

O/279/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2579244
BY
FIRM OF ABX
TO REGISTER THE TRADE MARK**

irevive

IN CLASSES 3 and 35

AND

**THE OPPOSITION THERETO
UNDER NO 102324
BY
GURWITCH PRODUCTS LLC**

Trade Marks Act 1994
In the matter of application no. 2579244
by Firm of ABX
to register the trade mark:
irevive
in classes 3 and 35
and the opposition thereto
under no. 102324
by Gurwitch Products LLC

BACKGROUND

1. On 21 April 2011, Firm of ABX (the applicant) applied to register the above trade mark in classes 3 and 35 of the Nice Classification system¹ as follows:

Class 03: Cosmetic and beauty products.

Class 35: Retail services connected with the sale of cosmetic and beauty products.

2. Following publication of the application in the *Trade Marks Journal* on 3 June 2011, Gurwitch Products LLC (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed against all of the applicant's goods and services. Under section 5(2)(b) of the Act, the opponent relies upon the following trade mark:

MARK DETAILS AND RELEVANT DATES	GOODS
CTM: 1907161 Mark: RÉ VIVE Date of application: 17 October 2000 Priority date: 21 April 2000 Date of registration: 8 February 2006	Class 03: Non-medicated skin products, namely, creams, lotions, gels, toners, cleaners and peels.

5. In its statement of grounds the opponent submits, inter alia:

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

4. *“The applied-for mark is similar to the Opponent’s earlier trade mark and the goods and services applied for are identical or similar to the Opponent’s goods...”*

6. Under section 5(4)(a) of the Act, the opponent states that it has used the mark Ré Vive throughout the United Kingdom since September 1998 in relation to the following goods:

“Non-medicated toilet preparations.”

7. It states:

“4...Use of the applied-for mark in respect of the goods and services in the application would lead to deception and misrepresentation, resulting in damage to the Opponent’s business.”

8. The applicant filed a counter statement, which denies the grounds upon which the opposition is based.

9. The opponent's mark is an earlier mark, which is, in principle, subject to proof of use because, at the date of publication of the application, it had been registered for five years.² However, at section 5 of its counter statement the applicant has answered ‘NO’ when asked if it requires the opponent to provide proof of use. Therefore I need consider it no further.

10. Both parties filed evidence in the proceedings, though the applicant’s evidence consisted of a witness statement containing only submissions; both parties filed written submissions in lieu of a hearing. I will refer to these as necessary below.

EVIDENCE

11. The opponent’s evidence consists of a witness statement from Lynn Eccersley, dated 6 December 2011, accompanied by exhibit LE1 (which is split into eleven separate items). Ms Eccersley is the Executive Director of Sales for Gurwitch UK Limited, a wholly-owned subsidiary of Gurwitch Products LLC (the opponent), a position she has held since January 2004.

12. As the opponent has not been put to proof of use in these proceedings, I will only detail the evidence to the extent that it is necessary to determine the distinctive character of the opponent’s earlier mark later in this decision. The key points are as follows:

- *„Ré Vive’ has been used in the UK since September 1998 in respect of non-medicated skin products, namely, creams, lotions, gels, serums, toners, cleaners and peels.*

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

- Turnover in the UK under the mark Ré Vive in the period 2006-2011 was as follows:

Period	Turnover (£)
2006-2007	1,354,463
2007-2008	1,668,251
2008-2009	1,468,373
2009-2010	1,457,900
2010-2011	1,822,422

- The amount spent on advertising and marketing goods sold under the „Ré Vive’ mark in the United Kingdom in the period 2008-2011 was as follows:

Period	Spend (£)
2008-2009	9,741
2009-2010	26,913
2010-2011	18,288

- The mark is used in various forms throughout the evidence. It appears in the form REVIVE on invoices, on the product as Ré Vive and in the text of advertising brochures and on websites it takes several forms, such as Liberty’s Christmas Catalogue (exhibited at item 6) where it is shown as Révive and on SpaceNK’s website where it is shown as RÉVIVE.
- The prices of the goods range from £30 - £300. Collections and kits range between £200 - £400.
- The products are sold through department stores such as Harrods, Liberty, House of Fraser and John Lewis and in boutiques and beauty salons such as Peter Jones and SpaceNK.
- The products are sold online through the websites of Harrods, House of Fraser, John Lewis, SpaceNK and www.panachecosmetics.com. Although the examples provided were printed after the material date, the witness statement acknowledges this and states that the relevant goods were sold under the trade mark during the relevant period.
- The products are advertised in store catalogues and promotional magazines as well as in *Tatler* in the UK and a selection of US „gossip’ magazines. These include references to celebrity customers.

