

O/400/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003414726

BY KIWI SKIN LIMITED TO REGISTER THE FOLLOWING TRADE MARK:

ASKINOLOGY

IN CLASSES 3 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 418356 BY LA COLLINE INTERNATIONAL

EUTM number: EU004740791¹

SKIN · OLOGY

Filing date: 24 November 2005; Date registration completed: 15 December 2006

Relying on its registered goods in class 3:

Anti-aging cosmetic products; beauty masks.

4. The Opponent claims that:

- the marks are similar;
- the respective goods are identical or highly similar;
- the Applicant's services are highly similar to the Opponent's goods;
- leading to a likelihood of confusion under section 5(2)(b).

5. The Applicant filed a defence and counterstatement in which:

- denies that the marks are similar;
- admits 'the third sentence of the Opponent's arguments', i.e. the third sentence for Q5 of the Notice of Opposition and Statement of Grounds, that 'The goods in the Application are either identical or highly similar to those protected in the Opponent's trade mark';
- denies that the Applicant's *services* are similar to, or complementary with, the Opponent's goods;
- requests that the Opponent provides evidence of genuine use of its mark in relation to the goods in respect of which it is registered;
- and denies that there is a likelihood of confusion under section 5(2)(b).

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

6. In first evidence round: the Opponent filed evidence comprising a Witness Statement and Exhibits. In the second evidence round: the Applicant filed written submissions; the Opponent filed evidence in reply in the form of a Witness Statement and Exhibits.
7. Both parties have filed written submissions in lieu of a hearing.
8. The Opponent is represented by Dolleymores; the Applicant is represented by Baron Warren Redfern.

Relevant dates

9. The Opponent's earlier mark had been registered for more than five years on the date on which the contested application was filed. It is, therefore, subject to the proof of use provisions under section 6A of the Act, and the Applicant has requested such proof. The Opponent has made a statement that it has made genuine use of all of the goods for which its mark is registered. The relevant time period for this purpose is the five years prior to and ending on the application date of the applied-for mark: 18 July 2014 to 17 July 2019.

Preliminary issues

10. EUIPO² Cancellation No 33041C (Revocation)

At the time of the filing of the Opposition, the Opponent's mark was subject to cancellation proceedings, the outcome of which had yet to be confirmed³. The mark had initially been registered in respect of the following goods:

Class 3 – Cosmetics; beauty masks; facial peels; facial masks; facial serums.

² European Union Intellectual Property Office

³ This is the reason why the Opponent's earlier goods specification, rather than the later reduced specification, appears on the Opposition and Statement of Grounds.

11. On 20 July 2020, the EUIPO confirmed that the revocation had been partially successful, resulting in the registration subsisting for the following reduced list of goods, as from 18 February 2019:

Class 3 - Anti-aging cosmetic products; beauty masks.

12. The Opponent has exhibited this decision as evidence that it has made genuine use of its mark in relation to the goods noted above at paragraph [11]. However, this Tribunal has not been privy to the body of evidence adduced in the EUIPO cancellation proceedings and must, therefore, base its assessment of whether genuine use has been proven only on the relevant evidence adduced in the instant proceedings. Consequently, I am unable to take the EUIPO cancellation decision into account.⁴

13. EUIPO Cancellation No 14788C relating to EUTM No 62638 for BIG MAC

The Applicant has referred to the above decision in its final written submissions, at paragraph [2.4], and underlined the principles according to which the EUIPO treats evidence in cases involving proof of use. Decisions of the EUIPO are not binding on this Tribunal and the evidential requirements relating to EUTMs are different to those under the Act: see the decision of Ms Anna Carboni, sitting as the Appointed Person in BL O/371/09 *G&D Restaurant Associates Limited v. Pasticceria E Confetteria Sant Ambroeus S.R.L.* The relevant legal principles to be followed by this Tribunal are set out below at paragraphs [58] – [62].

14. Notional use

The Opponent has exhibited printouts of a number of pages from the Applicant's website in its evidence (Exhibit JD6 is dealt with more fully below). How the Applicant is currently using its mark is irrelevant to the Tribunal's assessment of whether there is a likelihood of confusion between the respective marks. I must only consider the notional use of the Applicant's mark.

⁴ Earlier judgments cannot be used as evidence to support the findings of fact made therein: Mr Phillip Johnson, sitting as the Appointed Person, in BL O/258/21, *Original BUFF SA v. Baffour Owusu Amankwatia*.

15. The concept of 'notional use' was addressed in *Compass Publishing BV v Compass Logistics* [2004] R.P.C. 41 per Laddie J.:

"22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market-place but no confusion has been caused, then there cannot exist a likelihood of confusion under Art.9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s.10(2). So, no confusion in the market-place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

16. The Court of Justice of the European Union⁵ ('CJEU') has stated the following⁶:

"Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is

⁵ Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision makes reference to the trade mark case-law of EU courts.

⁶ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.

17. In my assessment, I must therefore consider all of the possible circumstances in which the mark applied for *might* be used if it were registered.

18. Decision O/347/19

The Opponent has exhibited the above decision of this Office, issued 19 June 2019, in an earlier opposition against a previous application by the Applicant for the following mark:



19. This previous opposition is irrelevant to the instant proceedings. The Tribunal's assessment of whether there is a likelihood of confusion *in this particular case* must only take into account the marks in, and relevant evidence and submissions filed in relation to, these proceedings.

