

O-0083-23

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3575363
BY YOUNIQUE, LLC IN RESPECT OF THE TRADE MARK**

YOU·OLOGY

IN CLASSES 3 AND 35

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 424871 BY
ASOCIATED NEWSPAPERS LIMITED**

BACKGROUND AND PLEADINGS

1. Younique, LLC (“the applicant”) applied to register the trade mark “YOU•OLOGY” in the UK on 6 January 2021. It was filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union and the EU filing date was 4 May 2018. It also claims a priority date of 7 November 2017 from two US registrations. It is this priority date that is the relevant date in these proceedings. It is applied for in respect of following goods and services in classes 3 and 35:

Class 3: *Skincare products, namely, non-medicated skin care preparations; Cosmetics; Make-up; toiletry preparations; Perfumery, essential oils; fragrances.*

Class 35: *Retail services in relation to the fields of cosmetics, skincare, perfumery and fragrances; Subscription-based order fulfillment services in the fields of cosmetics and skincare; Online retail services through direct solicitation by distributors directed to end-users in the field of cosmetics, skin care and beauty products; Retail services through direct solicitation by distributors directed to end-users in the field of cosmetics, skin care and beauty products; Retail shop-at-home party services in the field of cosmetics, skin care and beauty products.*

2. Associated Newspapers Limited (“the opponent”) opposes the application on the basis of section 5(2)(b) and section 5(3) of the Trade Marks Act 1994 (“the Act”). The section 5(2)(b) ground is based upon the three earlier marks detailed below. In respect of the ground based upon section 5(3), the opponent relies only on the first two of these:

(1) 900193276

YOU

Filing date: 1 April 1996

Registration date: 7 January 1999

Goods and services relied upon:

Class 9: *Computer software*

Class 16: *Printed matter; printed publications; periodical publications; magazines.*

Class 41: *Publication of magazines; organising and conducting exhibitions, and/or events; all the aforementioned services also provided on-line from a computer database or from the Internet.*

Class 42: *Provision of news; health and beauty services; all the aforementioned services also provided on-line from a computer database or from the Internet.*

(2) 3029970

YOU BEAUTY

YOU BEAUTY

(Series of 2 marks)

Filing date: 8 November 2013

Registration date: 11 July 2014

Goods and services relied upon:

Class 35: *Advertising, marketing, public relations, publicity and promotional services; classified advertising services; promotional advertising services; advertising and promotional services for the goods and services of others; promotional advertising of travel, events, concerts, exhibitions and shows, organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; arranging and conducting marketing promotional events for others; sales promotion for others; promotional marketing; provision of advertisement programmes; advertising mail order; compilation of advertisements for use as web pages on the Internet; rental of advertising space, dissemination of advertising matter; promoting the sale of goods and services of others; promoting goods and services of others via a website offering vouchers and rebates; arranging group buying discounts; on-line trading services; provision of an*

electronic marketplace for advertising transactions; organisation, operation and supervision of loyalty, reward and incentive schemes; bonus program schemes; business research; business services; business information services; business management and administration; business organisation and management consultancy services; business and market research, surveys and reports; market studies and analysis; compilation and provision of business information, advice and statistics; provision of commercial information; compilation and provision of product and service descriptions and comparative information; compilation, provision and dissemination of product ratings and reviews; advertising of the goods and services of other vendors, allowing customers to view and compare those vendors' goods and/or services; advertising and promotional services; online and electronic advertising; compilation and management of computer databases; compilation and provision of business directories; computerised file and database management; creating indexes of information, web sites and other resources available on a global computer network; compiling, storing, analysing and retrieving data and information; cost and revenue analysis; computerised business information storage and retrieval services; computerised data processing and business management advice and consultancy; storage of information; computerised database management; conducting business and pricing surveys; organization of exhibitions and trade fairs for commercial or advertising purposes; television, radio and satellite commercials; news clipping services; computerised accounting; tax preparation; economic forecasting; e-commerce services, namely arranging commercial transactions, for others via online shops; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; information services relating to economic commerce; providing an online commercial information directory on the Internet; search and retrieval of information; database subscriptions; newspaper subscriptions; electronic newspaper subscriptions; magazine and electronic magazine subscriptions; telecommunications service subscriptions; compilation and provision of product and service descriptions and comparative information; market information about products and services; price comparison services; providing pricing information; internet consumer comparison shopping services; providing information on product availability, discounts and promotions; provision of information relating to special offers, discounts and promotions offered by others; product reviews offered via a website with links to the websites of others; provision of ratings, reviews and commercial information regarding retailers, businesses and service providers; provision of retail shopping and consumer goods and services information; advertising services, namely the provision of retailer location for products; comparison services enabling consumers to conveniently view and compare the goods and services of others; presentation of goods on communications media, for retail purposes; consumer advice services; provision of ratings, reviews and information regarding businesses and service providers; on-line auctioneering services via the internet; on-line ordering services; retail services, including retail services provided through a television shopping channel, internet website, mail order catalogue, magazine or newspaper publication in connection with the sale of on-line electronic publications, electronic publications

