

O-124-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2374039B AND 2385263B
BY LASERCARE CLINICS (HARROGATE) LIMITED**

AND

**THE CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS 93805B AND 93844
BY
THE PROCTER & GAMBLE COMPANY**

Trade Marks Act 1994

**In the matter of application nos 2374039B and 2385263B
by Lasercare Clinics (Harrogate) Limited
and the consolidated oppositions thereto
under nos 93805B and 93844
by The Procter & Gamble Company**

Background

1) These oppositions concern two trade marks applications made by Lasercare Clinics (Harrogate) Limited, which I will refer to as Lasercare. Each application is for a series of trade marks. Application no 2374039B, applied for on 24 September 2004, is for the two trade marks:

sk:n
SK:N

This application was published for opposition purposes in *The Trade Marks Journal* on 15 July 2005. Application no 2385263B, applied for on 23 February 2005, is for a series of seven trade marks. The trade marks are all the same save for colour and background. Below is a representation of one of the trade marks:

sk:n
skin knowledge network

The application was published for opposition purposes in *The Trade Marks Journal* on 5 August 2005.

2) The Procter & Gamble Company, which I will refer to as Procter & Gamble, filed notices of opposition against the applications. Procter & Gamble is the owner of a United Kingdom and a Community trade mark registration for the trade mark **SK-II**. The specifications of both registrations are the same, namely:

soaps, perfumery, essential oils, cosmetics, hair lotions, preparations for the cleaning, care and beautification of the skin, scalp and hair; antiperspirants and deodorants for personal use.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The United Kingdom trade mark registration, no 2244934, has a filing date of 7 September 2000 and the registration process was completed on 9 March 2001. The Community trade mark registration, no 1569664, has a filing date of 22 March 2000 and the registration procedure was completed on 10 August 2001. The Community trade mark registration enjoys an international priority claim of 26 October 1999 from Switzerland.

3) Procter & Gamble's oppositions are only against the class 3 specifications of the applications. These specifications have been amended since publication, as part of an agreement in relation to other opposition proceedings. The specification now reads:

moisturisers, body creams, firming lotions, cleansing lotions, vitamin-enriched skin creams, aloe-vera enriched skin creams and conditioners, toners; soaps; cosmetics; shaving foams, shaving balms; cosmetic creams; bath salts; body powder; face creams and lotions; face powders; hair preparations; cosmetic washers; preparations for the removal of hair; non-medicated preparations for the care of the skin; none of the aforesaid goods being predominantly scented.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

4) Procter & Gamble claims that the respective trade marks are visually and phonetically similar. It claims that the respective class 3 goods are identical or similar. Consequently, there is a likelihood of confusion and registration of the trade marks in respect of the class 3 goods would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act). Lasercare in its counterstatements denies that there would be a likelihood of confusion, notwithstanding the identity or similarity of the goods. It claims that the respective trade marks are not at all phonetically, visually or conceptually similar; consequently, there is not a likelihood of confusion.

5) Both sides seeks an award of costs.

6) A hearing was held on 25 April 2007. Lasercare was represented by Henry Carr QC, instructed by Hammonds. Procter & Gamble was represented by Thomas Mitcheson, instructed by D Young & Co.

7) Both sides filed evidence in this case. Material exhibited by Procter & Gamble at HF 1, HF 2 and HF 3 either emanates from after the dates of application or has no indication of the date from which it emanates. In evidence for Procter & Gamble furnished by Mr Shivesh Ram a promotion figure for the United Kingdom of £310,000 is given for the year 2004/2005. There is no indication as to when the year 2004/2005 begins and ends; the best that can be said is that it probably overlaps both dates of application. As of 12 May 2006, well after both dates of application, products sold under the SK-II trade mark

were available in 19 retail outlets. A figure is given for the turnover in the United Kingdom for the year 2005 of €2,523,000 for goods bearing the trade mark. There is no indication as to whether this represents retail or wholesale price; whichever it is, the year 2005 is after the date of application of no 2374039B and, for the most part, after the date of application of no 2385263B. Looking through the various advertorials that have been exhibited it can be seen that products sold under the SK-II are expensive. The cheapest product for sale, at £9, is a facial treatment mask, other products are for sale at £32, £40, £45, £50, £55, £60, £65, £80, £90, £120, £135, £140, £165 and £180. A lot of the statement of Mr Ram relates to the time that he was signing his statement, 12 May 2006, rather than the dates of application.

8) Mr Ram at HF 4 has exhibited material relating to the promotion of goods sold under the trade mark. Some of this material emanates after the dates of application or is without clear provenance as to the date. Some of the evidence bears the name of a month but no year. Two pieces of the evidence of use are from abroad – the United States and France. I have listed below all the exhibits from HF 4 that emanate from within the United Kingdom and before the later of the application dates. The underlining indicates material that emanates from after the first application date; all the other material emanates from before this date and so is pertinent to both applications:

Hello – 8 February 2005 – SK-II Facial Treatment Repair C - £80.