20. Invoices preceding the relevant period

The Opponent has argued, at paragraph [6] of its final written submissions, that invoices which precede the relevant period are relevant because they indicate use which creates a 'market share prior to the relevant period' to be maintained by subsequent use. The Opponent argues that taking these invoices into account would, therefore, be in line with the CJEU decision in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 according to which:

'29. It follows from that line of authority that there is "genuine use" of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark.'

21. In my view, it does not necessarily follow that the Tribunal is obliged to consider invoices from outside the relevant period. An assessment of whether use of a mark is sufficient to establish genuine use entails considering the evidence relating to the relevant 5-year period and deciding whether it demonstrates use sufficient to create an outlet for the goods in question *or whether, if there were already an outlet for those goods, such use would be sufficient to preserve it*. The use necessary to create a market share is, necessarily, use sufficient to preserve a market share. If it is found that use during the 5-year period is not sufficient to *create* a market share for the goods, then it necessarily follows that the level of use is not sufficient to *maintain* a market share either.

Opponent's evidence

22. The Opponent's evidence comes from Mr Jérôme Desouches, President of the Opponent company, and Mr Christopher Lewis, Trade Mark Attorney at Dolleymores, the Opponent's representative.

23. Mr Desouches' Witness Statement is dated 12 December 2020. There are 10 Exhibits: Exhibits JD1-JD4 have been adduced in support of genuine use of the Opponent's mark; Exhibits JD5-JD10 have been adduced in support of the Opposition to the Applicant's mark.

24. Proof of Use - Exhibits JD1-JD4

Exhibit JD1

This Exhibit comprises 6 photographs, none of which are dated. The first photograph shows what appears to be packaging, in the form of a box. The box bears the name of the Opponent company, i.e. La Colline, with the words 'Swiss Riviera Beauty Treatment' beneath, as well as the mark 'Skin . Ology', beneath which appears the text 'Cellular Facial Anti-Aging Programme', along with its French translation, 'Programme Cellulaire Anti-Age Visage'.

25. The second and third photographs show, respectively: a sachet labelled 'Cellular Face Energizing Collagen Mask' and a 'pump action' bottle labelled 'Cellular Intense Radiance Serum', along with the French translations. Both products bear the name of the Opponent company and its mark, as described above.
26. The fourth photograph shows what appear to be 5 identical bottles of a product bearing the Opponent's name and mark. The full name of the product cannot be discerned from the photograph; the only text that can be seen clearly is 'Modelling Bio-Peel'. It is presumed that this product is some sort of beauty mask.
27. According to Mr Desouches' witness statement, photographs 5 and 6 show pages from the Opponent's 'Skincare Programme Brochure'. The cover page bears the Opponent's company name and the text 'Skincare Programme', though it does not feature the Opponent's 'Skin . Ology' mark. Photograph 6 displays an image of a product described as a 'Cellular Facial Anti-Aging Programme' comprising a box containing 7 items. The accompanying text suggests that the 7 items correspond to 3 different products: an exfoliant, a collagen mask and a serum. The text extols the rejuvenating properties of the products:

SKIN • OLOGY - CELLULAR FACIAL ANTI-AGING PROGRAMME

Comprising three high-performance phases, this treatment smoothes away the signs of fatigue, leaving the skin supple and glowing with vitality. An ultra-mild enzymatic exfoliation, suitable for all skin types, prepares the skin for the benefits of the collagen mask. Its perfect affinity with the epidermis allows it to infuse the tissues with powerful regenerating agents. Lastly, Cellular Intense Radiance Serum visibly reduces wrinkles and fine lines, instantly smoothing the skin and unifying the cutaneous relief. The complexion recovers its youthful glow.

28. I note that there is no information on the price of the goods, how to purchase them or to which Member State(s) the brochure is directed. The presence of text in French on the packaging, however, indicates that the goods are directed at French-speaking, as well as English-speaking, consumers.

29. Exhibit JD2

This Exhibit comprises a number of invoices, dated between 22 March 2012 and 8 July 2019, addressed to retailers based in France and Spain. The Tribunal is only able to consider invoices whose dates fall within the relevant 5-year period, i.e. 18 July 2014 and 17 July 2019.

30. The Opponent's argument that invoices dated *prior* to the relevant period are relevant has been addressed above at paragraph [20].
31. There are 61 invoices relating to the relevant period: 56 relating to sales to retailers based in France; the remaining 5 relating to sales to retailers based in Spain. The items highlighted on the invoice are listed as 'Cellular Facial Anti-Aging Programme', or its French translation 'Programme Cellulaire Anti-Age Visage'. This appears to be the only product in respect of which the Opponent is seeking to demonstrate sales.
32. It is not clear whether the invoices provided are by way of a selection or whether they demonstrate every sale of the Opponent's 'Cellular Facial Anti-Aging Programme'. The prices for the goods are expressed in Euros (€); it appears that the unit price for the product in France is €197.50, while in Spain it is between €60 to €65. The invoices provided to me demonstrate sales of 204⁷ units of 'Cellular Facial Anti-Aging Programme/ Programme Cellulaire Anti-Age Visage' amounting to €30,930.70 during the relevant period; of which €26,496 relates to sales in France (134 units) and €4,434.70 to sales in Spain (70 units). The invoices show that orders have been placed by 16 retailers in France; 2 retailers in Spain.
33. The majority of the sales in France were made to retailers based in Paris, with a few sales to retailers in the South Eastern region (the city of Grenoble; and communes⁸ including: Challes-les-Eaux, Courchevel-Saint-Bon, Saint-Jean-Cap-

⁷ The invoices demonstrate that, in addition to these 204 units, 39 units were supplied to various retailers free of charge.