14. The applicant’s evidence consists of a witness statement, dated 17 February 2012, by Iain Lamont, who is a partner in the applicant firm. There are no exhibits attached to the witness statement which states, inter alia:

“The purpose of this witness statement is to state that the opponents have never used the trademark irevive on any of their products or advertising...”

DECISION

15. I shall deal first with the ground of objection under section 5(2)(b). 5(2)(b) of the Trade Marks Act 1994, states:

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

....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

16. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77; *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 great 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

17. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods and services at issue. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and services and the frequency of the purchase.

18. The opponent submits that the „purchasing group’ for the goods are women. However, its own evidence includes magazine articles, largely available in the US, which show use of its products by male celebrities. It also states:

“20. Beauty products are sold in department stores where large areas are dedicated specifically to the demonstration of beauty products...Often, the products demonstrated are not bought in the shop but are later bought online, from a different retailer if there is a price advantage to be gained.”

19. In my view, the average consumer will be a member of the general public, not just women. While the purchasing act is not limited to that described by the opponent, it is, in my view, likely to be primarily a visual one as the goods will be selected from a website, catalogue or directly from a shelf. However, I do not ignore

aural considerations as it is not unusual to find more expensive cosmetic products kept in cases or behind counters in, for example, salons and department stores, in the manner described by the opponent. In my view, the average consumer will pay a reasonable degree of attention, to the extent that they are likely to consider, inter alia, intended skin type, particular ingredients, aroma etc. While it is clear from the evidence that the opponent's goods are at the more expensive end of the skincare product market, as neither parties' specifications are limited in any way, I must consider the goods in all price categories. However, as a general rule these are relatively low value, fairly frequent purchases and are unlikely to demand a particularly high level of attention to be paid in their selection.

Insofar as the retail services are concerned, once again the average consumer will, once again, be a member of the public (not just women) who is likely to select the retail outlet concerned by primarily visual means having encountered the trade mark in, for example, signage on the high street, in magazines and catalogues and on the internet. As to the degree of care that is likely to be taken when selecting a retail outlet, once again this is likely to vary depending on the nature of the retail outlet and the goods which are being retailed. For example, the average consumer is likely, in my view, to be much more attentive when selecting a retail outlet selling, expensive cosmetic products (where brand image and ingredients are relevant considerations) than they would when selecting a retail outlet to purchase an inexpensive item such as a newspaper. Considered in the context of the goods at issue and, much like the selection of the goods themselves, I think the average consumer will pay at least a reasonable level of attention to their selection.

Comparison of goods and services

20. The goods and services to be compared are as follows:

The opponent's goods	The applicant's goods and services
<p>Class 3: Non-medicated skin products, namely, creams, lotions, gels, toners, cleaners and peels.</p>	<p>Class 3: Cosmetic and beauty products.</p> <p>Class 35: Retail services connected with the sale of cosmetic and beauty products.</p>

21. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

22. The applicant's class 3 specification consists of the broad term „cosmetic and beauty products’, which clearly includes the opponent's goods (non-medicated)

„creams, lotions, gels, toners, cleaners and peels’.³ Therefore the goods are identical in accordance with the *Merix* principle.

23. When making a comparison between the opponent’s goods and the applicant’s retail services the opponent states in its written submissions:

“16. There is a similarity between the Opponent’s earlier goods and the services in the application because there is a link between the sale of beauty products and the products themselves.”

24. In respect of the retail services contained in the application, I am guided by the comments of the General Court (GC) in *Oakley, Inc v Office of Harmonisation in the Internal Markets (OHIM)*, Case T-116/06. The case concerned goods in classes 18 and 25 against retail services in respect of the same. The Court said:

*“54. Clearly in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable or, at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-Und Heimwerkermarkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”*

25. Consequently, as the applicant’s retail services are for the retail of the goods in the opponent’s class 3 specification, I find them to be similar in accordance with the principles outlined above.

Comparison of marks

26. The marks to be compared are:

Opponent's mark	Applicant's mark
RÉ VIVE	irevive

27. In making a comparison between the marks, I must consider the respective marks’ visual, aural and conceptual similarities with reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components⁴, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

³ Where a specification includes a broad term followed by ‘namely’ and a list of goods, the specification is limited to those named goods.