Guardian Weekend magazine of 22 January 2005 – SK-II Body Designer - £40.

heat – 12 – 18 February 2005 – SK-II Body Designer - £40.

New – 31 January 2005 – SK-II Body Designer - £40.

Guardian Weekend magazine of 29 January 2005 – SK-II facial treatment essence - £50.

Guardian Weekend magazine of 12 February 2005 – “Going up” – SK-II facial.

Sunday Express magazine of 15 August 2004 – SK-II Body Designer - £40.

Daily Express – 5 August 2004 – SK-II Body Designer.

Daily Star – 18 August 2004 – article about the actress Cate Blanchett referring to her being “the face of skin care products SK-II”.

Daily Post – 17 August 2004 – SK-II Body Designer - £40.

Wedding Day – October/November 2004 – SK-II Body Designer - £40.

Harpers – September 2004 – SK-II Body Designer - £65.

Wallpaper – September 2004 – SK-II Body Designer - £40.

Star – 28 June 2004 – SK-II “Sai-Chohwa” facial treatment at Harrods - £90.

Vogue – June 2004 - SK-II “Sai-Chohwa” facial treatment at Harrods - £90.

Daily Mail – 13 May 2004 – SK-II Airtouch spray on foundation - £150.

Daily Mail – 1 January 2004 – SK-II skin refining treatment - £60.

Daily Telegraph Magazine – 17 January 2004 – SK-II facial treatment concentrate - £180.

Centurion (American Express magazine) – November 2003 – SK-II Airtouch foundation – available at Harrods.

Brides – November/December 2003 – SK-II Air Touch foundation – ioniser - £110, foundation cartridges £40 for two.

She – November 2003 – SK-II Air-Touch foundation - £110.

ES (Evening Standard magazine) – 3 October 2003 - SK-II Air Touch foundation – ioniser - £110, foundation cartridges £40 for two.

Cosmopolitan – November 2003 – SK-II Air Touch foundation - £110.

Glamour – June 2004 – SK-II Whitening Source - £65.

She – June 2004 – SK-II facial treatment masks - £45.

Harpers & Queen – February 2004 – SK-II facial treatment concentrate - £180.

Daily Mail – 22 March 2004 – SK-II Ultimate Serenity Facial treatment - £90 – available at Spa SPC, Harrods and Selfridges in Manchester.

Bliss for Brides – April/May 2004 – SK-II facial lift emulsion - £75.

Metro – 25 March 2004 - SK-II Air Touch foundation – ioniser - £110, cartridges £40 for two- available from Harrods and Selfridges.

Harpers – April 2004 - SK-II facial lift emulsion - £75.

The Sunday Review of The Independent on Sunday – 28 March 2004 - SK-II Air Touch foundation- £110, cartridges £20 per month.

She – April 2004 – SK-II Air Touch - £150.

OK – 13 January 2004 – SK-II advanced protect essence UV - £50.

Daily Express – 7 February 2004 – an interview with Jenni Falconer, a television presenter, who refers to using SK-II facial treatment cleanser.

Hello – 6 January 2004 – SK-II eye treatment film - £45.

Glamour – March 2004 – SK-II facial treatment concentrate - £180.

Daily Express – 1 January 2004 – SK-II facial treatment massage cream - £60.

Harpers Spa Guide – January 2004 – Spa SPC – SK-II Ultimate Serenity Facial treatment.

for the Bride – January/February 2004 – SK-II facial treatment masks -£40 for six.

Telegraph Magazine – 15 November 2003 – SK-II Airtouch foundation – ioniser - £110, cartridges £40 for two.

Now – 5 November 2003 – SK-II skin refining treatment £60.

ES (Evening Standard magazine) – 14 November 2003 – SK-II facial treatment concentrate - £180 at Harrods.

Metro – 20 November 2003 – SK-II facial treatment concentrate - £180 at selected department stores.

She – November 2003 – SK-II Air Touch Foundation - £110.

Sunday Express – 30 November 2003 - SK-II facial treatment concentrate - £180.

Cosmopolitan Hair & Beauty – November/December 2003 – SK-II Signs Treatment - £90.

Glamour – October 2003 – SK-II Air Touch foundation - £150.

Elle – October 2003 – SK-II Air Touch foundation - £150.

Cosmetics International – 12 September 2003 – article about the launch of SK-II Air Touch foundation in the United Kingdom — trade publication.

vogue.co.uk web site – 24 June 2003 – “...put on an SK2 hydrating mask..”.

Harpers & Queen – July 2003 – “SK-II’s kit, £59, has skincare covered and includes two face-masks”.

Tatler – October 2002 – SK-II foaming massage cloths - £29.