(downloadable), electronic newspapers, software, downloadable software applications, downloadable games, pre-recorded CDs, pre-recorded DVDs, pre-recorded video tapes, pre-recorded discs, optical data storage media, games and cassettes, printed matter, paper, cardboard, supplements, booklets, brochures, printed guides books, journals, magazines, newspapers, publications, instructional and teaching material, calendars, diaries, greeting cards, photo and picture frames, photograph albums, posters, pictures, maps, guides, concert and event tickets, gift vouchers, stationery, handbags, purses, wallets, key rings, luggage, clothing, footwear, headgear, hair ornaments and accessories, lingerie, clothing accessories, beach accessories, spectacles and sunglasses, sportswear, fitness clothing, exercise equipment, sports bags, gymnastic and sporting articles, fitness aids, safety clothing and equipment, air filters, air fresheners, water filters, humidifiers, dehumidifiers, air purifying apparatus and preparations, anti-allergy devices and equipment, filtering machines, textiles, bed linen, mattresses, pillows, linen, towels, bathmats, table linen, table wear, wall hangings, soft furnishings, cushions, curtains, carpets, rugs, mats, furniture, bathroom fixtures and accessories, mirrors, lamps, lampshades, lighting fixtures and fittings, artificial flowers, decorations, ornaments, candles, candle holders, room sprays and scented goods for the home, table decorations, festive decorations, Christmas tree ornaments, clocks, timers, watches, jewellery, precious and semi-precious stones, jewellery boxes, costume jewellery, pharmaceutical and veterinary preparations, dietetic substances, vitamins, minerals and supplements, sanitary preparations, sanitary ware, first aid kits, medicines, pain relief devices and preparations, insect repellent, medical and orthopaedic supports, massage instruments and appliances, facial steamers, infrared lamps, orthopaedic articles, postural aids, walking aids, hearing aids, thermometers, healthcare equipment and devices, healthcare and beauty care products, scissors, tweezers, nail clippers, nail files, razors, razor blades, shavers, shaver and razor blade sharpeners, hair clippers, epilators, personal grooming equipment and products, body cleaning and beauty care preparations, body cream, body lotion, shaving preparations, hair care products, combs, brushes, sponges, shampoo, conditioner, hair care products and treatments, hair styling preparations, hair removal products, hair removal appliances, manicure and pedicure equipment, nail polish, toiletries, bath and shower products, bath oil, bubble bath, skin care products, face cream, facial masks, facial scrubs and peels, body scrubs and peels, cleansers, toners, moisturisers, cleansing products, exfoliating products, massage oils, wash bags, cosmetic bags, eye care products and accessories, perfumery, deodorants and antiperspirants, tanning equipment, tanning and self-tan products and preparations, sun-care products, after-sun lotion, cosmetics, make up, make up remover, dentifrices, baby care products, babies' bottle warmers, food for babies, foodstuffs and drinks, food and drink products, machines for chilling, cooling and heating, domestic electric kitchen machines and tools, stoves, heaters, boilers, cookers and coolers, fans, hair dryers, hair styling appliances, machines for household use, food and beverage preparation machines, kitchen machines, blending machines, mixers, kitchen equipment and accessories, kitchen utensils, parts, fittings for all the aforementioned; comparison services enabling consumers to

conveniently view and compare the goods and services of others; advice and assistance relating to the establishment of online retail stores; conducting business and pricing surveys; recruitment advertising, recruitment services; placement services; employment counselling; career counselling; business counselling; recruitment consultancy; employment consultancy; career information and advice; personnel management; personnel selection, consultancy, counselling and advisory services; job agency services; assistance relating to recruitment and placement of staff; job applicant management services; monitoring (business) services; job applicant monitoring and tracking services; recruitment, relocation and placement of staff; negotiation and organisation of transactions for third parties; services for the taking of sales orders; ordering services for customers; information, advisory and consultancy services relating to all the aforesaid services; all the aforesaid services also provided online from a computer database, on-line directory, the Internet or other electronic media.

Class 44: *Information, advice and consultancy in relation to health, well-being, beauty, beauty therapy and physical fitness; information, advice and consultancy in relation to wellness, mental health, complimentary medicine, holistic medicine, diet and nutrition; information, advice and consultancy in relation to skin, nail and hair care; information, advice and consultancy in the field of cosmetics, perfumery, beauty products, hair, skin and nail care products; information, advice and consultancy in relation to fashion; provision of information regarding health, wellness, mental health, complimentary medicine, nutrition, diet, holistic services, beauty, massage, spa, salon, hair care, manicure and pedicure services; provision of information regarding health, wellness, mental health, complimentary medicine, nutrition, diet, holistic services, beauty, hair care, manicure and pedicure services and service providers; beauty club services; all the aforesaid services also provided on-line from a computer database, on-line directory, the Internet or other electronic media.*

(3) 3029968

YOU BEAUTY DISCOVERY

Filing date: 8 November 2013

Registration date: 21 November 2014

Goods and services relied upon:

Class 35: *Advertising, marketing, public relations, publicity and promotional services; classified advertising services; promotional advertising services; advertising and promotional services for the goods and services of others; promotional advertising of travel, events, concerts, exhibitions*

and shows, organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; arranging and conducting marketing promotional events for others; sales promotion for others; promotional marketing; provision of advertisement programmes; advertising mail order; compilation of advertisements for use as web pages on the Internet; rental of advertising space, dissemination of advertising matter; promoting the sale of goods and services of others; promoting goods and services of others via a website offering vouchers and rebates; arranging group buying discounts; on-line trading services; provision of an electronic marketplace for advertising transactions; organisation, operation and supervision of loyalty, reward and incentive schemes; business research; business services; business information services; business management and administration; business organisation and management consultancy services; business and market research, surveys and reports; market studies and analysis; compilation and provision of business information, advice and statistics; provision of commercial information; compilation and provision of product and service descriptions and comparative information; compilation, provision and dissemination of product ratings and reviews; advertising of the goods and services of other vendors, allowing customers to view and compare those vendors' goods and/or services; advertising and promotional services; online and electronic advertising; compilation and management of computer databases; compilation and provision of business directories; computerised file and database management; creating indexes of information, web sites and other resources available on a global computer network; compiling, storing, analysing and retrieving data and information; cost and revenue analysis; computerised business information storage and retrieval services; computerised data processing and business management advice and consultancy; storage of information; computerised database management; conducting business and pricing surveys; organization of exhibitions and trade fairs for commercial or advertising purposes; television, radio and satellite commercials; news clipping services; computerised accounting; tax preparation; economic forecasting; e-commerce services, namely arranging commercial transactions, for others via online shops; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; information services relating to economic commerce; providing an online commercial information directory on the Internet; search and retrieval of information; database subscriptions; newspaper subscriptions; electronic newspaper subscriptions; magazine and electronic magazine subscriptions; telecommunications service subscriptions; compilation and provision of product and service descriptions and comparative information; market information about products and services; price comparison services; providing pricing information; internet consumer comparison shopping services; providing information on product availability, discounts and promotions; provision of information relating to special offers, discounts and promotions offered by others; product reviews offered via a website with links to the websites of others; provision of ratings, reviews and commercial information regarding retailers, businesses and service providers; provision of retail shopping and consumer goods and services information; advertising services, namely the provision of retailer location for products;

