

O/267/12

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION NO 2554078
IN THE NAME OF FACEWORK ESSENTIALS, INC

AND

OPPOSITION THERETO UNDER NO 101515
BY MYFACE LLC

Background

1. Application No 2554078 seeks registration of the mark MYFACEWORKS and stands in the name of Facework Essentials, Inc (“the applicant”). Registration is sought in respect of the following goods:

Cosmetic products, namely, moisturizing mask, refreshing mask, facial toning mask and facial paper mask.

2. Following publication of the application in the Trade Marks Journal, notice of opposition was filed on behalf of Myface LLC (“the opponent”). Whilst the notice of opposition disclosed objections brought under the provisions of sections 5(2), 5(3) and 5(4) of the Act, the opponent subsequently withdrew some of them. Consequently, the opposition is now based on grounds under section 5(2)(b) only. The opponent relies on the following trade marks, both of which are registered for an identical specification of goods as follows:

Mark	No	Filing/registration date	Specification of goods
MYFACE	CTM 6162978	19.7.2007/ 29.8.2008	Soaps; perfumery, essential oils, cosmetics and hair lotions; color cosmetics, facial cosmetics, skin care products, body and foot care products, fragrances, dentifrices, bath salts, cosmetic preparations for baths, body and shower products, colognes, eau de toilettes, body firming gels and lotions, nail polishes, lipsticks, makeup, sun block and deodorants
MYFACE.COSMETICS	CTM 6835565	25.3.2008/ 29.1.2009	

3. The applicant filed a counterstatement in which it requested the opposition be rejected.

4. Neither party filed evidence or requested to be heard. The opponent did file written submissions. I give this decision from the papers before me.

Decision

5. The single remaining ground of opposition is founded on section 5(2)(b) of the Act which states:

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

(a) ...

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

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

6. 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,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. The opponent relies on the two trade marks set out at paragraph 2 above. I note that each is an earlier mark within the meaning of section 6(1) of the Act. In its counterstatement, the applicant requested that the opponent prove use of its marks, however, given the dates of registration of the earlier marks, neither is subject to the proof of use requirements and I shall say no more about this. I intend to carry out the comparison on the basis of the opponent’s mark no 6162978 as if it cannot succeed in respect of this mark, it will not be in any better position as regards its other earlier mark.

8. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). As cited with approval in *Och-Ziff Management Europe Ltd and Oz Management LP v Och Capital LLP, Union Investment Management Ltd and Ochoki* [2010] EWCH 2599 (Ch) it is clear from these cases that:

- (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, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

9. In essence, the test under Section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be

attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Comparison of goods

10. In making my comparison of the respective goods, I take note of the decision in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) Meric Case T-133/05* whereby goods and services are considered to be identical when those covered by an earlier mark are included within a broader term included within a later mark and vice versa.

11. The applicant's goods are *moisturizing mask, facial toning mask and facial paper mask* all of which are cosmetic products and, being masks, are for use in caring for the face and its skin. The opponent's specification of goods includes *facial cosmetics* and *skin care products* which would include the applicant's goods and thus, under the *Meric* principles, the respective goods are identical.

The average consumer and the nature of the purchasing process

12. The goods are cosmetic or face care products which are goods traditionally bought by women, but increasingly are also bought by men. The average consumer is therefore the general public. The goods are such as are bought on a regular basis from retail stores such as pharmacies, supermarkets and more specialist cosmetic stores or beauty salons and may be bought on the High Street or via the Internet. Depending on such matters as the type of ingredients used in them, they are available within a range of prices, however, they are relatively low cost items. These are goods which are generally available off the shelf by self selection which means the visual aspects of the mark is likely to be of most relevance but not to the extent that the other aspects can be ignored given e.g. that consumers will sometimes seek advice as to which product might best suit their skin type or which ingredients are contained within a particular product. They are goods which will be bought with some, though not the highest, degree of care given that they are for personal use on the skin.

Comparison of marks

13. The opponent's registration is for the mark MYFACE in plain block capitals. Whilst presented as a single word, it naturally breaks down into the two component parts, MY and FACE. Each of the respective words is an everyday one which is well understood by the general public. The word FACE is not distinctive when used in relation to products for use on the face, however, the two words hang together and are presented in such a way that neither of the component parts is dominant. The distinctiveness of the mark rests in its whole.

14. The applicant's mark is for MYFACEWORKS again presented in plain block capitals and as a single word but naturally breaking down into its component parts MY FACE WORKS. The mark applied for therefore begins with the words making up the earlier mark but differs in that it ends in the additional word WORKS. The word WORKS is again a dictionary word which is an everyday one with a number of meanings. As the opponent points out in its written submissions, it may refer to a

factory or other production plant or may refer to something that operates. The word WORKS is also one well known as meaning something that is pleasing or effective. It is also a word in everyday use as referring to a complete set or collection of something and would not be distinctive in respect of goods forming a range. Again, it has no dominant elements and the distinctiveness of the mark applied for rests in the mark as a whole.

15. The respective marks differ only as regards the inclusion of the non-distinctive word WORKS in the applicant's mark. There is a high degree of similarity between them from both a visual and aural perspective. From a conceptual perspective, the word MYFACE brings to mind the speaker's face. The mark applied for also brings to mind the speaker's face and could suggest that that face "works" in the sense that it is somehow pleasing or that it operates or could bring to mind a range of goods for use on the face. There is at least a fair degree of similarity between the respective marks from a conceptual perspective.

Likelihood of confusion

16. The likelihood of confusion must be appreciated globally, taking account of all relevant factors. The matter must be judged through the eyes of the average consumer. The decision of the General Court in *New Look Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 and T-171/03, indicates that the circumstances in which the relevant goods and the marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. But I also have to make an assessment of all relevant factors and take into account the fact that the consumer will rarely have an opportunity to compare marks side by side but will instead rely on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co, supra*).

17. Another factor to be taken into account is the distinctive character of the earlier trade mark having regard to its inherent characteristics and the reputation it enjoys with the public. The opponent has not filed any evidence of the use of its mark and therefore it cannot be found to have benefitted from any enhanced distinctiveness through use. I consider it to be a mark with a fair degree of inherent distinctive character.

18. I have found the respective marks to share a high degree of similarity from both a visual and aural perspective and at least a fair degree of similarity from the conceptual perspective. I have found the respective goods to be identical. Those goods are such which are an everyday purchase over which some, though not the highest, degree of care will be exercised. Taking all matters into account, I have no hesitation in finding that there is a likelihood of confusion.

Summary

19. The opposition succeeds in full.

Costs

20. The opponent has succeeded and is entitled to an award of costs in its favour. I take note that neither it nor the applicant filed any evidence, though the opponent did file written submissions. I also note that no hearing took place. I make the award on the following basis:

For preparing a statement and reviewing the other side's statement:	£300
Official fee:	£200
For preparing written submissions:	£300
Total:	£800

21. I order Facework Essentials, Inc to pay Myface LLC the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of these proceedings if any appeal against my decision is unsuccessful.

Dated the 9th of July 2012

**Ann Corbett
For the Registrar
The Comptroller General**