

O-333-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2377015  
IN THE NAME OF SIMON GROGAN  
TO REGISTER THE TRADE MARK SK.4 IN CLASSES 3 AND 8**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 93633 IN THE NAME OF  
THE PROCTER AND GAMBLE COMPANY**

**Trade Marks Act 1994**

**IN THE MATTER OF Trade Mark Application No. 2377015  
in the name of Simon Grogan  
to register the trade mark SK.4 in Classes 3 and 8**

**And**

**IN THE MATTER OF opposition thereto  
under No. 93633 in the name of The Procter and Gamble Company  
BACKGROUND**

1. On 30 October 2004, Simon Grogan made an application to register a trade mark in Classes 3 and 8. The application was the subject of an amendment after publication, which resulted in a revision of the goods to the following specifications:

Class 03      Body and facial gels and serums for use with electrical beauty machines for beauty treatments in a place of business involving a qualified beauty therapist

Class 08      Electrical machines for beauty treatments (hand operated) including the use of ultrasound, micro-current and galvanic current, all for use in a place of business involving a qualified beauty therapist

The mark as applied for looks as follows:



2. On 29 July 2005, The Procter and Gamble Company filed notice of opposition to the application, the ground of opposition being as follows:

**Under Section 5(2)(b)** because the mark applied for is similar to the opponents' earlier marks, and is sought to be registered in respect of goods that are identical or similar to those for which this earlier marks are registered, such that there exists a likelihood of confusion.

Details of the earlier marks relied upon by the opponents in these proceedings can be found as an annex to this decision.

3. The applicant filed counterstatements in which he denies the ground on which the opposition is based.
4. Both sides ask that an award of costs be made in their favour.
5. Only the opponents filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, instead electing to file written submissions in lieu. After a careful study of the evidence and submissions, I now go on to give my decision.

#### **Opponents' evidence**

6. This consists of a Witness Statement dated 29 March 2006, from Shivesh Ram, General Manager of Procter and Gamble for the SK-II brand.

7. Mr Ram states that The Procter & Gamble Company launched the SK-II brand in Japan in 1980, with products under this name becoming available in the UK in 2000. Exhibit HF1 consists of a collection of prints taken from the SK2.co.uk website that show the range of products available under the brand. Exhibit HF2 consists of a collection of photographs of SK-II branded products. These Exhibits show SK-II to be used in relation to a range of facial, eye and skin treatment products. The prints were taken on 23 March 2006, after the relevant date, and the photographs are undated. This being the case, there is nothing that establishes when these products first became available for sale. However, the use of a UK telephone number for enquiries is a reasonable indication that at least some of the products were available in the UK.

8. Mr Ram says that the products are made available to the public via various sources including department stores, estimating that there are currently 19 retail outlets throughout the UK selling SK-II products. Mr Ram lists his company's current "large retail partners", which include The House of Fraser, Selfridges, Bental's, Fenwicks, Jenners, Harrods and John Lewis. Mr Ram provides copies of invoices issued to the retail clients as Exhibit HF-3. These invoices date from 28 December 2005 to 16 January 2006, well after the relevant date. Additionally, none actually show that they relate to SK-II branded goods.

9. Mr Ram says that since the launch his company has spent in excess of £310,000 for the year 2004-2005 and £255,000 for the year 2005-2006 promoting the brand, in particular by means of print advertising, Exhibit HF-4 consisting of examples. The earliest consists of a news item that appeared in the Metro Free Paper, which refers to the Japanese skincare range

SK-II opening its first in-store treatment room in London. Later examples rolling up to the relevant date show the name being used in relation to a range of facial, eye and skin treatment products. Mr Ram says that the brand has continued to enjoy substantial success in the UK, with an annual turnover for the range in 2005 (after the relevant date) in excess of 2,523,000 Euros. He says that through his company's promotional activities the brand has achieved an extremely high level of public recognition. In support of this contention, Mr Ram refers to Exhibit HF 5, which consists of a pack that, *inter alia*, refers to the promotion of SK-II products in some of the department stores mentioned earlier, and in various high-end publications. One part of the pack shows it to originate from 2001.

10. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

## **DECISION**

11. The opposition is founded on Section 5(2)(b). That section reads as follows:

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

(a) .....

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

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

12. An earlier trade mark is defined in Section 6 of the Act as follows:

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

(a) 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.”

13. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *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] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) 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*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (i) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

14. The opponents rely on two earlier trade mark registrations, neither of which achieved registration more than five years prior to 20 May 2005, the date on which the application in suit was published. This being the case, the provisions of Section 47(2)(A) introduced under The Trade Marks (Proof of Use, etc.) Regulations 2004 do not apply.

15. In any analysis it is inevitable that reference will be made to the elements of a mark, and particularly so where these are separated or made distinct in some way. However, it must be remembered that the consumer does not embark on a forensic analysis of trade marks and it is the marks as a whole that must be compared.

16. Both of the opponents' earlier marks consist of the letters SK in a plain upper case font, followed by a hyphen and the letters II, all in upper case. The mark applied for also consists of the letters SK in plain block capitals, but in their case followed by a full stop and the numeral 4.

17. Self evidently there is visual identity in the letters SK. Being at the beginning of what are very short trade marks gives them an enhanced significance and impact. In the opponents' marks these letters are followed by a hyphen whereas in the case of the applicants' mark this element is a period point, or full stop. Whilst this contributes to some degree of visual distinction, both serve as a separator of what I determine to be elements that have a stronger impact on the eye. Being placed as they are in the body of the marks, these symbols are somewhat subsumed in the overall visual impression of the marks as a whole. The final element of the respective marks consists of a numeral 4 and the letters II. If separated and compared side-by-side these elements are very different in appearance, but marks are rarely compared in this way, the consumer instead using an imperfect picture retained in their mind. I am conscious that in short textual marks small differences can have a greater impact than in longer trade marks. However, when added to the end of other elements and compared by their contributing impact in the entirety of the marks, I come to the view that their individual differences are diluted to the extent that I would say the respective marks are visually similar.

18. Similar considerations apply when considering the marks in an aural sense. Being the beginning of short trade marks that are composed of clear and different elements gives the letters SK a greater impact on the sound, and I have no doubt that they will be seen and enunciated as the letters. Whereas the "hyphen" in the opponents' mark, and the full-stop in the applicants' mark may have some degree of visual impact, this will not be the case when the marks are referred to in speech. These are typographical symbols separating two distinct and different elements. Other than perhaps in dictation, typographical symbols would not be spoken; a consumer would not say "S" "K" "hyphen", or "S" "K" "full-stop". The final element of the respective marks consists of a numeral 4 and the letters II. As separate elements I do not consider that there can be any doubt that they will sound quite different, but I again return to my conclusion that given their relative positioning in the marks, and the tendency to place less emphasis on the termination of words, when the marks are spoken as a whole, the sound of the first element SK will dominate that of the ending. These are marks that have aural similarity.

19. Looking at the conceptual message, if any, that the respective marks will send out, it is clear that both will be seen essentially as letter marks so to that extent the message will be the same. If the typographical symbols say anything, it will, in my view be the same or similar; they are separators. Perhaps if there is any distinction in the idea that the respective marks are likely to create in the minds of the consumer, it is that one mark contains a numeral whereas the others contain two letters. That said, letters are also roman numerals and commonly used in this way. So whilst it may well be that to some "II" will be seen as two letters "I", others will see it as a numeral, albeit denoting the number "2". To my mind there

is a strong case in favour of finding the respective marks to be conceptually similar.

20. As I have already said, the insertion of the typographical symbols between the letters “SK” and the “4” and “II” create marks that are composed of two separate elements. Two letter marks are generally considered to be distinctive unless there is a specific reason to believe that the particular letters will not be taken by the average consumer as a trade mark. There is no evidence that the letters SK have any relevance, descriptive or otherwise, for any of the respective goods, or that they are used as some form of codification. As such I would say that they form a distinctive element of the trade marks. A single numeral with little, or in this case no stylisation will be deemed to be devoid of distinctive character because numbers are used in trade to designate a characteristic of many goods. I do not know whether the numeral 4 designates any particular characteristic of the goods for which it is registered; I have no evidence one way or the other. The position is the same in respect of the letters (or numeral) “II”. I therefore come to the position that the letters SK are distinctive, but that the element that appears after the typographical matter may, or may not be distinctive in relation to the goods. Whatever is the case, I take the view that the letters SK are the dominant feature. Even if the distinctiveness of the respective marks rested in their whole, the letters SK would still be the dominant component because they are the most prominent by virtue of their positioning.