comparison services enabling consumers to conveniently view and compare the goods and services of others; presentation of goods on communications media, for retail purposes; consumer advice services; provision of ratings, reviews and information regarding businesses and service providers; on-line ordering services; retail services, including retail services provided through a television shopping channel, internet website, mail order catalogue, magazine or newspaper publication connected with the sale of on-line electronic publications, electronic publications (downloadable), electronic newspapers, software, downloadable software applications, downloadable games, pre-recorded CDs, pre-recorded DVDs, pre-recorded video tapes, pre-recorded discs, optical data storage media, games and cassettes, printed matter, paper, cardboard, supplements, booklets, brochures, printed guides books, journals, magazines, newspapers, publications, instructional and teaching material, calendars, diaries, greeting cards, photo and picture frames, photograph albums, posters, pictures, maps, guides, concert and event tickets, stationery, handbags, purses, wallets, key rings, luggage, clothing, footwear, headgear, lingerie, clothing accessories, beach accessories, spectacles and sunglasses, sportswear, fitness clothing, exercise equipment, sports bags, gymnastic and sporting articles, fitness aids, air filters, air fresheners, water filters, humidifiers, dehumidifiers, air purifying apparatus and preparations, anti-allergy devices and equipment, filtering machines, textiles, bed linen, mattresses, pillows, linen, towels, bathmats, table linen, table wear, wall hangings, soft furnishings, cushions, curtains, carpets, rugs, mats, furniture, bathroom fixtures and accessories, mirrors, lamps, lampshades, lighting fixtures and fittings, artificial flowers, decorations, ornaments, candles, candle holders, room sprays and scented goods for the home, table decorations, festive decorations, Christmas tree ornaments, clocks, timers, watches, jewellery, precious and semi-precious stones, jewellery boxes, costume jewellery, pharmaceutical and veterinary preparations, dietetic substances, vitamins, minerals and supplements, sanitary preparations, first aid kits, medicines, pain relief devices and preparations, medical and orthopaedic supports, orthopaedic articles, postural aids, walking aids, hearing aids, thermometers, healthcare equipment and devices, healthcare and beauty care products, scissors, tweezers, nail clippers, nail files, razors, shavers, hair clippers, epilators, personal grooming equipment and products, shaving preparations, hair care products, combs, brushes, sponges, shampoo, conditioner, manicure and pedicure equipment, toiletries, bath and shower products, skin care products, cleansers, toners, moisturisers, wash bags, cosmetic bags, eye care products and accessories, perfumery, deodorants and antiperspirants, sun-care products, cosmetics, dentifrices, baby care products, food for babies, foodstuffs and drinks, food and drink products, machines for chilling, cooling and heating, domestic electric kitchen machines and tools, stoves, heaters, boilers, cookers and coolers, fans, hair dryers, hair styling appliances, machines for household use, food and beverage preparation machines, kitchen machines, blending machines, mixers, kitchen equipment and accessories, kitchen utensils, parts, fittings for all the aforementioned; comparison services enabling consumers to conveniently view and compare the goods and services of others; advice and assistance relating to the establishment of online retail stores; conducting business

and pricing surveys; recruitment advertising, recruitment services; placement services; employment counselling; career counselling; business counselling; recruitment consultancy; employment consultancy; career information and advice; personnel management; personnel selection, consultancy, counselling and advisory services; job agency services; assistance relating to recruitment and placement of staff; job applicant management services; monitoring (business) services; job applicant monitoring and tracking services; recruitment, relocation and placement of staff; negotiation and organisation of transactions for third parties; services for the taking of sales orders; ordering services for customers; information, advisory and consultancy services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database, on-line directory, the Internet or other electronic media.

Class 44: *Information, advice and consultancy in relation to health, well-being, beauty, beauty therapy and physical fitness; information, advice and consultancy in relation to wellness, mental health, complimentary medicine, holistic medicine, diet and nutrition; information, advice and consultancy in relation to skin, nail and hair care; information, advice and consultancy in the field of cosmetics, perfumery, beauty products, hair, skin and nail care products; information, advice and consultancy in relation to fashion; provision of information regarding health, wellness, mental health, complimentary medicine, nutrition, diet, holistic services, beauty, massage, spa, salon, hair care, manicure and pedicure services; provision of information regarding health, wellness, mental health, complimentary medicine, nutrition, diet, holistic services, beauty, hair care, manicure and pedicure services and service providers; beauty club services; all the aforesaid services also provided on-line from a computer database, on-line directory, the Internet or other electronic media.*

3. In respect of the section 5(2)(b) ground, the opponent asserts that the respective marks are similar because they all commence with the word "YOU". It submits that the "OLOGY" element of the applicant's mark is a non-distinctive suffix which does not alter the meaning of the word "YOU" and that this element will be the most significant in the mark. It states that the words "BEAUTY DISCOVERY" in its 3029968 mark and "BEAUTY" in its 3029970 mark are non-distinctive. It concludes that the marks are similar to at least a medium degree. It also asserts that the applicant's goods and services are similar or identical to the opponent's skincare and body products in Class 3 and services relating to skincare and beauty products in Class 35 and also to its information, advice and consultancy services relating to beauty, skincare and cosmetics in Class 44. It also claims that the applicant's goods and services are also similar or identical to other services protected in Class 35 and Class 41 of its

YOUBEAUTY mark but provides no reason for this statement. It concludes that because of this, there is a likelihood of confusion.