New Woman – October 2002 – SK-II Signs Treatment - £120.

Prime Time – January 2003 – SK-II Signs Treatment anti-aging cream - £90.

Shape – May 2003 – SK-II Signs Susumi facial treatment.

Birmingham Post – 29 January 2003 – “Spotlight on SKII” – Purification massage cloths - £32, facial treatment cleanser - £32, Pitera soak facial treatment essence - £50, Signs Treatment - £90, facial treatment mask - £9, treatment film - £45.

you and your wedding – November – December 2002 – SK-II facial treatment masks - £40 for six.

Daily Telegraph Weekend – 12 October 2002 – “Stoke Park Club and SKII” – SKII Ultimate Serenity facial - £70, facial treatment essence - £50, Advanced Protect Essence –UV - £45.

South Bucks Express – 12 September 2002 – article about Spa SPC and its use of SK-II products.

The Scotsman – The Weekend – 14 September 2002 –SK-II facial treatment repair - £75 – available at Frasers, Glasgow and Jenners, Edinburgh.

Daily Express – 5 July 2003 – SK-II summer introductory kit - £59.

The Independent Review – 10 July 2003 – SK-II facial treatment masks - £9 each or £45 for six.

Glamour – February 2003 – SK-II Signs Treatment concentrate - £120.

Centurion (American Express magazine) – December 2002 - SK-II Signs Treatment concentrate – available at Harrods.

Eve – April 2003 – SK-II deep whitening, clarifying radiance emulsion - £50.

Daily Telegraph – 22 February 2003 – an article on the SK-II Ultimate Serenity facial and SK-II products.

M – The Sunday Mirror Magazine – 23 March 2003 - SK-II Facial Treatment Essence – from £50, SK-II Advanced Protect Essence UV - £45.

Hello – 11 February 2003 – SK-II Advanced Protect Essence UV - £45.

Telegraph Magazine – 11 January 2003 – SK-II Signs Treatment Concentrate - £120.

Harpers & Queen – February 2003 – SK-II products.

Guardian – 15 September 2000 – piece about the introduction into the United Kingdom of SK-II products – facial foaming cloths - £29, facial treatment essence - £45, moisturising fluid - £40, skin refining cream - £53, facial masks -£40 for six.

Daily Mail – 17 April 2003 - SK-II deep moisture facial - £25 – available at Harrods and department stores nationwide.

Harpers & Queen – December 2002 – SK-II - £8 for an individual treatment mask, Facial Treatment Essence - £50.

The Independent Magazine – 22 March 2003 – SK-II Signs Treatment Concentrate - £120 from Selfridges, London.

Harpers & Queen – January 2003 – SK-II Facial Treatment Mask - £45 for six, £9 each.

Daily Record – 9 October 2002 -SK-II Limited Edition Pitera Kit - £50 from Frasers, Glasgow.

heat – 26 October – 1 November 2002 – SK-II Eye Treatment Film - £45.

The Information – 12 – 18 October 2002 – SK-II Facial Treatment Massage Cream - £55.

Sunday Herald magazine – 13 October 2002 – SK-II one month Pitera Kit - £50 from House of Fraser, Glasgow.

Metro – 24 October 2002 – SK-II counter and treatment room in Selfridges in Manchester.

A galley proof for an advertisement in *Hello* with a handwritten annotation “Ad In Hello magazine Sept 04”. At the bottom of the proof there are various details, giving the

publication, the proof no, the operator, the job no and the date. The date is given as 26 September 2005. No copy of the advertisement in the actual magazine is exhibited. The advertisement is for a promotion of SK-II products in partnership with Selfridges.

9) Exhibited at HF5 are what are described as examples of promotional activities. The matter exhibited appears to be internal documentation relating to planned promotions and to plans for the promotions. The material that would appear to emanate from before at least the later date of application is as follows:

SK-II Facial Treatment Concentrate – promotion for November and December 2004 with Harrods and Selfridges.

SK-II Air Touch Foundation promotion with *Vogue* for September 2000.

SK-II Facial Treatment Essence – launch advertisement for *Vogue* in September 2000.

SK-II Selfridges promotion for May 2001.

SK-II – four page advertisements in *Vogue*, *Harpers & Queen* and *Glamour*.

SK-II – advertorial for *Vogue* for October 2001.

SK-II – Selfridges in-store promotional activity and single page spread in *OK* magazine for Summer Kit for May 2003.

SK-II advertorial for *Vogue* March 2002.

SK-II advertorial for *Tatler* May 2003.

The material exhibited at HF5 has to be approached with a deal of caution; this is not material actually used but plans for promotions. Despite the extensive press cuttings furnished in HF4, as far as I can see there are no cuttings which correspond with the magazine references above.