⁴ *Sabel v Puma AG*, para.23

Dominant and distinctive components

28. The opponent's mark consists of the words „RÉ VIVE' presented in block capitals. There is a space between the two elements of the mark and an acute accent over the first 'E'. The two components hang together and, in my view, may be construed by the average consumer as alluding to the word „revive'. The applicant's mark consists of the single word „irevive' presented in lower case. In my view, neither of the competing trade marks has a distinctive or dominant element, the distinctiveness of both trade marks lie in their totalities.

Visual and aural similarities

29. The applicant submits that the marks are substantially different in appearance and sound, while the opponent is of the view that the „lower case ‚j' is not sufficient to distinguish the Applicant's mark from the Opponent's earlier trade mark „RÉVIVE”.

30. I have described the competing trade marks above. Both contain the letters „re-v-i-v-e'. The opponent's mark will be pronounced „re-vive'. The average consumer will pronounce the applicant's marks as „j-revive'.

31. In terms of the letters making up the marks the only difference between them is the letter „j' which appears at the beginning of the applicant's mark. There is a general rule that the average consumer tends to place most importance on the start of a word,⁵ but it is exactly that - a general rule, which can be mitigated depending on the circumstances of the case.⁶ In this case, the fact that the applicant's mark contains the additional „j' at the beginning and that the opponent's mark contains the accent and space between the two elements, is not sufficient to lessen the degree of similarity where both marks contain the letter string making up the word „revive' and which is all of or all but one of the letters making up the mark.

32. Consequently, I find there to be a moderate degree of visual similarity between the marks and a high degree of aural similarity.

Conceptual similarities

33. For a conceptual meaning to be relevant it must be one capable of immediate grasp by the average consumer.⁷

34. The applicant submits that the marks have different meanings but has not indicated what these are. The opponent submits:

“12. The applied for mark irevive is essentially the Opponent's trade mark Révive prefixed by the letter ‚j' which is a prefix commonly used in trade marks in respect of all types of products. It is variously intended to refer to the Internet, or simply to imply that something is modern. Such marks have

⁵ *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-336/03*

⁶ *Castellani SpA v OHIM, T-149/06 and Spa Monopole, compagnie fermiere de Spa SA/NV v OHIM, T-438/07*

⁷ *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIMi [2006] e.c.r. -I-643; [2006] E.T.M.R. 29.*

become widespread following the popularity of ipod telephones and ipad notebooks. The lower case letter ‚j’ is not sufficient to distinguish the Applicant’s mark from the Opponent’s earlier trade mark RÉVIVE.

35. In my view, the opponent’s mark will be seen, by the average consumer, as the two elements ‚RE’ and ‚VIVE’. In the context of the goods and services, the mark in its totality may allude to the word revive and as a consequence may give the average consumer the impression of something refreshing or rejuvenating.

36. The applicant’s mark consists of the same word with the addition of the letter ‚i’ at the beginning of the mark. I agree with the opponent that the average consumer is used to encountering trade marks which contain the lower case ‘i’ as a prefix. However, there are, in my view, other conceptual considerations. The ‘i’ could be considered to be a statement, ‚I revive’, giving the average consumer the impression that the products or related services are sending a message that they have reviving properties or can assist the consumer in reviving their appearance. Alternatively, in the context of goods, which includes products for use around the eyes, it could be seen as a reference to the ‚eye’ and, in relation to the services, may be considered to be offering a range of products which have that effect. That is, products or services which enable the user to revive the eyes.

37. In any case, the essential message is that of a reviving, rejuvenating quality and this is clearly the case in respect of both marks.

38. Consequently, I find there to be a high degree of conceptual similarity between the marks.

Distinctive character

39. I must now assess the distinctive character of the opponent’s earlier trade mark. The distinctive character of the opponent’s earlier trade mark must be appraised first, by reference to the goods upon which I have found it has been used and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. 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 used 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.

40. The opponent submits:

“18. The Opponent’s trade mark is prima facie note[sic] a very strong mark, but the evidence shows that the trade mark has been used in the United Kingdom for over 10 years and that it has been supported by publicity in relevant women’s magazines and promotional material issued by the retailers which sell the RéVive products. By virtue of this significant use of the trade mark it has acquired reputation and become a strong distinctive mark.”

41. The opponent's mark is not descriptive of the goods but may be considered strongly to allude to the word „revive' resulting in an association with refreshing and rejuvenating properties. It is, as the opponent states, a trade mark possessed of a fairly low degree of inherent distinctiveness.