4. In respect of the section 5(3) ground, the opponent asserts that it has a reputation in relation to its “YOU” and “YOUBEAUTY” marks in respect of all of its Class 35 and Class 44 services. The opponent also claims that:

- The respective marks are confusingly similar and that the relevant public would believe there is an economic link between the respective trade mark owners;
- Use of the contested mark would take unfair advantage of the reputation of its mark because the public would make a link between its marks and the applicant’s mark and will be misled into believing that the applicant’s mark is a variation of its “YOUBEAUTY” mark. It also claims that because of the similarity to its “YOU” mark, use of the applicant’s mark will have the effect of inciting consumer interest in the applicant’s goods and services by adding the reputation of the opponent’s mark;
- Use of the contested mark will result in detriment to the reputation and distinctive character of the opponent’s marks because the opponent will have no control over the use of the applicant’s mark therefore undermining the reliability of the quality of the goods and services provided under the opponent’s marks will be undermined. Consequently, where the applicant’s goods and services are of inferior quality it will lead to tarnishment of the reputation of the opponent’s marks;
- Separately, it also claims that use of the applicant’s mark will erode the distinctive character of its marks thereby decreasing their ability to inspire an immediate association with the opponent’s services. It is claimed this would affect the economic behaviour of consumers of the opponent’s services if sales were diverted from the opponent to the applicant. It concludes that this would result in detriment to the distinctive character of its marks.

5. The applicant filed a counterstatement admitting that both its Class 35 specification and that of the opponent’s registrations include similar or identical services, namely, retail of beauty products and skin care products, but it denies the other claims made

and requesting that the opponent provide proof of use in respect of all the goods and services relied upon in its 900193276 YOU registration.

6. Only the opponent filed evidence and this will be referred to as and where appropriate during this decision.

7. A Hearing took place on 8 December 2022, with the opponent represented by Mr Michael Conway of Heseltine Lake Kempner LLP and the applicant represented by Ms Claire Evans of Graham Watt & Co. LLP.

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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

9. The opponent's evidence takes the form of the witness statement of Heather Orr, Trade Mark Attorney at Keseltine Lake Kempner LLP, together with Exhibits HO1 – HO18. Ms Orr provides evidence relating to the background of the opponent, and the YOU brand as the name of a magazine issued as a supplement to the Mail on Sunday newspaper and also as a standalone weekly magazine since 2006 and how it has been used in connection with the sale and promotion of beauty products.

DECISION

Proof of Use

10. The opponent has been put to proof of use in respect to its 900193276 YOU registration.

11. The relevant statutory provisions are as follows:

Section 6A:

“(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),
(aa) 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)-(5A) [Repealed]

(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.”

12. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

13. Section 100 of the Act states that:

“100. 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.”

14. The opponent must demonstrate use of its 900193276 YOU mark is the five-year period ending with the priority date of the base EUTM upon which the contested mark is based, namely, 8 November 2012 – 7 November 2017.

15. At the hearing, it was sensibly conceded by Ms Evans, on behalf of the applicant, that the opponent had demonstrated use in respect of print magazines and online magazines. This concession aligned with some of the submissions of Mr Conway, however, there is a technical argument he relied upon that feeds into the issue of a fair specification and I discuss that later. Mr Conway accepted that the only term in Class 9, *computer software*, would not include online magazines. In light of this, the opponent has not demonstrated any use in Class 9.

16. In respect of Class 16, Class 41 and Class 42, I must consider what constitutes fair specifications. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

17. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark

has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

18. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

19. In respect of Class 16, the term *printed matter* is extremely broad and use in respect of printed magazines is not sufficient to permit the opponent to retain such a broad term. The same applies to its broad term *printed publications*. Therefore, I consider a fair specification for Class 16 should consist of the category *periodical publications and magazines*.

20. In respect of the opponent’s Class 41 specification, Mr Conway argued that *non-downloadable magazines* are covered by the opponent’s term *publication of magazines; all the aforementioned services also provided on-line from a computer database or from the Internet* and, therefore, use should be found in respect of such services in this Class. Ms Evans did not agree. The WIPO’s list of terms proper to Class 41 includes the term “providing online electronic publications, not downloadable” and I accept that “publication of magazines ...provided online” and “providing online electronic publications” are interchangeable or at least substantially overlapping. Therefore, I consider Mr Conway’s approach to be correct, and that provision of an online magazine is fairly described by this term.

21. Mr Conway accepted that the evidence does not show use in respect of *organising and conducting exhibitions, and/or events*.

22. Finally, in respect of the terms listed in the opponent’s Class 42 specification, Mr Conway submitted that they describe the content of the opponent’s magazine and that, therefore, use of this service has been demonstrated. I do not agree. The average consumer would see a magazine. Just because a magazine may provide tips of health

and beauty is not sufficient to find that this is the provision of news or a health and beauty service. Generally, these services are distinct from the provision of a magazine and would be perceived as such. I conclude that the opponent has failed to demonstrate use in respect of the terms listed in its Class 42 specification.