10) Lasercare has included lengthy submissions and comments on the evidence of Procter & Gamble in its evidence, this is not evidence of fact. It also has included evidence in relation to its business as a laser and skin treatment specialist. The purpose of the evidence appears to be to show that confusion has not taken place in the market. The relevance of this runs into two hurdles. There is no clear evidence of use of the trade marks of the applications on the goods the subject of the opposition. Ms Gemma Reilly, for Lasercare, states that the trade marks have been used on two products, aloe vera gel and aloe vera sunblock. However, investigations made on behalf of Procter & Gamble were unable to find any use of the trade marks on such products. There is also solid case law that states that absence of confusion is not necessarily telling: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5. Ms Reilly states that the products for which she has claimed that there has been use are not available on the high street and only distributed via Lasercare's clinics, this is an excellent example of why an absence of confusion can, and often is, irrelevant. Ms Reilly states that the pronunciation of the trade marks is "skin" and that this is mandatory in the brand guidelines. I cannot see that this has a bearing on the case as brand guidelines cannot prescribe how average customers will see or say the trade marks.

Reputation of the earlier trade mark

11) Mr Mitcheson submitted that the evidence of Procter & Gamble demonstrates a reputation which enhances the scope of protection of its trade mark. I commented to Mr Mitcheson that there had been no claim to a reputation in the grounds of Procter & Gamble, not so much as a hint of such a claim. Mr Mitcheson did not think that this was of importance as assessment of reputation is part and parcel of the global appreciation that has to be applied in relation to likelihood of confusion. He submitted that if the registrar considers that it is necessary to specify that a reputation has to be claimed in pleadings a practice notice should be issued to this effect. It does not appear to me that a potential claim to a reputation is part and parcel of a claim under section 5(2)(b) of the Act. The pleadings should clearly tell the applicant what the specific nature of the attack is, if a reputation is to be relied upon the applicant should know; it is difficult to see how an applicant can properly decide on its response and the nature of the evidence it should file without a clear statement of the basis of the grounds of opposition. I do not think that this is something that needs to be the subject of a practice notice; notices of opposition should clearly state upon what basis a case is being brought. In *Julian Higgins' Trade Mark Application* [2000] RPC 321 the Vice Chancellor stated:

“If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.”

In *Demon Ale* [2000] RPC 345 Mr Geoffrey Hobbs QC, acting as the appointed person, stated:

“Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in Registry proceedings to provide a focussed statement of the grounds upon which they intend to maintain that the Tribunal should or should not do what it has been asked to do.”

How does one know to what the evidence is addressed if the pleadings do not specify the nature of the case? How does an applicant know the nature of the evidence it should furnish? Evidence can be furnished to specifically question a claim to reputation (an example of this type of evidence was furnished on behalf of A2P International Limited in BL O/300/06). It is a clear fundamental of law that a defendant should know the exact nature of the case which is being made against him/her. The witness statements of those giving evidence for Procter & Gamble do not make it clear that it is being advanced that its trade mark should enjoy enhanced protection as a result of the use made of it in the United Kingdom, despite the submissions that are included in the witness statements of Ms Waller and Ms Thornton–Jackson. (The case being put forward should, of course, be clearly outlined in the pleadings, not implied or indicated in the evidence.) The closest indication that the claim to reputation might be on the table is in the statement of Mr Ram where he writes:

“Thanks to considerable promotional awareness, expansion and success of the SK – II brand in the UK, public recognition of the brand is now extremely high.”

This is an assertion, not a claim to enhanced protection as a result of use; Mr Ram is also writing about the position as of 12 May 2006, well after both dates of application. Mr Mitcheson submitted that no prejudice had been caused to Lasercare; he cannot know that, he cannot know the case that it would have presented if the exact nature of the claim had been spelt out. An opponent should spell out its case, make it clear the exact basis of the claim; the applicant must know exactly what is being claimed; an opponent always has recourse to amendment of pleadings if it wants to add to its case. It is my experience that it is the norm in pleadings in cases before the registrar for a plaintiff to state if it is claiming a reputation in relation to grounds of opposition under section 5(2) of the Act.

12) The claim to reputation was first clearly put on the table in Mr Mitcheson’s skeleton argument, so at a very late stage. I will consider the evidence of Procter & Gamble in relation to a claim to reputation but only because my findings are such that it has no effect upon the case.

13) The evidence of Procter & Gamble is not clearly aimed at the material dates. In particular there are no turnover figures for the period prior to the material dates. Procter & Gamble knows what the material dates are, it has given a turnover figure for 2005 but, does not give figures for earlier periods. It gives the amount for promotion for 2004/2005 and 2005/2006 but not for earlier periods. The turnover given for 2005, and so not aimed at the material dates, is €2,523,000; there are no figures for the size of the market but this would seem to be a small amount, especially when taking into account the cost of the goods sold under the trade mark. As of 12 May 2006, well after the material dates, there were 19 retail outlets in the United Kingdom.