⁸ An administrative division in France equivalent to a town or village.

Ferrat, Saint-Quentin-Fallavier), one sale to a retailer in Marseille, 8 sales to a retailer in Lescar in the South West of France. All 70 units sold in Spain are concentrated in Madrid.

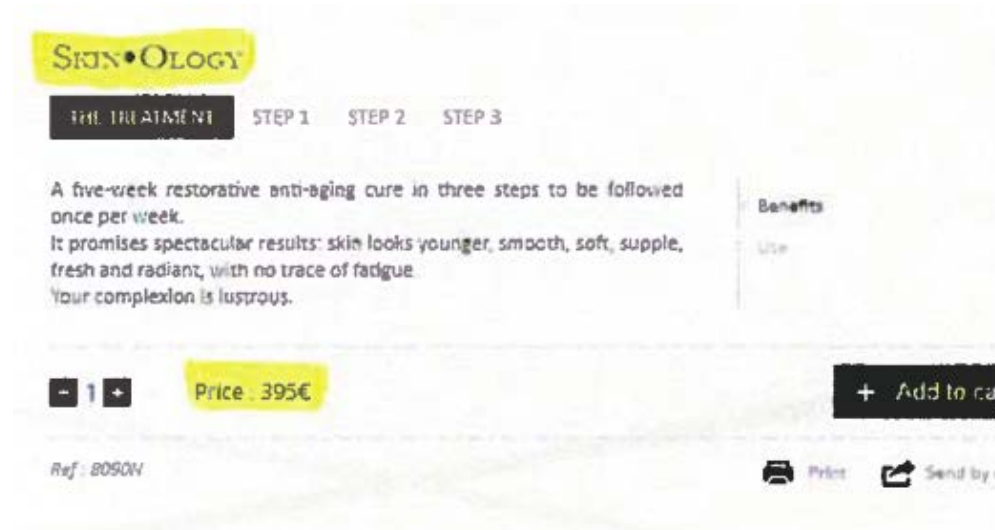
34. Sales appear to have been fairly regular, though the number of units sold was very modest; 39 of the invoices include orders of only 1 or 2 units.

35. Exhibit JD3

This Exhibit comprises a printout of a Wikipedia entry for 'Demographics of the European Union', accessed 13 December 2018. The Opponent has highlighted data in a table which indicates that the population of France accounts for 13.10% of the total population of the EU. According to these data, France is the second largest EU member state by population. Generally speaking, Wikipedia entries are, of lesser evidential value by virtue of the fact that they can be edited by any member of the public. However, it is a notorious fact that France is a major EU country.

36. Exhibit JD4

This Exhibit comprises 6 printouts of webpages from the Opponent's site obtained by Wayback Machine. Prints 1-4, dated 8 May 2016, show that there is a page dedicated to the Opponent's product 'Cellular Facial Anti-Aging Programme'. Upon magnifying the page, I am able to determine that the product featured is the product referred to in Exhibit JD1 and to which the invoices in Exhibit JD2 relate. The 'Skin . Ology' mark is displayed clearly beneath the photograph of the product. The mark also has prominence as a 'heading' above the product details and price:



The product description focuses on the anti-aging properties of the goods.

37. Prints 5 and 6, dated 18 January 2018, show the 'Skin.Ology' mark in relation to the same product for sale, albeit with different wording to describe the anti-aging properties of the goods:



38. The fact that prices are expressed in Euros indicates that the goods are marketed in the EU, at least to member states whose currency is the Euro.

39. Opposition - Exhibits JD5-JD10

Exhibit JD5

This Exhibit comprises a Wikipedia entry for the term 'Cosmeceutical', accessed 12 December 2018. Cosmeceuticals are described as 'cosmetic products with bioactive ingredients purported to have medical benefits'.

40. The Opponent submits, at paragraph [30] of its written submissions, that its goods are cosmeceuticals, which are 'complex chemical/biological formulations used to target and improve aspects of the human appearance'. This evidence is intended to support the Opponent's contention that there is similarity and/or complementarity between the Opponent's goods and the Applicant's Class 44 services. In my view, whether or not the Opponent's goods are 'cosmeceuticals' is not of great relevance to the Tribunal in its assessment of whether or not the respective goods are similar.

41. Exhibit JD6

This Exhibit comprises 22 printouts of pages from the Applicant's website. This material is irrelevant for the reasons provided above at paragraphs [14] – [17].

42. Exhibit JD7

This Exhibit comprises printouts from the following websites, accessed 12 December 2018: www.cosmeticskinclinic.com (7 pages); www.sknclinics.co.uk (20 pages) and www.courthouseclinics.com (5 pages).

43. The pages from the website of The Cosmetic Skin Clinic detail various skin treatments on offer including, *inter alia*, Botox and chemical skin peels. The following text indicates that skincare products are offered alongside its treatments:

Improving skin quality and preventing its premature ageing are very important, which is why we offer a varied and comprehensive range of cosmeceutical skincare products to enhance our non-surgical, facial rejuvenation treatments.