23. In summary, the opponent has shown use in respect of the following and, in respect of its 900193276 YOU mark, it is entitled to rely upon the following list of goods/services:

Class 16: *Periodical publications; magazines.*

Class 41: *Publication of magazines; all the aforementioned services also provided on-line from a computer database or from the Internet.*

Section 5(2)(b)

24. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

25. The following principles are obtained from the decisions of the Court of Justice of the European Union (“the CJEU”) 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 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

26. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

27. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case,¹ 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;

¹ [1996] R.P.C. 281

(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.

28. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“the GC”) stated that:

“29. In addition, 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”.

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

30. In *Sanco SA v OHIM*, Case T-249/11, the GC 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.”

31. 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.

32. I will consider similarity to the goods and services of each earlier mark, in turn.

Earlier Mark 900193276 YOU

33. The respective goods and services are as follows:

Earlier mark’s goods and services	Contested mark’s good and services
Class 16: <i>periodical publications; magazines.</i>	Class 3: <i>Skincare products, namely, non-medicated skin care preparations; Cosmetics; Make-up; toiletry preparations; Perfumery, essential oils; fragrances</i>
Class 41: <i>Publication of magazines; all the</i>	Class 35: <i>Retail services in relation to the fields of cosmetics, skincare, perfumery and fragrances;</i>

<p><i>aforementioned services also provided on-line from a computer database or from the Internet.</i></p>	<p><i>Subscription-based order fulfillment services in the fields of cosmetics and skincare; Online retail services through direct solicitation by distributors directed to end-users in the field of cosmetics, skin care and beauty products; Retail services through direct solicitation by distributors directed to end-users in the field of cosmetics, skin care and beauty products; Retail shop-at-home party services in the field of cosmetics, skin care and beauty products.</i></p>
--	--

Class 3

34. The high point of this comparison is that the opponent’s periodical publications, magazines and publication of magazines relate to skincare products (including such products being offered for sale in the magazine) and the retailing of the same. Applying the *Canon* criteria to this comparison, it is clear that the respective nature, purpose and methods of use of the goods and services are different. Magazines are printed paper products (or online equivalents) providing entertaining reading whereas the applicant’s goods are preparations for applying to the body for changing/improving its appearance. As a result, they are clearly not in competition with each other and nor are they complementary in the sense expressed in *Boston Scientific*. Finally, there is no overlap in trade channels.

35. In summary, I conclude that neither the opponent’s Class 16 goods nor Class 41 services share any similarity with the applicant’s Class 3 goods.

Class 35

36. Again the high point of the opponent’s case is that its magazine has a focus on health and beauty, and it also provides, from time to time, offers to purchase third party goods through its magazine. Once again, the nature, purpose and method of use of a magazine is different to that of a retail service and the respective trade channels will be different and the respective goods and services will not generally be in competition. Where a magazine includes offers to buy products, this is more aligned to advertising rather than retail services because such promotions/offers do not include the services

associated with retail such as allowing the consumer to view the goods and seek information about them. The primary purpose of a magazine is to provide entertaining reading to the consumer, and they are bought for this reason whereas retail services are accessed with the principal purpose of providing an environment to compare, obtain information about goods and to purchase those goods. There may be some overlap in users because those interested in using retail services relating to skincare may also be interested in a magazine in the field of health and beauty, but this is not sufficient to find that the respective goods and services share any similarity.

37. In summary, I conclude that these respective goods and services do not share any similarity.

Earlier Mark 3029970 YOU BEAUTY and 3029968 YOU BEAUTY DISCOVERY

38. The breadth of goods and services originally relied upon by the opponent was very wide but at the hearing, Mr Conway stated that he would only rely upon the goods and services he mentioned or that are specifically mentioned in the Form TM7. I restrict my considerations accordingly.

Class 3

39. Mr Conway argued that the opponent's retail services relating to the type of goods covered in the applicant's specification are similar to at least a medium degree. He referred to the judgment of the General Court ("the GC") in *Oakley, Inc v OHIM*, Case T-116/06 where, at paragraphs 46-57, it held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods and distributed through the same trade channels.

40. He also referred to the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, where he reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of BOO! for handbags in Class 18 and shoes for women in Class 25 and use of MissBoo for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

41. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

42. Mr Conway submitted that it is common to provide the goods of the applicant through retail including being provided under a retailer's own brand. Consumers of such goods and services are ordinary members of the public and, as a consumer of such goods, I concur with this submission. It is common place to see retail establishments for such goods providing both the retail services and the goods themselves under the same trade mark. Ms Evans conceded that skincare products and the retailing of the same are complementary. Mr Conway claimed that similarity was "at least" medium. Keeping in mind the parties submissions, together with the authorities cited above, I find that there is a medium level of similarity but I would not put it higher than that.

43. In its Form TM7, the opponent also relied upon *information, advice and consultancy in relation .. beauty...; information, advice and consultancy in relation to ...skin, ... care; information, advice and consultancy in the field of cosmetics* in Class

44. These services differ in nature and purpose and methods of use to the applicant's goods. There may be overlap of users and an element of complementarity as the existence of goods of the type covered by the applicant's specification are indispensable or important for the provision of such services. I conclude this leads to no more than a medium level of similarity. In making this finding, I recognise that the provision of information, advice and consultancy relating to certain goods by the provider of such goods is not a service of the kind listed in Class 44 but rather a promotion of its own goods or something provided as part of a retail offering and proper to Class 35.

Class 35

44. The earlier mark contains the following services in its own Class 35 specification:

retail services, including retail services provided through a television shopping channel, internet website, mail order catalogue, magazine or newspaper publication in connection with the sale of ... healthcare and beauty care products, ..., body cleaning and beauty care preparations, body cream, body lotion, ... nail polish, toiletries, bath and shower products, bath oil, bubble bath, skin care products, face cream, facial masks, facial scrubs and peels, body scrubs and peels, cleansers, toners, moisturisers, cleansing products, exfoliating products, massage oils, ..., perfumery, deodorants and antiperspirants..., cosmetics, make up, make up remover, ...

