

O/430/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003490381

BY HAYLEY MCCAUGHRAN

TO REGISTER:

Skin Sisters

AS A TRADE MARK IN CLASS 3

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. OP600001433 BY

SAMANTHA HEATLEY

BACKGROUND AND PLEADINGS

1. On 15 May 2020, Haley McCaughran (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK (“the applicant’s mark”). The application was published for opposition purposes on 5 June 2020 and registration is sought for the following goods:

Class 3: Skin care preparations; Non-medicated skin care preparations; skin care oils, creams and lotions; Moisturiser; Skin hydrators; Hydrating creams for cosmetic use; Hair care agents and preparations; hair care lotions, creams, gels, sprays; hair shampoo; hair conditioner; toiletries; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Body cleaning and beauty care preparations.

2. On 28 July 2020, the applicant’s mark was partially opposed by Samantha Heatley (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is aimed at the following goods in the applicant’s mark’s specification only:

Class 3: Non-medicated skin care preparations; skin care oils, creams and lotions; Moisturiser; Skin hydrators; Hydrating creams for cosmetic use; beauty care preparations.

3. The opponent relies on the following trade mark:

SKINSister

UK registration no. 3370765

Filing date 28 January 2019; registration date 19 April 2019

Relying on all services, namely:

Class 44: Aesthetician services.

(“the opponent’s mark”)

4. In her notice of opposition, the opponent submits that as a result of the similarity between the parties’ marks and the identity/similarity between the marks’ goods

and services, there exists a likelihood of confusion between the marks. The applicant filed a counterstatement denying the claims made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
7. The applicant is represented by MC Legal (UK) Limited and the opponent is unrepresented. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. During the period allowed for parties to file written submissions, the opponent filed a witness statement dated 3 December 2020. I note that in her cover email to the Tribunal, the opponent referred to this document as her submissions. Given the content of the witness statement, I do not consider it to be evidence of fact but, instead, consider it to be written submissions in lieu of a hearing. I have taken this document into consideration and will refer to it below, where necessary, as the opponent’s submissions. This decision is taken following a careful perusal of the papers.
8. 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 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.

DECISION

Section 5(2)(b): legislation and case law

9. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

10. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

“(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.

12. The opponent's mark qualifies as an earlier trade mark under the above provisions.

As the opponent's mark had not completed its registration process more than 5 years before the application date of the contested mark, it is not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the services for which her mark is registered.

13. The following principles are gleaned from the decisions of the EU courts 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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

14. The competing goods and services are as follows:

The opponent's services	The applicant's goods
<u>Class 44</u> Aesthetician services.	<u>Class 3</u> Non-medicated skin care preparations; skin care oils, creams and lotions; Moisturiser; Skin hydrators; Hydrating creams for cosmetic use; beauty care preparations.

15. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

16. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

17. In her counterstatement, the applicant states that:

“The Applicant manufactures beauty products and has made an application to register in [the] appropriate class, being class 3.

The Opponent provides bea[u]tician and skin care services. The Opponent has registered for the relevant class 43. The Opponent does not have a trademark registered under class 3.

18. I note that the applicant refers to the opponent’s services being registered in class 43 when, in fact, they are registered in class 44.

19. The applicant’s goods consist of “non-medicated skin care preparations”, “skin care oils”, “creams and lotions”, “moisturiser”, “skin hydrators”, “hydrating creams for cosmetic use” and “beauty care preparations”. These goods can be said to be different types of beauty products. The opponent’s specification contains the term “aesthetician services”. The opponent, in her notice of opposition, refers to her services as “aesthetic services relating to facials, skin peels, facial microneedling, facial skin injectables, home and in clinic skin care.” Further, in the submissions referred to at paragraph 17 above, the applicant refers to the opponent’s services as beautician and skin care services. These descriptions of the opponent’s services are further supported by Collin’s Online Dictionary that defines ‘aesthetician’ as “another name for beauty therapist.”¹ I, therefore, accept that “aesthetician services” in the opponent’s specification are services that relate to beauty and skin care.