21. The opponents say that they launched their SK-II products in the UK in the year 2000, a claim that has not been challenged. Sales are said to have been made through various outlets, Mr Ram stating that there currently 19 throughout the UK selling SK-II products. Details of “large retail partners” are given and include The House of Fraser, Selfridges, Bental, Fenwicks, Jenners, Harrods and John Lewis, but there is no evidence that says when these stores started selling SK-II branded goods. Turnover figures have only been given for 2005, and although quite substantial, this is after the relevant date. The evidence showing the mark in use is thin to say the least and much of what there is does little to assist in establishing use in the UK at a given time. Exhibit HF 5 consists of a pack that refers to the promotion of SK-II products in a number of the department stores previously mentioned, and also in various high-end publications, in one part showing this to date from 2001. Advertising features found in Exhibit HF4 show use of SK-II from October 2002 up to and beyond the relevant date, in relation to a range of facial, eye and skin treatment products. The figures given for the amount spent promoting the brand are significant, but it is not possible to tell how much relates to the period prior to the relevant date. I am therefore able to say what the mark has been used for and when the use started, from which I feel able to say that the opponents are likely to have built a reputation. However, as I am not able to determine the extent of sales and promotion from prior to the relevant date, it is not possible to gauge the impact any reputation, or say that the use had enhanced the distinctive character of the SK-II brand by the time that the application was filed.

22. Turning to the question of the similarity (or otherwise) of the goods of the opponents’ earlier marks and those for which the applicant seeks registration. I am required to determine the matter on the basis of the “notional” range of goods covered by the respective specifications. The opponents’ earlier marks cover the following goods in Class 3:

“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.”

23. The application also covers goods in Class 3, namely “body and facial gels and serums” that have been qualified as being “for use with electrical beauty machines for beauty treatments in a place of business involving a qualified beauty therapist.” The specifications of the opponents’ earlier marks are not limited in any way, so if they cover goods that are the same or similar to “body and facial gels and serums”, they will notionally cover such goods for all purposes, including those that are for the same use as specified in the application.

24. The descriptions “gels and serums describe the physical nature of the goods, the terms “body and “facial” denoting the parts of the body to which such gels and serums are applied. To my mind the descriptions “cosmetics” and “preparations for the cleaning, care and beautification of the skin” encompass goods of this nature that may be applied to all parts of the body. This would include those that are used with electrical beauty machines, for beauty treatments, in a place of business involving a qualified beauty therapist. The article that appeared in the Metro Free Paper (Exhibit H-4) refers to the Japanese skincare range SK-II opening its first in-store treatment room in London. To my mind this shows that whilst the overlap in the goods may be a notional consideration, there is evidence that establishes that the goods are actually used in the same business environment.

25. Turning to the goods covered by Class 8 of the application. I propose to determine the question of similarity by adopting the guidelines formulated by Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 (pages 296, 297), and the *Canon* judgement. The criteria in *Treat* clearly indicates that consideration should be given to the nature of the goods, and the circumstances of the trade. Evidence from or relating to the manner in which the market in the respective goods is conducted can be of considerable help in determining whether goods should be considered similar. This does not, however, mean that absent such evidence the registrar cannot make a judgment based upon his knowledge of the types of goods that fall within the class(es) in which the respective goods have been applied for or registered (as required by *Altecnic’s* application [2002] RPC 34). The notional extent of the specifications is based upon what is the usual and ordinary meaning of the descriptions.