45. It is common ground that these services are identical to the applicant's retail services.

Comparison of marks

46. Some similarity between the respective goods and services is required. If there is no similarity, there can be no likelihood of confusion.² I have found that the applicant's goods and services are dissimilar to those covered by the opponent's earlier mark 900193276 YOU and it, therefore, follows that there can be no likelihood of confusion. Consequently, it is not necessary to consider this issue further and I do not need to consider the similarity of the applicant's mark to this earlier mark. In respect of the remaining two earlier marks, at the hearing, Mr Conway sensibly focussed his submissions on the opponent's 3029970 YOUBEAUTY mark. My view is that the remaining earlier mark would not place the opponent in a stronger position and, consequently, I will only consider similarity of the applicant's mark with this earlier mark.

47. 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



² *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49 and *Waterford Wedgwood plc v OHIM* – C-398/07 P

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.”

48. It would be wrong, therefore, to dissect the marks artificially, 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.

49. The respective marks are shown below:

Earlier marks	Contested mark
	

50. The opponent’s mark consists of the words YOU and BEAUTY. These words retain their own identity within the mark, despite being conjoined, because they are presented in different text styles and different colours. They do not obviously form a unit, but rather they retain individual character within the mark. The word YOU is at the start of the mark. The word BEAUTY is longer and provides a contribution to the mark but as it lacks distinctiveness and appears at the end of the mark, the word YOU is the dominant and distinctive element. The applicant’s mark consists of the word YOU, a dot, and the suffix OLOGY. The opponent’s case is that OLOGY lacks distinctive character, but Mr Conway sensibly withdrew this claim. I see no reason for it to be without distinctive character. He also submitted that the dot between the YOU and OLOGY elements of the applicant’s mark results in the YOU element presenting as the dominant element. Ms Evans suggested that these elements combine to form

a unit that will be understood as meaning “the science of you”. I will discuss this in more detail shortly, but I record here that I do not agree with Mr Conway but concur with Ms Evans that the distinctive elements will combine to form a unit that is likely to be understood in the way suggested by her and this is not impacted by the presence of the dot. I conclude that the distinctive character residing in this unit rather than any single element.

51. In respect of visual similarity, both marks share the same first word YOU, but differ in other respects. The second elements that, visually, form the greater proportion of both marks, are different. I conclude that the respective marks share similarity but that this is between a low and medium level.

52. Aurally, the opponent’s mark consists of the three syllables roughly approximating to U-BEW-TY. The applicant’s mark consists of the four syllables U-OL-O-GEE. Therefore, the share only the first syllable, the remaining syllables are different and the applicant’s mark is longer. Taking all of this together, I find the respective marks share a low level of aural similarity.

53. Conceptually, the opponent’s mark will be perceived as being formed by the two unrelated concepts of YOU, being the second person pronoun, and BEAUTY meaning “...the state of being beautiful” or as a synonym meaning “good-looker, looker [informal], lovely [slang], sensation”.³ Therefore, two possible concepts appear apparent. The first is where the two words retain unconnected meanings. I consider this by far the most likely and the meaning that the majority of the relevant public are likely to perceive. There is a further possible meaning, namely, that the words form an exclamation “you beauty!” meaning “you (are a) looker” or similar. However, without an exclamation mark or context that would lead to this perception and because of the different presentation of the words leading the relevant public to see the words as being independent, I consider that this meaning is unlikely to be perceived.

54. As Ms Evans submitted, and as I noted earlier, the applicant’s mark is likely to be perceived as meaning “the science of you”. Mr Conway conceded that this is one of

³ [Beauty definition and meaning | Collins English Dictionary \(collinsdictionary.com\)](https://www.collinsdictionary.com/en/definition/beauty)

the possible meanings that may be attributed to the mark, claiming that the OLOGY element is likely to impart the impression of science and that it is common for this type of claim to be used in respect of Class 3 goods.

55. Taking the above into account, the respective marks share the concept created by the second person pronoun YOU, but they differ in all other respects, and I conclude that this creates a low level of conceptual similarity between the marks.

Average consumer and the purchasing act

56. 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*.

57. 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.”

58. The average consumer for skincare products and similar and the retail of these goods are likely to be members of the general public. The goods and services may be purchased on a regular basis and some care and attention will be paid to the suitability of the product to meet the consumer's requirements. I conclude that the level of care attention will be average, neither particularly high nor low. The purchasing process will

be predominantly visual in nature, but I do not ignore that aural considerations may play a part.

Distinctive character of the earlier trade mark

59. 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).”

60. The opponent’s mark consists of the two words YOU and BEAUTY presented in such a way as the two words retain their own identity. Ms Evans submitted that the word YOU is of a low distinctive character because it merely indicates something that is personally directed at the consumer i.e. that the goods and services are suitable for you, the consumer. Mr Conway disagreed, submitting that there is no evidence of this. He argued that, as a personal pronoun, there is no reason why it should not have

distinctive character. He conceded that it may be “very slightly allusive” but with a medium level of distinctive character. I am persuaded by Ms Evan’s submission. As a personal pronoun, the word YOU is not endowed with any great distinctive character and will be a word that is readily understood and commonly used. I must consider the mark as a whole and I note that Mr Conway accepted that the word “Beauty” is descriptive. Taking the two words together and taking account of the slight stylisation present in the mark, I conclude that it is endowed with a reasonably low level of inherent distinctive character.

