders may be placed over the telephone; and purchases may be made on word-of-mouth recommendations or the advice of sales assistants or representatives.

Comparison of the marks


32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

² Case C-342/97, *Lloyd Schuhfabrik Meyer*.

“.....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.”

33. 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.

34. The respective trade marks are shown below:

Revite Cosmetics	
Earlier trade mark	Contested trade mark

Overall Impression

35. In comparing the marks there is no difference between the variation in the casing; because a word trade mark registration protects the word itself, not its written form. Therefore, it is of no consequence whether a word mark is represented in lower or upper case letters or a combination of both.³ I am also reminded (by the opponent’s submission that it “may use its mark ... in green”), that the doctrine of notional and fair use extends to use of a registered word mark in any colour. The opponent would therefore be entitled to use of its mark in exactly the same colours as those in the applicant’s mark.

³ *Bentley Motors Limited v Bentley* 1962 Limited BL O/159/17

36. The opponent's first earlier mark consists of two words, the first of which is *Revite* and the second, *Cosmetics* (a known noun). *Revite* is more dominant than *Cosmetics*; on account of the primary position it occupies in the mark and because *Cosmetics* is descriptive of the goods under the mark.
37. The applicant's mark consists of a series of textual elements in different dimensions and a figurative device, against a white background. The element/s *RevitaRub* are set in a proportionately larger font in the centre of the mark. The words are not separated by a space, but by two predominant colours. The *Revita* element is in a dark blue-green colour, and *Rub* appears in a lighter herb green. There are two stylised leaves at the top centre of the mark, in the same colour as the *Rub* element (i.e. herb green). I note the use of the ® symbol at the right side of the *Rub* element. However, I believe due to its size, it is unlikely to be noticed; and if noticed, the average consumer would attach no significance to this symbol. The mark also includes the text "ESTD" at the left side of the stylised leaves and "2020" to the right (both in a lighter blue-green colour; seemingly lighter on account of the smaller size font). At the bottom of the mark, below the *RevitaRub* elements are the words (in a smaller font) "Natural Relief Oil", also in the lighter blue-green colour. The elements *RevitaRub* are the dominant elements of the mark; as they stand out compared to the other elements of the mark (which attach no origin or trade mark significance to the mark). The words "Revita" and "Rub" will be perceived separately, given their different colours. The "Revita" element stands out more due to its position and bolder colour. The "Rub" element is weaker, as it conveys clear meaning to the relevant public. The word *Rub* has little, if any, distinctive character in respect of many, if not all, of the applicant's goods; as they relate to goods which are/can be applied to one's person by rubbing. The other elements, due to their smaller size, lighter colour and subordinate orientation, play a secondary role in the overall impression of the mark. Therefore *Revita* stands out as the distinctive element.

Visual Comparison

38. Visually, the marks coincide in the sequence of the letters “Revit”, which is placed at the beginning (and constitutes almost all) of the dominant element of the contested mark, “*RevitaRub*”; and the first word of the opponent’s *Revite Cosmetics* mark. The marks differ by the last letter of the common element *Revit* (with an “e” in the opponent’s mark and an “a” in the applied-for mark); as well as the by the words *Cosmetics* and *Rub*, respectively. Visual differences are also obvious in the stylisation of the contested mark and its additional elements (as set out above). In light of all of these considerations, I find that the respective marks share a low to medium degree of visual similarity.

Aural Comparison

39. Aurally, the marks overlap in the identical articulation of the letters “Revit”. The pronunciation differs in the sound of the last letter “a” (at the end of “Revit”) of the contested mark and where articulated, the sound of the postfix, “Rub”; and the *Cosmetics* element (of the opponent’s mark). The figurative element and the less dominant, descriptive elements (in smaller, lighter coloured typeface) in the applicant’s mark are unlikely to be articulated by the average consumer.⁴ Where the respective marks are articulated as *RevitaRub* and *Revite* (with a proportion of the average consumer choosing not to articulate the descriptive and less dominant elements, such as *Natural Relief Oil* and *Cosmetics*), the marks are aurally similar to an above average degree. In the scenario where the marks are articulated as *RevitaRub* and *Revite Cosmetics*, they can be said to be aurally similar to a medium degree. The aural similarity would diminish in the unlikely event of the other elements of the applicant’s mark being articulated in addition to the *RevitaRub* element.

⁴ With regard to the figurative element ..., where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name than by describing the figurative element of the trade mark. [The Board of Appeal] correctly takes the view that that general line of reasoning could reasonably be applied in the present case. According to the Board of Appeal, it is reasonable to assume that the average consumer will perceive the verbal element as the trade mark and the figurative element as a decorative element. Moreover, the figurative element is placed ... in a less visible position. (T-312/03, *Selenium-Ace*, § 37).

Conceptual Comparison

40. I earlier indicated that the more dominant and distinctive elements of the respective marks are *Revite* and *Revita*. Conceptually, neither element has obvious meaning; and as such, would likely be understood as invented words by a significant proportion of the relevant public. Having said that, however, I do not consider that these words are incapable of conveying any meaning. Even though the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; according to settled caselaw, when perceiving a word element, they will break it down into parts which, for them, suggest a specific meaning or which resemble words they know.⁵ *Revite* and *Revita*, albeit invented, are words which may be evocative or suggestive of a concept relating to revitalising. I therefore consider that a section of the relevant public may make a connection between *Revite/a* and revitalise or revitalising; and will understand its meaning in relation to the goods on offer.

41. The *Cosmetics* and *Rub* elements play similar roles in the respective marks. I consider it highly likely that, whilst perceiving the marks, the average consumer will recognise these elements of the marks as being standard dictionary words with clear meanings: *Cosmetics* are “substances put on the face or body that are intended to improve its appearance or quality”;⁶ and *Rub*, as meaning “to press or be pressed against something with a circular or up-and-down repeated movement”;⁷ or a noun, meaning a mixture or solution to be applied by rubbing.