20. The opponent’s services, in my view, often include treatments with non-medicated skin care preparations, skin care oils, creams, lotions, moisturiser, skin hydrators,

¹ <https://www.collinsdictionary.com/dictionary/english/aesthetician>

hydrating creams and other types of beauty care preparations. Whilst it is true that the goods and services differ in their nature, they still share the same general purpose, i.e. beauty and skin care. The goods and services also target the same consumers meaning that there is an overlap in user. Further, the applicant's goods can be said to be important and indispensable to the provision of aesthetician services and the average consumer is likely to think that the undertaking responsible for the goods is also responsible for the services, and vice versa.² This is particularly the case given that the goods and services share trade channels in that beauty salons where the opponent's services are likely to be provided often sell their own beauty products and recommend them for further home treatments. Therefore, the commercial origin of these goods and services can coincide. Overall, I find that the applicant's goods and the opponent's services are similar to a medium degree.

The average consumer and the nature of the purchasing act

21. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

² *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

22. The average consumer of the goods and services at issue is a member of the general public. Such goods and services are selected fairly frequently, although I am of the view that the services are likely to be selected less frequently than the goods. As the goods at issue are most likely to be obtained by self-selection from the shelf of retailers such as supermarkets or beauty salons, or from the pages of a website, visual considerations are likely to dominate the selection process. However, the selection of the goods could also require the intervention of a sales assistant and the goods could be discussed with beauticians, so aural considerations must not be discounted. With regard to the services, they will, in my view, be selected primarily from signage on the high street or from the pages of magazines and websites, so, once again, visual considerations are likely to dominate in the selection process. However, as such services may also be the subject of oral recommendations, aural considerations must not be discounted.

23. The goods and services at issue are likely to range in cost from relatively inexpensive items such as skin creams to fairly expensive treatments such as deep skin peels. As for the level of attention paid by the average consumer, this will also vary on the basis that the average consumer, depending on what they are selecting is likely to have different considerations. For example, when selecting skin creams, the average consumer is likely to consider such things as suitability, ingredients used or whether the product has been tested on animals. However, for services such as skin peels, the average consumer is likely to consider such things as qualifications held by the person providing the treatment, what chemicals are being used and testimonials from previous customers. Overall, I consider that for a majority of the goods and services, the average consumer is likely to pay a medium degree of attention. However, I acknowledge that for some services, the level of attention paid will be higher than medium.

Distinctive character of the opponent's mark

24. In *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).”

25. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not pleaded that her mark has obtained an enhanced level of distinctiveness nor has she filed any evidence to that effect. Therefore, I have only the inherent position to consider.

26. The opponent’s mark is a word only mark, being ‘SKINSister’. I am of the view that the opponent’s mark being presented as one word will be overlooked and the average consumer will identify it as two separate words, being ‘SKIN’ and ‘Sister’. On the services for which the opponent’s mark is registered, the word ‘SKIN’ will be seen as descriptive of the type of services offered, in that they are services that are related to skin care. The word ‘Sister’ will be attributed its ordinary dictionary

meaning of a female sibling. Neither word is particularly remarkable from a trade mark perspective and when viewed in combination, will be allusive to the fact that the services are skin care services being provided by someone referred to by the nickname, 'Skin Sister'. Taking all of this into account, I consider that the opponent's mark enjoys a low degree of inherent distinctive character.

Comparison of marks

27. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

28. 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.”

29. 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.

30. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
SKINSister	Skin Sisters

31. The opponent's mark is a word only mark. I have set out above that the average consumer would recognise this mark as two words, being 'SKIN Sister'. There are no other elements that will contribute to the overall impression of the mark, which lies in the words themselves. The same can be said to apply to the applicant's mark on the basis that it is also a word only mark made up of two words, being 'Skin Sisters'.
32. Visually, the marks share the element of 'SKIN SISTER', albeit presented differently. I have already found that these words' presentation as one word in the opponent's mark will be overlooked. There is a difference in the addition/absence of the letter 's' that sits at the end of the applicant's mark. Taking all of this into account and also bearing in mind that both marks are registered as word only marks (meaning that they are covered for use in any standard typeface including presentation in upper or in lower case letters³), I find that the marks are visually similar to a very high degree.
33. Both marks will be pronounced in the ordinary way with the only difference coming in the pronunciation of the additional letter 's' that sits at the end of the applicant's mark. Overall, the marks are aurally similar to a very high degree.
34. Moving on to the conceptual comparison, I consider that the concept of the opponent's mark is one of someone who is referred to by the nickname 'Skin Sister'. The same concept also applies to the applicant's mark with the only difference coming as a result of the use of 'Sisters' in the plural, giving it the concept of two or more 'Skin Sisters'. In my view, this only creates a very slight point of conceptual difference meaning that the marks are conceptually similar to a very high degree.

Likelihood of confusion

35. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that

³ *Migros-Genossenschafts-Bund v EUIPO*, Case T-189/16

exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

36. I have found the goods and services to be similar to a medium degree. I have found the average consumer for the goods and services to be members of the public who will select the goods and services by primarily visual means, although I do not discount an aural component. I have concluded that the average consumer will mostly pay a medium degree of attention, however, this may be higher than medium for some services. I have found the opponent's mark enjoys only a low degree of inherent distinctive character. However, I note that a finding of low distinctive character does not preclude a finding of likelihood of confusion.⁴ I have found the marks to be visually, aurally and conceptually similar to a very high degree.

37. Taking all of these factors into account together with the principle of imperfect recollection, I consider that the average consumer is likely to mistake the applicant's mark and the opponent's mark for one another. This is particularly the case given the very high similarities between the marks. In my view, the addition of the letter 's' at the end of the applicant's mark is likely to be overlooked or forgotten, particularly considering that the average consumer tends to focus on the beginnings of marks. I, therefore, consider there to be a likelihood of direct confusion between the marks, even where the average consumer pays a higher

⁴ *L'Oréal SA v OHIM*, Case C-235/05 P

than medium degree of attention when selecting the services. For the sake of completeness, I will now move to consider indirect confusion.

38. Indirect confusion involves recognition by the average consumer of the differences between the marks. In the present case, even if the differences between the marks are noticed, I am of the view that an average consumer is likely believe that the applicant's mark is an alternative mark or a re-branding of the owner of the opponent's mark.⁵ This is because the average consumer will see the reference to 'Sisters' in the plural in the applicant's mark as being logical and consistent with a rebranding of the opponent's mark. For example, the reference to 'Sisters' in the plural (when compared with 'Sister' in the singular) is likely to be seen as a reference to the business expanding its staff or ownership and, therefore, the difference between the marks will be considered a re-branding to acknowledge that fact. I, therefore, consider there to be a likelihood of indirect confusion between the marks, even where the average consumer pays a higher than medium degree of attention when selecting the services.

CONCLUSION

39. The opposition has succeeded in its entirety and the application is refused for the following goods:

Class 3: Non-medicated skin care preparations; skin care oils, creams and lotions; Moisturiser; Skin hydrators; Hydrating creams for cosmetic use; beauty care preparations.

40. The application can proceed to registration for the following goods against which the opposition was not aimed:

Class 3: Skin care preparations; hair care agents and preparations; hair care lotions, creams, gels, sprays; hair shampoo; hair conditioner; toiletries; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Body cleaning [...] preparations.

⁵ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

COSTS

41. As the opponent has been successful, she is entitled to a contribution towards her costs. However, I note that the opponent has not been provided with a costs proforma. As a result, I am unable to deal with the issue of costs at this stage.

42. A copy of the costs proforma will be provided to the opponent upon the issuance of this decision. The opponent is hereby directed to file a completed costs proforma to the Tribunal within 14 days of the date of this decision. Once this is received, I will issue a supplementary decision dealt with the issue of costs.

43. In the event that the opponent fails to file a costs proforma within 14 days of the date of this decision, she will only be entitled to recover the official fee that was paid upon filing the opposition. Regardless of whether the opponent files a costs proforma or not, I still propose issuing a supplementary decision dealing with the issue of costs.

Dated this 8th day of June 2021

A COOPER

For the Registrar