61. Mr Conway urged me to take account of the reputation of the YOU element of the opponent’s YOUBEAUTY mark, arguing that its reputation means that the YOU element benefits from enhanced distinctive character. He relied upon the GC judgment in *China Construction Bank Corp. v EUIPO*, Case T-665/17, where it held (at paragraph 52 of the judgment) that evidence showing that part of the earlier mark has acquired an enhanced degree of distinctive character through use may be relevant to the assessment of the distinctiveness of that element within the earlier mark. Such enhanced distinctiveness may affect the likelihood of confusion between that mark (as a whole) and a later mark including the same, or a similar, element. However, in the current case, the reputation shown by the opponent in respect of its YOU mark relates to magazines that are dissimilar to the applicant’s goods and services. It would not be correct for a party to rely upon a reputation in part of a mark where that reputation relates to dissimilar goods and services to those relied upon because it would result in circumvention of the principle that likelihood confusion can only exist where there is some similarity between the respective goods and services. Consequently, this approach cannot apply here, and I dismiss this submission. In summary, the opponent’s mark does not benefit from an enhanced level of distinctive character in respect of the opponent’s goods and services that are identical or share similarity to the applicant’s goods and services.

Global Assessment – Conclusions on Likelihood of Confusion

62. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. I must make a global assessment of the competing

factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

63. In the current case, I have found that:

- The respective goods of the opponent's YOU mark and the applicant's mark are dissimilar and there can be no likelihood of confusion;
- In respect of comparing the contested application with the opponent's 3029970 YOU BEAUTY mark, I found:
 - The applicant's Class 3 goods share a medium level of similarity to some of the opponent's retail services and the respective Class 35 services are identical;
 - The word YOU is the dominant and distinctive element of the opponent's mark and the applicant's mark consists of elements that form a unit with no one element dominating;
 - The respective marks share a low to medium level of visual similarity and a low level of aural and conceptual similarity;
 - The average consumer is a member of the general public who will pay an average degree of care and attention during the purchasing act. This will be visual in nature but I do not ignore that aural considerations may play a part;
 - The opponent's mark is endowed with a reasonably low level of inherent distinctive character that is not enhanced through use.

64. Mr Conway submitted that the YOU element is dominant in both the opponent's marks and the applicant's mark and when factoring in imperfect recollection there is a likelihood of confusion. Ms Evans submitted that the applicant's mark is dissimilar to the opponent's mark. therefore, there is no direct likelihood of confusion. I accept that

the word YOU is the dominant element of the opponent's mark, but as I have already discussed, I do not agree that it is the dominant element of the applicant's mark. Rather it forms a unit with the OLOGY element to create a distinctive combination. Also keeping in mind that the word YOU is a personal pronoun very commonly used and understood by consumers, it is likely that the consumer will only perceive this meaning of YOU when viewing it in the context of the applicant's mark. It is not likely that it will even bring the opponent's mark to mind, let alone be confused with it. I conclude that even with identical services being involved, there is no likelihood of direct confusion when considering each mark as a whole.

65. Mr Conway also submitted that there was a likelihood of indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite

distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

66. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

67. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

68. Mr Conway submitted that there is a likelihood of indirect confusion because the applicant's mark would be perceived as a natural brand extension of the opponent's YOUNBEAUTY mark and as indicating a scientific range of the opponent's YOU products. Mr Conway claimed this falls squarely with the third group identified by Mr Purvis KC. This is an attractive submission but for the fact that the word YOU, as it appears in the applicant's mark, will be perceived as use of the personal pronoun rather than use of the YOU element of the opponent's mark. The proposition may have been attractive if the first element was more distinctive. It is not. Consequently, my view is that the average consumer will not assume that goods and services provided under the applicant's mark originate from the same or linked undertaking as the opponent's services. There is no likelihood of indirect confusion.

Summary of findings under section 5(2)(b)

69. This ground fails in its entirety.

SECTION 5(3)

70, Section 5(3) states:

“(3) A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

71.. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

72. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of the types of damage claimed will occur and/or that the contested mark will, without due cause, take unfair advantage of the reputation and/or distinctive character of the reputed mark. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

73. The relevant date for the assessment under section 5(3) is the priority date of the application i.e. 7 November 2017

Reputation

74. At the hearing Mr Conway informed me that the opponent would now only be relying upon its 900193276 YOU mark for this ground.

75. The authoritative statement as to what is required to demonstrate reputation comes from the CJEU in the *General Motors* case⁵ where the court held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

76. In *Burgerista Operations GmbH v Burgista Bros Limited*,⁴ Judge Hacon stated that “*Reputation constitutes a knowledge threshold.*” The nature of the reputation may bring with it other qualities and values, but in the first instance it is simply a question of how many of the potential consumers of the goods/services covered by the earlier mark know about it.

77. I note the following from the evidence:

- YOU has been the name of a supplement to the Mail on Sunday newspaper since 1984 with a new focus since 1994 to specifically target a female audience;⁵

⁴ [2018] EWHC (IPEC)

⁵ Ms Orr’s witness statement, para 8

- The Mail on Sunday is one of the UK's leading Sunday newspapers⁶ with a circulation of nearly 800,000 as of September 2021⁷ and 735,800 in May 2022.⁸ Also, circulation figures published by the opponent show a circulation of 1 million and a readership of 2.4 million for the period April 2018 to March 2019;⁹
- The YOU mark is used primarily as a title for the magazine that has a focus on lifestyle;¹⁰
- Example covers from 1991, 1997 2010, 2011, 2015, 2016 and 2021 are provided, all showing the YOU title;^{11 12}
- The YOU magazine was redesigned and relaunched as a standalone glossy magazine in 2006 but continued to be issued as a supplement to the Mail on Sunday.¹³ Press articles recording this relaunch are provided from the Guardian newspaper, dated 6 March 2006, and the Press Gazette, dated 9 February 2006;¹⁴
- YOU magazine is available weekly in printed and electronic format with a dedicated website www.you.co.uk. This website was fully launched in 2015.¹⁵ An archived extract from the website, dated 19 August 2015, is provided.¹⁶ There is a reference to tickets for sale in respect of a "YOU Big Beauty Weekend" but otherwise there is no reference to YOU;
- The magazine has a focus on women's lifestyle issues such as beauty, fashion, interiors, health, food, travel, relationships and celebrity news and this is reflected in an extract from its website;¹⁷
- The website also features shopping advice, retail offers, advertising and promotions.¹⁸