14) Mr Mitcheson submitted that there was a continuity of use from Japan to the United Kingdom which acted effectively as a springboard; he referred to articles which noted the origins of the product in Japan. There is nothing to suggest that the average consumer in the United Kingdom would have been aware of the use of Procter & Gamble’s trade mark in Japan. I cannot see that this assists in establishing a reputation in the United Kingdom. The promotion of the trade mark has been made for the most part by way of advertorial, in the vast majority of cases it is one amongst several products, although there are a few articles which are devoted to goods sold under the trade mark. Mr Mitcheson appeared to be submitting that the presence of references to Procter & Gamble’s products in publications was a demonstration that the publication positively wanted to write about the products, being indicative of the fame of the products. As I commented to Mr Mitcheson, advertorials and the like are the result of the promotional activities of undertakings, they are the result of the promotional expenditure of Procter & Gamble. Mr Mitcheson also noted the fact that articles showed various celebrities using the products and that this acted as effective publicity. The European Court of Justice (ECJ) in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97 set out the sort of criteria and evidence that was necessary to establish a reputation:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

There is no indication as to the size of the market for the goods of Procter & Gamble; however, I consider that it is likely to be a very large one. There are a good number of advertorial references to the goods of Procter & Gamble prior to the material dates. However, they compete, for the most part, in the advertorials with other products. There is nothing to tell what effect the advertorials have; owing to the cost of the products and the limited distribution, the references could easily be dismissed from the mind of the reader. There is absence of evidence of conventional stand-alone advertising or advertising in non-print media. At the material dates there is no indication of the turnover for Procter & Gamble’s products, the figure for 2005 does not appear large, the goods are sold in only a limited number of retail outlets. Expensive products with a limited number of customers can enjoy a reputation, this is the case for instance for some cars, clothes and watches. However, the establishment of such reputations would be a matter of fact based on evidence ie survey evidence. From the evidence before me I do not consider that Procter & Gamble has established a reputation that would potentially enhance the protection of its trade mark.

15) Reputation cannot of itself give rise to a likelihood of confusion, as per *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723¹. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 the ECJ held that reputation can be a factor in the global appreciation of a likelihood of confusion where the respective goods/services, although similar, are not very similar². There was no dispute at the

¹ “41. The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

² “24. In the light of the foregoing, the answer to be given to the first part of the question must be that, on a proper construction of Article 4(1)(b) of the Directive, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity

hearing that the respective goods are identical or highly similar, so reputation cannot assist Procter & Gamble as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* In *Sabel BV v Puma AG* [1998] RPC 199 the ECJ held that the distinctiveness of an earlier trade mark has to be taken into account in the global appreciation, that distinctiveness could be inherent **or** as a result of reputation; reputation can come into play when the earlier mark is not highly distinctive³. If Procter & Gamble's earlier trade mark is highly distinctive, as Mr Mitcheson claims, then reputation is not going to assist it as per *Sabel BV v Puma AG*.

16) So Mr Mitcheson's claim to reputation for Procter & Gamble runs into three hurdles:

1. It was not pleaded.
2. It is not made out.
3. If the earlier trade mark is highly distinctive, as claimed, it would not assist Procter & Gamble.

Likelihood of confusion – section 5(2)(b) of the Act

The Law

17) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

18) The trade marks of Procter & Gamble are earlier trade marks as per the Act.

19) In determining the question under section 5(2)(b), I take into account the guidance provided by the ECJ in *Sabel BV v Puma AG*, *Canon Kabushiki Kaisha v Metro-*

between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.”

³ “64. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public”.

Goldwyn-Mayer Inc, Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV [2000] FSR 77 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P.*

Average consumer and nature of purchasing decision

20) The goods of Procter & Gamble are expensive but in considering the issue of the average consumer I have to consider notional and fair use in relation to all of the goods of the earlier registrations and the applications. The respective goods are everyday goods, they are goods that could be very cheap and bought without a great deal of consideration; they might be sold in a prestige department store or from a market stall. I consider that the public at large is the average consumer. The goods could well be bought with little care and consideration, although I take into account that the average consumer “is deemed to be reasonably well informed and reasonably circumspect and observant⁴”. They are goods that could be bought in a supermarket dash; they are not goods by their nature which require a careful and educated purchasing decision. The degree of attention that is taken in the purchasing will have an effect on the extent that imperfect recollection is relevant; the lesser the attention, the greater the effect of imperfect recollection.

Comparison of goods

21) There is no dispute that the respective goods are either identical or highly similar.