44. The pages from the website of 'SK:N' detail skin treatments including, *inter alia*, laser hair removal, skin peels and 'anti-age injectable treatments', as well as a number of skin products. The following 'anti-aging product' is featured:



45. The pages from the Courthouse Clinics website also offer various skincare treatments (e.g. laser hair removal, microdermabrasion, skin tag removal, to name a few) alongside skincare products. Skincare products featured include the following 'age defence peptide complex' and 'age defence peptide cream':



46. Exhibit JD8

This Exhibit comprises printouts of product listings on Amazon.co.uk, accessed 12 December 2018. Mr Desouches states, at paragraph [11] of his Witness Statement, that there are:

‘products that are available to purchase from Amazon.co.uk and which enable the consumer to self-administer, in their own home, the services for which the Applicant is seeking registration. This includes:

Dermal filler treatments; lines and wrinkles treatments, Radio Frequency skin tightening treatments; LED light skin treatments; Body fat freezing treatments; Microdermabrasion treatments; Mole and skin tag removal; Age Spot Removal; Laser hair removal; Cellulite and body shaping treatments; Thread vein removal.’

47. This Exhibit includes the product ‘Avon Revolutionary Clinical Pro Line Corrector Targeted Dermal Filler with AF-33’. The following details indicate that the product is not a substance to be injected into the body but rather a cosmetic applied topically:

- Pin-point pen targets the 3 dimensions of fine lines and wrinkles - length, width and depth.
- Formulated with exclusive collagen-boosting A-F33, to help fill and reduce wrinkles and expression lines throughout the day.
- Apply to frown lines, smile lines and crow's feet to get targeted results fast.
- 90% of women showed an instant improvement in deep expression lines.
- Formulated with exclusive collagen-boosting A-F33.

48. The remaining product listings relate to machines or devices, rather than preparations, intended to bring about cosmetic results.

49. Exhibit JD9

This Exhibit comprises information printed from the website of NHS Direct Wales on Non-surgical cosmetic procedures, accessed 12 December 2018. The Introductory paragraphs state that these procedures 'aren't regulated in the same way as cosmetic surgery, and practitioners of many treatments don't require medical qualifications'. Mr Desouches indicates in his witness statement, at paragraph [12], that this evidence has been adduced to refute the Applicant's claim that their 'services cannot be provided by an unqualified person outside of a specialised clinic.'

50. Whether or not the Applicant's services are regulated is of little importance in the Tribunal's assessment of the likelihood of confusion between the respective marks. Whether those administering the treatments are medically qualified or not, the fact remains that *services* are, by their very nature, administered by a professional person (i.e. in the course of a business) in contrast to *goods* which are, by their very nature, tangible items. Even if the Applicant's class 44 services are not regulated, that factor alone would not guarantee that the Applicant's services are similar to the Opponent's goods.

51. Exhibit JD10

This Exhibit comprises decision O/347/19, issued 19 June 2019, in the opposition brought by the Opponent against a previous application by the Applicant and has been addressed above in paragraphs [18] and [19].

52. Witness Statement of Mr Christopher Lewis

Mr Lewis' Witness Statement is dated 26 March 2021. The evidence adduced comprises the EUIPO decision in Cancellation No 33041C (Exhibit CL1) already addressed at paragraphs [10] – [12]. Exhibit CL2 comprises an official letter from the EUIPO, dated 20 July 2020, confirming that the above-mentioned decision had become final and is also, therefore, irrelevant for the reasons already provided.

Applicant's submissions in evidence round

53. The Applicant's written submissions of 15 February 2021 include the following points:

- That the Opponent's evidence is insufficient to establish genuine use of its mark in relation to the goods in respect of which it is registered;
- That there is no likelihood of confusion between the respective marks.

54. At paragraph [4.9] the Applicant submits that:

"...it is informative that between May 2017 ... and the present day there has not been a single instance of confusion on the part of the relevant public between the Applicant and the Opponent. This demonstrates that in the real world there is in fact no likelihood of confusion between the Application and the Registration."

55. I bear in mind the following Court of Appeal decision which cautions that an absence of *evidence* of confusion does not conclusively establish that there is no likelihood of confusion:

In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

“80.the likelihood of confusion must be assessed globally taking into account all relevant factors and having regard to the matters set out in *Specsavers* at paragraph [52] and repeated above. If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. But conversely, the absence of actual confusion despite side by side use may be powerful evidence that they are not sufficiently similar to give rise to a likelihood of confusion. This may not always be so, however. *The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.*” [my emphasis].

56. The following Decision has been made after careful consideration of the papers before me.

Decision

Genuine Use

57. Section 6A of the Act provides that:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be

construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

58. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows⁹:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

⁹ Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

[EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

59. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase

of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a

genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Use in relation to an EUTM:

60. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

61. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the

territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

62. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

63. The onus is on the Opponent, as the proprietor of the earlier mark, to show use because Section 100 of the Act states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

64. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole; not whether each individual piece of evidence shows use by itself¹⁰.