⁶ Ditto, para 7

⁷ Exhibit HO2

⁸ Exhibit HO7

⁹ Exhibit HO8

¹⁰ Ms Orr's witness statement, para 16

¹¹ Exhibit HO3

¹² Exhibit HO5

¹³ Ms Orr's witness statement, para 10

¹⁴ Exhibit HO4

¹⁵ Ms Orr's witness statement, paras 17, 19

¹⁶ Exhibit HO10

¹⁷ Ms Orr's witness statement, para 22 and Exhibit HO11

¹⁸ Ms Orr's witness statement, para 24

- The YOU magazine also has dedicated social media channels on Facebook, Instagram, Pinterest and Twitter.¹⁹

78. I must consider whether the opponent's mark has a reputation and is known by a significant part of the public concerned. Ms Evans submitted that, at best, the evidence demonstrates a reputation in respect of "online magazines" and "magazines", but she asserted that it does not exist, even for these goods. She points to the YOU magazine only being provided as a free magazine with the Mail on Sunday newspaper or on the website www.you.co.uk. Ms Evans concluded that there is no use in respect of any services relied upon.

79. Mr Conway conceded there was no use in respect of Class 9 goods but made submissions that I accepted (see earlier comments) that the opponent's Class 41 services included online, non-downloadable magazines.

80. In respect of the submission that the magazine is only provided free with the Mail on Sunday. It is not clear that this is the case. Whilst the price will be printed on the front page of the newspaper, it is likely to be the cost for the whole package of supplements and the magazine. Consumers of printed newspapers are the general public and I comment as one of these consumers; it is normal for Sunday papers to be more expensive than their weekday equivalents and this supports the proposition that this higher cost is for the whole package including the magazine. Consequently, and in the absence of evidence to the contrary, I consider that the YOU magazine is not free when provided with the Mail on Sunday newspaper. That said, even if I am wrong and they are provided free, the use is such as to create and maintain a market for magazines and by extension, able to build a reputation for the mark in respect of such goods.

81. There is some evidence that the YOU magazine was relaunched as a standalone glossy magazine in 2006, however, there is no further information about this or what were the standalone sales were/are.

¹⁹ Ms Orr's witness statement. para 21

82. Mr Conway's submissions were confined to arguing that the opponent's YOU mark had a reputation in respect of printed and online magazines. Taking the evidence together with these submissions, I agree that the evidence clearly demonstrates the existence of a reputation of the YOU mark in respect of printed and online magazines. With this in mind, the opponent is able to rely upon the following goods and services:

Class 16: *Magazines.*

Class 41: *Publication of magazines; all the aforementioned services also provided on-line from a computer database or from the Internet.*

Link

83. As identified above, whether a link exists must be assessed globally taking account of all relevant factors, including the following:

Degree of similarity between the respective marks

84. The word YOU is the only element of the opponent's mark and the first element of the applicant's mark. The applicant's mark also contains a dot and the suffix OLOGY. Taking account of these similarities and differences, I conclude that they are similar to a low to medium degree.

Degree of similarity between the goods/services

85. As I discussed earlier, the respective goods and services are dissimilar.

Extent of the overlap between the relevant consumers for those goods/services

86. The relevant consumer of the opponent's magazine are the newspaper purchasing members of the general public. The consumer of the applicant's goods and services will be members of the general public who are users of skincare products. Insofar as both relevant consumers are drawn from the general public, there is some similarity.

The opponent goods are a lifestyle magazine aimed at female readers. This will increase the overlap.

Strength of the earlier mark's reputation

87. Taking account of the length of time that the opponent's magazine has been produced and the circulation figures associated with the Mail on Sunday newspaper (and therefore, the YOU magazine provided with the newspaper), I conclude that the magazine enjoys a strong reputation.

Strength of the earlier mark's distinctiveness

88. As I have already discussed, I consider the distinctive character of the word YOU to be reasonably low. The word is a personal pronoun and commonly understood and used as such. Consequently, the word YOU is not endowed with any great distinctive character and will be a word that is readily understood and commonly used.

89. I keep in mind that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.²⁰ The high point is that the opponent's case is that its YOU magazine is a lifestyle magazine aimed at women and will include articles about cosmetics and skin care products, but this is insufficient reason to conclude that the requisite link. This is because:

(i) the word YOU does not have the identity asserted by Mr Conway outside the field of magazines but, rather it is a very commonly used personal pronoun that has the ability to be used in a way where its dictionary meaning is retained. This is the case here, and;

(ii) because of the distance between the respective parties' goods and services the relevant public will not be prompted to make a link between them.

²⁰ *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, para 72.

90. In summary, I conclude that the requisite link is not likely to exist and, consequently, the ground based upon section 5(3) falls at this point and it is not necessary that I go on to consider detriment or unfair advantage.

SUMMARY

91. The opposition has failed, and the application may proceed to registration.

COSTS

92. The applicant has been successful and is entitled to a contribution towards its costs. I calculate the award as follows:

Considering the Form TM7 and preparing the Form TM8/defence:

£350

Considering other side's evidence £500

Preparing for, and attending the hearing: £600

Total: £1450

93. I therefore order Associated Newspapers Limited to pay Younique, LLC the sum of £1450. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 26th day of January 2023

Mark Bryant
For the Registrar