Comparison of the trade marks

22) The trade marks to be compared are:

Procter & Gamble’s trade mark:

SK II

Lasercare’s trade marks:

sk:n
skin knowledge network

sk:n
SK:N

⁴ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*

23) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

24) Mr Mitcheson and Mr Carr both made submissions on the appropriate way to deal with similarity and likelihood of confusion. Mr Carr, relying upon *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM)*, submitted that it was first necessary to decide if the respective trade marks are similar. If it is decided that they are not, then that is an end to the matter, there can be no likelihood of confusion. Mr Carr also referred to one of my decisions in support of this position, BL O/139/05. (In that case the respective trade marks were clearly dissimilar.) In several decisions I have written to the effect that similarities between trade marks should not be conflated with the trade marks being similar. It is a reasonable presumption that there will be similarities between conflicting trade marks, otherwise why would there be an opposition or invalidation action? It is necessary as part of the cumulative process⁵ for trade marks to be similar and, if they are not, there is no question as to likelihood of confusion; part of the essential legal test is failed. Mr Mitcheson referred to the decision of Mr Geoffrey Hobbs QC where he held that section 5(2) of the Act raises a single composite question⁶. If it is decided that the respective trade marks are not similar one

⁵ In relation to the equivalent of section 5(2) of the Act the CFI has referred to the cumulative approach in *Alecansan, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-202/03 and *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 353/04. In the former case the CFI stated: “35 However, a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services referred to in the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (*Canon*, paragraph 22, concerning the provisions of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), and Case C-106/03 P *Vedial v OHIM* [2004] ECR I-9573, paragraph 51, concerning Article 8(1)(b) of Regulation No 40/94). Thus, even where the sign applied for is identical to a mark which is highly distinctive, it must be established that the goods or services covered by the opposing marks are similar (judgment of 1 March 2005 in Case T-169/03 *Sergio Rossi v OHIM– Sissi Rossi (SISSI ROSSI)* [2005] ECR II-0000, paragraph 53; see also, by analogy, *Canon*, paragraph 22).” In relation to section 5(3) of the Act the CFI has referred to the cumulative approach in *Sigla SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 215/03 and *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-67/04.

⁶ *Raleigh International Trade Mark* [2001] RPC 202.

cannot consider that single composite question, or make the global appreciation that the ECJ requires. So it could be better to consider the effects of the similarities and differences between the trade marks when undertaking the global appreciation, where the trade marks are not clearly dissimilar. The similarity of trade marks in the cumulative process is still being considered but in the context of all the facts of the case. If the trade marks are clearly dissimilar then it is clear that one of the requirements of the cumulative process is absent and so there can be no likelihood of confusion and so a global appreciation is both redundant and irrelevant. Two of the appointed persons have made it clear that they favour an approach that goes forward to a global appreciation where the trade marks are not clearly dissimilar⁷. A number of cases from the European courts leave the matter to simply a decision as similarity rather than clear dissimilarity⁸. However, in at least one case the CFI adopts a position similar to that of the appointed persons⁹.

25) Mr Mitcheson submitted that there is a threshold to be reached to establish some level of similarity but that that it is a very low one. There is a danger in that approach, it might end up conflating having similarities with being similar. There are conflicting judgments in the High Court as to whether there is even a threshold in relation to either conflicting signs or goods. (The threshold will or will not apply equally to similarity of goods/services as well as similarity of trade marks.) The Chancellor in *Hachette Filipacchi Press SA v S Aprotex International (Proprietary) Limited* [2007] EWHC 63 (Ch)¹⁰ and Patten J in *Sihra's Trade Mark Application* [2003] RPC 44¹¹ considered that there is a threshold. Lewison J in *L'Oreal SA and others v Bellure NV and others* [2007]

⁷ Geoffrey Hobbs QC in BL O/197/06 and Richard Arnold QC in BL O/020/07.

⁸ Eg *Bitburger Brauerei Th. Simon GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Cases T-350/04 to T-352/04: "136 That article requires inter alia that the mark applied for and the earlier mark be identical or similar. Since it has been concluded that the marks applied for and the earlier German marks Nos 505 912 and 39 615 324 (BIT), and Nos 704 211 and 1 113 784 (Bitte ein Bit!) were not identical or similar, Article 8(5) of Regulation No 40/94 cannot provide a basis for the opposition by Bitburger Brauerei in the present case."

⁹ *Soffass SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-396/04: "39 Where the marks are not clearly dissimilar, but have a number of similar factors together with certain components capable of distinguishing them, the assessment of the respective importance of those components must not be carried out in isolation, but in an overall assessment of the likelihood of confusion, taking account of all the relevant factors (see paragraph 29 above)."

¹⁰ "40 Counsel for HFP contends that the Hearing Officer was wrong to describe the first issue as a threshold test. He suggested that the attribution of that description to Patten J in **Intel Corporation v Sihra** [2004] ETMR 4 was wrong because it was the editors of Kerly 14th Ed who were responsible for that heresy, see para 9-056. I do not accept any of these submissions. In paragraph 12 of his judgment Patten J did refer to the test of similarity as being a threshold test. I see nothing wrong in that description. It is common ground that both tests must be satisfied. In the absence of a sufficient degree of similarity the issue of likelihood of confusion cannot arise. In the case of sequential issues such as those the first may be described as the threshold to be crossed before consideration of the second."