65. The Opponent’s submissions on the issue of genuine use, set out at paragraphs [14] – [19] of its written submissions, can be summarised as follows:

- that use of the Opponent’s mark has been ‘stable and consistent’ throughout the relevant period;
- the mark has been used in relation to goods which fall under both terms within the specification, i.e. *Anti-ageing cosmetic products* and *beauty masks*, as an indicator of the origin of those goods;
- that the high price point of the goods places them at the upper end of the market and that, therefore, there is the expectation that fewer units will be sold than is the case with cheaper products;
- that use of the mark in France constitutes use in a substantial part of the EU by virtue of the fact that the population of France comprises over 13% of the population of the EU as a whole.

66. The main thrust of the Applicant’s arguments regarding genuine use of the Opponent’s mark seems to be that the Tribunal ought to reject the Opponent’s evidence on the ground that individual Exhibits, considered in isolation, have ‘evidential deficiencies’ (paragraph [1.4] of Applicant’s final written submissions). Examples given include: the fact that the photographs in Exhibit JD1 are undated and the fact that the mark is not shown on any of the invoices in Exhibit JD2.

¹⁰ Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, GC.

67. In my view, the evidence adduced by the Opponent is not impressive; but nor is it devoid of probative value. The provision of revenue figures for the relevant 5-year period would have strengthened the evidence and would not have been onerous to obtain. However, my global assessment has determined that the totality of the evidence presented succeeds in establishing that the Opponent has made genuine use of its mark during the relevant period. The material adduced is such that where an individual piece of evidence, taken in isolation, has evidential shortcomings, other pieces of evidence are able to 'fill in the gaps'.

68. Despite the photographs in Exhibit JD1 being undated, the Wayback prints supplied at Exhibit JD4 clearly demonstrate use of the Opponent's mark in relation to its product 'Cellular Facial Anti-Aging Programme' on 8 May 2016 and 18 January 2018, dates within the relevant period. Mr Desouches has stated in his witness statement that the items highlighted in the invoices are 'Skinology' goods and that they are packaged as shown in Exhibit JD1. I am satisfied that the product of the same name referred to in the invoices is the product featured in the undated photographs as well as the Wayback prints. The product name 'Cellular Facial Anti-Aging Programme', or, in French 'Programme Cellulaire Anti-Age Visage', is lengthy and specific.

69. The presence of the Opponent's mark (whether in the form 'Skin . Ology' or 'Skinology') on the invoices would have strengthened the evidence of use of the mark. I note, however, that brands do not appear to have been mentioned in relation to any of the other items enumerated in the invoices either. The Applicant argues, at paragraph [3.14] of its written submissions of 15 February 2021, that the disparity between the pricing of the goods on the Opponent's website and the prices shown on the invoices casts doubt on whether the respective Exhibits relate to the same product. I disagree. The goods to which the invoices relate were sold to retailers and, therefore, wholesale prices will apply; whereas prices on the Opponent's website are retail prices and will, therefore, necessarily be higher.

70. Based on the invoices available to me, I find that sales have been fairly frequent even though many orders have been very small. Prices have been expressed in Euros (€) which indicates that the goods are aimed at, and have been sold in, the EU market. The bulk of the sales has been to retailers in France, with a reasonable geographical spread. The fact that many of the retailers have been returning customers indicates that there is some demand for the Opponent's goods. I note that, in many cases, retailers have ordered just one or two units of the Opponent's goods at a time; however, I also note that a significant number of products besides the Opponent's are ordered in such quantities. I therefore consider demand for the Opponent's goods sold under its earlier mark to be of a similar level to demand for a number of other skincare products listed on the invoices.

71. The evidence available to me demonstrates that the Opponent has availed itself of the following two trade channels through which to market its goods in the EU: directly via its own website; and via third party retailers.

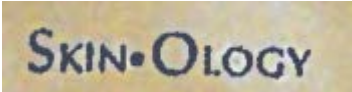
72. The product names displayed on the packaging in the photographs in JD1, together with the images and product information shown in the Opponent's webpages, demonstrate that the product being marketed and sold is an anti-aging skincare product which includes a beauty mask.

73. Consequently, I find that the Opponent has succeeded in establishing genuine use of its mark for the relevant period in respect of the terms *anti-aging cosmetic products; beauty masks*.

74. Variant use of the mark

In reaching my conclusion, I have borne in mind the provision laid down by Section 6A(4)(a) of the Act according to which 'use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered....'.

75. The Applicant submits, at paragraph [3.7] of its written submissions of 15 February 2021, that the use of the mark on the Opponent's products constitutes unacceptable variant use of the mark as registered. The forms of the mark to be compared are:

Opponent's mark as registered:	Opponent's mark as used:
SKIN · OLOGY	

76. The test for whether variant use of a mark constitutes genuine use under s46(2), which is the equivalent of section 6A(4(a) of the Act, was summarised by Mr Richard Arnold Q. C. (as he then was) in *Nirvana Trade Mark*, BL O/262/06:

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

77. The only difference between the mark as registered and the mark as used is the magnification of the font size for the 'S' and 'O' of 'Skin' and 'Ology' in the mark as used. The distinctive character of the registered mark resides in the combination of 'Skin' with 'Ology' with a dot placed between those two elements. In my view, this magnification of the 'S' and 'O' in the mark as used does not alter that character. The separation of the two elements by the dot between them

remains unchanged. I therefore find that this iteration of the mark constitutes 'genuine use'.