42. The other elements of the applicant’s mark (although entirely descriptive of the nature of the goods or the applicants’ business), add points of conceptual differences between the marks. The word sequence “Natural Relief Oil” and the stylised leaves help to convey the conceptual message: that the rub is an oil

⁵ Case T-189/05 *Usinor SA v OHIM*; Case T 356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II 3445, § 51, and Case T 256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II 0000, § 57.

⁶ Cambridge Dictionary: <https://dictionary.cambridge.org/dictionary/english/cosmetics?q=cosmetics>

⁷ Cambridge Dictionary: <https://dictionary.cambridge.org/dictionary/english/rub>

made from natural ingredients for natural relief. The “ESTD” and “2020” elements simply indicate when the applicant’s trade was established.

43. In consideration of all of the foregoing, I find that the respective marks are conceptually similar to a medium degree.

Distinctive character of the earlier trade mark

44. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁸. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

45. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings” - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

46. Trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the opponent has not pleaded that its mark has acquired enhanced

⁸ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

distinctiveness through use and has not filed any evidence to support such a claim.⁹ Consequently, I have only the inherent position to consider.

47. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. sitting as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

48. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

49. The distinctive character of the earlier mark rests with the *Revite* element. The *Cosmetics* element describes the goods on offer under the mark and; consequently, adds little or nothing to the distinctive character. *Revite*, in my view, is not a word used in everyday language, neither for designating cosmetics nor for describing their essential characteristics. Whilst it may be seen as a

⁹ I could not accept the opponent’s claim that it has “invested considerable amount (sic) in sales and marketing of the brand to make it a reputed brand in United Kingdom”; in the absence of evidence to substantiate this claim.

lexemic invention; however, I find that it may be evocative or suggestive of revitalising. From the perspective of the average consumer who sees *Revite* as an invented word, or a word with no particular meaning in relation to the goods at issue, the mark is of a high degree of inherent distinctive character. In the scenario where the average consumer makes a connection or association between *Revite* and revitalising and perceive a meaning in relation to the goods concerned, the mark would be inherently distinctive to at least an average degree.

Conclusions on Likelihood of Confusion

50. The applicant submits that “the differences between the marks as discussed and the level of attention the average consumer of the services [sic] concerned is likely to give mean [sic] that there is no likelihood of confusion between the mark of the present application and the mark of the opponent’s registration”.

51. In determining whether there is a likelihood of confusion, 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 trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer for the goods, the nature of the purchasing process and 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 they have retained in their mind.

52. Confusion can be direct (where the average consumer mistakes one mark for the other), or indirect (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).

53. I have found that the applicant's mark consists of a number of elements, and that its dominant elements are the words REVITA and RUB, with the former playing a more prominent role, particularly in terms of its distinctiveness in relation to the latter. In the opponent's REVITE COSMETICS word mark, I have found the dominant and distinctive element to be the word REVITE. I concluded that the marks share a low to medium level of visual similarity; that the level of aural similarity is at least medium (or above medium where the marks are verbalised as *RevitaRub* and *Revite*); and that they are conceptually similar to a medium degree.

54. I determined that the average consumer is predominantly ordinary members of the public, who will pay an average (and in limited instances, a higher) degree of attention in the purchasing process. Without disregarding the aural component, I found that the selection process is likely to be visual. I also concluded that the opponent's mark, which has not been enhanced through use, is of at least average inherent distinctive character (or high where the *Revite* element is perceived to be an invented word only).

55. In reaching a conclusion, I remind myself that the competing goods are either at least highly similar or identical. Although I have concluded that the average consumer will pay at least a moderate degree of attention during the purchasing process, the cumulative effect: of the low to average degree of visual similarity, the at least medium level of aural similarity and medium degree of conceptual similarity between the marks; and the average to high degree of inherent distinctive character of the earlier mark; leads me to conclude that there is a likelihood of confusion. As the differences between the competing trade marks do not play a significant role in their respective overall impressions, I find the shared dominant, distinctive element is likely to trigger perceptions and recollections leading to the marks being mistaken for one another; that is, there will be direct confusion.

56. In case I am wrong about that, I will now consider the likelihood of indirect confusion. The distinction between direct and indirect confusion was explained

in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

57. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18. The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points [my emphasis].

19. The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are

situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20. The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21. The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

58. It is also important to point out that, even an element which has only weak distinctive character may dominate the overall impression of a composite mark or have an independent distinctive role in that mark, in the *Medion* sense. This may materialise because of its position in the mark or its size for example, which make an impression on consumers and enable them to remember the mark.

59. In view of my conclusions on the identity or high degree of similarity between the goods; the visual and aural similarities between the marks; the overall impression conveyed by the common distinctive element of the marks (Revit/e/a - with the difference in the endings being of no material consequence); that its impression is perceived independently within the overall impression of the

marks; and that that impression remains largely unaffected, notwithstanding the additional (descriptive) elements in the respective marks; I am satisfied that the average (even highly attentive) consumer is likely to perceive the identical (or near identical) goods as originating from undertakings which are economically linked (leading to indirect confusion).

Conclusion

60. The opposition based upon *Revite Cosmetics* has succeeded in full and, subject to any successful appeal, the application will be refused.

COSTS

61. The opponent has been successful and is entitled to a contribution towards its costs. I bear in mind that the pleadings were relatively short and that neither party filed evidence or submissions in lieu of hearing. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying this TPN as a guide, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£200
Official fee:	£100
Total:	£300

Dated this 26th day of March 2021

**Denzil Johnson,
For the Registrar**