¹¹ "12. It is clear that the flexibility inherent in this global approach leaves intact the threshold requirement for a recognisable degree of similarity between the goods and services in question. The distinctiveness and strength of the earlier mark may lessen the degree of similarity required, but it does not eliminate it. The remedy for the proprietor of a distinctive mark which is challenged in respect of non-similar goods is to oppose registration under s.5(3)."

ETMR 1¹² did not consider that there is a minimum threshold. If the concept of a minimum threshold is applicable, Mr Carr did not consider that it had been reached in this case.

26) The approach that I intend to adopt in this case is to analyse the similarities, the dissimilarities and differences between the respective trade marks and then consider, in the global appreciation, whether there will be a likelihood of confusion. The effects of the similarities, dissimilarities and differences in the marks can then be considered within the context of all that has to be considered in relation to the global appreciation. (I accept that this has the danger of being an a posteriori analysis rather than an a priori analysis, which the cumulative approach appears to demand. However, it is difficult to see another methodology that would satisfy the findings of the appointed persons to which I have previously referred.) In this way I will still be deciding if the trade marks are similar or similar enough for Procter & Gamble to succeed and so satisfy one of two essential requirements for likelihood of confusion.

27) How will Procter & Gamble's trade mark be seen? At the hearing Mr Mitcheson referred to it as SK2, the vogue.co.uk web site on 24 June 2003 actually said "put on an SK2 hydrating mask". I have little doubt that some will perceive the trade mark in the way that Mr Mitcheson referred to it. However, I consider that some will perceive the mark more simply as SK eleven. I do not consider that anything turns upon some seeing the trade mark of Procter & Gamble as SK2 and some as SK eleven, although both potential perceptions have to be taken into account. Nevertheless, I cannot see that Procter & Gamble's case can be any better in relation to the latter perception than to the former, so I will deal with the trade mark simply as being perceived as SK2.

28) There is no evidence to suggest that SK or II either separately or in combination have any meaning in relation to the goods of the registrations or any consequent conceptual association. If there were a range of SK trade marks that were followed by different numerals to differentiate between them, and the public were aware of this, then II might be seen as simply acting as a qualifier of the SK element of the trade mark, and so subservient to it. However, this is not the case. The consumer is presented with two capitals letters without meaning and a numeral. They are equal in terms of size. The numeral comes after the letters but I am unconvinced that the order of itself sets up a clear division in terms of distinctiveness and dominance. In the abstract, two apparently random letters are more likely to have an effect upon the recollection than a numeral when used in relation to a trade mark. Consequently, I am of the view that SK is more dominant and distinctive than II, however, I do not consider the numeric element is submerged in the entirety of the trade mark.

29) The element in all three types of trade mark of Lasercare that jumps out at me is the letters SKN or skn. I consider that in terms of recollection or identification that there is little real difference between the letters in upper or lower case, none of the letters appear stylised. The colon appears in an odd place, for a colon, however, this oddity does not of

¹²"Accordingly, in my judgment, there is no minimum threshold of the kind for which Mr Wyand contended. It is a question of degree in every case."

itself make the colon the distinctive and dominant element. In certain of the trade marks the words “skin knowledge network” appear, in terms of position and size these are subservient to the rest of the trade marks; these words are also quite likely to be seen as a descriptor rather than as being of trade mark significance. I consider that the distinctive and dominant element of all of the trade marks of Lasercare is the letters skn, whether in upper or lower case.

30) The common element of the trade marks is that they begin with the letters SK, there is effective visual identity in relation to these letters. If the letters are spoken there is phonetic identity. The other elements of the trade marks are all different.

31) There is no conceptual association with the trade mark of Procter & Gamble. Taking into account the nature of the goods, the trade marks of Lasercare have an evocative effect¹³. The average consumer, in my view, will perceive the trade marks of Lasercare as clearly referring to the word skin, the colon will become a substitute for the missed letter which the consumer will be expecting. (This is certainly the effect of the trade marks upon me.) It is necessary to bear in mind that this is a matter of perception and not simple sight, it is a matter of how the average consumer will interpret and so perceive the message of the visual stimuli, not how the optic nerve of the average consumer will react to the stimulus of the trade marks. The CFI has held on a number of occasions that any conceptual meaning must be clear and obvious to have an effect in the comparison of trade marks¹⁴. I consider that in the context of the goods that the trade marks of Lasercare will have the clear evocation, and consequent conceptual association, of the word skin. Consequently, the respective trade marks are conceptually different.