42. I must also determine whether the trade mark RÉ VIVE has acquired an enhanced distinctive character through the use made of it. It is clear from the evidence provided by the opponent that the mark is used in a variety of forms on invoices and on websites. However, it is also clear from the evidence that the mark is always used on the product in the following form:



43. In its submissions, the opponent states:

“9. A mark does not have to be used precisely as registered. Use of a mark in a form which differs in elements which do not alter the distinctive character of the mark in the form in which it was registered are deemed use of the registered trade mark (viz S.46(2) TMA 1994). It is submitted that the manner of use of the mark differs hardly at all from the registered mark and falls within the ambit of S.46(2) TMA 1994.”

44. I agree. Use of the mark in title case rather than block capitals (when all other elements of the mark are identical to that registered) does not, in the circumstances of this case, alter the distinctive character of the mark as registered. As a consequence, the use made by the opponent of its mark in the form shown above, can be taken into account when determining whether the mark has achieved enhanced distinctiveness through use.

45. The evidence shows that the mark has been used in the UK for at least the last ten years. Turnover figures between 2006 and 2011 show sales totalling £7,771,409 and advertising spend between 2008 and 2001 amounted to £54,942 which is clearly sufficient to show an established business within the cosmetics/beauty industry. However, in the absence of any evidence to show the size of that market in the UK for the goods at issue (which must, in my view, be considerable), I am unable to determine the extent to which the distinctive character of the mark has been enhanced by the use made of it.

Likelihood of confusion

46. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled

perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁸ I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and must have regard to 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 goods and services and vice versa.

47. In its counterstatement and submissions, the applicant points out that there are other „revive’ marks on the register:

“See registered trademark 2501778 purevive in same class which establishes precedent to allow revive with a prefix added and does therefore not cause consumer confusion.”

48. It also states that there are other marks which use an ‘i’ prefix:

“The use of the letter „i’ in front of words, even those words or phrases previously registered as trademarks is well established and has been allowed in several cases.”

49. It is clear from a number of cases decided by the courts of the UK and the Community, that state of the register evidence of this sort does not assist the applicant.⁹

50. I have found that the marks share a moderate degree of visual similarity and a high degree of aural and conceptual similarity. I have identified a fairly low level of inherent distinctive character in the opponent’s earlier mark, which has been enhanced by the use made of it, though I cannot conclude to what extent. I have found the parties’ goods to be identical (in class 3) and similar, (in respect of the opponent’s class 3 goods when compared to the applicant’s services in class 35). I have identified the average consumer, namely a member of the general public. I have concluded that the purchase will be primarily visual, though I do not discount aural considerations and will involve a reasonable degree of care and attention.

51. In this case the fact that the first letter is different, in marks which otherwise contain the word „revive’, and the fact that the opponents mark includes a space between the RE and VIVE elements and an acute accent over the first ‘E’ are not, in my view, significant factors. The similarities between the competing marks far outweigh these minor differences.

52. Taking all the above factors into account and considering the concept of imperfect recollection, I have no difficulty concluding that the similarities between the respective marks are such that one mark may be mistaken for the other i.e. there will be direct confusion. If I am wrong in this, there is, in my view, little doubt, that the similarities between the respective marks are sufficient that where used on goods or services which are identical or similar, there is a likelihood that consumers will be

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27

⁹ *See, in particular, British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 and *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04 the General Court (GC)*

confused into believing that the goods and services provided by the applicant, come from an undertaking linked to the opponent i.e. there will be indirect confusion. Accordingly, the opposition is successful.

53. Given what I consider to be a very clear finding under section 5(2)(b) of the Act, I need not go on to consider the opposition under section 5(4)(a) and decline to do so.

CONCLUSION

54. The opposition succeeds.

Costs

55. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I note that as a result of the opponent adding a ground under section 5(4)(a), the applicant was required to amend its counterstatement. However, as this only took the form of a short additional paragraph, I do not think it is necessary to make a reduction to the award. I have taken into account that no hearing has taken place and the opponent filed evidence as well as written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement:	£ 300
Preparing evidence and considering the other side's evidence:	£ 500
Written submissions:	£ 300
Official fee:	£ 200
Total:	£ 1300

56. I order Firm Of ABX to pay Gurwitch Products, LLC the sum of £1300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of July 2012

**Ms AI Skilton
For the Registrar,**