Opposition under s5(2)(b)

Section 5(2)(b) of the Act and related case law

78. Section 5(2)(b) of the Act states:

“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.”

80. The following principles are derived from the decisions of the Court of Justice of the European Union (“CJEU”)¹¹ in:

Sabel BV v Puma AG, Case C-251/95; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97; *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98; *Matratzen Concord GmbH v OHIM*, Case C-3/03; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case

¹¹ Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

81. Similarity of goods and services – Nice Classification

Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the ‘Nice Classification’ means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

82. I must therefore be mindful of the fact that the appearance of the respective goods or services in different classes is not a sufficient condition for dissimilarity between those goods or services.

83. The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 held that:

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

84. The Tribunal may group goods (or services) together for the purposes of assessment:

Separode Trade Mark BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

85. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

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

86. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281¹², identified the following factors for assessing similarity of the respective goods and services:

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

87. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.¹³

¹² *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

¹³ *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

88. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods [or services]. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

89. In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“...it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

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

Opponent's mark:	Applied-for mark:
<p>Class 3 <i>Anti-aging cosmetic products; beauty masks.</i></p>	<p>Class 3 <i>Cosmetics; skin care products; skin creams; cleansers; toners; moisturisers; sun creams; sun tan lotions; vitamin creams and serums.</i></p> <p>Class 44 <i>Botulinum toxin treatments; dermal filler treatments; providing dermatological treatments; microdermabrasion treatments; skin peel treatments; radio frequency skin tightening treatments; fractional laser skin treatments; mole and skin tag removal treatments; LED light skin treatments; body fat freezing treatments; cellulite and body shaping treatments; laser treatment for hair removal; sweating reduction treatments; lines and wrinkles skin treatments; acne treatments; unwanted hair removal treatments; unwanted fat or cellulite removal treatments; age spots and pigmentation removal treatments; facial thread veins and redness removal treatments; leg thread veins removal treatments.</i></p>

91. I will make my comparison with reference to the Applicant's goods and services, all of which have been opposed.

Class 3 goods

92. As noted above at paragraph [5], the Applicant has conceded that the *goods* in the Application are either identical or highly similar to those protected in the Opponent's trade mark'.

93. I find that *both* of the Applicant's broad class 3 terms *cosmetics* and *skin care products* will include *both* of the Opponent's class 3 terms *anti-aging cosmetic products* and *beauty masks*. The Applicant's *cosmetics* and *skin care products* are therefore *Meric* identical with the Opponent's goods.

94. In my view, *cleansers; toners; moisturisers; skin creams and vitamin creams and serums*, will include versions of the products described as having anti-ageing properties. These will fall under the Opponent's term *anti-aging cosmetic products*. I therefore also find these goods to be *Meric* identical with the Opponent's goods.

95. I now compare the Applicant's *sun creams* and *sun tan lotions* to the Opponent's *anti-aging cosmetic products*. *Anti-aging cosmetic products* often contain SPFs (sun protection factors). Consequently, I find *sun creams* and *sun tan lotions* to be highly similar to the Opponent's goods.

Class 44 services

96. I now compare the Applicant's class 44 services against the Opponent's term *anti-aging cosmetic products*. With the exception of *sweating reduction treatments* (dealt with below at [97]), the Applicant's services are intended enhance the condition and appearance of the skin through, *inter alia*, removal of wrinkles, hair, scarring and thread veins. The Opponent's goods are intended to enhance the condition and appearance of the skin to make the user look more

youthful. The respective goods and services therefore overlap in terms of purpose. Methods of use will differ; the Opponent's goods will be applied topically by the consumer themselves, whereas the Applicant's services will be administered by a professional. There will be consumer overlap; consumers of both will be seeking to enhance the condition and or appearance of their skin. Trade channels will be shared to the extent that some providers of the Applicant's services will also sell *anti-aging cosmetic products* alongside treatments. The physical nature of the respective goods and services will necessarily be very different. Goods are tangible objects whereas services are acts carried out by a professional person. In my view, there is some complementarity between the respective goods and services. Goods under the term *anti-aging cosmetic products* may well be recommended to consumers of the Applicant's treatments by way of aftercare, for example. Exhibit JD7 demonstrates that other businesses providing similar services to those provided by the Applicant also provide goods similar to those sold by the Opponent. Consequently, I find that, with the exception of *sweating reduction treatments*, the Applicant's services are similar to the Opponent's goods to a medium degree.

97. I now compare the Applicant's *sweating reduction treatments* against the Opponent's *anti-aging cosmetic products*. The purposes of the respective goods and services will be very different. The Applicant's treatment is specifically intended to reduce sweating and, therefore, has a functional aim; whereas the Opponent's goods are intended for beautification. The users will also be different; users of the Opponent's goods will be seeking a more youthful appearance whereas users of the Applicant's treatments will be hoping to reduce their sweating. The respective methods of use will differ. The Opponent's goods will be applied topically to the skin by the consumers themselves, whereas the Applicant's services will be administered by a professional person using a syringe. The physical nature of the respective goods and services will necessarily be very different, in the way described above at [96]. Trade channels will overlap somewhat; some businesses providing *sweating reduction treatments* may well also sell *anti-aging cosmetic products*. The purposes of the respective goods and services are so distinct that I do not consider there to be a competitive relationship; nor do I find any complementarity.