26. The respective goods may notionally be used in beautification treatments and applied by beauticians, but are very different in their physical nature. The opponents’ earlier marks cover substances that are applied in the treatment, whereas the application is in respect of an apparatus. I have no evidence that substances and apparatus for use in beauty treatment pass through the same trade channels. It would not seem unreasonable to infer that by seeking registration in respect of both types of goods, the applicant is typical of a trade that manufactures both the apparatus and the substances. I also do not see any reason why a beauty parlour would not use both substances and apparatus in their treatments. That the applicant’s goods are for use in a business environment suggests that these are not goods bought in the high street. That said, the opponents’ goods are not limited in a way that excludes them from also being for use by beauticians as part of their business. I see no reason why the respective goods should not be considered complementary; the opponents’ substances may be used as part of the applicants’ mechanical treatment. They may also be used as an alternative. I have no evidence as to how the relevant trade classifies such goods, or whether they consider them to be in the same market sector. They are capable of being used in the same market sector at the retail end.



27. I come to the view that there is a marked degree of overlap in the “notional” trade circumstances between the goods covered by Class 8 of the application, and those covered by the opponents’ earlier marks, and I find these to also be the same or similar.

28. The goods covered by the applicants’ specifications are limited to those for use in a place of business by a qualified beauty therapist, which makes the relevant consumer the beauty therapist rather than the public at large. The opponents’ specifications are not limited in any way, so notionally cover goods for general retail to the public, and also those intended for sale to the professional user, including beauty therapists. It must therefore be the case that the relevant consumers of the respective goods are notionally the same.

29. It seems reasonable to infer that a professional is likely to be better informed and more circumpect and observant than a member of the public at large. This could be taken to mean that the relevant consumer will either be aware that two competing products are being sold under similar marks, or will be better placed and more likely to see the differences in the respective marks. This could swing the balance against a finding of a likelihood of confusion if the question of the similarity of the marks and/or the goods was marginal. That is not the case here; there is a strong similarity in the marks, identity in respect of the goods in Class 3, and reasonable similarity in respect of the goods in Class 8 of the application.

30. Taking a balanced view of all of the factors and adopting the global approach advocated, I come to the view that if the applicant was to use his mark in respect of the goods for which registration is sought, this would cause the relevant public to wrongly believe that the respective goods come from the opponents or an economically linked undertaking. On my assessment there is a likelihood of confusion and the ground under Section 5(2)(b) succeeds.

31. The opposition having been successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicant pay the opponents the sum of £2,150 their costs. This sum 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 9<sup>th</sup> day of November 2007**

**Mike Foley  
for the Registrar  
the Comptroller-General**

## **Case details for Trade Mark 2244934**

Licensee details, where held, are available via Case history

### **Mark**

Mark text: SK-II

### **Status**

Status: Registered

Class: 03

### **Relevant dates**

Filing date: 07 September 2000

Next renewal date: 07 September 2010

Registration date: 09 March 2001

### **Publication in Trade Marks Journal**

First advert:

Journal: 6355

Page: 20517

Publication date: 22 November 2000

Registration:

Journal: 6374

Publication date: 11 April 2001

### **List of goods or services**

Class 03: 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.

### **Names and addresses**

Proprietor: The Procter & Gamble Company  
One Procter & Gamble Plaza, Cincinnati, Ohio - 45201, United States of America  
Incorporated state: Ohio  
Incorporated country: United States of America  
Residence country: United States of America

Agent: D. Young & Co.  
120 Holborn, London  
EC1N 2DY

## **Case details for Community Trade Mark CTM 1569664**

**Mark text: SK-II**

### **Status**

UK case status: Registered  
Original language: English  
Second language: French  
Class: 03

### **Relevant dates**

Filing date: 22 March 2000  
Publication date: 17 September 2001  
Registration date: 10 August 2001

### **Priority claims**

Priority date: 26 October 1999  
Country: Switzerland  
Reference: 09669/1999

### **List of goods or services**

Class 03: 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.

### **Names and addresses**

Applicant: The Procter & Gamble Company  
One Procter & Gamble Plaza  
Cincinnati, Ohio  
United States  
45202

Representative: Deborah Brincat Procter & Gamble France SNC  
96, avenue Charles-de-Gaulle  
Neuilly-sur-Seine  
France, 92201