¹³ In *Ontex NV v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 353/04 the CFI stated “90 Second, it should be noted that the earlier mark, although it does not correspond as such to any word in the relevant European languages, has a certain ‘evocative force’ in that it is very close to the words ‘euro’ and ‘Europe’, words particularly well known and easily recognisable in all of the languages examined, generally used to refer to Europe or the European Union, or as regards ‘euro’, also to the single currency (see, as regards the evocative force, *MUNDICOR*, cited in paragraph 38 above, paragraphs 89 and 90, and, as regards the word ‘euro’, Case T-359/99 *DKV v OHIM (EuroHealth)* [2001] ECR II-1645, paragraph 26, and Case T-34/00 *Eurocool Logistik v OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 48). Consumers will be aware of the evocative effect of the earlier mark without undertaking a conceptual analysis of it, but simply by focussing their attention instinctively on the recognisable element of the word mark EURON, that is to say, the term ‘euro’ (see, to that effect, Case T-186/02 *BMI Bertollo v OHIM – Diesel (DIESELIT)* [2004] ECR II-1887, paragraph 57).

91 This evocative effect is independent of whether or not the word mark EURON designates a characteristic of the goods for which registration of the earlier mark was made, since that fact does not influence the ability of the relevant public to make an association between that word mark and the words ‘euro’ and ‘Europe’ (see, by way of analogy, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54). In the same way, the evocative force of the earlier mark cannot be altered by the fact that it is supposedly ‘made up’. Even a made-up word may carry conceptual weight.”

¹⁴ See for instance *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04.

Conclusion

32) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are either identical or highly similar. As Mr Mitcheson submitted, a cigarette paper cannot be slid between them.

33) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). 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] ETMR 585). SK-II has no meaning, it has no allusion to the goods, it is an arbitrary and invented sign; I consider that it enjoys a good deal of inherent distinctiveness. (I have decided that it cannot benefit from any claim to reputation.)

34) The nature of the average consumer will have to be taken into account and the consequent purchasing process. I have decided that the average consumer is the public at large and that, taking into account notional and fair use in respect of all the respective goods, there will not be a particularly careful and educated purchasing decision. The nature of the purchasing decision means that imperfect recollection is likely to have a greater force than it would for goods that are purchased after a careful and educated purchasing decision.

35) It is necessary to take into account how the goods are likely to be purchased. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the CFI stated:

“49 However, it should be noted that in the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (*BUDMEN*, paragraph 57). The extent of the similarity or difference between the signs may depend, in particular, on the inherent qualities of the signs or the conditions under which the goods or services covered by the opposing signs are marketed. If the goods covered by the mark in question are usually sold in self-service stores where

consumer choose the product themselves and must therefore rely primarily on the image of the trade mark applied to the product, the visual similarity between the signs will as a general rule be more important. If on the other hand the product covered is primarily sold orally, greater weight will usually be attributed to any aural similarity between the signs.”

36) In my experience the goods of the registrations and the applications are sold in environments where the consumer will primarily rely upon the image of the trade mark applied to the product.

37) The public is used to distinguishing between short trade marks by limited differences, that is how relatively close acronyms can effectively distinguish between different goods.

38) The effect of conceptual dissimilarity has been stated by the CFI on a number of occasions. The fountain from which these pronouncements flow is *Phillips-Van Heusen Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-292/01 [2004] ETMR 60:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

39) Having taking into account all the above factors, I consider that bearing in mind the conceptual dissimilarity between the trade marks, arising from the evocative effect, the visual and phonetic differences between the trade marks, that the similarities that exist are not sufficient to give rise to a likelihood of confusion. In making such an analysis I bear in mind the distinctive and dominant elements of the respective trade marks.

40) The grounds of opposition are dismissed.

Costs

41) This is a straight forward section 5(2)(b) case. It is difficult to see why the sides felt compelled to file evidence. In the case of Procter & Gamble there was no clearly pleaded reason as to why its first round of evidence was filed. At least part of Procter & Gamble's evidence in reply did respond directly to the evidence of Lasercare. However, the evidence of Lasercare was without any purpose at all; it established nothing within the context of this case. Owing to the nature of Lasercare's evidence I do not intend awarding any costs in relation to the filing of it.

42) Lasercare having been successful it is entitled to a contribution towards its costs. I award costs upon the following basis:

Considering notice of opposition:	£200
Statement of case in reply:	£300
Considering evidence of Procter & Gamble:	£500
Preparation and attendance at hearing:	£1,000
Total:	£2,000

These costs are the combined costs for the two consolidated cases. Owing to the nature of the two statements of case in reply and the two notices of opposition, I do not consider it appropriate to award costs twice in respect of these items.

43) I order The Procter & Gamble Company to pay Lasercare Clinics (Harrogate) Limited the sum of £2,000. 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 11th day of May 2007

**David Landau
For the Registrar
the Comptroller-General**