98. Consequently, I find that the Applicant's *sweating reduction treatments* are similar to the Opponent's *anti-aging cosmetic products* to no more than a low degree.

Average consumer and the purchasing act

99. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

100. In *Hearst Holdings Inc*¹⁴ Birss J. described the average consumer thus:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

101. I consider that the average consumer of the class 3 goods will be, predominantly, a member of the general public; a smaller number of purchasers will be members of the professional public looking to equip beauty salons or clinics, health spas and the like with products to be used in the provision of their services, or to be sold alongside them. Purchasers of the Opponent's *anti-aging cosmetic products* will be hoping to improve the condition and appearance of their skin by targeting signs of ageing. Purchasers of the Applicant's goods will also be seeking to enhance their skin's condition and appearance, though their concerns will not always be focused on anti-ageing.

¹⁴ *Hearst Holdings Inc Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch).

102. The price of the goods will range from a few pounds to many pounds. In my view, the goods would be purchased with at least an above average degree of attention. Consumers would likely consider factors including whether the product is scented or non-scented, or hypoallergenic; in retail premises, some consumers would also sample the product by applying a small amount to the back of their hand from a ‘tester’ bottle/tube. The goods will, in most cases, be purchased by self-selection based on visual inspection of the goods, either physically from shelves in shops or online. Some purchases may also be made aurally by way of discussion with a professional or recommendations from other consumers. There will be a range of price points and an accordingly varied degree of attention (though, as noted above, at least an average degree of attention).

103. I now consider the average consumer of the Applicant’s class 44 services. I find the average consumer of these services to be a member of the general public with a specific concern about the condition or appearance of their skin. These treatments will involve, *inter alia*, a minor surgical procedure (e.g. mole and skintag removal), the injection of a chemical into the skin or other tissue (e.g. dermal fillers) or the focusing of intense light on to an area of skin (e.g. laser hair removal). These procedures will therefore entail a degree of risk. The treatments will also be expensive, ranging from tens to several thousands of pounds¹⁵. The purchasing decision will likely be made after, first of all, viewing information displayed on a website or brochure, followed by a consultation and discussion with a practitioner at the service provider’s premises involving an examination of the proposed area of the skin for which treatment is sought. In some instances, for example laser treatments, a ‘patch test’ will be performed involving a small area of skin; the treatment would proceed only in the absence of adverse effects. In my view, decisions to undergo these treatments will not be taken lightly. I therefore find that the Applicant’s services will be purchased with a high level of attention.

Comparison of the marks

¹⁵ Exhibit JD7, at [217] – [227], includes the price list for treatments provided by ‘Sk:n Clinics’ and I have no reason to consider these prices atypical.

SKIN · OLOGY	ASKINOLOGY
Opponent's (Earlier) mark	Applicant's (contested) mark

104. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

105. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks, and to give due weight to any other features which are not negligible and, therefore, contribute to the overall impressions created by the marks.

106. The Opponent's mark comprises the two elements 'SKIN' and 'OLOGY' separated by a space in which a small dot occupies a central position. The text is rendered in a plain font of uniform size, all characters being in upper case. The overall impression resides in the mark in its entirety; neither element having greater weight in the overall impression than the other.

107. The Applicant's mark comprises a single word element 'ASKINOLOGY' rendered in a plain uniform font, all characters being in upper case. The overall impression resides in the mark in its entirety

108. Visual comparison

The word elements comprising the Opponent's mark are wholly incorporated in the Applicant's mark in the order in which they appear in the earlier mark. The points of difference are:

- The 'SKIN' and 'OLOGY' components of the Opponent's mark are separated as described above in paragraph [106], and the presence of a dot between them which is absent from the Applicant's mark;
- The presence of the letter 'A' at the start of the Applicant's mark, which is absent from the earlier mark;
- And the fact that the letters comprising the Applicant's mark are run together as one word.

109. Consequently, I find that the level of visual similarity between the respective marks is at least medium.

110. Aural comparison

I consider that the Opponent's mark will be articulated as 'SKIN-OL-UJEE', with the emphasis on the second syllable. The Applicant's mark will be articulated as 'ASS-KIN-OL-UJEE', with emphasis on the third syllable. I do not consider the space and dot between the 'SKIN' and 'OLOGY' in the Opponent's mark to be discernible aurally; to my mind, the two elements would naturally flow together when spoken, as if one word. But for the first letter of the Applicant's mark, the marks are aurally identical. I find the marks to be similar to a high degree.

111. Conceptual comparison

The Opponent has submitted the following at paragraph [44] of its written submissions:

Conceptual similarity: neither mark has a meaning in the English language, or one that would be recognised by the average consumer in the UK, and, as such, the marks are conceptually neutral. This, therefore, has no bearing on the assessment of the similarity of the marks.

112. The Applicant has not addressed the matter of conceptual similarity in its written submissions.

113. In my view, the absence of a word from the English language does not necessarily preclude that word from conveying a concept. Dealing with the Opponent's mark first, I find that the separation of the 'SKIN' and 'OLOGY' elements by the space and the dot, as described above in paragraph [106], divides the 'word' into two. The average consumer will recognise the word 'SKIN' because it is a common word in the English language denoting the outer surface of the body. The average consumer will also, in my view, be familiar with the element 'OLOGY' as a common ending to a word denoting a certain field of study or area of expertise, e.g. biology, psychology, reflexology etc. In my view, the fact that there is no such word as 'skinology' in the English language does not prevent the mark from conveying the idea of a field of enquiry focused on the skin.

114. I now turn to the Applicant's mark. Although the word 'SKIN' is incorporated into the word 'ASKINOLOGY', it is less readily discernible upon visual exposure to the mark than in the case of the Opponent's mark. I consider that the presence of the 'A' prevents the 'SKIN' element from 'jumping out' of the mark with the same immediacy with which it is seen in the Opponent's mark. In my view, the presence of 'A' as the first letter of the mark also 'reveals' the word 'ASK'. I consider that for some average consumers, the word 'ASK' would be seen first, whereas for others, the word 'SKIN' will be noticed first. I find that the 'OLOGY' element of the mark will be understood by the average consumer in the way described above under paragraph [106].

115. In my view, a significant proportion of average consumers will see the word 'SKIN' in the mark. For those consumers, the mark will convey the same concept described above at [114]. For the group of average consumers who discern 'ASK', the presence of the 'A' prevents the word from being meaningful beyond conveying the notion that the user of the mark has some sort of expertise or specialism.

116. Consequently, I find that, for the average consumer who sees 'SKIN' in the Applicant's mark, the marks are conceptually highly similar. For the average consumer who sees 'ASK', the respective marks are conceptually similar to no more than a medium degree.

Distinctive character of the earlier mark

117. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV, Case C-342/97* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting

the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

118. I consider the Opponent’s mark to be somewhat descriptive of, and allusive to, the goods in respect of which it has been registered and for which genuine use has been proven i.e. *anti-aging cosmetic products; beauty masks*. The inherent distinctive character of the mark derives from the addition of ‘OLOGY’ to ‘SKIN’ which conveys the notion of expertise in the field of skincare. I conclude that the earlier mark is inherently distinctive to an average degree.

119. The evidence available to me does not demonstrate use of the Opponent’s mark in the UK. Consequently, I do not find the inherent distinctive character of the mark to be enhanced.

Likelihood of confusion

120. Confusion can be direct or indirect. Mr Ian Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹⁶. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹⁷, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a ‘sub brand’, for instance.

¹⁶ Case BL O/375/10 at [16].

¹⁷ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

121. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [80].

122. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods may be offset by a lesser degree of similarity between the marks, and vice versa.

123. My comparison of the respective goods and services has determined that:

- The following **class 3** goods are **identical** with the Opponent's *anti-aging cosmetic products*:

Cosmetics; skin care products; skin creams; cleansers; toners; moisturisers; vitamin creams and serums.

- The following **class 3** goods are **highly similar** to the Opponent's *anti-aging cosmetic products*:

sun creams and sun tan lotions.

- With the exception of *sweating reduction treatments*, the Applicant's **class 44** services are **similar** to the Opponent's *anti-aging cosmetic products to a medium degree*;
- *sweating reduction treatments* in **class 44** are **similar** to the Opponent's *anti-aging cosmetic products to no more than a low degree*.

124. My comparison of the marks has determined that:

- The level of visual similarity between the marks is at least medium;
- The marks are aurally similar to a high degree;
- For the average consumer who sees ‘SKIN’ in the Applicant’s mark, the respective marks will be highly conceptually similar. For the average consumer who sees ‘ASK’, the marks are conceptually similar to no more than a medium degree.

125. I have found that the Opponent’s mark is inherently distinctive to an average degree. The CJEU held in *Sabel*¹⁸ that:

“24. The more distinctive the earlier mark, the greater will be the likelihood of confusion.”¹⁹

126. I find that a significant proportion of average consumers would confuse the marks. Although, for some average consumers (i.e. those who see ‘ASK’ in the Applicant’s mark), the marks will be conceptually similar to no more than a medium degree; for the significant proportion of average consumers who see ‘SKIN’, the marks will be highly conceptually similar. The inherent distinctive character of the earlier mark derives from the combination of ‘SKIN’ with ‘OLOGY’ which conjures the idea of expertise in the field of skincare. ‘SKINOLOGY’ is wholly incorporated in the Applicant’s mark ‘ASKINOLOGY’, the only difference being the presence of the ‘A’ at the beginning of the mark. In

¹⁸ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

¹⁹ This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited* BL O-075-13:

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

these circumstances, it is my view that when the average consumer tries to remember the Applicant's mark, the 'A' may be forgotten and therefore missing from the image in the 'mind's eye'. I find this to be the case even where the Applicant's services are purchased with a high level of attention. There is a likelihood of confusion.

Final Remarks

127. The Opposition has succeeded and the application is refused.

COSTS

128. I award the Opponent the sum of **£1,200** as contribution towards its costs, calculated as follows²⁰.

Official fee for 5(2)(b) only:	£100	
Filing the opposition and considering the counterstatement	£200	
Preparing evidence	£600	
Preparation of submissions in lieu of a hearing	£300	
Total:		£1,200

129. I therefore order Kiwi Sun Limited to pay to La Colline International the sum of **£1,200**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

²⁰ Based upon the scale published in Tribunal Practice Notice 2/2016.

Dated this 27th day of May 2021

Mx N. R. Morris

For the Registrar,

the Comptroller-General